Hideki Takaishi Article Collection

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English Edition

388 articles

Complete English translations of the revised Ameblo articles

In chronological order of the original Ameblo publication date

Confirmed errors in wording, legal descriptions, and translations have been corrected. Unless otherwise stated, descriptions of legal rules, outlooks, and statistics reflect the time when each original article was published.

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160 2022-06-10 [US Patents] May 2017 US Supreme Court: IMPRESSION PRODUCTS v. LEXMARK

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173 2022-06-23 [US Patents] May 2018 US CAFC: TAOS v. Intersil

174 2022-06-24 [US Patents] 1998 US CAFC: Ethicon v. U.S. Surgical Corp.

175 2022-06-25 [US Patents] May 2001 US CAFC: Mycogen Plant v. Monsanto

176 2022-06-25 [Article] “Prima Facie Evidence in Applications to Suspend Imports and Exports” (Tomohiko Inui, Chief Intellectual Property Investigator, Customs Clearance Department, Tokyo Customs)

177 2022-06-27 [Article] “Study on Pleading and Proof to Rebut Presumed Damages in Patent Infringement Litigation,” Intellectual Property Management Vol. 72

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179 2022-06-29 IP High Court, 2021 (Gyo-Ke) 10056 [Information Processing Device Case] <Shoji>

180 2022-06-30 IP High Court, 2020 (Gyo-Ke) 10128 [Safety Confirmation System] <Shoji>

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189 2022-07-11 Osaka District Court, 2020 (Wa) 7486 [Apparatus and Method for Instantaneous Removal of Blood from a Fish by Injecting High-Pressure Water into the Hemal Arch] <Sugiura>

190 2022-07-11 IP High Court, 2010 (Gyo-Ke) 10265 [Socks] <Takizawa>

191 2022-07-11 [Trademark Rights] Tokyo District Court, 2019 (Wa) 8117 — Prior-use right not established

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194 2022-07-13 IP High Court, 2020 (Gyo-Ke) 10015 [Novel Formulations for Stabilizing Immunogenic Compositions and Inhibiting Precipitation] <Tsuruoka>

195 2022-07-14 IP High Court, 2008 (Gyo-Ke) 10304 [Oxygen Absorbent for Incorporation into Resin] <Takizawa>

196 2022-07-15 IP High Court, 2016 (Gyo-Ke) 10212 [Contact Terminal] <Takabe>

197 2022-07-16 IP High Court, 2019 (Gyo-Ke) 10026 [Fluid-Pressure Cylinder and Clamping Device] <Tsuruoka>

198 2022-07-16 Support requirement for an invention specified in terms synonymous with its problem

199 2022-07-17 I held a training seminar entitled “Cinematographic Works” at the Shunjukai Patent Attorneys' Association, so I am sharing an edited, shortened version.

200 2022-07-18 How the technical concept underlying motivation affects assessment of effects

201 2022-07-19 IP High Court, 2018 (Gyo-Ke) 10175 <Takabe> [Access Port]

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205 2022-07-23 IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno>

206 2022-07-23 IP High Court, 2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe>

207 2022-07-25 IP High Court, 2013 (Gyo-Ke) 10275 [Vulcanized Rubber Composition] <Ishii>

208 2022-07-26 IP High Court, 2018 (Gyo-Ke) 10108 [Waste Treatment Method] <Takabe>

209 2022-07-27 IP High Court, 2012 (Gyo-Ke) 10005 [Glucosamine-Containing Poultice] <Shiotsuki>

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212 2022-07-29 We have published an “Open Innovation” page on the NAKAMURA & PARTNERS website.

213 2022-07-30 IP High Court, 2015 (Gyo-Ke) 10081 [Crystals of Pitavastatin Calcium Salt] <Takabe>

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225 2022-08-11 IP High Court, 2020 (Gyo-Ke) 10077 [5-HT1A Receptor Subtype Agonists] <Otaka>

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228 2022-08-12 IP High Court, 2005 (Gyo-Ke) 10737 [Bactericide] <Mimura>

229 2022-08-15 IP High Court, 2021 (Ne) 10022 [Webpage Browsing Method] <Shoji>

230 2022-08-16 Tokyo District Court, 2017 (Wa) 3569 [Solenoid] <Shimasue>

231 2022-08-17 Appeal: IP High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

232 2022-08-18 U.S. Supreme Court judgment, 2022.6.13, ZF Automotive v. Luxshare

233 2022-08-19 [Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036 <A case recognizing the outer box and container as an indication of goods or business>

234 2022-08-22 Tokyo District Court, 2021 (Wa) 3816 [Vitamin D Derivative Crystals and Method for Producing Them] <Shibata>

235 2022-08-22 2022.01 U.S. CAFC — Evolusion v. Juggernaut

236 2022-08-22 <Trademark> IP High Court, 2021 (Gyo-Ke) 10010 (Otaka)

237 2022-08-23 Tokyo District Court, 1998 (Wa) 8345 [Ear-Hanging Apparatus for Cultured Shellfish] <Mimura>

238 2022-08-24 Tokyo High Court, 1998 (Gyo-Ke) 298 — Generalizing the CD-ROM embodiment to “disk recording and/or reproduction apparatus”

239 2022-08-25 Tokyo District Court, 2003 (Wa) 3552 [Quartz Crystal Resonator] <Takabe>

240 2022-08-26 Osaka District Court, 2002 (Wa) 6178 [Artificial Kidney Perfusion Agent for Bicarbonate Dialysis] <Komatsu>

241 2022-08-27 Osaka District Court, 2016 (Wa) 2688 [Coated Copper Wire for Ball Bonding]

242 2022-08-27 Tokyo District Court, 2002 (Wa) 16268 [Copper-Based Alloy for Electrical Connectors] <Iimura>

243 2022-08-29 Tokyo District Court, 2003 (Wa) 9102 [Nonaqueous Secondary Battery] <Iimura>

244 2022-08-30 IP High Court, 2005 (Ne) 10052 [Electronically Detectable and Deactivatable Marker] <Tsukahara>

245 2022-08-31 Tokyo High Court, 2003 (Ne) 1223 [Method for Searching for Stable Complex Structures of Biological Macromolecules and Ligand Molecules] <Yamashita>

246 2022-09-01 Tokyo District Court, 2003 (Wa) 6742 [Narrow-Necked Bottle with Packaging Label] <Takabe>

247 2022-09-02 Osaka District Court, 1992 (Wa) 6690 [Transfer Printing Sheet] <Komatsu>

248 2022-09-03 IP High Court, 2021 (Ne) 10007 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda>

249 2022-09-03 IP High Court, 2019 (Ne) 10009 [Roll Paper for Packaging Medicine into Individual Doses] <Otaka>

250 2022-09-05 Tokyo District Court, 2002 (Wa) 9503 [Nucleic Acid Amplification Reaction Monitoring Apparatus]

251 2022-09-06 Osaka District Court, 2003 (Wa) 13703 [Hair Treatment Promoting Apparatus] <Yamada>

252 2022-09-07 Tokyo High Court, 2004 (Gyo-Ke) 4 [Pipe-Mounting Fitting for Balconies] <Tsukahara>

253 2022-09-08 Tokyo High Court, 2001 (Gyo-Ke) 392 [Biaxially Oriented Polyamide Film and Method for Producing It] <Sato>

254 2022-09-09 IP High Court, 2020 (Gyo-Ke) 10004; IP High Court, 2020 (Gyo-Ke) 10056

255 2022-09-10 Tokyo District Court, 2018 (Wa) 35053 “2UNDR Case”

256 2022-09-12 Tokyo High Court, 2000 (Gyo-Ke) 120 [Nickel Electrode Active Material for Alkaline Storage Batteries] <Yamashita>

257 2022-09-12 Tokyo District Court, 2002 (Wa) 1943 [Finely Powdered Fossil Coral] Case

258 2022-09-13 IP High Court, 2021 (Gyo-Ke) 10136, 10138 [Soldering Apparatus] <Honda>

259 2022-09-13 I will speak at “Sugoi Chizai EXPO” (October 6–7, 2022) on “20 Selected Important Patent Decisions”

260 2022-09-14 IP High Court, 2020 (Ne) 10059 [Equol-Containing Extract and Method for Producing It] <Honda>

261 2022-09-15 <Article> A Study of Judicial Determinations on Priority (Intellectual Property Management, Vol. 72, No. 4, 2022)

262 2022-09-15 Trade Secrets (Keeping Information Confidential) — Choosing a Strategy for Protecting Corporate Technical Information

263 2022-09-16 IP High Court, 2008 (Gyo-Ke) 10196 [Die-Bonding Material and Bonding Method] <Nakano>

264 2022-09-20 IP High Court, 2019 (Gyo-Ke) 10142 [Roll Product Package] <Mori>

265 2022-09-20 Tokyo High Court, 2001 (Ne) 959 [Substituted Purines (Acyclovir)] <Yamashita>

266 2022-09-20 Tokyo High Court, 2004 (Ne) 1589 <Tsukahara> [Liquid-Crystal Composition] = First instance: Tokyo District Court, 2002 (Wa) 25697

267 2022-09-20 [Design] IP High Court, 2021 (Gyo-Ke) 10067 — The articles of the design at issue and the cited design differ. ⇒ Novelty affirmed.

268 2022-09-20 [YouTube Shorts] [Patent] Comparison of Exhaustion Doctrines in Japan and the United States

269 2022-09-20 [YouTube Shorts] [Patent] The “Resolution” of an Invention

270 2022-09-20 [YouTube Shorts] [Patent] What Is a Pioneer Invention?

271 2022-09-21 Tokyo District Court, 2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

272 2022-09-22 Tokyo High Court, 2002 (Gyo-Ke) 58 “Sewing Machine” (Yamashita)

273 2022-09-23 [Unfair Competition Prevention Act; Copyright] Kyoto District Court, 2020 (Wa) 1874

274 2022-09-23 [YouTube Shorts] The Extent to Which a Patent “Co-Owner” May Freely Grant Licenses and Take Similar Actions

275 2022-09-23 NAKAMURA & PARTNERS Has Been Rated Outstanding in the Asialaw Rankings

276 2022-09-27 IP High Court, 2010 (Gyo-Ke) 10122 <Iimura>

277 2022-09-27 [YouTube Shorts] CGC (Corporate Governance Code) Revision and Intellectual Property

278 2022-09-27 Legal Information and Newsletter from NAKAMURA & PARTNERS

279 2022-09-27 IP High Court, 2021 (Gyo-Ke) 10037 [Display Device Supportable with One Hand] <Kanno>

280 2022-09-27 [YouTube Shorts] Doctrine of Equivalents (Summary, 2022 Edition)

281 2022-09-27 IP High Court, 2020 (Gyo-Ke) No. 10150 [Equol-Containing Fermented Soybean-Hypocotyl Product] <Honda>

282 2022-09-27 [YouTube Shorts] Functional Claims

283 2022-09-27 IP High Court, 2019 (Gyo-Ke) 10108 [Control Channels in a Communication Network System] <Kanno>

284 2022-09-28 [Foreign-server issue] IP High Court, 2018 (Ne) 10077 (Dwango v. FC2, INC.) <Presiding Judge Honda>

285 2022-09-29 IP High Court, 2021 (Ne) 10049, 10069 [Blowgun dart] <Honda> Loses on reversal (claim limitations not satisfied)

286 2022-09-29 “Act on the Protection of Personal Information” has been posted on the Nakamura & Partners website.

287 2022-09-30 Appeal: IP High Court, 2020 (Ne) 10029 [Cellulose powder] <Otaka>

288 2022-10-03 Tokyo District Court, 2019 (Wa) 7038, 9618 <Kokubu> Graphitic carbon material used as a graphene precursor

289 2022-10-03 IP High Court, 2019 (Ne) 10078 <Kanno> [Construction method for a roof chimney penetration and waterproof structure for a roof chimney penetration]

290 2022-10-04 IP High Court, 2019 (Gyo-Ke) 10043 “High-contrast tire pattern” <Tsuruoka>

291 2022-10-05 Tokyo District Court, 2013 (Wa) 30271 <Action seeking remuneration for an employee invention>

292 2022-10-06 [Copyright] IP High Court, 2021 (Ne) 10028 “Idle RPG” case <Otaka>

293 2022-10-07 [Unfair Competition Prevention Act] Osaka District Court, 2018 (Wa) 8708

294 2022-10-08 Osaka District Court, 2018 (Wa) 5037

295 2022-10-11 Tokyo District Court, 2003 (Wa) 19324 [Method for producing Branut granules] <Mimura>

296 2022-10-11 Tokyo High Court, 2002 (Ne) 2457 [Method for reusing ready-mixed concrete sludge] <Yamashita>

297 2022-10-11 IP High Court, 2021 (Gyo-Ke) 10059 [Container for microwave-heated food] <Shoji>

298 2022-10-12 Tokyo District Court, 2017 (Wa) 24942 [Webpage browsing method … apparatus] <Sato>

299 2022-10-13 [Copyright] Tokyo District Court, 2021 (Wa) 4491 <Sato>

300 2022-10-14 Tokyo District Court, 2019 (Wa) 23407 […Suspension … apparatus] <Shibata>

301 2022-10-16 Tokyo District Court, 2019 (Wa) 23164 [Image-forming apparatus] <Tanaka>

302 2022-10-16 Intellectual property that decision-makers should understand in light of the CGC (Corporate Governance Code)

303 2022-10-16 [Patents: Case introduction (YouTube)] IP High Court, 2020 (Ne) 10057 <Otaka>

304 2022-10-16 [Patent YouTube #short] ① Responding to rejections; ② Utilizing dependent claims (claim differentiation)

305 2022-10-17 IP High Court, 2021 (Gyo-Ke) 10006 [X-ray inspection apparatus] <Kanno>

306 2022-10-18 US Patents 2016 CAFC Shaw Industries v. Automated Creel

307 2022-10-19 [US Patents] 2016.06 US Supreme Court Cuozzo Speed v. Lee

308 2022-10-20 Tokyo District Court, 2020 (Wa) 33027 [Control system for fee-charging automatic machines] <Nakashima>

309 2022-10-21 Tokyo District Court, 2021 (Wa) 13905 […Use of eribulin] <Shibata>

310 2022-10-21 [Individual Patent Case Introduction (YouTube)] IP High Court, 2020 (Ne) 10004 [Light irradiation] case <Otaka>

311 2022-10-24 2021.08 CAFC Gsk v. Teva Sale of skinny-label generics—Induced infringement found

312 2022-10-24 2014.03 CAFC Endo v. Actavis Settlement of earlier litigation—Scope of presumed implied license

313 2022-10-25 US Designs 2019 CAFC Curver Luxembourg v. Home Expressions

314 2022-10-26 2015 CAFC INEOS USA v. Berry Plastics Inventions with numerical limitations and novelty

315 2022-10-27 IP High Court (Grand Panel), 2020 (Ne) No. 10024 [Chair-type massage machine]

316 2022-10-27 An article on “Rights of Publicity” has been uploaded to the Nakamura & Partners website.

317 2022-10-28 2014.06 US Supreme Court Nautilus v. Biosig

318 2022-10-29 Section 252 of the US Patent Act—Effect of reissue (intervening rights)

319 2022-10-31 2022.01 CAFC Evolusion v. Juggernaut

320 2022-11-01 <WIPO Japan Office Webinars> Past videos and materials have been uploaded.

321 2022-11-01 [US Designs] 2021.10 CAFC In re SurgiSil, L.L.P., Peter Raphael, Scott Harris

322 2022-11-02 Tokyo High Court, 1997 (Gyo-Ke) 87 [False-twist processing method] case <Ito>

323 2022-11-04 IP High Court, 2012 (Gyo-Ke) 10328 <Shibata> [Odor-neutralizing and liquid-absorbing waste bag]

324 2022-11-04 Osaka District Court, 2019 (Wa) 9113 [Information communication unit] <Sugiura>

325 2022-11-05 2004.8.16 US CAFC Fisher-Price v. Safety 1st, Inc

326 2022-11-05 IP High Court, 2021 (Gyo-Ke) 10082 [Electrically insulating cable] <Shoji>

327 2022-11-07 [Copyright] Osaka District Court, 2020 (Wa) 9992 Copyrightability of the clock's “original artwork” was denied.

328 2022-11-07 [Patents] Support requirement: Polarizing Film Grand Panel judgment—On “parameter inventions”

329 2022-11-08 [Designs] Tokyo District Court, 2018 (Wa) 38585 and other cases (Status as creator of the design ⇒ denied)

330 2022-11-09 IP High Court, 2021 (Ne) 10091 […Fracture fixation system] <Honda>

331 2022-11-11 IP High Court, 2016 (Gyo-Ke) 10118 [High-efficiency propeller] <Shimizu> “Publication” under Article 29(1)(iii)

332 2022-11-12 “The Essence of Trademark Similarity in Supreme Court Precedents” (former judge Mitsuru Shishido): Introduces 11 Supreme Court trademark judgments

333 2022-11-12 [Patents] Addition of new matter (parent, child, and grandchild applications)

334 2022-11-12 Osaka District Court, 2020 (Wa) 3474 [Lighting fixture] <Tani>

335 2022-11-14 [Article] “Practice of Patent Licensing Agreements” (Professor Masayasu Ishida)

336 2022-11-15 Tokyo District Court, 2014 (Wa) 17797 [Compression-bonded herbaceous material] <Okinaka> Substantial quantities outside the numerical range ⇒ Claim limitation not satisfied

337 2022-11-16 IP High Court, 2021 (Gyo-Ke) 10111 [Laser processing apparatus] <Kanno> Correction to a negative limitation ⇒ Inventive step satisfied

338 2022-11-17 Tokyo District Court, 2019 (Wa) 33246 [(Sequel) case] <Kokubu> ⇒ Pursuing the earlier infringement action was not a tort.

339 2022-11-18 My posts were mentioned in “Sotoku Diary.”

340 2022-11-18 IP High Court, 2020 (Ne) 10004 <Otaka> [Light irradiation apparatus] =Osaka District Court, 2017 (Wa) 7532 <Sugiura>

341 2022-11-21 IP High Court, 2014 (Gyo-Ke) 10059 Ishii Package containing a dry liposomal pharmaceutical composition containing an iodophor

342 2022-11-21 Tokyo District Court, 2020 (Wa) 8506 […Work gloves] <Sato>

343 2022-11-21 YouTube [Patents] Inventive step (parameter inventions)

344 2022-11-21 [Trademarks] Osaka District Court, 2020 (Wa) 3646

345 2022-11-21 IP High Court, 2021 (Ne) 10029 [Handrail installation method] case <Shoji> ≪Multi-actor infringement⇒ Joint direct infringement established

346 2022-11-22 Tokyo District Court, 2018 (Wa) 1130 [Printed retroreflective sheeting] <Tanaka> Damages

347 2022-11-24 IP High Court, 2021 (Ne) 10088 and other cases [Information communication unit]—No concurrent application of paragraphs (2) and (3) to deductions for competing products

348 2022-11-24 [Copyright] Osaka District Court, 2021 (Wa) 3208 Sale of pirated copies ⇒ Damages under Article 114(3) of the Copyright Act

349 2022-11-24 IP High Court, 2017 (Ne) 10090 [Pharmaceutical] case <Takabe>

350 2022-11-25 Tokyo District Court, 2020 (Wa) 13326, 13331 [Forearm-fracture inhibitor containing eldecalcitol] <Shibata>

351 2022-11-26 IP High Court, 2020 (Ne) 10048 <Tsuruoka> ⇒ A case denying a claim for employee-invention remuneration for know-how

352 2022-11-26 [Patents] Offer for assignment: Tokyo District Court, 2016 (Wa) 25436 [Method for producing L-glutamic acid] <Yamada>

353 2022-11-28 IP High Court, 2010 (Ne) 10001 [Motor] <Nakano> *International jurisdiction

354 2022-11-28 “Dispatch of Lecturers—Strong Support for Developing In-House Intellectual Property Personnel—” has been uploaded to the Nakamura & Partners website

355 2022-11-28 [US Patents] 2022.06 CAFC Novartis v. Accord Healthcare

356 2022-11-29 <Trademarks> IP High Court, 2021 (Gyo-Ke) 10013 “Lingua Franca” Cancellation for non-use

357 2022-11-30 Tokyo High Court, 2001 (Gyo-Ke) 489 [Spring structure] <Tsukahara> *No patentability even if a previously known product happens to fall within the numerical range.

358 2022-12-01 [Article] (United States) ITC Features Worth Knowing for Litigation Strategy (IP Management, Vol. 69, No. 1, 2019)

359 2022-12-02 [Article] A case dismissing an action against a corporate representative because the arbitration agreement extended to the representative (JCA Journal, Vol. 69, No. 8)

360 2022-12-04 [Copyright] Tokyo District Court, 2020 (Wa) 19840 <Nakashima> Copyrightability denied for a company name (trade name) rendered as a logotype

361 2022-12-04 Osaka District Court, 2020 (Wa) 4023 […Attachment-assisting plate] <Tani>

362 2022-12-05 Osaka District Court, 2018 (Wa) 866 <Claim for employee-invention remuneration> Exclusivity benefit denied ⇒ Claim dismissed

363 2022-12-06 Tokyo High Court, 2001 (Ne) 2630 […Reinforcing rod] <Shinohara> Equivalent substantially identical to an earlier-filed, later-published application

364 2022-12-07 Osaka District Court, 1999 (Wa) 12699 [Infringement of an inventor's right of honor] <Komatsu> True inventor may demand amendment of the inventor field

365 2022-12-08 IP High Court, 2019 (Gyo-Ke) 10132 <Tsuruoka> [Brunnian link-making device and kit]

366 2022-12-09 IP High Court, 2019 (Gyo-Ke) 10120 [Oil-cooled screw compressor] <Tsuruoka> Motivation found from a general problem

367 2022-12-10 Tokyo District Court, 2020 (Wa) 13326, 13331 <Shibata> [Forearm-fracture inhibitor containing eldecalcitol]

368 2022-12-12 IP High Court, 2021 (Ne) 10031 <Shoji> [Semiconductor integrated circuit device] =Tokyo District Court, 2020 (Wa) 6675

369 2022-12-12 Tokyo District Court, 1997 (Wa) 938 [Fragrant liquid bleach composition] (Kabi Killer)

370 2022-12-13 IP High Court, 2019 (Gyo-Ke) 10041 [Wound dressing] <Kanno> Support requirement satisfied; inventive step satisfied

371 2022-12-14 Damages (concurrent application of paragraphs (2) and (3)): IP High Court (Grand Panel), 2020 (Ne) 10024; IP High Court, 2021 (Ne) 10088

372 2022-12-16 [US Patents] 2009 CAFC Section 271(f) of the US Patent Act does not apply to method claims.

373 2022-12-17 [US Patents] 2016.03 CAFC Could have been raised ⇒ IPR not instituted ⇒ No estoppel for invalidity grounds

374 2022-12-17 [Individual Case Introduction] Tokyo District Court, 2019 (Wa) 30991 […Composition] <Tanaka>

375 2022-12-17 [US Patents] 2016 Supreme Court Claim construction in IPR proceedings also followed the BRI standard under the rules then in force

376 2022-12-19 2019.05 US Supreme Court Mission Product v. Tempnology

377 2022-12-20 [United States] Section 337 of the US Tariff Act—Also covers products that do not satisfy the claim limitations at importation but do when customers use them after importation

378 2022-12-20 [United States] Statements made during prosecution of a parent application affect claim construction in a continuation if relevant to the continuation's patent claims

379 2022-12-21 [US Patents] Scope in which an implied license is presumed from settlement of earlier litigation (general proposition)

380 2022-12-22 [US Patents] Induced infringement found for a skinny-label generic pharmaceutical product.

381 2022-12-26 [US Patents] 2014.06 US Supreme Court Nautilus v. Biosig Standard for the definiteness requirement

382 2022-12-26 [Article] “US Patent Litigation as an Intellectual Property Strategy” Section 252 of the US Patent Act—Effect of reissue (intervening rights)

383 2022-12-27 [US Patents] HZNP v. Actavis “consisting essentially of”

384 2022-12-27 IP High Court, 2017 (Gyo-Ke) 10089, 10090 [Medical flexible container] case <Takabe>

385 2022-12-28 [US Patents] Eli Lilly v. Teva The purpose of a method of use is construed restrictively by the preamble

386 2022-12-28 “Valuation of Intellectual Property Rights” has been uploaded to the Nakamura & Partners website.

387 2022-12-31 [United States] CAFC Evolusion v. Juggernaut Construction of claim language

388 2022-12-31 “Valuation of Intellectual Property Rights—Ensuring an Objective Valuation When Transferring … Within a Group—”

Tokyo District Court, 2010 (Wa) 26341, Oil-Based Liquid Cleansing Composition <Osuga>

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719352846.html

Tokyo District Court, 2010 (Wa) 26341, Oil-Based Liquid Cleansing Composition <Osuga>

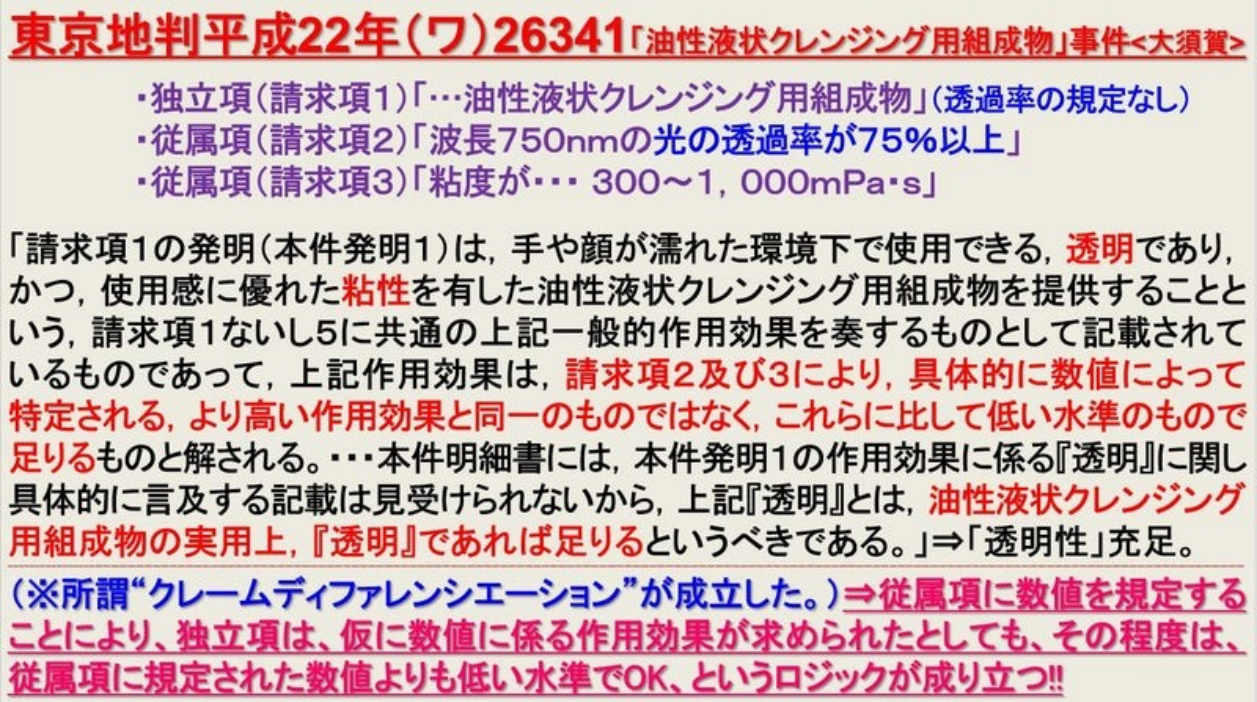
*An example of applying the enablement requirement in which the court held that a person skilled in the art could work the invention by appropriately changing the blending proportions

(The same applies to the support requirement.)

*In construing the claim wording “oil-based liquid cleansing composition,” the effect of “transparency” was treated as a claim limitation.

⇒ Ultimately, infringement was found because “transparency” was satisfied.

(Infringement was found even though the transparency was below the numerical value in the dependent claim.)



English translation of the figure

Tokyo District Court, 2010 (Wa) 26341, “Oil-Based Liquid Cleansing Composition” <Osuga>

Independent claim (Claim 1): “… an oil-based liquid cleansing composition” (no transmittance specified).
Dependent claim (Claim 2): “the transmittance of light having a wavelength of 750 nm is 75% or more.”
Dependent claim (Claim 3): “the viscosity is … 300–1,000 mPa·s.”

“The invention of Claim 1 (Invention 1 at issue) is described as providing an oil-based liquid cleansing composition that can be used when the hands or face are wet, is transparent, and has a viscosity giving an excellent feeling in use, which are the general functions and effects common to Claims 1 to 5. The above functions and effects are therefore interpreted as not being identical to the higher functions and effects specifically defined by numerical values in Claims 2 and 3, but as being sufficient at a lower level than those. … Since the specification at issue contains no description specifically referring to the ‘transparency’

of the functions and effects of Invention 1 at issue, the above transparency should be sufficient if the oil-based liquid cleansing composition is ‘transparent’ for practical use.” ⇒ The transparency requirement is satisfied.

(The so-called “claim differentiation” was established.) ⇒ Specifying numerical values in dependent claims establishes the following reasoning: even if the independent claim requires functions and effects relating to those numerical values, a lower level than the numerical values specified in the dependent claims is sufficient!!

<Excerpts from the judgment>

Infringement

• Independent claim (claim 1): “…an oil-based liquid cleansing composition” (no transmittance specified)

• Dependent claim (claim 2): “a transmittance of 75% or more for light at a wavelength of 750 nm”

• Dependent claim (claim 3): “a viscosity of … 300–1,000 mPa·s”

“The invention of claim 1 (Invention 1 at Issue) is described as producing the above general effects common to claims 1 through 5: providing an oil-based liquid cleansing composition that can be used when the hands or face are wet, is transparent, and has a viscosity that gives an excellent feel in use. Those effects are not identical to the higher effects specifically defined by numerical values in claims 2 and 3; a lower level than those is sufficient. … Since no passage in the Specification at Issue specifically addresses the meaning of ‘transparent’ in relation to the effects of Invention 1 at Issue, the above ‘transparent’ should be understood as requiring only that the oil-based liquid cleansing composition be ‘transparent’ for practical purposes.” ⇒ “Transparency” satisfied.

(*So-called “claim differentiation” was established.)

⇒ By specifying numerical values in a dependent claim, one can establish the logic that, even if the independent claim is required to produce the effects associated with those values, a level below the numerical values specified in the dependent claim is OK!!

Article 36(4) of the Patent Act (enablement requirement)

…The effect of Invention 1 at Issue is to provide an oil-based liquid cleansing composition that can be used when the hands or face are wet, is transparent, and has an appropriate viscosity. That effect is presented as common to the inventions of claims 1 through 5 of the Patented Invention at Issue. In addition to the features of Invention 1 at Issue, claim 2 limits the transparency aspect of those effects by light transmittance, showing that a higher effect may be obtained.

Accordingly, Invention 1 at Issue can be said to encompass cases falling within claim 2. … The “appearance” and “transmittance” in the descriptions of the Examples … in the Specification at Issue demonstrate the effects of claim 2. Thus, the Specification at Issue discloses a composition consisting of components (A) through (D) and states that the effects of claim 2 were obtained in that case. … Although the Specification at Issue does not describe the effects of the features of Invention 1 at Issue alone, it does demonstrate the effects of claim 2, which includes the features of Invention 1 at Issue, and therefore contains disclosure substantiating that Invention 1 at Issue produces its effects. …

Moreover, the Specification at Issue gives specific examples … of components (A) through (D), discloses preferred amounts of each component …, and shows specific combinations and amounts of the components in Examples 1 through 7. … A person skilled in the art who reads the Specification at Issue can therefore obtain an oil-based liquid cleansing composition producing the effects of Invention 1 at Issue by referring to that disclosure and appropriately determining the specific combinations and amounts of the substances used as components (A) through (D), in accordance with common general technical knowledge. This is also clear from the fact that oil-based liquid cleansing compositions producing the effects of Invention 1 at Issue

were obtained in the experiments conducted by the plaintiff and the defendant (Plaintiff's Exhibits 25, 27, 29, and 30; Defendant's Exhibit 2-8).

In this regard, the defendant argues that the Inventions at Issue lack enablement because even some compositions containing components (A) through (D) with blending proportions determined in accordance with the Examples in the Specification at Issue … lacked stability. However, … the defendant's experimental results concern either compositions in which, among the substances used as components (A) through (D) in the Examples in the Specification at Issue, component (C) was replaced with a substance different from that in the Examples and part of component (D) was likewise replaced, while the blending proportions of the components were kept identical to those in the Examples (…) or compositions in which decaglyceryl diisostearate, blended as component (E) in the Examples, was omitted and the proportion of the oil agent was increased by the corresponding amount (…). Although the defendant's experiments produced results such as a lack of stability, the plaintiff has submitted experimental results (…) showing that an oil-based liquid cleansing composition producing the effects of Invention 1 at Issue was obtained by changing the blending proportions without changing the substances used for each component from those in the defendant's experiments. Thus, a person skilled in the art can work Invention 1 at Issue by appropriately changing the blending proportions of components (A) through (D), taking into account the properties of each substance and so forth, in response to changes in the substances used as components (A) through (D) or the omission of component (E). Such appropriate changes in the blending proportions and so forth are possible in accordance with the common general technical knowledge of a person skilled in the art.

Article 36(6)(i) of the Patent Act (support requirement)

…The Specification at Issue describes specific examples of substances usable as components (A) through (D) and preferred blending proportions for each component. Moreover, … of the Specification at Issue states: "…The amount of the oil agent is desirably 40–95% by mass relative to the total amount of the oil-based liquid cleansing composition. Below 40% by mass, the effect of lifting makeup cosmetics from the skin is poor; above 95% by mass, rinsing off after blending with the makeup cosmetics becomes difficult"; … "…The amount of the dextrin fatty acid ester is preferably 0.5–5% by mass. Below 0.5% by mass, sufficient viscosity is difficult to obtain; above 5% by mass, transparent dissolution becomes difficult and the formulation tends to become too firm"; … "The ester of a fatty acid having 8–10 carbon atoms and polyglycerol is preferably blended in a range of 1–40%, particularly 5–25%, of the total composition of the cleansing composition of the present invention. Below 1%, the composition's cleansing and water-rinsing properties become insufficient; above 40%, possibilities include 'poor flowability, preventing maintenance of an oil-based liquid state' and 'problems such as skin irritation during use'"; and … "…The amount of the anionic surfactant is preferably 0.1–1% by mass. Below 0.1% by mass, the effect of transparently dispersing the dextrin fatty acid ester is difficult to obtain; at 1% by mass or more, the anionic surfactant may precipitate." These passages explain why the above blending proportions and so forth are preferred in relation to cleansing power when the skin is wet, transparency, stability, and viscosity. A person skilled in the art reading the Specification at Issue can therefore recognize from those passages that the problem addressed by the Inventions at Issue—providing an oil-based liquid cleansing composition that can be used when the hands or face are wet, is transparent, and has an appropriate viscosity—can be solved.

Accordingly, the Inventions at Issue do not lack the so-called support requirement. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82335.pdf

United States, June 2004, CAFC, Honeywell v. Hamilton

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719426346.html

United States, June 2004, CAFC, Honeywell v. Hamilton

Where an independent claim is canceled during prosecution and a dependent claim is rewritten in independent form, estoppel is presumed, and the doctrine of equivalents generally cannot be asserted.

⇒ The requirements of the U.S. Supreme Court's Festo decision are applied.

Tokyo District Court, 2016 (Wa) 35182 <Shimasue>

Intellectual Property High Court, 2017 (Ne) 10096 <Takabe>

To the same effect

Honeywell v. Hamilton CAFC en banc June 02 2004www.tatsuoyabe.aki.gs

UK Supreme Court, [2017] UKSC 48; German Federal Court of Justice, X ZR 29/15; Actavis v. Eli Lilly

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719429225.html

UK Supreme Court, [2017] UKSC 48, Actavis v. Eli Lilly

The Supreme Court decision that recognized the doctrine of equivalents for the first time in the United Kingdom.

Although the claims were narrowed by amendment during European prosecution, the court held that the amendment was intended to overcome an added-matter objection based on an impermissible intermediate generalization and merely satisfied the requirements for amendment.

German Federal Court of Justice, X ZR 29/15, Actavis v. Eli Lilly

If the reason for an amendment is to limit the subject matter over the prior art, the doctrine of equivalents is excluded. An amendment prompted by formal requirements (added matter or clarity), however, is not deemed a selection decision by the patentee, and the doctrine of equivalents is not excluded.

⇒ This has spread to Japan!

Tokyo District Court, 2016 (Wa) 25436 <Yamada>

https://www.hoffmanneitle.com/wp-content/uploads/Recent-Trends-of-IP-Law-in-Europe-Chizai-Kanri-vol.68-No.4_2018.pdf

United States, March 2002, CAFC en banc, Johnson & Johnston v. R.E. Service

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719429450.html

United States, March 2002, CAFC en banc, Johnson & Johnston v. R.E. Service

(The dedication doctrine)

Embodiments disclosed in the specification but not recited in the patent claims are deemed dedicated to the public, and the doctrine of equivalents cannot be asserted.

=PSC v. FOXCONN (CAFC2004.01)

= Supreme Court of Japan, 2016 (Ju) 1242

[Patent ★★★] Supreme Court decision affirming the Intellectual Property High Court's Grand Panel judgment finding infringement under the doctrine of equivalents of a patented invention relating to a process for manufacturing a chemical substance (maxacalcitol) — NAKAMURA & PARTNERS March 24, 2017 (2016 (Ju) No. 1242) (Supreme Court, Second Petty Bench) ◆ Full text of the judgment (Summary of the judgment)www.nakapat.gr.jp

United States, November 2006, CAFC, DePuy Spine v. Medtronic

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719429671.html

United States, November 2006, CAFC, DePuy Spine v. Medtronic

(The vitiation doctrine)

If replacing part of a claim limitation would vitiate that limitation, equivalence is not established.

Approach to determining “vitiated”

Phillips v. AWH(CAFC en banc2005)

“…Where a claim term is expressly defined in the specification, the specification acts as a dictionary.”

DEPUY SPINE V MEDTRONIC SOFAMOR, No. 05-1311 (Fed. Cir. 2006)DEPUY SPINE V MEDTRONIC SOFAMOR, No. 05-1311 (Fed. Cir. 2006) case opinion from the US Court of Appeals for the Federal Circuitlaw.justia.com



United States, March 2009, CAFC, Crown Packaging v. Rexam

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719430053.html

United States, March 2009, CAFC, Crown Packaging v. Rexam

The inquiry is whether the limitation performs substantially the same function in substantially the same way to achieve substantially the same result. In this case, equivalence could not be ruled out.

Where both method and product inventions are included, but only the method invention is asserted, patent marking is unnecessary and 35 U.S.C. § 287(a) does not apply.

*Different from the May 2017 CAFC decision!!

https://www.cafc.uscourts.gov/opinions-orders/08-1284.pdf

United States, May 2017, CAFC, Mylan v. Aurobindo Pharma

Original Ameblo publication: 2022-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719430321.html

United States, May 2017, CAFC, Mylan v. Aurobindo Pharma

Of the equivalence frameworks derived from Graver Tank (U.S. Supreme Court, 1950), the court suggested considering whether the insubstantial differences test would be more appropriate in this case.

The court did not categorically exclude use of the function-way-result test.

When applying the function-way-result test, differences in how the oxidizing agents operate and other relevant differences must be assessed for each claim limitation.

[U.S. Patents] ++ Doctrine of Equivalents (DOE, “Doctrine of Equivalents”)#Patents #UnitedStates #DoctrineOfEquivalents #DOE #GraverTank #Festo #Festo #EliLily #EliLilly #function-way-result #insubstantial-difference [U.S. Patents] Doctrine of Equivalents (DOE, “Doctrine of Equivalents”) (Attorney-at-law, patent attorney, U.S. C...www.youtube.com

May 2017, U.S. Supreme Court, TC Heartland [Venue in Patent Infringement Litigation]

Original Ameblo publication: 2022-01-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719539970.html

May 2017, U.S. Supreme Court, TC Heartland v. Kraft Foods

[Venue in Patent Infringement Litigation]

If the defendant is a U.S. corporation,

(1) The state of incorporation

or

(2) The district where the defendant has committed acts of infringement and has a regular and established place of business.

*Although non-U.S. companies fall outside its scope, Japanese companies are also affected in relation to their U.S. subsidiaries!!

Overturning the 1990 VE decision (CAFC), the Court returned to the standard of the 1957 U.S. Supreme Court decision in Fourco.

⇒ The May 2018 CAFC decision (In re: HTC Corporation) held that a patent action against a non-U.S. company may be brought in any U.S. federal district court that has personal jurisdiction over the defendant and where the defendant can be properly served with the complaint.

https://www.jetro.go.jp/ext_images/_Ipnews/us/2017/20170525.pdf

May 2017, U.S. Supreme Court, Water Splash v. Menon

Original Ameblo publication: 2022-01-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719709986.html

May 2017, U.S. Supreme Court, Water Splash v. Menon

Where the receiving state has not objected, the Hague Service Convention does not prohibit service by mail. Such service must also be authorized under otherwise-applicable law.

⇒**In December 2018, the Japanese government declared its objection to Article 10(a) of the Hague Convention;** therefore, direct service by mail on a defendant located in Japan is not permitted.

<Remaining issues>

Whether direct service by email is permitted

Whether a complaint in English (without a Japanese translation) is permitted

https://japanese.pillsburylaw.com/sitefiles/41049/legal%20wire%2059_ver2%2020230213.pdf

IP High Court, 2020 (Gyo-Ke) 10044, Lipid-Containing Composition <Otaka>

Original Ameblo publication: 2022-01-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719914040.html

IP High Court, 2020 (Gyo-Ke) 10044, Lipid-Containing Composition <Otaka>

*Although the publication stated the numerical value, it did not suggest limiting the amount to that value or less.

The disclosure in Publication 5 neither states that the increase in “fat intake” to “40 g per day” is itself a problem nor suggests that it should be improved.

⇒ Super pro-patent!!?

(Excerpts from the judgment)

[Claim 19] …a lipid-containing formulation wherein the dose of ω-6 fatty acids is 40 g or less.

The defendant argues as follows: (1) Publication 5 states that fat intake has increased to 40 g per day and recognizes this as a problem. The invention of Publication 5 is based on curbing excessive intake of lipids (fat) and embodies the technical concept of consuming ω-6 and ω-3 fatty acids in a balanced manner. It is therefore natural to keep ω-6 fatty acids, a subset of unsaturated fatty acids that themselves constitute a subset of lipids, below a certain level, and there is strong motivation to specify an amount no greater than 40 g, which is recognized as excessive for lipids as a whole. (2) Moreover, daily lipid intake also comes from foods other than the drink composition of the invention of Publication 5. Setting an upper limit of 40 g or less of ω-6 fatty acids per day or per dose is therefore a technical matter that a person skilled in the art could readily accomplish. Accordingly, a person skilled in the art could easily have conceived of adopting, in the invention of Publication 5, the features of the claimed invention relating to Difference 2.

However, … the statement in Publication 5 that “The recent Japanese diet has become increasingly Westernized, with a substantial increase in opportunities to eat meat-centered meals and an increase in fat intake to 40 g per day. Accompanying this, the types of disease have also changed: cardiovascular diseases such as hypertension and heart disease, as well as breast cancer and colorectal cancer, have increased, likewise showing Westernization and becoming a major social problem,” neither states that the increase in “fat intake” to “40 g per day” is itself a problem nor suggests that it should be improved. Furthermore, even considering the disclosure of Publication 5 as a whole, it contains no description or suggestion that fat intake should be restricted to 40 g per day, or that the “dose of ω-6 fatty acids” should be “40 g or less” per day or per dose. In addition, in this case there is no other evidence sufficient to establish that making the “dose of ω-6 fatty acids 40 g or less” was common general technical knowledge. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90569.pdf

The third edition of Patent Case Law Encyclopedia by Issue was published today. (Keizai Sangyo Chosakai)

Original Ameblo publication: 2022-01-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12719980022.html

The third edition of Patent Case Law Encyclopedia by Issue was published today. (Keizai Sangyo Chosakai)

400 court decisions added since the second edition!!

100 more pages!!

Complete with an index!!

In addition to using it as an encyclopedia, please use it as you see fit: dip into the ★★★ cases to grasp recent judicial trends, skim the one-line commentaries to identify the issues, and so on!!

(I would be delighted if you could write a review on Amazon, if possible!!)

Thanks to all of you, this edition has again reached No. 1 in Amazon's "Inventions and Patents" category.

I promise that this third edition will meet your expectations, and I intend to work even harder going forward.

I look forward to your continued guidance and encouragement.

Hideki Takaishi, Attorney-at-law and Patent Attorney



English translation of the book listing

Patent Case Law Encyclopedia by Issue, Third Edition (Modern Industry Selected Books, Intellectual Property Practice Series). Large-format book — January 8, 2022. Hideki Takaishi (author).

Cover: Patent Case Law Encyclopedia by Issue, Third Edition. For rapid investigation and use. Hideki Takaishi. Keizai Sangyo Chosakai.

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IP High Court, 2020 (Gyo-Ke) 10132, Therapeutic Agent for Osteoporosis <Kanno>

Original Ameblo publication: 2022-01-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12720173501.html

IP High Court, 2020 (Gyo-Ke) 10132, Therapeutic Agent for Osteoporosis <Kanno>

*Unpredictable and remarkable effects

It is permissible to take into account the effects of the cited invention selected as having features close to those of the invention at issue, as well as effects of the same kind already achieved in the state of the art.

= IP High Court, 2020 (Gyo-Ke) 10056 <Kanno>

= IP High Court, 2020 (Gyo-Ke) 10004 <Kanno>

<Excerpts from the judgment>

Whether the effects of an invention are unpredictable and remarkable must be examined from the perspectives of whether, as of the reference date for assessing patentability, a person skilled in the art could not have predicted that the features of the invention would produce those effects, and whether the effects are remarkable in exceeding the range of effects that a person skilled in the art could have predicted from those features (Supreme Court, 2018 (Gyo-Hi) No. 69 …). Nevertheless, … it is permissible to take into account the effects of the cited invention selected as having features close to those of the invention at issue, as well as effects of the same kind already achieved in the state of the art. … The effects must be regarded as within the range that a person skilled in the art could have predicted from the features of the Invention at Issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90550.pdf

IP High Court, 2020 (Gyo-Ke) 10106, Reading Device <Mori>

Original Ameblo publication: 2022-01-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12720173926.html

IP High Court, 2020 (Gyo-Ke) 10106, Reading Device <Mori>

*Eligibility as a cited invention denied (“Exhibit Ko 1 Invention 2”)

⇒ If standalone use is not contemplated, eligibility as a cited invention fails.

The “read/write module 200” of the Exhibit Ko 1 Invention cannot, on its own, be recognized as the “reading device” to be compared with the Invention at Issue.

(Excerpts from the judgment)

…The “read/write module 200” of the Exhibit Ko 1 Invention is not contemplated as being used on its own without a “barrier”; in other words, prevention of radio-wave leakage or interference by the “read/write module 200” alone is not contemplated. The function of preventing radio-wave leakage to the outside or interference is indispensable to the “reading device” to be compared with the Invention at Issue. Accordingly, the “read/write module 200” of the Exhibit Ko 1 Invention cannot, on its own, be recognized as the “reading device” to be compared with the Invention at Issue. It follows that Exhibit Ko 1 Invention 2 cannot be identified and compared with the Invention at Issue in the manner adopted in the Trial Decision at Issue.

…The defendant cites … as publicly known publications and the like that treat a reading device as an independent invention. However, the configuration of the “read/write module 200” of the Exhibit Ko 1 Invention differs from the technologies described in those prior publications. The defendant’s argument therefore does not affect the above … conclusion.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90343.pdf

IP High Court, 2020 (Gyo-Ke) 10115, Beauty Device <Kanno>

Original Ameblo publication: 2022-01-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12720174348.html

IP High Court, 2020 (Gyo-Ke) 10115, Beauty Device <Kanno>

Given the wording “may be spherical or of any other arbitrary shape,” it is natural to understand a “sphere” as the primary shape contemplated.

⇒ No motivation to make the central handle of the primary reference elongated. There is a teaching away.

= IP High Court, 2020 (Gyo-Ke) 10057 <Kanno>

<Excerpts from the judgment>

Exhibit Ko 1 recites in claim 1 a “central handle of arbitrary shape,” and its detailed description states that the central handle gripped by the user “may be spherical or of any other arbitrary shape.” It can therefore be understood not to exclude an elongated handle. However, given the wording “may be spherical or of any other arbitrary shape,” it is natural to understand a “sphere” as the primary shape contemplated. Moreover, the accompanying drawings … in Exhibit Ko 1 are all front views of the device and are said to depict embodiments; in light of the shape of the handle and the overall balance shown, they can only be understood to disclose a spherical handle. … Even if the handle may have an arbitrary shape and is not limited to a sphere, making the spherical handle of the Exhibit Ko 1 Invention elongated would create a problem with operability. Thus, there is no motivation to make the central handle of the Exhibit Ko 1 Invention elongated when only a spherical embodiment is disclosed. … Rather, there is a teaching away. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90449.pdf

IP High Court, 2020 (Gyo-Ke) 10134, System for … Controlling Digital Art Distribution and Viewing … <Mori>

Original Ameblo publication: 2022-01-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12720653960.html

IP High Court, 2020 (Gyo-Ke) 10134, System for Controlling Digital Art Distribution and Viewing and Image Formation over the Internet <Mori>

*The primary and secondary references concern different technical fields.

It is difficult to find the application obvious merely because they belong to a broad technical field, without considering their relationship or any other circumstances.

⇒ Inventive step affirmed.

<Excerpts from the judgment>

…Whereas the Exhibit Ko 3 Technology concerns a peer-to-peer system …, the Cited Invention can perform compound tasks such as content ingestion, automatic publishing, distribution, storage, and monetization, and is understood as a method that itself actively performs content ingestion, distribution, and so forth. The Exhibit Ko 3 Technology and the Cited Invention therefore differ in technical field to no small degree. In this regard, it is difficult to find that a person skilled in the art could easily have conceived of applying the Exhibit Ko 3 Technology to the Cited Invention merely because they fall within the broad technical field of "methods for transmitting and receiving data among a transmitting client, a receiving client, and a server," without considering their relationship or any other circumstances. Nor can any other passage in Exhibit Ko 3 be recognized as providing motivation or a suggestion to apply the Exhibit Ko 3 Technology to the Cited Invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90508.pdf

Osaka District Court, 2019 (Wa) 5444, Carbon Dioxide-Containing Viscous Composition — Liability of the Defendant Director under Companies Act Article 429(1) Affirmed

Original Ameblo publication: 2022-01-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12720849524.html

Osaka District Court, 2019 (Wa) 5444, Carbon Dioxide-Containing Viscous Composition

*After the Grand Panel judgment, the defendant went bankrupt.

⇒ Liability of the defendant director under Article 429(1) of the Companies Act affirmed.

Cf. Tokyo District Court, 2016 (Wa) 2720, Foreign Matter Removal Machine for Raw Nori <Shimasue>

⇒ Joint tort liability of the defendant's wholly owning parent company and liability of the defendant director under Article 429(1) of the Companies Act were denied.

(Excerpts from the judgment)

…Even after receiving a warning of patent infringement, defendant P3 continued selling Defendant's Product 14 and committing the tort of patent infringement until the court disclosed its preliminary view, relying mainly on explanations from Neochemir, the manufacturer of Defendant's Product 14, without taking measures such as those considered in items ① through ④ in (1) above. Because this caused damage to the plaintiff, P3 breached the duty of care of a prudent manager owed as a director. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90602.pdf

Osaka District Court, 2020 (Wa) 3247, Device for Detecting Water-Leak Locations in Water Supply Piping <Sugiura>

Original Ameblo publication: 2022-01-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721028813.html

Osaka District Court, 2020 (Wa) 3247, Device for Detecting Water-Leak Locations in Water Supply Piping <Sugiura>

*Bringing a patent infringement action was held to constitute a tort!!

⇒ ¥500,000 awarded.

“The plaintiff had not necessarily conducted its own proactive investigation, before bringing this action, into the leak-detection method used by the defendant or the equipment used for that method.”

(Excerpts from the judgment)

In the series of exchanges between the plaintiff and the defendant, although the defendant sometimes responded that its method “does not violate the law, including by patent infringement,” the plaintiff never mentioned why it believed the method and so forth used by the defendant infringed the plaintiff’s patent rights. Moreover, the first time the plaintiff asked questions or the like about the specific leak-detection method used by the defendant and the equipment used for it was in its “Final Notice” dated February 7, 2018. In addition, in light of the plaintiff’s arguments and evidence in this case, particularly the plaintiff’s own statement that “Until filing the lawsuit, I had no way of knowing the method the defendant was using,” and the fact that the plaintiff has actually presented its arguments and evidence on the premise of the configuration of the Defendant’s Device as asserted by the defendant, it appears that the plaintiff had not necessarily conducted its own proactive investigation, before bringing this action, into the leak-detection method used by the defendant or the equipment used for that method. Considering these circumstances leading to the filing of the action, the course of the litigation, and so forth, as well as the fact that, as stated above, the Defendant’s Device does not fall within the technical scope of any of the Inventions at Issue, it is appropriate to view the plaintiff as having deliberately brought this action to impede the defendant’s business development—that is, to interfere with its business—even though at least an ordinary person could easily have known that the rights or legal relationship asserted in this action lacked a factual and legal basis. Thus, the plaintiff’s institution of this action is found to be markedly unreasonable in light of the purpose and objectives of the judicial system and constitutes a tort against the defendant.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90580.pdf

Osaka District Court, 2017 (Wa) 10716, Handrail Mounting Device <Sugiura>

Original Ameblo publication: 2022-01-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721197597.html

Osaka District Court, 2017 (Wa) 10716, Handrail Mounting Device <Sugiura>

*Patent Act Article 102(2): rebuttal of the presumption to the extent of 20%

*“Profits” under Article 102(2) also include the amount corresponding to consumption tax.

= IP High Court, 2016 (Ne) 10082 <Tsuruoka>

[Device for Preventing Co-Rotation of Raw Nori in a Device for Separating and Removing Foreign Matter from Raw Nori]

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86532.pdf

⇒ Consumption tax is calculated at the rate applicable at the time of infringement.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90093.pdf

Osaka District Court, 2018 (Wa) 6015 <Sugiura>

Original Ameblo publication: 2022-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721743528.html

Osaka District Court, 2018 (Wa) 6015 <Sugiura>

*The assignee of the patent rights also succeeded to the licensor's position.

⇒ The licensee terminated the agreement for breach of the obligation under the license agreement to maintain the patents.

⇒ Restitution claim granted: ¥88.57 million.

*There are various views on a licensor’s obligation to maintain patents, but this case concerned a contractual obligation to maintain the patents.

(Excerpts from the judgment)

…Taking all the circumstances into account, the defendant succeeded to JRT’s position as licensor under the License Agreement at Issue in connection with the Assignment Agreement at Issue. …

The defendant’s allowing Patent Rights 5 through 8 at Issue to lapse through nonpayment of patent fees constitutes nonperformance of its obligation to maintain the patents (…) under the License Agreement at Issue. Accordingly, because the License Agreement at Issue was terminated by the plaintiff’s declaration of termination …, the defendant owes the plaintiff an obligation to refund the royalties paid by the plaintiff under that agreement and to pay interest, as restitution (Civil Code Article 545). … Of the Patent Rights at Issue, Patent Right 6 … was the last to lapse. Until then, the plaintiff enjoyed its status as a non-exclusive licensee under the License Agreement at Issue. Consequently, upon termination of that agreement, the plaintiff is also obliged to return the benefit it enjoyed during that period.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90194.pdf

IP High Court, 2014 (Ne) 10109, Transdermal Preparation, Transdermal Preparation Holding Sheet … <Otaka>

Original Ameblo publication: 2022-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721744471.html

IP High Court, 2014 (Ne) 10109, Transdermal Preparation, Transdermal Preparation Holding Sheet … <Otaka>

*The scope in which indirect infringement would be established was considered in determining whether there was a substantial change.

“If such a … correction were permitted, … the scope in which indirect infringement … would be established would also differ, potentially prejudicing the interests of third parties generally who rely on the wording of the claims.”

(Excerpts from the judgment)

…The Correction at Issue … changes “…a transdermal absorption agent” … to “…a transdermal preparation holding sheet that is …” … and can be regarded as changing the subject of the invention from a product invention directed to a “transdermal preparation” to a product invention directed to a “transdermal preparation holding sheet.”

If a correction changing the subject of a product invention in this manner were permitted, the scope in which indirect infringement (Article 101(i) through (iii) of the same Act) would be established through acts such as producing “a product used exclusively for producing that product” or “a product used for producing that product” would also differ, potentially prejudicing the interests of third parties generally who rely on the wording of the claims. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85412.pdf

IP High Court, 2020 (Ne) 10045, Dot Pattern <Kanno>

Original Ameblo publication: 2022-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721744986.html

IP High Court, 2020 (Ne) 10045, Dot Pattern <Kanno>

*Two incompatible embodiments were combined and claimed.

⇒ Addition of new matter.

“The two dot patterns use incompatible methods of defining information, and combining the two dot patterns amounts to nothing other than creating an entirely new method of defining information.”

= IP High Court, 2013 (Gyo-Ke) 10346, Method for Manufacturing a Crystal Oscillator <Ishii>; IP High Court, 2016 (Gyo-Ke) 10257, Portable Information Communication Device <Mori>

(Excerpts from the judgment)

According to the appellant’s argument, part (1) of Amendment 1 at Issue is based on the Figure 105 dot pattern, while part (2) corresponds to the Figure 5 dot pattern. Amendment 1 at Issue therefore combines these two patterns. … The two dot patterns use incompatible methods of defining information, and combining the two dot patterns amounts to nothing other than creating an entirely new method of defining information.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90069.pdf

IP High Court, 2013 (Gyo-Ke) 10346, Method for Manufacturing a Crystal Oscillator <Ishii>

Original Ameblo publication: 2022-01-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12721929610.html

IP High Court, 2013 (Gyo-Ke) 10346, Method for Manufacturing a Crystal Oscillator <Ishii>

*Adding a combination of matters described independently in two paragraphs of the specification ⇒ Addition of new matter.

⇒ Correction requirements not satisfied.

“Because the configurations described in the respective passages are independent of each other, what is disclosed there consists of separate technical matters, and …”

[(Corrected) Claim 1] A step of forming grooves on at least one of the upper and lower surfaces of a first tuning-fork arm, on both sides of a neutral line while leaving that neutral line intact, so that the partial width including said neutral line is less than 0.05 mm and the width of each groove is less than 0.04 mm; and a step of forming grooves on at least one of the upper and lower surfaces of a second tuning-fork arm, on both sides of a neutral line while leaving that neutral line intact, so that the partial width including said neutral line is less than 0.05 mm and the width of each groove is less than 0.04 mm; …

(Excerpts from the judgment)

…Paragraph [0041] of the Patent Specification at Issue describes a configuration in which grooves are formed on both sides of a neutral line while leaving that neutral line intact, the partial width W7 of the tuning-fork arm including the neutral line is less than 0.05 mm, and the width of each groove is less than 0.04 mm. It also states that this configuration can make M1 greater than Mn. Paragraph [0043] states that the tuning-fork-shaped flexural crystal resonator used in the crystal oscillators of the first through fourth embodiments, in which grooves are provided in the tuning-fork arms so as to straddle (include) the neutral line, is configured such that the capacitance ratio r1 in fundamental-mode vibration is smaller than the capacitance ratio r2 in second-harmonic-mode vibration. It further states that this configuration makes the frequency change of a flexural crystal resonator vibrating in the fundamental mode greater than that of a flexural crystal resonator vibrating in the second-harmonic mode for the same change in load capacitance CL.

However, the configurations described in paragraphs [0041] and [0043] above are independent of each other. What is disclosed there consists of separate technical matters; these passages cannot be combined to say that they disclose the Added Matter at Issue, namely, that “where grooves are formed on both sides of a neutral line while leaving said neutral line intact, such that the partial width including said neutral line is less than 0.05 mm and the width of each groove is less than 0.04 mm, the capacitance ratio r1 in fundamental-mode vibration is smaller than the capacitance ratio r2 in second-harmonic-mode vibration, and the figure of merit M1 in the fundamental mode is greater than the figure of merit Mn in harmonic-mode vibration.” … Accordingly, the addition of the Added Matter at Issue must be regarded as introducing a new technical matter in relation to the technical matters derived by considering all the disclosures in the Patent Specification and Other Documents at Issue together.

[Patent ★] A case holding that a combination of three particular compounds separately described in the specification constituted added matter (a violation of the amendment requirements), because no basis was disclosed for the combination being inevitable — NAKAMURA & PARTNERS— Tokyo District Court, 2019 (Wa) No. 30991 <Presiding Judge Tanaka> [2,3-Dichloro-1,1,1-Trifluoropropane, 2-Chloro-1,1,1-Trifluoropropene, 2-Chlorowww.nakapat.gr.jp

IP High Court, 2016 (Gyo-Ke) 10257, Portable Information Communication Device <Mori>

Original Ameblo publication: 2022-01-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12722094731.html

IP High Court, 2016 (Gyo-Ke) 10257, Portable Information Communication Device <Mori>

*Adding a combination of matters described independently in two paragraphs of the specification ⇒ Addition of new matter.

“Paragraph [0143] contains no disclosure suggesting a relationship with the cases of browsing a web page or displaying television video described in paragraphs [0117] and [0118].”

(Excerpts from the judgment)

C. The plaintiff argues that Function A of the Invention-Defining Matter at Issue is derived by a person skilled in the art by considering together the disclosures in paragraphs [0117], [0118], [0120], [0143], and so forth of the Specification at Issue.

(a) However, paragraph [0117] does not describe downloading an image data file from a web server; it describes browsing a web page. The “page image” in that paragraph is an image of a web page displayed by a browser and cannot be regarded as a disclosure concerning downloading image data as a data file.

Moreover, that paragraph states that, when the web page being browsed uses a fixed-width layout wider than the horizontal screen resolution of LCD panel 15A, central processing circuit 1_10A1 generates a command to render a page image with the same number of horizontal pixels as that fixed width and writes it to VRAM 1_10C, while graphics controller 1_10B extracts bitmap data for an image having the same resolution as the screen resolution of LCD panel 15A and transmits it to LCD driver 15B. However, “as a result, the page image is displayed in a scrolling manner on LCD panel 15A.” Because the signal transmitted to LCD driver 15B is a signal containing bitmap data corresponding to a portion of the image, it cannot be said that, in this case, the resolution is changed from an image whose original resolution is greater than the screen resolution of the display panel to an image having the same resolution as the screen resolution of the display panel.

Next, paragraph [0118] describes the functions of graphics controller 1_10B, VRAM 1_10C, and so forth when mobile telephone 1 is used to watch television programs. Since the “image” displayed by mobile telephone 1 is the “image of a television program” received by television reception antenna 112A, this must be distinguished from downloading image data as a data file.

Furthermore, paragraph [0143] contains no disclosure suggesting a relationship with the cases of browsing a web page or displaying television video described in paragraphs [0117] and [0118]. Its disclosure is as stated above and describes displaying an image data file without changing its resolution. A person skilled in the art who reads paragraph [0143] therefore cannot be expected to associate it with paragraphs [0117] and [0118] and understand it as disclosing changing the resolution of an image file when downloading an image data file from a web server and displaying the image.

(b) Paragraph [0120] states that “digital audio signals and/or digital moving-image signals are converted into data files and stored, or the stored data files are read out and subjected to the necessary processing,” and that “image data files and/or audio data files can also be stored by accessing a website, … having central processing circuit 1_10A1 receive the received and converted digital signals via bus 19, perform the necessary conversion, and write them to flash memory 14A.” However, paragraph [0120] merely describes converting received “digital audio signals and/or digital moving-image signals” into data files in mobile telephone 1 and storing them, or reading them out for playback. Even considering that disclosure together

with paragraph [0143], the content of which is described above, a person skilled in the art cannot be expected to conceive of the function of reading bitmap data of an image having the same resolution as the screen resolution of the display panel from VRAM, generating a digital display signal conveying the bitmap data read out, and transmitting it to the display control means, when downloading from a web server an image data file whose original resolution is greater than the screen resolution of the mobile telephone's display panel and displaying the image.

(c) Accordingly, even considering together the respective disclosures in the Specification at Issue relied upon by the plaintiff, they cannot be found to yield the function relating to Correction Matter 7 of "when downloading an 'image data file whose original resolution is greater than the screen resolution of the display panel' from said web server and displaying the image, reading 'bitmap data of an image having the same resolution as the screen resolution of said display panel' from said VRAM, generating 'a digital display signal conveying said bitmap data read out,' and transmitting said digital display signal to said display control means." There is no other description or suggestion in the Specification at Issue concerning implementation of that function.

D. Therefore, Correction Matter 7 cannot be regarded as having been made within the scope of the matters disclosed in the Specification and Other Documents at Issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87162.pdf

IP High Court, 2020 (Gyo-Ke) 10027, Sensor Assembly for Body Fluids <Mori>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12722272844.html

IP High Court, 2020 (Gyo-Ke) 10027, Sensor Assembly for Body Fluids <Mori>

*Numerical values are matters of design choice.

In view of the respective disclosures in the cited reference … and in general, … changing the dimensions of a spacer groove according to sample size, sample amount, and so forth is a matter appropriately undertaken by a person skilled in the art.

⇒ Making the dimensions of the spacer's cutout groove … is obvious.

(Excerpts from the judgment)

In view of the respective disclosures … and the general principle that, for devices performing biochemical component analysis using electrodes, changing the dimensions of a spacer groove according to sample size, sample amount, and so forth is a matter appropriately undertaken by a person skilled in the art, making the dimensions of the spacer's cutout groove "10–50 mm in length, 1–5 mm in width, and 0.2–0.6 mm in depth" (giving an internal volume of 2–150 μL when calculated on this basis) must be regarded as something a person skilled in the art could readily have conceived.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90218.pdf

Tokyo District Court, 2019 (Wa) 30991, Composition Containing … or 2,3,3,3-Tetrafluoropropene <Tanaka>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12722444687.html

Tokyo District Court, 2019 (Wa) 30991, Composition Containing … or 2,3,3,3-Tetrafluoropropene <Tanaka>

*The original specification disclosed no basis for a combination of three particular compounds, each separately described, being inevitable.

— Nor did it state any reason for focusing on these compounds.

⇒ Amendment requirements not satisfied (addition of new matter).

(Excerpts from the judgment)

…Through the … amendment (the Amendment at Issue), claims 1 and 2 … of the Claims at Issue came to contain the wording "comprising … HFO-1243zf and HFC-245cb in an amount greater than zero weight percent and less than 1 weight percent." …

In the first place, the Original Specification does not in any way describe selecting, from among the many compounds listed as "additional compounds" to HFO-1234yf, the particular combination of HFO-1243zf and HFC-245cb. In this regard, although HFO-1234yf, HFO-1243zf, and HFC-245cb are each separately described in the Original Specification, they are not described as a combination of three particular compounds, nor is any basis disclosed for that particular combination of three compounds being inevitable. Furthermore, Table 6 (Example 16) lists eight compounds and an "unknown" component, but the Original Specification states no reason for focusing on "245cb" and "1234yf" among them. Moreover, the Original Specification describes many compounds not included in Table 6, as listed in claim 1 as originally filed. Nevertheless, selecting HFO-1243zf alone from among them and combining it with HFC-245cb and HFO-1234yf to form a configuration combining three compounds would require disclosure motivating a person skilled in the art to derive such a configuration, and no such disclosure can be found. (There is no evidence sufficient to establish that, between the priority date claimed for the Patent at Issue and the filing date, any disclosure was made to a different effect from the foregoing explanations.) …

[Patent ★] A case holding that a combination of three particular compounds separately described in the specification constituted added matter (a violation of the amendment requirements), because no basis was disclosed for the combination being inevitable — NAKAMURA & PARTNERS— Tokyo District Court, 2019 (Wa) No. 30991 <Presiding Judge Tanaka> [2,3-Dichloro-1,1,1-Trifluoropropane, 2-Chloro-1,1,1-Trifluoropropene, 2-Chlorowww.nakapat.gr.jp

[Gas Dissolution Apparatus] Can a Person Skilled in the Art Recognize that the Problem Can Be Solved When 0.8 < L < 1.4?

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12722979001.html

[Gas Dissolution Apparatus] Can a person skilled in the art recognize that the problem can be solved when 0.8 < L < 1.4?

(1) Tokyo District Court, 2017 (Wa) 13797 <Sato>

*It must be possible to recognize that the problem can be solved throughout the entire numerical range.

⇒ Support requirement not satisfied.

(2) IP High Court, 2019 (Gyo-Ke) 10025 <Otaka>

*The problem addressed by the invention was understood in abstract terms.

⇒ Support requirement satisfied.

*The different outcomes on the support requirement for the same patent, JP6116658, may partly reflect a change in the judges making the decision. However, I believe the difference is one of timing: (1) was a judgment during the two dark years, whereas (2) was a judgment after the pro-patent turn on the support requirement following the Pyrimidine Grand Panel decision.

⇒ Under the approach used in (1), many numerical-limitation inventions and parameter inventions would violate the support requirement!!

(Excerpts from judgment (1))

(a) …The Correction at Issue specifies the internal diameter and length of the "narrow tube" in claim 1 as "a narrow tube having an internal diameter greater than 1.0 mm and not greater than 3.0 mm (excluding those having a length of 0.8 m or less)." According to the wording of claim 1 after the Correction at Issue, the length of the corrected "narrow tube" encompasses all lengths greater than 0.8 m.

(b) The objectives of the Corrected Invention at Issue are (1) to dissolve a gas in a liquid in a supersaturated state and provide it while stably maintaining that supersaturated state, and (2) to provide a gas dissolution apparatus that can readily be attached to a water dispenser or the like. … Concerning the supersaturated concentration to be maintained, the Specification and Other Documents state that "the supersaturated state can be maintained by being greater than 2.0 ppm." … Regarding the "tubular passage" of the Corrected Invention at Issue, … they state that "depending also on the pressure of the liquid flowing inside it, tubular passage 5a is preferably relatively long and has a small diameter." According to these passages, stably maintaining the supersaturated state, which is the problem addressed by the Corrected Invention at Issue, requires a supersaturated concentration greater than 2.0 ppm. However, as to the length of the tubular passage (narrow tube), the only disclosure is that a relatively long length is preferred; it is unclear what specific length would solve the problem addressed by the Corrected Invention at Issue.

(c) Turning to the Examples and Comparative Examples disclosed in the Specification and Other Documents at Issue, Examples 1 through 13 reportedly used narrow tubes 1.4 m to 4 m long and obtained hydrogen water in a supersaturated state that could be maintained continuously. By contrast, the Comparative Examples reportedly used narrow tubes 0.4 m and 0.8 m long but could not obtain hydrogen water in a supersaturated state of 2.0 ppm or above. … The Examples and Comparative Examples … show that the problem addressed by the Corrected Invention at Issue can be solved using narrow tubes 1.4 m to 4

m long, but cannot be solved using narrow tubes 0.8 m or less in length. They do not, however, show results demonstrating that a narrow tube longer than 0.8 m but shorter than 1.4 m can produce hydrogen water capable of solving that problem.

(Excerpts from judgment (2))

The Correction at Issue … changed "a tubular passage serving as a pressure-reducing transfer means" to "a tubular passage serving as a pressure-reducing transfer means consisting of a narrow tube having an internal diameter greater than 1.0 mm and not greater than 3.0 mm (excluding those having a length of 0.8 m or less)," thereby limiting the numerical values for the internal diameter and length of the narrow tube. …

…The Specification at Issue is found to disclose that the problem addressed by Patented Invention 1 at Issue is to provide a "gas dissolution apparatus" that "dissolves a gas in a liquid in a supersaturated state and stably maintains that supersaturated state," and that, as the means for solving that problem, it adopts a configuration in which "a pressure-reducing transfer means is provided and the pressure applied to the liquid is further adjusted." …

It is common general technical knowledge that a larger value of pressure Y in the pressurized gas dissolution means allows more gas to dissolve in the liquid but may increase the velocity of the liquid flowing through the narrow tube, and that a larger value of narrow-tube length L may decrease the velocity of the liquid through resistance from the inner wall of the tube. … Where the internal diameter X of the narrow tube and the flow rate of hydrogen water are the same, it can be understood that the hydrogen concentration can be increased by selecting the respective values so that the rate of increase in pressure Y of the pressurized gas dissolution means exceeds the rate of increase in narrow-tube length L.

…From the detailed description of the invention in the Specification at Issue and common general technical knowledge, a person skilled in the art would understand that the gas dissolution apparatus of Patented Invention 1 at Issue generates hydrogen water by dissolving hydrogen in water and discharges it through an outlet; that it comprises gas generation means for generating a gas, pressurized gas dissolution means for pressurizing and dissolving the gas in a liquid, a dissolution tank for receiving the gas-containing liquid and maintaining it in solution and in storage, and pressure-reducing transfer means for reducing the pressure as the liquid flows through a tubular passage consisting of a narrow tube; and that its characteristic lies in preventing pressure fluctuations within the tubular passage caused by discharge of hydrogen water from the outlet and forming laminar flow within that passage through the pressure-reducing transfer means, rather than necessarily in strict numerical control. For example, even when the internal diameter X of the narrow tube is greater than 1.0 mm and not greater than 3.0 mm, and the length L is within a numerical range greater than 0.8 m and less than 1.4 m, the skilled person can take into account that "where the internal diameter X and the hydrogen-water flow rate are the same, the hydrogen concentration can be increased by increasing pressure Y of the pressurized gas dissolution means; and, where both pressure Y and narrow-tube length L are increased, the hydrogen concentration can be increased by selecting the respective values so that the rate of increase in pressure Y exceeds the rate of increase in narrow-tube length L." … By selecting X, Y, and L to form laminar flow in the hydrogen water within the tubular passage consisting of the narrow tube, the skilled person can recognize that the problem of Patented Invention 1 at Issue —"dissolving a gas in a liquid in a supersaturated state and stably maintaining that supersaturated state"— can be solved.

[Patents] Support Requirement (2): The Two Dark Years Immediately Before the Pyrimidine Grand Panel Decision#Patents #SupportRequirement #ProblemAddressedByTheInvention #Pyrimidine #PatentActArticle36 #GrandPanelDecision [Patents] Support Requirement (2): The Two Dark Years Immediately Before the Pyrimidine Grand Panel Decision (Hideki Takaishi, Attorney-at-law, Patent Attorney, and California Attorney) ★ Download the presentation materials here!! https://www.takaishihideki.co...www.youtube.com

Osaka District Court, 2015 (Wa) 5869, Scour Prevention Material for Underwater Structures <Morisaki>

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Osaka District Court, 2015 (Wa) 5869, Scour Prevention Material for Underwater Structures <Morisaki>

*If the publicly worked product falls within the numerical range, public working is established even without recognition of the range!!

“The plaintiff argues … that the numerical limitations would not be recognized, but if the manner of use of the publicly worked OB Net Unit falls within the above limited numerical values … then … the invention was publicly worked.”

(Excerpts from the judgment)

[Claim 1] …A scour prevention material for underwater structures, wherein the amount of lump material filling the bag body is such that, when the bag body is lifted by a suspension rope, 25%–80% of the height of the scour prevention material formed into a conical shape constitutes a conical void containing no lump material.

The plaintiff argues that, to the extent of the recognition described above, the numerical limitation “formula $3 \leq N/M \leq 20$” in constituent feature A or “25%–80%” in constituent feature E of the Invention at Issue would not be recognized. However, if the manner of use of the publicly worked OB Net Unit falls within the above limited numerical values—that is, corresponds to a subordinate concept of the Invention at Issue—it is proper to say that the Invention at Issue was publicly worked. The plaintiff’s argument on this point is therefore without merit.

[Patents] Novelty and Inventive Step Based on Publicly Worked Inventions[Patents] Novelty and Inventive Step Based on Publicly Worked Inventions (Hideki Takaishi, Attorney-at-law, Patent Attorney, and California Attorney) ★ Download the presentation materials here!! https://www.takaishihideki.com/youtube (1) ★ “Where the cited invention is a publicly worked invention, the embodiment itself is the actual concrete technology that exists, and ...www.youtube.com

IP High Court, 2020 (Gyo-Ke) 10147, Game Program <Mori>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12722981205.html

IP High Court, 2020 (Gyo-Ke) 10147, Game Program <Mori>

A person skilled in the art reading the Original Specification would understand that the “specific item” is not something “stored and retained in an item box.”

⇒ The invention-defining matter … of “storing and retaining a ‘specific item’ in an ‘item box’” constitutes added matter.

(Excerpts from the judgment)

…A person skilled in the art reading the Original Specification would understand that the “specific item” is not something “stored and retained in an item box.” Accordingly, the new invention-defining matter of “an item storage function that stores said specific item in association with an item box associated with said user,” which means “storing and retaining a ‘specific item’ in an ‘item box,’” cannot be regarded as falling within the scope of the technical matters derived by a person skilled in the art from considering all the disclosures in the Original Specification and Other Documents together.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90452.pdf

IP High Court, 2019 (Gyo-Ke) 10159, X-Ray Fluoroscopy Imaging Apparatus <Kanno>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12723163707.html

IP High Court, 2019 (Gyo-Ke) 10159, X-Ray Fluoroscopy Imaging Apparatus <Kanno>

It is entirely possible to regard the invention as significant for newly identifying the matter as a problem to be solved. …

It cannot be said that there is motivation, premised on the existence of such a problem, to adopt the features constituting the difference from the Cited Invention. …

"It is entirely possible to regard the claimed invention as significant for focusing on the operator's convenience and newly identifying, from the operator's perspective, a problem to be solved in order to facilitate image adjustment. …

Cited Document 1 neither describes nor suggests the problem (Problem B2) that the viewing direction of the 'operator,' who operates while looking at 'operating liquid crystal display device 21,' does not coincide with the direction in which the 'surgeon,' who looks at 'diagnostic image monitor device 17,' views the 'subject.' … It cannot be said that there is motivation, premised on the existence of such a problem, to adopt the features constituting the difference from the Cited Invention. …"

=IP High Court, 2010 (Gyo-Ke) 10075, Ventilation Fan Filter <Iimura>

(Excerpts from the judgment: X-Ray Fluoroscopy Imaging Apparatus)

…The defendant argues that … a person skilled in the art would … refer to the well-known problem … of aligning an image with each operator's direction of viewing the subject (viewing direction), where "operators" face the subject from different directions in an image display device showing the affected part of a subject during surgery, and would naturally identify the problem of aligning the orientation of the image on operating liquid crystal display 21 viewed by an operator facing the subject from a different direction with that operator's direction of viewing the subject (viewing direction), thereby providing motivation to apply Technical Matter 2 to the Cited Invention. However, … as the plaintiff argues, in light of the difference in relative authority and roles between the surgeon and the operator, operators previously concentrated on adjusting the image in the direction desired by the surgeon, in accordance with the surgeon's instructions, without specifically recognizing such a problem; by contrast, it is entirely possible to regard the claimed invention as significant for focusing on the operator's convenience and newly identifying, from the operator's perspective, a problem to be solved in order to facilitate image adjustment. …

The difference between the claimed invention and the Cited Invention is solely that the claimed invention "comprises an image rotation mechanism that rotates only the X-ray image displayed on said display unit among said X-ray images," whereas the Cited Invention contains no such specification (the image rotation mechanism itself in the claimed invention is nothing new). However, Cited Document 1 neither describes nor suggests the problem (Problem B2) that the viewing direction of the "operator," who operates while looking at "operating liquid crystal display device 21," does not coincide with the direction in which the "surgeon," who looks at "diagnostic image monitor device 17," views the "subject." The documents submitted by the defendant are insufficient to establish the existence of a problem, in an image display device showing the affected part of a subject during surgery, of aligning the orientation of the image on operating liquid crystal display 21 viewed by an operator facing the subject from a different direction with that operator's direction of viewing the subject (viewing direction). Therefore, there is no motivation,

premised on the existence of such a problem, to adopt the features constituting the difference from the Cited Invention. Moreover, the Trial Decision at Issue erred in identifying Technical Matter 2, and it cannot be said that the features constituting that difference would be conceived from the matters disclosed in Cited Document 2 (Technical Matter 2′). Accordingly, the claimed invention ultimately cannot be regarded as one that a person skilled in the art could readily have conceived based on the Cited Invention and Technical Matter 2′ disclosed in Cited Document 2. The contrary conclusion in the Trial Decision at Issue is erroneous, without any need to decide the remaining issues.

(Excerpts from the judgment: Ventilation Fan Filter)

…Whether an invention could readily have been conceived is a comprehensive determination. Thus, finding that an invention was obvious may require not only that "adopting a particular configuration to solve the problem was easy," but also that "setting the problem to be solved was easy." In other words, even if "adopting a particular configuration to solve the problem was easy," where "the setting of, or focus on, the problem to be solved was unique" (for example, where a problem not generally conceived was identified), the invention cannot automatically be said to be obvious. Since assessing whether "setting the problem to be solved was easy" concerns the ease of the conception itself, hindsight and subjective judgments are liable to intrude. A logical explanation based on evidence is therefore indispensable to prevent such judgments. It also goes without saying that, as a premise, accurately understanding the problem the invention sought to solve is particularly important in reaching a conclusion on obviousness. …

…Even the examples in Exhibits Ko 18, 19, 32, and so forth do not show the setting of the problem of "facilitating easy separation after use of a metal filter frame and a nonwoven filter material in a ventilation fan filter in which they are bonded by an adhesive, while maintaining a strong bond under ordinary conditions." A person skilled in the art therefore cannot be regarded as having been able readily to conceive of the features of Invention 1 at Issue differing from Invention A by applying the invention disclosed in Exhibit Ko 2 to Invention A. In other words, Exhibit Ko 2 does not suggest proceeding from Invention A to the characteristic feature of Invention 1 at Issue, namely, "using an aqueous emulsion adhesive containing a film-forming polymer (which bonds firmly under ordinary conditions but whose adhesive strength decreases upon immersion in water, allowing the metal filter frame and nonwoven filter material to be separated easily)." Ultimately, therefore, applying the invention disclosed in Exhibit Ko 2 to Invention A cannot be regarded as easy.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90249.pdf

Tokyo District Court, 2011 (Wa) 27781, Touch-Screen Display …, Interlocutory Judgment <Osuga>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12723344450.html

Tokyo District Court, 2011 (Wa) 27781, List Scrolling, Document Translation, Scaling, and Rotation on a Touch-Screen Display, Interlocutory Judgment <Osuga>

*Objects covered by 28 U.S.C. § 1782: necessity of examining the evidence denied.

“The above request for inspection and applications for an order to present objects for inspection and an order to produce documents are unnecessary to prove public working.”

(Excerpts from the judgment)

5. Request for inspection and applications for an order to present objects for inspection and an order to produce documents

Regarding their allegations of public working at Macworld and elsewhere and through the iPhone guided tour, the defendants requested inspection of, and an order to present for inspection, (1) the iPhone used in the demonstration at Macworld 2007, (2) the iPhone used in the demonstration in the iPhone guided tour, and (3) an iPhone installed with an executable file of the same version of the operating system installed on the iPhones in (1) and (2). They also applied for an order to produce a recording medium containing the source code for executing the same operating system as that installed on the iPhones in (1) and (2). However, the above request for inspection and applications for an order to present objects for inspection and an order to produce documents are unnecessary to prove public working, and all are therefore dismissed.

[Patents] Orders to Produce Documents (4): Gathering Evidence through U.S. Discovery for Use in Japan (U.S.C. § 1782)#Patents #OrdersToProduceDocuments #Discovery #Discovery #USC1782 #Intel #EvidenceGathering [Patents] Orders to Produce Documents (4): Gathering Evidence through U.S. Discovery for Use in Japan (U.S.C. § 1782) (Hideki Takaishi, Attorney-at-law, Patent Attorney, and California Attorney) ★ Download the presentation materials here...www.youtube.com

IP High Court, 2020 (Gyo-Ke) 10030, Drain Plug Device <Otaka>

Original Ameblo publication: 2022-01-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12723523451.html

IP High Court, 2020 (Gyo-Ke) 10030, Drain Plug Device <Otaka>

Even well-known technology requires motivation to combine.

⇒ No motivation (inventive step affirmed).

*Former Judge Shimizu stated that motivation is unnecessary for well-known technology if the technical field is the same, but the context was that “well-known technology” means technology so well known that motivation is unnecessary.

(Excerpts from the judgment)

Even considering the entire disclosure of Exhibit Ko 1 (including its drawings), … there is no passage suggesting a problem requiring improvement in terms of mounting strength, watertightness, or the like. … Exhibits Ko 3, 5, and 8 concerning the Well-Known Technology at Issue contain no discussion of the action or the like of the configuration in which an inward flange formed at the bottom of a cylindrical recessed portion is mounted by being clamped between a drain fitting and a connecting pipe. Nor do Exhibits Ko 3, 5, and 8 suggest that, in terms of mounting strength, watertightness, or the like, the configuration in which an inward flange is mounted by being clamped between a drain fitting and a connecting pipe is superior to the configuration shown in the drawings of Exhibit Ko 1, in which edge portion 2 is mounted by being clamped between drain cup 6 and drain casing 3. … A person skilled in the art who reads Exhibit Ko 1 cannot be said to recognize a problem with the configuration of edge portion 2 of the Exhibit Ko 1 Invention in terms of mounting strength or watertightness. Accordingly, motivation to apply the configuration of the Well-Known Technology at Issue to edge portion 2 of the Exhibit Ko 1 Invention cannot be found.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90279.pdf

Osaka District Court, 2007 (Wa) 2076, Combination Weighing Apparatus

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12723691765.html

Osaka District Court, 2007 (Wa) 2076, Combination Weighing Apparatus

*Sales to overseas customers were used as the basis for the damages calculation.

(A general principle was also stated.)

Cf. The Intellectual Property High Court Grand Panel decision, 2012 (Ne) 10015, "Waste Storage Device," also concerned overseas lost profits of the plaintiff (a foreign corporation).

*Although the patent was corrected after expiration of its term, negligence was presumed under Article 103 of the Patent Act.

(Excerpts from the judgment)

The evidence … and the entire purport of oral argument establish that, during the term of the Patent at Issue …, the defendant manufactured and sold 236 units of the Defendant's Products for the domestic market and 4,562 units for foreign markets; that during that period sales of the Defendant's Products for the domestic market amounted to ¥915,598,000 and those for foreign markets amounted to ¥25,537,859,000; that gross profit, calculated by deducting cost of sales from sales, was ¥85,938,000 for domestic sales and ¥6,965,416,000 for foreign sales; and that operating expenses associated with sales of the Defendant's Products (the total of selling expenses and general administrative expenses) were ¥455,759,000 for domestic sales and ¥4,829,031,000 for foreign sales. … It is appropriate to calculate the defendant's marginal profit by deducting from the gross profit associated with sales of the Defendant's Products the respective portions of the defendant's foreign operating expenses (… yen …) and domestic operating expenses (… yen …). …

Needless to say, the Patent Right at Issue is effective only within Japan. However, as the patentee, the plaintiff exclusively holds the right not only to manufacture products embodying the Patented Invention at Issue in Japan and sell them in Japan in the course of business, but also to work the invention by manufacturing such products in Japan and selling (exporting) them to foreign customers and others in the course of business. The plaintiff has exclusive rights under the Patent Right at Issue over these acts of working. … The defendant established … YDW … as a sales company in the United States; received, through YDW, orders compiling customers' requirements for the model, specifications, and presence or absence of accessories of the Defendant's Products; manufactured the products in Japan; sold them initially to YDW; and then delivered them to customers. It is also established that the Defendant's Products were sold to customers in foreign countries other than the United States in the same manner. These acts plainly infringe the plaintiff's above exclusive rights, and it is equally clear that they deprived the plaintiff of profits it could have obtained based on those rights. …

Even if the plaintiff and its affiliate have brought damages actions in Europe under patent EP268346 against the defendant's customers concerning the same Defendant's Products manufactured and sold by the defendant as those at issue in this litigation, patent EP268346 and the Patent Right at Issue are separate rights. Moreover, in this action the plaintiff seeks compensation under Article 102(2) of the Patent Act for the profits obtained by the defendant through manufacturing and selling the Defendant's Products, treating those profits as damages. It does not seek compensation for the profits obtained by the defendant's customers as damages suffered by the plaintiff. Accordingly, the plaintiff cannot be found to be seeking

double recovery in Japan and Europe for the same Defendant's Products, and it is not appropriate to limit the plaintiff's claim in this action concerning the Defendant's Products destined for Europe. …

As examined above, all Defendant's Products manufactured in Japan and sold for foreign markets must be included within the scope of the damages sought in this claim.

The defendant also argues that the presumption of negligence under Article 103 of the Patent Act does not apply where grounds for invalidity appear to exist in the patent before correction. However, even if grounds for invalidity existed in the patent based on the claims before correction, it is possible that they would be overcome through a request for a correction trial or a request for correction in an invalidation trial, and this must be regarded as readily foreseeable. Accordingly, the presumption of negligence under Article 103 should require only foreseeability that one's conduct is an act of working falling within the technical scope of the patented invention. The mere existence of grounds for invalidity in the patent before correction cannot be understood to rebut the presumption of negligence under Article 103. …

Article 724 of the Civil Code establishes a time limit (extinctive prescription) for tort damages claims. In view of the fact that legal relationships arising from tort may occur between previously unknown parties based on unexpected circumstances, it provides a special rule for the starting point of extinctive prescription with the victim's exercise of a damages claim in mind. Thus, "the time when [the victim] comes to know of the damage and the perpetrator" in that Article should be understood to mean the time when the victim learns of these matters to an extent that makes a damages claim against the perpetrator practically possible, in circumstances permitting such a claim. The time when the victim comes to know of the damage should be understood as the time when the victim actually recognizes that damage has occurred. For a damages claim based on the tort of patent infringement, as in this case, even if the victim knows that the perpetrator is manufacturing and selling a product, the victim cannot actually recognize resulting damage or exercise a damages claim unless the victim actually recognizes, by comparing the product with its patented invention, that the product falls within its technical scope and that the perpetrator's conduct infringes the victim's patent right. Accordingly, "knowing of the damage and the perpetrator" should be understood to require actual recognition that the perpetrator's conduct infringes the victim's patent right. …

The defendant argues that … the Settlement at Issue licenses it to work the U.S. '125 Patented Invention, which concerns substantially the same technology as the Patented Invention at Issue; that this also permits manufacturing the Defendant's Products embodying the U.S. '125 Patented Invention in Japan for export to the United States; and that the Defendant's Products destined for the United States are therefore outside the scope of damages. … (However,) the Settlement at Issue expressly defines the scope of licensed patent and other rights as those listed in the Schedule at Issue, "patent rights concerning automatic quantitative weighing apparatuses granted by the date of this settlement," and "rights relating to pending patent applications concerning automatic quantitative weighing apparatuses published by the date of this settlement." Because the application for the Patent at Issue was published after the Settlement at Issue, the wording of the settlement terms clearly excludes the Patent Right at Issue from the license granted by that settlement. Furthermore, patent rights are separate rights arising in each country. Even where they concern substantially identical technology, it is entirely possible, and not at all unnatural, to grant a license under a patent in one country but not another according to each country's market conditions and so forth. In addition, the Schedule at Issue, which lists the rights licensed under the Settlement at Issue, classifies the licensed patent and other rights by country. It is therefore clear that the plaintiff and the defendant naturally proceeded on the premise that the Settlement at Issue would determine separately, for each country's patent rights, whether a license would be granted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-38428.pdf

IP High Court, 2020 (Gyo-Ke) 10037, Gaming Machine <Otaka>

Original Ameblo publication: 2022-01-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724234706.html

IP High Court, 2020 (Gyo-Ke) 10037, Gaming Machine <Otaka>

This would change the grounds for refusal in the trial decision at the litigation stage. Allowing such a change would deprive the appellant in the appeal against the examiner's refusal of an opportunity to defend itself in those appeal proceedings;

*Even if the primary cited document is the same, a new technical matter cannot be asserted in an action to rescind the trial decision.

(Excerpts from the judgment)

…The defendant's above argument amounts to asserting that the Amended Claimed Invention lacks novelty based on an invention relating to Technical Matter A that differs from the Cited Invention identified in the Trial Decision at Issue as the invention disclosed in Cited Document 1. It changes, at the stage of this litigation, the grounds for refusing the application stated in the Trial Decision at Issue. Allowing such a change in grounds for refusal would deprive the appellant of its opportunity to defend itself in the proceedings for an appeal against the examiner's refusal (Patent Act Articles 159(2) and 50). The argument itself should therefore not be permitted merely because the primary cited reference is the same. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90211.pdf

Tokyo District Court, 2019 (Wa) 31214, Vinylidene Chloride Resin Wrapping Film <Tanaka>

Original Ameblo publication: 2022-02-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724415647.html

Tokyo District Court, 2019 (Wa) 31214, Vinylidene Chloride Resin Wrapping Film <Tanaka>

A case affirming inventive step by rejecting the obviousness of focusing on a “parameter,” and also finding the support requirement satisfied, where it was unclear whether satisfying the composition values would also satisfy the physical-property values. Infringement was also affirmed.

I have uploaded a commentary to the firm’s website!!

[Summary of This Judgment and Some Observations]

1. Claims (Claim 1)

(A, B, and D are “physical-property values”; the others are “composition values.” ⇒ The primary reference matches all the “composition values,” but its “physical-property values” are unknown.)

A. Having a tear strength in the TD direction (the width direction of the wrapping film) of 2–6 cN, and

B. a tensile modulus in the MD direction (the machine direction of the wrapping film) of 250–600 MPa,

C. a vinylidene chloride resin wrapping film,

D. having a low-temperature crystallization onset temperature of 40–60°C as measured by a temperature-modulated differential scanning calorimeter,

E. relative to a polyvinylidene chloride resin containing 72–93% vinylidene chloride repeating units,

F. containing 0.5–3% by weight of an epoxidized vegetable oil and 3–8% by weight of at least one compound selected from the group consisting of citric acid esters and dibasic acid esters, and

G. having a thickness of 6–18 μm,

H. the vinylidene chloride resin wrapping film.

2. Inventive Step of Parameter Inventions (Related Cases Are Presented Below)

*This judgment recognized inventive step by rejecting the obviousness of focusing on the parameter (= IP High Court, 2019 (Gyo-Ke) No. 10137, Celecoxib Composition <Otaka>).

*The court recognized critical significance, but it was not decisive (= IP High Court, 2020 (Gyo-Ke) No. 10043, Crosslinked Acrylic Resin Particles <Mori>).

*The court held that the evidence did not establish that the problem addressed by the Invention at Issue had been known.

(Excerpts from the judgment)

…The defendant argues that a “vinylidene chloride resin wrapping film” satisfying the composition values of the Invention at Issue necessarily also satisfies its physical-property values (constituent features A, B, and D). However, … because that relationship is not established for the Invention at Issue, Cited Invention 1-2 cannot be found necessarily to satisfy the physical-property values merely because it is a “vinylidene chloride resin wrapping film” satisfying the composition values of the Invention at Issue. Nor is there other evidence sufficient to establish this. … It cannot be said to lack novelty. …

Although Cited Reference 1-2 (Defendant’s Exhibit 12), the primary reference, describes “adhesiveness” and “cuttability” as performance characteristics of wrapping film, it does not describe the related physical

properties of “tear strength” or “tensile modulus,” nor does it suggest that setting numerical ranges for them is a problem to be solved. It is therefore difficult to say that a person skilled in the art reading Cited Reference 1-2 would have motivation to single out “tear strength” and “tensile modulus” from among various physical properties and apply Cited Reference 2. The above difference cannot be regarded as readily conceivable. …

The defendant argues that, even if there is a difference between the Invention at Issue and Cited Invention 1-2 relating to the physical-property value in constituent feature D of the Invention at Issue (a low-temperature crystallization onset temperature of 40–60°C), the numerical range for that property lacks critical significance and cannot support inventive step. However, according to the Specification at Issue, the Invention at Issue seeks to solve the problem of suppressing unwanted tearing by controlling the “low-temperature crystallization onset temperature,” which exceeded 60°C in conventional wrapping films, to “40–60°C” (it does not fall below 40°C), through adjustments to the film stretching environment, stretching ratio and speed, relaxation environment and ratio, storage environment of the original film roll, and so forth. Its effect is demonstrated by the Examples and Comparative Examples. … Accordingly, the numerical range for the physical-property value in constituent feature D cannot be said to lack critical significance. Moreover, neither Cited Reference 1-2 nor Cited Reference 2 describes “low-temperature crystallization onset temperature” or suggests that setting its numerical range is a problem to be solved. A person skilled in the art reading Cited Reference 1-2 (and Cited Reference 2) therefore cannot be said to have motivation to single out “low-temperature crystallization onset temperature” from among various physical properties, and the above difference cannot be regarded as readily conceivable. The defendant’s argument cannot be accepted. … Nor can the Invention at Issue be said to lack inventive step based on Cited Invention 1-2.

3. The Proper Relationship Between “Composition Values” and “Physical-Property Values” Under the Support Requirement

*This judgment also found the support requirement satisfied where it was unclear whether satisfying the “composition values” would satisfy the “physical-property values,” without requiring that a film defined by the “composition values” have a high probability of satisfying the “physical-property values” (the exact opposite of the IP High Court decision in 2016 (Gyo-Ke) No. 10189, Optical Glass <Tsuruoka>!!).

*In the IP High Court case 2016 (Gyo-Ke) No. 10189, Optical Glass <Tsuruoka>, the court held that “it is necessary that a person skilled in the art can recognize, from descriptions or suggestions in the detailed description of the invention or from common general technical knowledge at the filing date, that the optical glass defined by the composition requirements of the application can satisfy the physical-property requirements of the application with a high probability.” (*However, the outcome in Optical Glass favored the rights holder.)

*In the IP High Court case 2012 (Gyo-Ke) No. 10151, High-Strength, High-Ductility Steel Sheet for Containers <Shibata>, the question was likewise whether an “alloy,” limited only in its carbon weight percentage, would satisfy the numerical limitations specified in the claim even with compositions other than those described in the specification. The court found a violation of the support requirement.

(Excerpts from the judgment)

…The defendant argues that, if the relationship whereby a wrapping film satisfying the composition values of the Invention at Issue also satisfies its physical-property values is rejected, … the support requirement is not satisfied. … Considering this point, … the “Problem to Be Solved by the Invention” section of the Specification at Issue states that, with conventional vinylidene chloride resin wrapping films, lowering the tear strength to improve cuttability leads to frequent unwanted tearing, while increasing the tear strength to reduce such tearing worsens cuttability, and that achieving both suppression of unwanted tearing and improved cuttability was therefore a problem. … Furthermore, the “Means for Solving the Problem” section states that, as the means for solving that problem, the Invention at Issue adopts … a vinylidene

chloride resin wrapping film having physical-property values of a tear strength in the TD direction of 2–6 cN, a tensile modulus in the MD direction of 250–600 MPa, and a low-temperature crystallization onset temperature of 40–60°C measured by a temperature-modulated differential scanning calorimeter. … Thus, … the problem addressed by the Invention at Issue is to provide a vinylidene chloride resin wrapping film achieving both suppression of unwanted tearing and improved cuttability. As its means of solution, the Invention at Issue adopts a film satisfying the physical-property values in addition to the composition values. It can readily be recognized that this results in a vinylidene chloride resin wrapping film achieving both suppression of unwanted tearing and improved cuttability. …

On the foregoing basis, the Invention at Issue is described in the detailed description of the invention in the Specification at Issue and falls within the scope in which it can be recognized from that description that the problem can be solved. The Patent at Issue therefore cannot be said to have a ground for invalidity (Patent Act Article 123(1)(iv)) based on failure to satisfy the support requirement (Article 36(6)(i)).

4. Infringement of Parameter Inventions

*The plaintiff's measurement conditions and so forth were appropriate, while the defendant's measurement conditions were inappropriate. ⇒ Infringement.

*Where numerical measurements vary depending on the measurement conditions, if those conditions can be derived from the specification or from common general technical knowledge at the filing date, whether a product falls within the scope is determined by the results obtained under those conditions. One point to note for this category is that, where multiple measurement conditions were conventionally known and the specification does not uniquely identify the conditions, the technical scope of the invention is narrower when specific measurement conditions are not recited in the claim (the opposite of the usual intuition). This is because, without specific measurement conditions in the claim, infringement must be established under every one of the "conventionally known measurement conditions."

(Excerpts from the judgment)

…Regarding "tear strength in the TD direction" in constituent feature A of the Invention at Issue, the defendant argues that the method for measurement using a "light-load tear tester (manufactured by Toyo Seiki)" in accordance with "JIS P 8116" is unclear, and that measurements made through a third-party organization in accordance with "JIS P 8116" produced a result of approximately 7 cN. However, … according to paragraph [0057] of the Specification at Issue, a person skilled in the art can understand how to measure the "tear strength in the TD direction" of wrapping film using a "light-load tear tester (manufactured by Toyo Seiki)." The "Test Method" field of the test certificate … prepared by Kaken Test Center, a general incorporated foundation, and submitted by the defendant states "JIS P 8116 applied mutatis mutandis," and the number of superimposed test specimens was 16. It is therefore considered that the measurement used an "Elmendorf-type tear tester" … described in "JIS P 8116" … rather than the "light-load tear tester (manufactured by Toyo Seiki)" … specified in the Specification at Issue. … The measurement method itself thus differs from the method that can be understood from the Specification at Issue. …

[Related Cases: Inventive Step of Parameter Inventions]

Regarding inventive step of numerical-limitation inventions and parameter inventions, the JPO Examination Guidelines present an approach that recognizes inventive step where there is an unpredictable advantageous effect that is either "different in kind" from that of the cited invention or "of the same kind but remarkable," and denies inventive step for inventions lacking such effects.

Looking back at past cases, until around 2010 there were a certain number of judgments, like the JPO Examination Guidelines, determining inventive step of numerical-limitation inventions and parameter inventions according to whether the invention had an "effect different in kind" or an "effect of the same

kind but remarkable." Under that test, the rights holder must allege and prove the effects and thus bears the burden of proof.

However, looking at more recent cases, the Pharmaceutically Stable Formulation of Oxaliplatinum case <Iimura> (Intellectual Property High Court, January 31, 2011, see the courts' website, 2010 (Gyo-Ke) No. 10122) held: "Generally, in determining whether an invention could readily have been conceived, it is reasonable to reach a conclusion by comparing the invention with a particular prior invention, identifying the features that differ, and examining whether, given the state of the art at the filing date, a person skilled in the art could readily have arrived at the features of the invention relating to those differences. … This approach does not differ at all even where the features relating to the differences include features limited by a numerical range. Needless to say, the invention's technical significance, the nature of the problem solving, its effects, and so forth must be considered comprehensively, including the features relating to other differences." From around that time, the overwhelming majority of judgments have differed from the JPO Examination Guidelines: they regard the parameters or numerical values as invention-defining matters and assess whether setting those parameters or values and their ranges would have been obvious, recognizing inventive step if it would not. As with ordinary inventive-step analysis, this framework places on the party denying inventive step the burden of alleging and proving the obviousness of setting the parameter or numerical value and its range. Once a new parameter or numerical value is set, proving obviousness is often difficult, except where it can be uniquely converted to an existing one (in which case it is difficult to call it new). Many judgments have therefore been unable to deny inventive step conclusively.

That is, (1) where the parameter or numerical value itself is new and motivation to focus on it cannot be demonstrated, the mainstream in recent case law is to reject the obviousness of the invention-defining matter and affirm inventive step. In contrast, (2) turning to cases where the parameter or numerical value itself was found to have been known or capable of attracting attention, even recent case law contains many instances in which its range was held obvious and inventive step was denied (on grounds such as that it was a matter of design choice or that combination with a secondary cited invention disclosing the parameter or numerical value was obvious).

Accordingly, (1) the decisive issue in assessing inventive step for an invention whose scope is defined by a new "numerical value" or "parameter" is whether a person skilled in the art at the filing date could readily have focused on that value or parameter. This is consistent with the general reasoning for denying inventive step of a parameter invention stated in the Stretch Wrapping Film case discussed below (Intellectual Property High Court, September 26, 2005, see the courts' website, 2005 (Gyo-Ke) No. 10222): "There must be motivation to focus on the parameter, and specific means for achieving Requirements B and C must be known to a person skilled in the art." Also instructive are the Film-Like Adhesive for Circuit Connection and Circuit Board case below (Intellectual Property High Court, April 12, 2005, see the courts' website, 2005 (Gyo-Ke) No. 10091), which relied on the upper and lower limits of the numerical range each solving a particular problem as grounds for affirming inventive step, and the Run-Flat Tire case below <Takabe> (Intellectual Property High Court, December 21, 2017, see the courts' website, 2017 (Gyo-Ke) No. 10058), which denied inventive step through the following reasoning: (1) the parameter could have attracted attention ⇒ (2) there was motivation to combine the primary and secondary references ⇒ (3) the numerical values had no remarkable effect ⇒ (4) the numerical range was a matter of design choice. Beyond these, my analysis of all the cases leads me to believe the key phrase is "the problem addressed by the invention." If it can be demonstrated that a person skilled in the art at the priority date knew of, or could have focused on, the problem addressed by the invention, it may be possible to reason that focusing on the "numerical value" or "parameter" from that problem was also obvious. Conversely, if a person skilled in the art at the priority date could not have focused on the problem addressed by the invention, it is difficult to establish that focusing on the new "numerical value" or "parameter" was obvious, making inventive step more likely to be affirmed.

(2) Even where the parameter or numerical value itself was found to have been known or capable of attracting attention, if the problem addressed by the invention was known or could have attracted attention, the range of that “numerical value” or “parameter” is more likely to be regarded as a matter of design choice. If a secondary reference discloses that “numerical value” or “parameter,” combining it with the primary reference is more likely to be held obvious.

These observations are not peculiar to numerical-limitation inventions and parameter inventions; rather, they align with recent case-law trends for inventions generally. When assessing whether combining primary and secondary references is obvious, recent judgments give considerable weight not only to the commonality of problems between those references, as indicated by the JPO Examination Guidelines, but also to the commonality of problems between the invention at issue and the primary reference. Where those problems differ, courts tend to affirm inventive step on the basis that arriving at the invention at issue from the primary reference would not have been obvious.

⇒ When assessing whether combining primary and secondary references is obvious, recent judgments give considerable weight not only to the commonality of problems between those references, as indicated by the JPO Examination Guidelines, but also to the commonality of problems between the invention at issue and the primary reference. Where those problems differ, courts tend to affirm inventive step on the basis that arriving at the invention at issue from the primary reference would not have been obvious.

For numerical-limitation inventions and parameter inventions as well, insofar as the “numerical value” or “parameter” is treated as an invention-defining matter and its obviousness is assessed, the question, as with ordinary inventions, is whether arriving at that value or parameter from the primary reference would have been obvious. In that assessment, considerable weight tends to be given to the commonality of problems between the invention at issue and the primary reference. Together with the recent judicial tendency to regard “numerical values” or “parameters” as invention-defining matters, this has brought the problem addressed by the invention into focus for numerical-limitation inventions and parameter inventions as well.

Finally, I consider the relationship between the framework in the JPO Examination Guidelines and that in recent case law, and which is more likely to result in an affirmative finding of inventive step. For a rigorous analysis, first consider the relationship between an invention’s “problem” and “effect.” Even if “whether a problem to be solved and a means of solving it have been presented is inseparably related to the nature of the ‘effect of the invention,’” the two do not correspond one to one. If solving any of Problems A, B, or C produces Effect α, there are three possible problems whose solution can produce Effect α. Thus, if the inquiry is whether the “effect” differs in kind, as in the JPO Examination Guidelines, inventive step may be denied because the effect does not differ in kind from that of a reference solving a problem (for example, Problem B or C) different from the invention’s problem (for example, Problem A). Under the framework in recent case law, however, even in such a situation inventive step may still be affirmed on the basis that focusing on the “numerical value” or “parameter” to solve new Problem A, which differs from the problem addressed by the cited invention, was not obvious. First, therefore, in terms of the relationship between the invention’s “problem” and “effect,” the latter framework (recent case law) appears to permit a broader range of affirmative inventive-step findings. (However, where the “effect” differs, the invention’s “problem” often differs too.)

Continuing this analysis, where an “effect different in kind” is recognized under the JPO Examination Guidelines’ framework, the corresponding relationship is that the parameter or numerical value is new and focusing on it is not obvious. Where an “effect of the same kind but remarkable” is recognized, the corresponding relationship is that the range is not obvious even if the parameter or numerical value is publicly known. Accordingly, when an “effect different in kind” or an “effect of the same kind but remarkable” is recognized, both frameworks reject obviousness of the parameter/numerical invention and affirm inventive step. Conversely, where neither type of effect is recognized, the JPO Examination Guidelines’ framework immediately yields a negative inventive-step finding. Under the framework in

recent case law, however, inventive step is affirmed unless, in light of the problem addressed by the invention, both focusing on the “numerical value” or “parameter” and defining its range would have been obvious. Inventive step is therefore easier to establish under the recent case-law framework. In fact, in reviewing and analyzing all the cases, I have found that this judicial tendency is reflected in the many judgments since 2008 rescinding trial decisions that had denied inventive step. This also supports the foregoing analysis.

The converse of these observations is that, in constructing an argument against inventive step of a parameter or numerical value under the recent case-law framework, one should focus first on (1) proving that “the parameter or numerical value itself was known,” or first proving that the problem addressed by the invention was known and then using this as a foothold to prove that “a person skilled in the art at the priority date could have focused on the parameter or numerical value itself.” Next comes (2) a second stage, again using the problem addressed by the invention as a foothold, attempting to establish that the range of the parameter or numerical value was a matter of design choice or was disclosed in a secondary reference that could readily be combined, and so on. Thus, two stages of reasoning are required (three if proof that the problem addressed by the invention was known is counted separately).

Below, among the cases treating parameters or numerical values as invention-defining matters, I introduce those affirming inventive step (finding non-obviousness), followed by those denying inventive step (finding obviousness). Comparing the two sets of cases reveals the reasoning and argument strategy described above for denying inventive step of numerical-limitation inventions and parameter inventions.

<Omitted in the original>

[Patent ★] Action for Damages and Other Relief (A case affirming inventive step by rejecting the obviousness of focusing on a “parameter,” and also finding the support requirement satisfied, where it was unclear whether satisfying the composition values would also satisfy the physical-property values. Infringement was also affirmed.) — NAKAMURA & PARTNERS— Tokyo District Court, 2019 (Wa) No. 31214, Vinylidene Chloride Resin Wrapping Film <Presiding Judge Tanaka> — ◆ Full text of the judgmentwww.nakapat.gr.jp

[U.S. Designs] September 2019, CAFC, Curver Luxembourg v. Home Expressions

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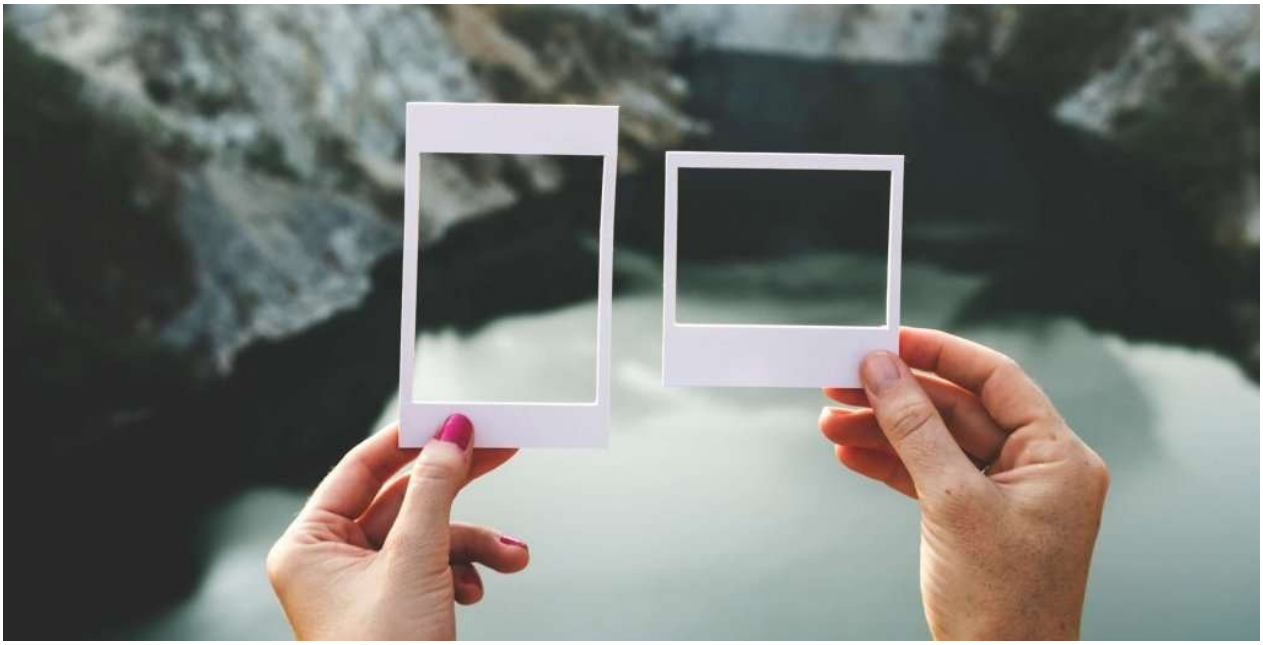
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724778130.html

[U.S. Designs] September 2019, CAFC, Curver Luxembourg v. Home Expressions

In assessing infringement of a U.S. design patent, although the drawings in the design patent publication did not show a “chair,” the claim wording had been amended to a pattern for “a chair.”

⇒ The design patent right is limited to a pattern for a chair.

The Scope of Prior Art Available for Design Patents Narrows — Open Legal Community The U.S. Court of Appeals for the Federal Circuit (CAFC) held that prior art for design patent applications is limited to analogous fields. This makes obtaining design patents easier for applicants, but may make invalidating design patents more difficult.openlegalcommunity.com



[U.S. Designs] October 2021, CAFC, In re SurgiSil, L.L.P.

Original Ameblo publication: 2022-02-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724778280.html

[U.S. Designs] October 2021, CAFC, In re SurgiSil, L.L.P.

In assessing anticipation of a U.S. design patent, the claimed design is limited to the lip implant identified in the claim and depicted in the drawings. A prior-art design for an art tool therefore does not anticipate the claimed lip implant merely because the shapes are similar.

Cf. 2019 CAFC "Curver"

https://www.cafc.uscourts.gov/opinions-orders/20-1940.opinion.10-4-2021_1843781.pdf

June 2014, U.S. Supreme Court, Nautilus v. Biosig

Original Ameblo publication: 2022-02-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724778476.html

June 2014, U.S. Supreme Court, Nautilus v. Biosig

Definiteness requirement: the reasonable-certainty standard. The Court changed the test to indefiniteness where a person skilled in the art, even after consulting the specification and prosecution history, cannot understand the scope of the invention with reasonable certainty.

⇒ A violation of the definiteness requirement is now more likely to be found!!

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/Nautilus-v-Biosig.pdf

October 2019, CAFC, HZNP v. Actavis

Original Ameblo publication: 2022-02-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724778588.html

October 2019, CAFC, HZNP v. Actavis

Definiteness requirement: the claim language “consisting essentially of.” To determine whether an unnamed, unrecited ingredient materially changes the basic and novel properties, the standard in the Supreme Court’s Nautilus decision requires those properties to be known and clear.

⇒ The conclusion was indefiniteness.

https://www.oliff.com/wp-content/uploads/2019/11/2017-2149-OBJP.pdf

August 2021, CAFC, Eli Lilly v. Teva

Original Ameblo publication: 2022-02-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724778695.html

August 2021, CAFC, Eli Lilly v. Teva

In contrast to product claims, a method of use depends entirely on “what is done.” Since what is done is ordinarily recited in the preamble, the purpose of a method of use tends to be construed as limited by the preamble.

In the United States, a method claim’s preamble may be limiting in light of the specification and other relevant context; it was limiting in this case.

https://www.cafc.uscourts.gov/opinions-orders/20-1876.opinion.8-16-2021_1819528.pdf

I Have Uploaded an Article Introducing the LINE Furufuru (“Shake It”) Lawsuit to the Firm’s Website. Tokyo District Court, 2017 (Wa) 36506 <Sato>

Original Ameblo publication: 2022-02-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724873890.html

I have uploaded an article introducing the LINE Furufuru (“Shake It”) lawsuit to the firm’s website.

2017 (Wa) 36506 <Sato>

(1) A case in which the logic of extracting only the “GPS search function” from a secondary reference and applying it to the primary reference was rejected, and inventive step was recognized because there was a teaching away from that application.

(2) A case holding that the defendant’s services for which infringement had not been argued were outside the scope of damages, and that sales having “at most a tenuous relationship” lacked an adequate causal relationship and were outside the scope of damages under paragraph (3).

[Summary of This Judgment and Some Observations]

1. Claims (Claim 1)

A. A computer system that supports interaction through communication over a network using a computer, by users who have met in the real world operating user terminals,

B. comprising contact-list display control means for controlling the display to a user of a list of multiple contacts so that users who have mutually agreed to interact through communication can interact;

C. input-content notification means for notifying, at said user terminals, content entered by a user and a selected other user through operation of their user terminals, so that, when the user selects and designates a person with whom the user wishes to communicate from among the multiple contacts displayed by said contact-list display control means, the selecting user and the selected other user can convey their entered content to each other and send and receive messages;

D. search means for obtaining location information of said user terminals and, based on that information, searching for user terminals located within a predetermined distance during a predetermined time;

E. and contact-addition means for performing a contact-addition process that adds a terminal as a new contact to said contact list to enable sending and receiving said messages with the terminal found by the search, on the necessary condition that said search means has found a user terminal located within said predetermined distance during said predetermined time;

F. wherein, when a person who has selected and designated a person with whom to communicate from among said multiple contacts performs an operation of entering and sending a message to the selected person, control is executed to provide, at the selected person’s user terminal, a pop-up notification that a message has been entered, while

G. in response to a request from one of the user terminals designated as said contacts and capable of sending and receiving messages with each other, control is performed so that said pop-up notification is not given even if an operation of entering and sending a message is performed from the other user terminal;

H. and wherein said contact list is displayed on said user terminal based on control from said computer, thereby enabling said users to interact without disclosing personal contact information to each other;

I. the computer system.

2. Excerpts from the Judgment (1): The Inventive-Step Analysis

(1) Differences from the Primary Cited Invention (Exhibit Otsu 5)

"(b) Difference 2

The Inventions at Issue comprise so-called GPS search means for obtaining the location information of user terminals and searching, based on that information, for user terminals located within a predetermined distance during a predetermined time, whereas the Exhibit Otsu 5 Invention does not comprise such search means.

(c) Difference 3

The Inventions at Issue obtain location information of user terminals and perform a contact-addition process to add a contact to the contact list on the necessary condition that, based on that location information, a user terminal located within a predetermined distance during a predetermined time has been found. By contrast, the Exhibit Otsu 5 Invention adds other-party IDs to a list based on short-range wireless communication between the users' encounter-support devices 11."

(2) Assessment of the Obviousness of Differences 2 and 3

"Difference 2 … and Difference 3 … concern the following distinction: the Inventions at Issue use GPS search means to obtain location information of user terminals and perform a contact-addition process to add a contact to the contact list on the necessary condition that a user terminal located within a predetermined distance during a predetermined time has been found based on that information, whereas the Exhibit Otsu 5 Invention adds other-party IDs to a list based on short-range wireless communication between the users' encounter-support devices 11.

On this point, the defendant argues that, as described in Publications Otsu 42 through 45, means for detecting the distance between user terminals in encounter-support systems using such terminals are known to include wireless radio communication between terminals and GPS searches; that it is common general technical knowledge that a person skilled in the art appropriately selects between these; and that Publication Otsu 5 not only permits methods other than transmitted and received radio waves for detecting proximity between users but also contemplates integration with a PDA having GPS functionality. The defendant therefore argues that a person skilled in the art could readily have conceived of configuring the Exhibit Otsu 5 Invention to detect proximity using GPS search means.

(a) Considering this issue, the technologies disclosed in Publications Otsu 43 through 45 cited by the defendant all presuppose disclosure to the other party of personal information such as name, address, telephone number, and email address. There is therefore a teaching away from applying those technologies to the Exhibit Otsu 5 Invention, whose purpose is 'to improve the likelihood of encounters between users, particularly between men and women, with matching hobbies and preferences, without the other party learning important personal information in the initial stages of an encounter.' Moreover, in light of the fact that Exhibit Otsu 42 was published three months before the priority date of the Patent at Issue (February 15, 2010), on December 17, 2009 [sic], the technology disclosed in that publication cannot be recognized as well known at the priority date of the patent application at issue.

(b) Next, we consider the defendant's argument that Publication Otsu 5 not only permits methods other than transmitted and received radio waves for detecting proximity between users but also contemplates integration with a PDA having GPS functionality.

It is true that paragraph [0063] of Publication Otsu 5 states that an encounter-support device may detect proximity using infrared rays or a combination of infrared rays and radio waves. However, that infrared communication also detects proximity through direct communication between encounter-support devices.

By contrast, using GPS functionality in the Exhibit Otsu 5 Invention would require a more complex system in which each encounter-support device obtains location information and the like by GPS, while a server or

the like separately determines proximity based on that information and transmits the result to each device (see Exhibits Otsu 27, 28, and 55). It is difficult to identify any particular reason to adopt such a cumbersome configuration. Thus, the existence of the above disclosure does not make it easy to replace the short-range wireless communication technology of the Exhibit Otsu 5 Invention with a method using GPS functionality.

Furthermore, paragraph [0065] of Publication Otsu 5 states that a PDA or the like may be substituted for the PC terminal. In the Exhibit Otsu 5 Invention, however, it is encounter-support device 11, not PC terminal 102, that determines proximity and so forth between users. Even if GPS was well known as one function of a PDA, it is difficult to find that a person skilled in the art would readily have conceived of replacing the proximity determination and so forth performed by encounter-support device 11 with a method using GPS functionality.

(c) Accordingly, a person skilled in the art cannot be found readily to have conceived of the features relating to Differences 2 and 3 by applying the technologies disclosed in Publications Otsu 42 through 45 to the Exhibit Otsu 5 Invention."

3. Excerpts from the Judgment (2): The "Sales Revenue" Portion of the Damages Analysis

"(1) Sales Revenue

(a) The parties' arguments

The plaintiff argues that, among the defendant's businesses, the businesses subject to the Patent Right infringement at issue are … sales from 'account advertising' and 'communication' within its core business.

The defendant, in contrast, argues that account-advertising sales, which mainly come from companies and others holding accounts on the Defendant's App, are not included in the damages calculation, and that even if communication sales can be included, only the portion related to the Function at Issue should be covered.

(b) Findings of fact

Considering this matter, the underlying facts set out above, the evidence cited below, and the entire purport of oral argument establish the following facts.

(i) The defendant's businesses and sales revenue (…) …

a. Nature of account-advertising sales and related matters

Account-advertising sales comprise sales from (1) official accounts, (2) Business Connect, (3) LINE@, (4) sponsored stickers, (5) sales promotions, (6) advertisements, (7) ●(omitted)●, (8) ●(omitted)●, and (9) limited-edition stickers.

Items (1) through (3) are services through which companies and others can open accounts and send messages and the like to users who have added those accounts as friends. The defendant earns revenue from monthly and other fees paid by companies and others using paid plans.

Item (4) is a service allowing companies and others to provide users with their own original stickers free of charge for advertising and promotional purposes. Companies must pay a fixed amount to use it, generating revenue for the defendant.

Item (5) comprises services allowing campaigns through the Defendant's App and services through which users receive 'LINE Points' free of charge only if they satisfy certain conditions (missions). Companies and others must pay fees corresponding to the campaign content and so forth, generating revenue for the defendant.

Item (6) consists of advertisements placed by companies and others in the Defendant's App, generating advertising-fee revenue for the defendant.

Item (7): ●(omitted)●

Item (8): ●(omitted)●

Item (9) involves the defendant receiving payment from companies and others when it sells stickers through them.

b. Nature of communication sales and related matters

Communication sales comprise sales from (a) LINE Stickers, (b) LINE Themes, (c) LINE Emoji, (d) Creators' Stickers, (e) Creators' Themes, (f) Creators' Emoji, (g) LINE Stickers Premium, and (h) LINE Out.

Stickers ((a), (d), and (g)) are illustrations that can be sent in chats between users and purchased from the Sticker Shop within the Defendant's Service.

Themes ((b) and (e)) change the background of a user's own Defendant's App and can be purchased from the Theme Shop within the Defendant's Service.

Emoji ((c) and (f)) can be inserted into text messages in chats between users and purchased from the Sticker Shop within the Defendant's Service. Also, tapping or otherwise selecting a sticker or emoji used by another person (a friend or the like) in a chat room takes the user to the Sticker Shop selling that sticker. Users can therefore visit the Sticker Shop and purchase the sticker or emoji in that way as well.

When users purchase stickers, themes, and emoji ((a) through (g)), the purchases generate revenue for the defendant.

Item (h) is a service allowing users to make paid voice calls using telephone lines, and use of it generates revenue for the defendant. Users of the Defendant's App can, however, make free calls to each other within the app using an internet connection, so there is no need for them to use paid service (h).

(ii) Means of adding friends (Exhibits Otsu 81 and 101)

●(omitted)●

(iii) Adding corporate and other accounts as friends through 'Shake It' (Drawings of the Defendant's System and Other Products, Figure 38; Exhibit Ko 61)

Where companies and others using services such as LINE@ have registered location information for their addresses in advance, an ordinary user who selects 'Shake It' on the add-friends screen of the Defendant's App and shakes the smartphone in hand is also shown those companies and others within a 1 km radius as candidates to add as friends. If the user performs the add-friend process for such a company or other entity, it is additionally registered as that user's friend.

(c) Sales and other matters relating to adding friends by methods other than 'Shake It' and exports to overseas companies

The plaintiff argues that damages should not be limited to adding friends through 'Shake It' and interacting with users who became friends that way, but should also include other methods of adding friends, such as QR codes and ID searches, and should cover consolidated sales including overseas companies.

(i) However, from the outset of this action, the plaintiff consistently argued that adding friends through 'Shake It' and subsequent interaction fall within the technical scope of the Inventions at Issue (…). Allegations and proof that adding friends by other means and related acts fall within that scope were not included in the infringement phase. Thus, the sales revenue covered by damages must be limited to the scope having an adequate causal relationship with adding friends through 'Shake It.'

(ii) Furthermore, the argument that consolidated sales including overseas companies should be covered is understood to seek inclusion of sales from the defendant's exports of products embodying the inventions to overseas companies. However, the defendant's acts of working targeted by the plaintiff in the infringement phase were limited to use of the Defendant's System and production, transfer, and offers for transfer of the Defendant's App. Even if the Defendant's System and Other Products are exported, the evidence in this

case does not establish whether those products include the Function at Issue. The plaintiff's argument on this point is therefore also difficult to accept.

(d) Scope of sales revenue covered by damages

We therefore consider … the scope of sales revenue covered by damages in this case.

(i) Account-advertising sales

Account-advertising sales concern revenue from companies and others. Although ordinary users can add such companies and others as friends through 'Shake It,' in that case the companies and others must have registered location information for their addresses in advance, and it is difficult to envisage them operating smartphones at the time. Accordingly, it is difficult in the first place to find that this case meets 'interaction through communication using computer (14), through nearby users operating smartphones (2) to add each other as friends' (feature a and so forth). There is no other adequate allegation or proof that the Defendant's System and Other Products in this case fall within the technical scope of the Inventions at Issue.

Moreover, … considering the nature of the respective categories comprising account-advertising sales, they must all be regarded as having either no relationship or, at most, a tenuous relationship with ordinary users adding each other as friends through the Function at Issue.

Thus, it is appropriate to conclude that account-advertising sales are not covered by damages in this case.

(ii) Communication sales

a. Among communication sales, themes (items (b) and (e) in (b)(i)b above) change the background of a user's own Defendant's App and must therefore be regarded as having either no relationship or, at most, a tenuous relationship with adding friends through the Function at Issue and subsequent interaction.

Furthermore, given that users of the Defendant's App can make free calls to one another within the app, it can be inferred that LINE Out ((h) above) is ordinarily used when a user of the Defendant's App calls someone who is not a user. It likewise must be regarded as having either no relationship or, at most, a tenuous relationship with adding friends through the Function at Issue and subsequent interaction.

By contrast, stickers ((a), (d), and (g) above) and emoji ((c) and (f) above) are used, for example by being sent to one another, when users registered as friends communicate in chat rooms. They can therefore be said to be used in connection with adding friends through 'Shake It' and subsequent interaction, and their sales revenue is related to the defendant's infringing conduct. … Sales revenue for stickers and emoji during the Damages Calculation Period at Issue (sales of stickers and emoji in the Sticker Shop) is found to be ●(omitted)●. …

4. Some Observations

(1) The Inventive-Step Analysis

The issue was whether, in the primary reference (Exhibit Otsu 5), it would have been obvious to "use GPS search means to obtain location information of user terminals and perform a contact-addition process to add a contact to the contact list on the necessary condition that a user terminal located within a predetermined distance during a predetermined time has been found based on that information."

Because the secondary references (Exhibits Otsu 42 through 45) disclosed means for detecting the distance between user terminals using GPS searches, the defendant (LINE) argued that it would have been obvious to perform the "contact-addition process to add a contact to the contact list" "using GPS search means" instead of the short-range wireless communication in the primary reference (Exhibit Otsu 5).

However, this judgment found a teaching away because the purpose and problem of the primary cited invention (Exhibit Otsu 5) are "to improve the likelihood of encounters between users, particularly between men and women, with matching hobbies and preferences, without the other party learning important personal information in the initial stages of an encounter," whereas the secondary references "presuppose

disclosure to the other party of personal information such as name, address, telephone number, and email address." This analysis does not directly take up and assess the logic of omitting the personal-information notification features of the secondary references (Exhibits Otsu 42 through 45), extracting only the technology of "detecting the distance between user terminals using GPS searches" as a secondary cited invention (or well-known technology), and then combining that extracted secondary cited invention (or well-known technology) with the primary reference (Exhibit Otsu 5). It would have been interesting to see how the appellate court assessed this point, but I understand that a settlement was reached before the appellate judgment.

Below, I organize cases in which part of a cited invention's configuration could, or could not, be extracted.

(2) The "Sales Revenue" Analysis in the Damages Phase

As a general principle, the presumption in Article 102(3) of the Patent Act extends only to the "amount" of damages; the patentee bears the burden of alleging and proving the existence of damage.

Moreover, the "amount of money that should be received for the working of the patented invention" is calculated as "sales revenue" related to working the patented invention × "reasonable royalty rate." This judgment held that "sales revenue" under paragraph (3) is "limited to the scope of sales revenue having an adequate causal relationship" with working the patented invention (adding friends through 'Shake It'), and then determined that scope separately for each of the defendant's services.

There were broadly two issues in this case, both decided in the defendant's favor.

(2-1) First, the plaintiff argued that damages should not be limited to adding friends through 'Shake It' and interacting with users who became friends that way, but should also include other methods of adding friends, such as QR codes and ID searches, and should cover consolidated sales including overseas companies. However, the judgment found that "from the outset of this action, the plaintiff consistently argued that adding friends through 'Shake It' and subsequent interaction fall within the technical scope of the Inventions at Issue," and held that "adding friends by other means and related acts" were not covered by damages because infringement had not been argued for them.

On this point, for example, where there are ten types of accused products, it is often the case that infringement is argued for one representative type and the conclusion also extends to the other nine. Naturally, however, if the other nine present non-infringement arguments different from those concerning the representative type, the conclusion does not extend to them. This case falls into the latter category. Even if the scope of accused products was narrowed through case management in the infringement phase, one must also consider the scope of the damages claim. Where it is disputed whether the result of the infringement proceedings concerning the representative product extends to the other accused products, it is necessary to insist on separate infringement arguments for each accused product.

(2-2) Second, account-advertising sales and LINE Out sales within communication sales were held outside the scope of damages as revenues not falling within "the scope having an adequate causal relationship with adding friends through 'Shake It.'" (As to account-advertising sales, the judgment also points out that infringement had not been sufficiently argued, but in a separate paragraph from that context it states, as with LINE Out, that there is "either no relationship or, at most, a tenuous relationship.")

The judgment uses the expression "either no relationship or, at most, a tenuous relationship." In particular, exploring the boundary at which a relationship is deemed "at most tenuous" (so that an "adequate causal relationship" is denied and damages are unavailable) will be extremely important in future patent practice. It would also have been interesting to see how the appellate court assessed this point, but I understand that a settlement was reached before the appellate judgment.

[Cases in Which the Issue Was Whether Part of a Cited Invention's Configuration Could Be Extracted]

In identifying a cited invention, a cohesive set of features and a technical concept contained in it can be extracted.

1. Cases Favorable to the Rights Holder

*Cases in which part of the features of a secondary cited invention could not be independently extracted

(1) IP High Court, 2019 (Gyo-Ke) No. 10102, Vertical Shaft Construction Machine <Takabe>

(Excerpt from the judgment) Identifying from Cited Reference 3 the invention described in Section 3.2 [Plaintiffs' Arguments] (1) above would focus only on part of the slewing bearing. Because that part alone would not allow the slewing bearing to function as an integrated whole, it is inappropriate to identify an invention from Cited Reference 3 in the manner argued by the plaintiffs.

(2) IP High Court, 2015 (Gyo-Ke) No. 10077, Flush Toilet <Shimizu>

(Excerpt from the judgment) In the technical field of flush toilets, the number of flush-water outlets, the structure of the water passage, the flush-water supply path, and the flow path constitute a series of technical matters. Focusing on only one aspect of such a series of technologies and extracting part of a cohesive set of technical matters is itself an act of creating a technical concept. Simplistic abstraction or generalization to a higher-level concept is therefore impermissible; careful examination corresponding to the technical matters is required. … Flush-toilet washing involves various forms of flush-water supply, numbers of outlets, and shapes of water passages and flow paths. Without considering these differences in flushing methods, it is inappropriate to recognize the provision of a horizontal water passage guiding flush water to the upper edge of a bowl surface as well-known technology regardless of the number of outlets or the flush-water flow path, which necessarily differs accordingly. At least, whether such well-known technology can be recognized should be assessed on the premise of a flush-toilet washing method having a single outlet supplying flush water horizontally and a unidirectional flow path, as in the Corrected Invention at Issue and the Exhibit Ko 1 Invention.

(3) IP High Court, 2017 (Gyo-Ke) Nos. 10119 and 10120, Pneumatic Tire <Takabe>

= IP High Court, 2009 (Gyo-Ke) 10242; = IP High Court, 2016 (Gyo-Ke) 10226

(Excerpt from the judgment) The technical matters in (b)(1) through (3) above are inseparable as features for solving the problem described in Exhibit Ko 4. The natural understanding is that all those features together solve the problem of the invention described in Exhibit Ko 4: providing a pneumatic radial tire for passenger cars with improved wear resistance as well as improved dry-road performance, wet-road performance, and ride comfort. Accordingly, it is not possible to disregard the fact that Exhibit Ko 4 Technology A presupposes a block pattern and further extract only the technical matter relating to the groove-area ratio, thereby finding that Exhibit Ko 4 discloses the Exhibit Ko 4 Technology.

(4) IP High Court, 2011 (Gyo-Ke) No. 10284, Open-Type Fermentation Treatment Apparatus

(Excerpt from the judgment) …In the Cited Invention, the configuration of the agitator and the travel path are functionally linked. …

(5) IP High Court, 2011 (Gyo-Ke) No. 10385, Heat-Treatment Furnace with an Internal Heater <Shibata>

= IP High Court, 2015 (Gyo-Ke) 10077

(Excerpt from the judgment) The characteristic feature of the Cited Invention is the configuration with fan 28 inside the furnace to solve the problems of the conventional firing furnace shown in Figures 3 and 4. Identifying the Cited Invention as if that characteristic were absent would mean identifying an invention while disregarding the technically most important part of the elements constituting the cohesive technical concept disclosed in the cited reference, and must be deemed impermissible. In the Cited Invention, fan 28, driven by a drive motor located outside the furnace body and supported by one furnace wall, forcibly

agitates the atmosphere gas heated by the heater to make the furnace temperature uniform. It is therefore reasonable for heater 33 to be located between fan 28 and the stack of saggers 22 containing the objects to be fired, and a configuration in which heating elements are arranged in parallel along the furnace sidewall cannot be contemplated.

(6) IP High Court, 2011 (Gyo-Ke) No. 10100, High-Tensile-Strength Galvannealed Steel Sheet

(Excerpt from the judgment) …Table 1 of the cited reference illustrates five separate steels, giving the contents of the elements contained in Steels 1 through 5. For alloys, a difference in the content or the like of even one constituent normally changes the overall properties of each alloy, and the entire combination of alloying elements in predetermined amounts is technically evaluated as an integrated whole. … Even considering all the evidence in this case, it cannot be found that "each element constituting an alloy always has an inherent action unaffected by other elements," or, in other words, that "the content and so forth of each element independently has a particular technical significance."

2. Cases Unfavorable to the Rights Holder

*Cases in which part of the features of a cited invention could be independently extracted

(1) IP High Court, 2006 (Gyo-Ke) No. 10499, Wireless Door-Lock Control Device <Shinohara>

(Excerpt from the judgment) Cited Reference 2 does not describe only a single technology; … it describes various inventions. From among them, it is possible to identify the publicly known technology of Cited Invention 2A, or to identify publicly known technology that includes Incidental Matters (1) and (2). The former is clearly a broader concept encompassing the latter, but the usual approach in identifying and assessing inventive step in comparison with publicly known technology is to select the technology closest to the Invention at Issue. … Where a switch is exposed, unintended contact and the like can cause accidental operation, which is clear from experience. In a structure that locks and unlocks using an exposed switch, a person skilled in the art would naturally recognize, and should be aware of, the common general technical knowledge that unintended accidental operation of the switch may release the lock. Accordingly, focusing on and selecting Cited Invention 2A from Cited Reference 2 is extremely easy for a person skilled in the art.

(2) IP High Court, 2010 (Gyo-Ke) No. 10220, Portable Household Generator

Cf. IP High Court, 2010 (Gyo-Ke) 10162;

= IP High Court, 2005 (Gyo-Ke) 10105, Microwave Rice Cooker

(Excerpt from the judgment) Admittedly, the Cited Invention is one configuration for solar power generation and charging in the "portable fan" described in the cited reference, and can be said primarily to serve the operation of that fan. However, the disclosed structure and mechanism for solar power generation and charging are not directly related to operating the fan. They are technically independent in themselves and can be discussed separately from the operation of the fan. … Accordingly, a person skilled in the art reading those disclosures in the cited reference can, considering its disclosures as a whole, identify the Cited Invention—a solar cell capable of multipurpose use—as an independent technical concept. …

(3) IP High Court, 2010 (Gyo-Ke) No. 10160, Dicing/Die-Bonding Tape and Method for Manufacturing Semiconductor Chips

Cf. IP High Court, 2010 (Gyo-Ke) 10162;

(Excerpt from the judgment) In Cited Invention 2, … the function of permitting easy peeling performed by adhesive layer (2a) is achieved through the coexistence of a function independent of adhesive layer (2b). It is therefore not affected by the presence of adhesive layer (2b), but is performed independently by adhesive layer (2a) alone. Thus, … a person skilled in the art can recognize adhesive layer (2a), with relatively weak adhesive strength, and adhesive layer (2b), with relatively strong adhesive strength, in Cited Invention 2 as separate features, and can recognize their respective technical significance individually. Accordingly,

adhesive layer (2a) can be independently extracted as a layer having relatively weak adhesive strength by focusing on its easy-peeling property when chip-shaped workpieces are peeled from the adhesive layer.

(4) Tokyo High Court, 2004 (Gyo-Ke) No. 159, Housing Case for a Control Circuit Board in a Gaming Machine

(Excerpt from the judgment) The Decision at Issue cited Publications 2 and 3 to establish that, at the filing date of the Patent at Issue, it was well known, in housing cases for gaming-machine control circuit boards, to provide projecting board-fixing pins on the bottom plate of the housing case and to secure the control circuit board to that bottom plate with those pins. In light of Publications 2 and 3 and common general technical knowledge, it is clear that the technology of fixing a control circuit board to the bottom plate of its housing case is technically unrelated to the technology of providing electrostatic (electromagnetic-wave) countermeasures for the housing case. Applying the above technical matters in Publications 2 and 3 to the Publication 1 Invention therefore raises no issue of adverse effects on electrostatic countermeasures. …

(5) IP High Court, 2005 (Gyo-Ke) No. 10672, High-Frequency Bolt Heater

(Excerpt from the judgment) …In identifying a cited invention, a cohesive set of features and a technical concept contained in it may be extracted, and there is no reason to regard that process as limited to the particular embodiments described in the cited publication. … The specific configuration for high-frequency induction heating itself, which Exhibit Ko 1 does not describe in an implementable manner, … was common general technical knowledge … at the filing date of the Patent at Issue. Thus, a person skilled in the art could have understood the Exhibit Ko 1 Invention as capable of implementing high-frequency induction heating by considering the specific configuration of the induction heating body that was such common general technical knowledge in relation to high-frequency induction heating by the "…high-frequency heating torch" of Exhibit Ko 1.

Plaintiff (patentee): Future Eye Co., Ltd.

Defendant (alleged infringer): LINE Corporation

[Patent ★★] Action for Damages and Other Relief ((1) A case in which the logic of extracting only the "GPS search function" from a secondary reference and applying it to the primary reference was rejected, and inventive step was recognized because there was a teaching away from that application. (2) A case holding that the defendant's services for which infringement had not been argued were outside the scope of damages, and that sales having "at most a tenuous relationship" lacked an adequate causal relationship and were outside the scope of damages under paragraph (3).) — 2017 (Wa) No. 36506, Computer System (LINE Furufuru ("Shake It") Case) <Presiding Judge Sato> — NAKAMURA & PARTNERS— 2017 (Wa) No. 36506, Computer System (LINE Furufuru ("Shake It") Case) <Presiding Judge Sato> — ◆ Full text of the judgmentwww.nakapat.gr.jp

IP High Court, 2008 (Ne) 10061, Refrigeration System and Condensing Heat Exchanger <Nakano> — Jurisdiction over Patent Cases

Original Ameblo publication: 2022-02-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12724970735.html

IP High Court, 2008 (Ne) 10061, Refrigeration System and Condensing Heat Exchanger <Nakano>

“Actions relating to patent rights” broadly encompass litigation connected with patent rights … and are not limited to actions seeking injunctions or damages for patent infringement or payment of compensation for employee inventions. They also include litigation concerning agreements establishing exclusive or non-exclusive patent licenses, as in this case.

⇒ The original judgment (Saitama District Court, 2007 (Wa) 1020) was rendered without jurisdiction.

*Commentary in Hanrei Times

⇒ The term is understood also to include actions seeking payment of royalties under patent license agreements, declarations of ownership of the right to obtain a patent or of patent rights, registration of transfers of patent rights, and litigation concerning the existence or ownership of an exclusive license.

(Excerpts from the judgment)

It is appropriate to construe “actions relating to patent rights” here as broadly encompassing litigation connected with patent rights, not limited to actions seeking injunctions or damages for patent infringement or payment of compensation for employee inventions, but also including litigation concerning agreements establishing exclusive or non-exclusive patent licenses, as in this case. Accordingly, because the first-instance plaintiff is domiciled in Tokyo and all first-instance defendants are domiciled in Saitama Prefecture, territorial jurisdiction at first instance belongs exclusively to the Tokyo District Court under Article 6(1) of the Code of Civil Procedure. The original judgment was therefore rendered without jurisdiction and must be reversed.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-37256.pdf

IP High Court, 2020 (Gyo-Ke) 10075, Package <Mori>

Original Ameblo publication: 2022-02-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12725250732.html

IP High Court, 2020 (Gyo-Ke) 10075, Package <Mori>

*Obviousness cannot be found solely on the basis of a common technical field.

*The problems were identified specifically, and motivation to combine was denied because the primary and secondary references addressed different problems.

⇒ Inventive step affirmed.

“Exhibit Ko 1 … prevents deformation of the container and distortion of the tube during packaging … Exhibit Ko 3 … addresses the problem of achieving high mechanical strength in the width direction perpendicular to the principal shrinkage direction …”

(Excerpts from the judgment)

The Exhibit Ko 1 Invention and the invention disclosed in Exhibit Ko 3 have little in common either in their problems or in their means of solution. Motivation to apply the matters disclosed in Exhibit Ko 3 to the Exhibit Ko 1 Invention therefore cannot be found. …

The defendant argues that the Exhibit Ko 1 Invention and the matters disclosed in Exhibit Ko 3 share the action and function of heat shrinkage. However, heat shrinkage is ordinarily only one of the basic actions and functions of a boxed-meal package. The defendant’s argument therefore amounts to finding motivation based substantially on a common technical field alone, which is insufficient as a basis for motivation. Accordingly, motivation to apply the heat-shrinkable film shown in the matters disclosed in Exhibit Ko 3 as the heat-shrinkable film in the Exhibit Ko 1 Invention cannot be found.

The Exhibit Ko 1 Invention and the matters disclosed in Exhibit Ko 3 are both found to belong to the technical field of boxed-meal packaging. … However, the Exhibit Ko 1 Invention addresses the problem, in a boxed-meal package using a heat-shrinkable tube, of preventing deformation of the container and distortion of the tube during packaging without cumbersome control of heat shrinkage, and also preventing deformation of the meal container when reheated by microwave at the store. … By contrast, the invention disclosed in Exhibit Ko 3 addresses the problem of making a heat-shrinkable film for a label that not only has good shrinkability in the longitudinal direction, its principal shrinkage direction, and high mechanical strength in the perpendicular width direction, but also has a good shrink finish after being wrapped directly from a film roll around a bottle and heat-shrunk, good workability in subsequent processing, and improved tearing behavior. … To solve its problem, the Exhibit Ko 1 Invention forms tube (20) from non-heat-shrinkable film (21) and heat-shrinkable film (22), as a tubular body in which the circumferential width of heat-shrinkable film (22) is no more than half the total tube circumference; heat shrinkage of film (22) reduces the tube circumference to approximately the outer circumference of the meal container and secures it to the container. By contrast, the heat-shrinkable film of the invention in Exhibit Ko 3 specifies respective numerical values as stated in its claims. The two inventions thus have little in common either in their problems or in their means of solution. Motivation to apply the matters disclosed in Exhibit Ko 3 to the Exhibit Ko 1 Invention therefore cannot be found.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90112.pdf

[Trademarks] Osaka District Court, 2018 (Wa) 11672, “Re Shukatsu” and “Rishu Katsu”

Original Ameblo publication: 2022-02-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12725524372.html

[Trademarks] Osaka District Court, 2018 (Wa) 11672

Trademark owner: “Re Shukatsu”

Alleged infringer: “Rishu Katsu”

After the warning,

an application for the “Rishu Katsu” trademark ⇒ Registration.

⇒ The opposition decision also found dissimilarity.

The Osaka District Court found similarity, reasoning that recruiting companies would not be confused but job seekers would.

⇒ Settlement on appeal on terms reflecting dissimilarity.

History of the “Rishu Katsu” Trademark Infringement Litigation and Terms of Settlement | Academic Record Utilization Consortiumconsortium.workstudy.jp

Tokyo District Court, 2019 (Wa) 2034 <Sato> — Breach of the Non-Compete Obligation in a Business Transfer Agreement ⇒ Injunction

Original Ameblo publication: 2022-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12725700445.html

Tokyo District Court, 2019 (Wa) 2034 <Sato>

After transferring its business to the plaintiff, the defendant resumed the same kind of business.

⇒ Breach of the non-compete obligation in the business transfer agreement.

(The scope of the non-compete obligation was disputed.)

⇒ Injunction against the defendant's business granted!!

(The damages claim was dismissed for failure of proof.)

*In general, contract-based injunctions are unusual.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90186.pdf

[Request for Disclosure of Sender Information] Osaka District Court, 2020 (Wa) 1995

Original Ameblo publication: 2022-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12725874810.html

[Request for Disclosure of Sender Information] Osaka District Court, 2020 (Wa) 1995

A request for disclosure of sender information based on login records after the infringing information was posted was granted!!

⇒ Previous case law was divided, but in light of the necessity also noted in this judgment and the purpose of Article 4, legislative work is proceeding toward allowing such disclosure.

https://www.soumu.go.jp/main_content/000708778.pdf

[Unfair Competition Prevention Act] IP High Court, 2019 (Ne) 10008 — Advertisements Such as “100% Survival Rate” Were Held to Be Quality-Misrepresenting Indications!!

Original Ameblo publication: 2022-02-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726078767.html

[Unfair Competition Prevention Act] IP High Court, 2019 (Ne) 10008

Advertisements such as “100% survival rate” were held to be quality-misrepresenting indications (in violation of Article 2(1)(xx) of the Unfair Competition Prevention Act).

⇒ Damages of ¥43.46 million awarded.

Reversing the first instance (Presiding Judge Okinaka), which had held that proof of a survival rate other than 100% was unsuccessful!!

(The plaintiff bears the burden of proving that the survival rate is not 100%.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90568.pdf

IP High Court, 2020 (Gyo-Ke) 10103, Multicolor Penlight <Shoji>

Original Ameblo publication: 2022-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726518744.html

IP High Court, 2020 (Gyo-Ke) 10103, Multicolor Penlight <Shoji>

*The trial decision erred in identifying the problem inherent in the primary reference.

*“Color rendering” in relation to the primary reference’s problem means something different from the “color rendering” identified as a technical matter disclosed in the secondary reference.

⇒ It cannot provide a basis for motivation.

⇒ Inventive step affirmed (trial decision rescinded).

(Excerpts from the judgment)

…Exhibit Ko 1 cannot be found to disclose a problem inherent in producing the yellow color designated “yellow.” …

The technical fields of the Exhibit Ko 1 Invention and the technical matters disclosed in Exhibit Ko 2 cannot be said to coincide completely; they are merely related. Thus, finding it easy to conceive of Invention 1 at Issue by adopting the technical matters in Exhibit Ko 2 in the Exhibit Ko 1 Invention requires commensurate motivation to make that adoption. …

As a premise for finding motivation to adopt the technical matters in Exhibit Ko 2 in the Exhibit Ko 1 Invention, and for finding that Invention 1 at Issue could readily have been conceived through that adoption, the Trial Decision at Issue found that the Exhibit Ko 1 Invention had a problem inherent in producing the yellow color designated “yellow” … and shared with Exhibit Ko 2 the problem of improving color rendering. … However, … the finding that the Exhibit Ko 1 Invention has a problem inherent in producing the yellow color designated “yellow” is erroneous. Moreover, the “color rendering” … identified by the Trial Decision at Issue in relation to the problem of the Exhibit Ko 1 Invention differs from the “color rendering” identified as a technical matter disclosed in Exhibit Ko 2—that is, “color rendering” in its general sense of whether the color of an illuminated object approximates its appearance under natural light. … The Trial Decision at Issue therefore erred in identifying the problem of the Exhibit Ko 1 Invention that would underpin motivation to adopt the technical matters in Exhibit Ko 2. … Such motivation cannot be found.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90618.pdf

IP High Court, 2020 (Gyo-Ke) 10011, Catheter Assembly <Otaka>

Original Ameblo publication: 2022-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726519465.html

IP High Court, 2020 (Gyo-Ke) 10011, Catheter Assembly <Otaka>

*Inventive step of functional claims

The reference cannot be seen to have the function.

⇒ A difference.

From Figure 26 of the cited document …, it cannot immediately be discerned that slit 462 is “openable to permit inflow and outflow” of fluid. Nor is there any disclosure suggesting this.

(Excerpts from the judgment)

[Claim 1] …A catheter assembly characterized in that … the second valve member is openable so as to permit flow in both the proximal and distal directions …

Cited Document 1 … does not state that slit 462 is “openable to permit inflow and outflow” of fluid. Moreover, in light of the shape of slit 462 shown in Figure 26, it cannot immediately be discerned from that figure that the slit is “openable to permit inflow and outflow” of fluid. Even considering the entirety of Cited Document 1 (including the drawings), there is no disclosure suggesting that slit 462 is configured to be “openable to permit inflow and outflow” of fluid.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90032.pdf

IP High Court, 2020 (Ne) 10025, Light-Emitting Device and Other Inventions <Mori>

Original Ameblo publication: 2022-02-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726785172.html

IP High Court, 2020 (Ne) 10025, Light-Emitting Device and Other Inventions <Mori>

*Following the rule in the Grand Panel judgment, damages under Patent Act Article 102(3) were calculated on the basis of the defendant's products (televisions), not the patented products (LEDs).

⇒ ¥132 million awarded.

*The first instance (2017 (Wa) 27238 <Shibata>) awarded approximately ¥17.95 million based on LED sales.

(Excerpts from the judgment)

(a) The base to which the royalty rate is applied (royalty base)

(i) In addition to the points concerning Article 102(3) of the Patent Act noted in (1) above, (1) the LEDs at Issue were installed in direct-lit backlights used in the First-Instance Defendant's Products, and those backlights are one of the core components incorporated within those liquid crystal televisions and cannot be said to be readily separable from them; (2) LED performance greatly affects the picture quality of liquid crystal televisions, while the choice of LEDs and their manufacturing method also affect manufacturing costs; and (3) as described in (b) below, the first-instance defendant sold its products as finished products taking advantage of the characteristics of the LEDs at Issue and earned revenue from those sales. In light of these circumstances and others, it is appropriate to calculate the amount equivalent to a royalty under Article 102(3) based on sales of the First-Instance Defendant's Products. …

The First-Instance Defendant's Products, which are liquid crystal televisions, consist of many components other than the LEDs at Issue, so it is inappropriate simply to apply the royalty rate in (i) above. However, … the technology of Inventions 1 through 3 at Issue was greatly utilized in white LEDs for liquid crystal television back monitors, and the First-Instance Defendant's Products sold well … with image beauty as one selling point, among others. The technology of Inventions 1 through 3 at Issue therefore made a considerably large contribution to those sales. … Even taking into account circumstances such as the price of white LEDs …, it is appropriate to find that the royalty rate, when based on sales of the First-Instance Defendant's Products, is no lower than 0.5%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89853.pdf

Tokyo District Court, 2012 (Wa) 14227, Method for Manufacturing a p-Type Gallium Nitride Compound Semiconductor <Takano>

Original Ameblo publication: 2022-02-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726788288.html

Tokyo District Court, 2012 (Wa) 14227, Method for Manufacturing a p-Type Gallium Nitride Compound Semiconductor <Takano>

★The permissible range of “impurities” is the range that does not impede the effects of the invention.

*“Substantially free of” ⇒ Infringement despite a trace amount.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84218.pdf

Cf. Tokyo District Court, 2000 (Wa) 22926: non-infringement.

Cf. Tokyo District Court, 2000 (Wa) 12193: “free of,” with a trace amount found non-infringing.

(Excerpts from the judgment)

[Claim 1] …A method for manufacturing a semiconductor … characterized by annealing … in an atmosphere substantially free of hydrogen … to release hydrogen …

Using a gas containing hydrogen atoms, such as NH3 or H2, in the annealing atmosphere, or a material containing hydrogen atoms in the cap layer, is considered undesirable because the reaction for producing p-type conductivity—thermally dissociating hydrogen atoms bonded to p-type impurities—may fail to proceed and the above effects may not be achieved. Conversely, however, the reaction for producing p-type conductivity by thermally dissociating hydrogen atoms bonded to p-type impurities may proceed and achieve those effects. Accordingly, using a gas containing hydrogen atoms, such as NH3 or H2, in the annealing atmosphere, or a material containing hydrogen atoms in the cap layer, cannot be said to be entirely excluded.

If so, “an atmosphere substantially free of hydrogen” in constituent feature B should be construed to mean an atmosphere that produces such effects; in other words, an atmosphere containing hydrogen only to an extent that does not prevent obtaining a low-resistance p-type gallium nitride compound semiconductor through annealing.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84218.pdf

Osaka District Court, 2016 (Wa) 2688, Coated Copper Wire for Ball Bonding

Original Ameblo publication: 2022-02-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12726972710.html

Osaka District Court, 2016 (Wa) 2688, Coated Copper Wire for Ball Bonding

★The permissible range of impurities is the range within which the problem can be solved.

⇒ The permissible Pd content is approximately 2%.

“If more than approximately 2% palladium (Pd) from the inner coating layer mixes into the surface coating layer formed of gold (Au), the problem-solving principle of the Inventions at Issue, utilizing the relative melting points of the metals, no longer holds.”

(Excerpts from the judgment)

…Where palladium is used for the intermediate coating layer, … the melting point increases above approximately 1064°C as the palladium content increases, and when the palladium content exceeds approximately 2%, it rises above copper’s intrinsic melting point of approximately 1085°C. … Thus, if more than approximately 2% palladium (Pd) from the inner coating layer mixes into the surface coating layer formed of gold (Au), the problem-solving principle of the Inventions at Issue, utilizing the relative melting points of the metals, no longer holds. Conversely, if palladium admixture remains within approximately 2%, the gold-palladium alloy’s melting point is lower than that of copper (Cu), and, as stated above, the melting point of that alloy reflects the respective intrinsic melting points of gold (Au) and palladium (Pd). The problem-solving principle of the Inventions at Issue therefore remains applicable. Accordingly, where palladium (Pd) is used for the intermediate coating layer, the “gold (Au) skin layer” need not consist solely of gold (Au), but, as the defendant argues in the alternative, should be construed to require a layer with no more than approximately 2% palladium (Pd) admixture.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88033.pdf

Osaka District Court, 2006 (Wa) 6162, Lead-Free Solder Alloy <Yamada>

Original Ameblo publication: 2022-02-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12727151261.html

Osaka District Court, 2006 (Wa) 6162, Lead-Free Solder Alloy <Yamada>

*A case finding non-infringement for Product I, which contained a component not recited in the alloy claim.

★The permissible range of “impurities” is the range that does not impede the effects of the invention.

Even if exceptionally permitted, … they are limited to substances foreseeably having no effect on the improvement in the alloy’s fluidity. …

(Excerpts from the judgment)

…According to the Specification at Issue, the technical significance of the Invention at Issue lies in discovering that a lead-free solder alloy with the composition … “0.3–0.7% by weight Cu, 0.04–0.1% by weight Ni, and the balance Sn” … has the property of “suppressing formation of intermetallic compounds and improving fluidity.” In general, however, alloys normally differ greatly in properties when their component composition differs. This is considered to be why the composition of the Invention at Issue is strictly limited as stated above.

In light of these points, the Invention at Issue should be construed as not, in principle, permitting components other than those recited in constituent feature A. Even if exceptions are allowed, they are limited at most to unavoidable impurities identified as such in the Specification at Issue, or substances similarly and readily foreseeable, in light of common general technical knowledge at the filing date or priority date, as having no effect on the improvement in the alloy’s fluidity. The Defendant’s Product, however, contains 0.084% Ag as stated above, exceeding the permissible impurity range (0.05%) for Sn-Cu solder alloys under the JIS standard at the filing date or priority date of the Invention at Issue, and therefore cannot be regarded as an unavoidable impurity. Even if the JIS standard was amended after the filing or priority date, that amendment is presumed to have been based on the common general technical knowledge and circumstances at that later time. Thus, the fact that JIS Z 3282 enacted in 2006 specifies 0.10% Ag or less for Sn-Cu lead-free solder does not establish that it was readily foreseeable, in light of the common general technical knowledge at the filing or priority date, that approximately 0.084% Ag would not affect the improvement in the alloy’s fluidity. Nor is there other evidence sufficient to establish this.

Details of Case Law Search Result | Courts — Courts in Japanwww.courts.go.jp

Judgment (full text): https://www.courts.go.jp/assets/hanrei/hanrei-pdf-35950.pdf

Tokyo District Court, 2013 (Wa) 3360, Ferromagnetic Sputtering Target with Dispersed Nonmagnetic Material Particles <Hasegawa>

Original Ameblo publication: 2022-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12727328595.html

Tokyo District Court, 2013 (Wa) 3360, Ferromagnetic Sputtering Target with Dispersed Nonmagnetic Material Particles <Hasegawa>

★The permissible range of “impurities” is the range that does not impede the effects of the invention.

*“All particles” ⇒ Every particle must satisfy the limitation.

“Constituent feature 1-B … requires that none of the nonmagnetic material particles be coarse particles (…).”

(Excerpts from the judgment)

[Claim 1] …All particles of nonmagnetic material in the structure observed on a polished surface consist of particles that are smaller than every imaginary circle of radius 2 μm centered on any point within a nonmagnetic material particle, or have a shape and dimensions such that said imaginary circle and the interface between the ferromagnetic and nonmagnetic materials have at least two points of tangency or intersection …

Constituent feature 1-B … requires that none of the nonmagnetic material particles be coarse particles (particles large enough to contain an imaginary circle of radius 2 μm). According to the results of the commissioned expert examination and the parties’ arguments, however, at least four coarse particles exist on the polished surface of Defendant’s Product 1 after the second polishing. …

Tokyo District Court, 2017 (Wa) 44053, Combination Therapy for … B-Cell Lymphoma <Yamada>

Original Ameblo publication: 2022-02-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12727504574.html

Tokyo District Court, 2017 (Wa) 44053, Combination Therapy for … B-Cell Lymphoma <Yamada>

*According to the package insert for the Defendant's Formulation, its dosage and administration differ from the patented invention.

*The disclosures in the specification were not found to correspond to the use of the invention.

⇒ Rather than focusing on the problem to be solved, the court found no description or suggestion of the use of the invention.

(Excerpts from the judgment)

[Claim 1] A pharmaceutical composition comprising rituximab for use in combination with chemotherapy in a human patient in the treatment of low-grade/follicular non-Hodgkin's lymphoma (NHL), wherein a therapeutically effective amount of said pharmaceutical composition is administered to said patient during said chemotherapy, and said chemotherapy is CVP.

…In light of the descriptions in numerous publications issued before the filing date of the Original Application at Issue, it is appropriate to regard many of the publications cited by the plaintiffs as containing descriptions differing from the general understanding amid research into diverse chemotherapies. It is appropriate to find that CVP therapy and COP therapy were distinguished by the timing of cyclophosphamide administration: from day 1 through day 5 in CVP therapy, but only on day 1 in COP therapy.

…The package insert for the Defendant's Formulation includes "when used in combination with other antineoplastic agents" in the dosage and administration section. As a precaution relating to dosage and administration, it states: "When used in combination with other antineoplastic agents, thoroughly understand the content of the [Clinical Results] section regarding the dosing intervals, timing of administration, and other matters studied in clinical trials of the reference biologic, and refer to the latest domestic and overseas guidelines and the like." The clinical-results section states, as clinical results for the Defendant's Formulation, that patients with previously untreated advanced follicular lymphoma received either the Defendant's Formulation or the reference biologic under an R-CVP regimen. It also states, as clinical results for the reference biologic, that patients with follicular non-Hodgkin's lymphoma (NHL) received remission-induction therapy under an R-CVP regimen and other therapies in an overseas phase III clinical trial (the PRIMA trial). … The R-CVP regimen described in the package insert for the Defendant's Formulation is found to administer rituximab on day 1, cyclophosphamide (CPA) and vincristine (VCR) on day 1, and prednisolone or prednisone (PSL) from day 1 through day 5.

Accordingly, the Defendant's Formulation cannot be said to satisfy "CVP" in constituent feature 2B because the R-CVP regimen described in its package insert administers cyclophosphamide only on day 1, not from day 1 through day 5.

…Regarding the timing of administration of rituximab, identified as an anti-CD20 antibody or a chimeric anti-CD20 antibody, paragraph [0015] merely lists "before or after other therapies" alongside "simultaneously or within the same time frame (that is, the therapies proceed concurrently, but the drugs are not administered at exactly the same time)." Paragraph [0017] likewise merely lists "before … or after chemotherapy" alongside "during it." Neither explains the dosing periods or drug-free intervals of the agents used in chemotherapy. It is therefore difficult to recognize from those disclosures the use of

Invention 1 at Issue, in which rituximab is administered during the dosing periods of the respective agents in CHOP therapy. Nor, of course, can one recognize the use of Invention 3 at Issue, in which the pharmaceutical composition containing rituximab and the respective chemotherapy agents are administered on day 1 of each chemotherapy cycle. … These are use inventions specifying the target disease, the chemotherapy used in combination, and the timing of administration of a pharmaceutical composition containing rituximab. Paragraph [0015] does not specify the target disease or the combined chemotherapy, while paragraph [0017] does not specify the target disease and lists CHOP therapy only as one of numerous options for combined chemotherapy. In this respect as well, those passages are insufficient to be recognized as describing or suggesting the uses of Inventions 1 and 3 at Issue.

[Article] “The Actual-Material Approach under the Plant Variety Protection and Seed Act,” Judges Kazuhide Shimasue and Yasuo Nishimura

Original Ameblo publication: 2022-02-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728046395.html

[Article] “The Actual-Material Approach under the Plant Variety Protection and Seed Act,” Judges Kazuhide Shimasue and Yasuo Nishimura

Reasons for adopting an actual-material approach rather than a claim-based approach

(1) The application examination stage uses an actual-material approach.

(2) The UPOV Convention

(3) Finding infringement merely because all registered characteristics of the registered variety happen to be satisfied would be excessive.

(4) Even if some registered characteristics are not satisfied, infringement occurs if the actual material is identical.

(5) Promotion of deposits

And others

https://ci.nii.ac.jp/ncid/BB19076064

[Article] “Transfer of Articles Used to Work a Patented Invention and Whether Exhaustion Arises,” Professor Yasuyuki Echi

Original Ameblo publication: 2022-02-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728046580.html

[Article] “Transfer of Articles Used to Work a Patented Invention and Whether Exhaustion Arises,” Professor Yasuyuki Echi

Cf. Ink Tank Grand Panel Decision

All steps of the method invention can be performed using the item (iv) product alone + the product is exclusively dedicated

⇒ The method invention is exhausted.

The item (iv) product is used only for some steps of the method invention.

⇒ The method invention is generally not exhausted.

[Patents] Exhaustion (2): Transfer of Indirectly Infringing Products and Exhaustion — YouTube

I Was Ranked in Band 4 by Chambers.

Original Ameblo publication: 2022-02-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728047051.html

I was ranked in Band 4 by Chambers.

I will work even harder to meet the expectations of those who recommended me.

『He is described by market sources as "a recommended lawyer who studies cases really well."』

I am truly delighted that my enthusiastic commitment has been recognized!!

Hideki Takaishi, Global | Chambers Profiles

IP High Court, 2013 (Ne) 10026, Apparatus for Mixing Powder and Granular Material and Removing Fine Powder <Iimura>

Original Ameblo publication: 2022-02-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728216862.html

IP High Court, 2013 (Ne) 10026, Apparatus for Mixing Powder and Granular Material and Removing Fine Powder <Iimura>

= Osaka District Court, 2008 (Wa) 10819

*General principle concerning “indispensable”

⇒ At first instance, indirect infringement under item (iv) was not established for Product I (indirect infringement under items (ii) and (v) was, however, established).

⇒ On appeal, indirect infringement under item (v) was likewise upheld (the appellate court adopted the first-instance reasoning).

Not an exclusively dedicated product ⇒ An injunction granted without limitation by use (excluding the injunction against export and import).

“It is appropriate to recognize the necessity of enjoining manufacture, sale, and other acts regardless of use, and granting such relief cannot be regarded as imposing an excessive burden on the defendant.”

(Excerpts from the first-instance judgment (Osaka District Court, 2008 (Wa) 10819), whose reasoning the appellate judgment adopted)

“Indispensable for resolving the problem through the invention” is a concept different from the constituent elements of the invention (invention-defining matters) recited in the claims. It can include tools, raw materials, and the like used to produce a product or use a method, even if they are not constituent elements of the invention.

Conversely, even a constituent element recited in the claims does not qualify as “indispensable for resolving the problem through the invention” if it was conventionally required irrespective of the problem the invention seeks to solve. In other words, parts, tools, raw materials, and the like whose use makes it possible for the first time to solve “the problem the invention seeks to solve” fall within that category. Put differently, it encompasses distinctive components, raw materials, tools, and the like that directly provide the particular configuration or ingredient characterizing the distinctive technical means, absent from the prior art, newly disclosed by the invention as a method of solving the problems of the prior art.

Accordingly, even components, ingredients, and the like recited in the claims are not “indispensable for resolving the problem through the invention” if they do not directly form the distinctive technical means newly disclosed by the invention to solve the problem. …

…Feature e of Product I is: “A level meter (70) is provided above horizontal pipe (4B) to measure the level of resin material within vertical pipe (4A) while said suction air source is stopped.” This is identical to the above “distinctive technical means absent from the prior art” relating to Patented Invention 2 at Issue. Product I therefore directly forms the distinctive technical means newly disclosed by Patented Invention 2 at Issue to solve the problem. …

* The link in the heading points to the first-instance judgment (Osaka District Court, 2008 (Wa) 10819, February 21, 2013). Appellate judgment (IP High Court, 2013 (Ne) 10026, March 27, 2014): https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84160.pdf

United States, 2009, CAFC en banc, Cardiac v. St. Jude Medical

Original Ameblo publication: 2022-02-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728315716.html

United States, August 2009, CAFC en banc

Cardiac Pacemakers v. St. Jude Medical

35 U.S.C. § 271(f) does not apply to method claims.

(Reason) Congress enacted § 271(f) intending to overturn the Supreme Court's Deepsouth decision (406 U.S. 518 (1972)).

Deepsouth concerned exports of the "physical components" of an apparatus.

⇒ Legislative purpose

Judgment (English original): Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.

United States, April 2007, Supreme Court, Microsoft v. AT&T

Original Ameblo publication: 2022-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728583561.html

United States, April 2007, Supreme Court, Microsoft v. AT&T

Copies of Windows installed on computers constitute “components” under 35 U.S.C. § 271(f).

An extra step—encoding the software instructions on a computer-readable medium to produce a copy—is needed to make software a usable, combinable part of a computer. ⇒ Such a copy, rather than abstract code itself, qualifies as a “component” that is “combinable” under § 271(f). In this case, the master disk “supplied” from the United States was not the copy actually installed on the foreign-made computers.

So long as copying of the code (information) occurs outside the United States, the copies (installed on computers) that constitute “components” have not been “supplied” from the United States.

Microsoft v. AT&T: Supreme Court Reverses the Lower-Court Judgment (jetro.go.jp)

United States, July 2004, CAFC, Pellegrini v. Analog Devices

Original Ameblo publication: 2022-02-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12728741625.html

United States, July 2004, CAFC, Pellegrini v. Analog Devices

Even if design and sales instructions concerning components of an invention covered by a U.S. patent are issued within the United States, there is no infringement of § 271(f)(1) so long as manufacture, sale, and offers for sale of the components occur outside the United States.

(Unless the components physically exist within the United States, they have not been “supplied” abroad.)

Gerald N. Pellegrini, Plaintiff-appellant, v. Analog Devices, Inc., Defendant-appellee, 375 F.3d 1113 (Fed. Cir. 2004) :: Justia

United States, June 2000, CAFC, Rotec v. Mitsubishi

Original Ameblo publication: 2022-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729290697.html

United States, June 2000, CAFC, Rotec v. Mitsubishi

An offer to sell outside the United States does not constitute “supply … in or from the US” and therefore does not infringe 35 U.S.C. § 271(f)(2).

(Section 271(f)(2) requires actual supply of components. The “offer to sell” language of § 271(a) cannot be applied by analogy to § 271(f).)

ROTEC INDUSTRIES INC v. Mitsubishi International Corporation, Defendant-Appellee. | FindLaw

United States, April 2001, CAFC, Waymark v. Porta Systems

Original Ameblo publication: 2022-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729291033.html

United States, April 2001, CAFC, Waymark v. Porta Systems

Under § 271(f)(2), where a semifinished product has been supplied outside the United States, it is unnecessary to prove that the patented product was actually completed abroad; proof of an intention to combine is sufficient.

⇒ In a case where completion of the system was planned but it was never actually assembled, the court vacated the summary judgment of non-infringement under § 271(f)(2), which had required actual assembly, and remanded.

Waymark Corp. v. Porta Systems Corp., 245 F.3d 1364 | Justia

United States, June 2018, Supreme Court, WesternGeco v. ION Geophysical

Original Ameblo publication: 2022-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729291340.html

United States, June 2018, Supreme Court, WesternGeco v. ION Geophysical

The Court held that damages under 35 U.S.C. § 284 could include profits lost outside the United States as a result of infringement under § 271(f)(2).

(The damages awarded to WesternGeco by the district court based on lost profits outside the United States resulted from a domestic application of 35 U.S.C. § 284.)

WesternGeco LLC v. ION Geophysical Corp., 585 U.S. 407 (2018) | Cornell LII

February 27, 2022 — I Took the 160th Unified Grade 2 Bookkeeping Examination (Paper-Based).

Original Ameblo publication: 2022-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729291807.html

I took the 160th Unified Grade 2 Bookkeeping Examination (paper-based). (2022.02.27)

I am deliberately posting this before the results are out: it was considerably easier than the various predicted-question practice tests.

On the practice tests I only just reached 70 points and used the full 90 minutes, but in the actual examination I had 20 minutes left.

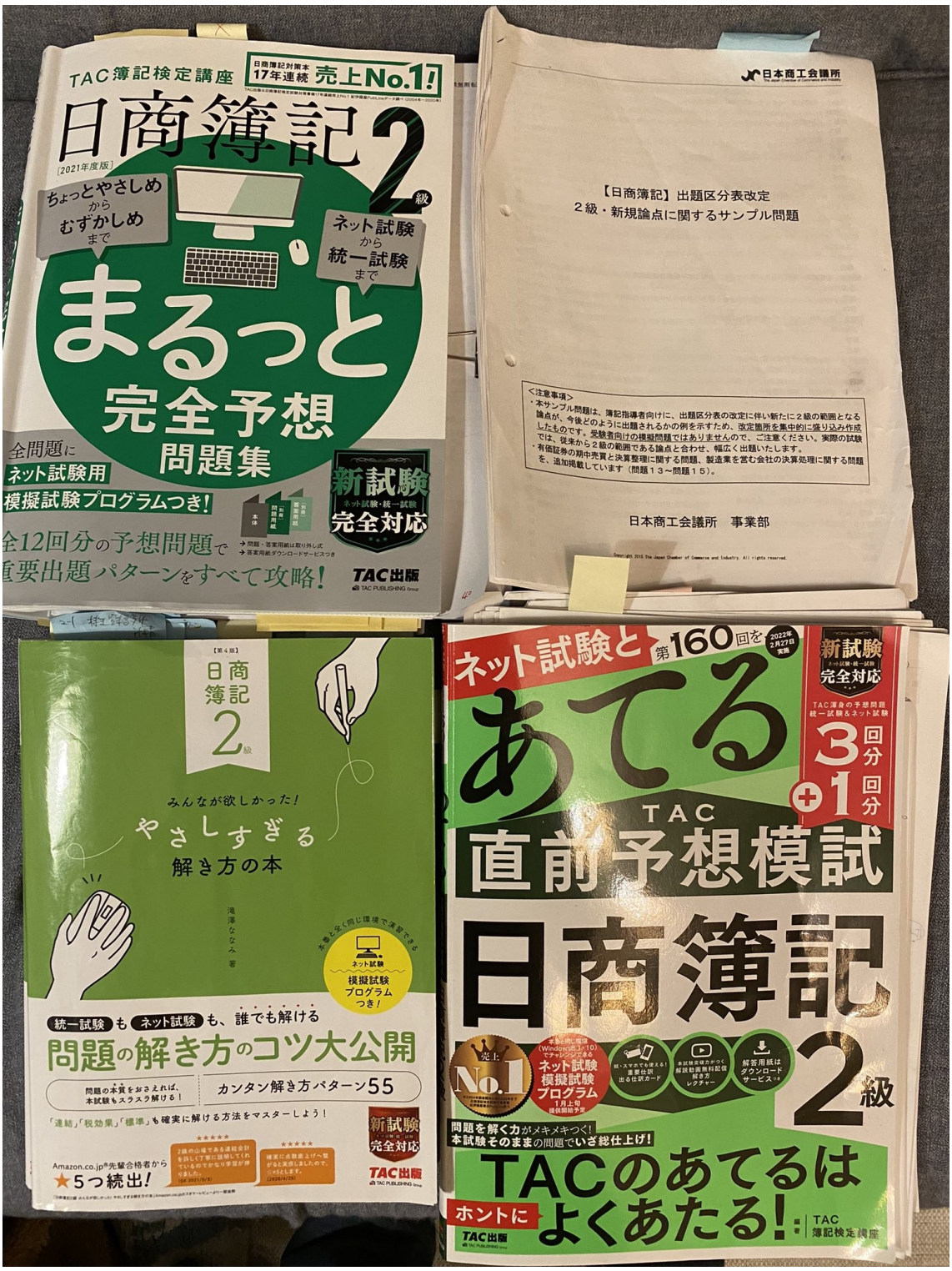
There is little information about whether the predicted questions match the actual examination's difficulty, so I am sharing my experience. (It will be quite a laugh if I fail … but I am posting despite the risk of embarrassment.)

Some candidates may feel discouraged because the predicted questions are too difficult. But the actual examination is not that hard, so please do not give up—keep at it!!

(Perhaps the predicted questions have not become easier even though the time limit was reduced from 120 minutes to 90. And because past papers since the time reduction have not been published, the available information seems likely to be skewed. However, the pass rate for recent unified examinations has not fallen, so it would not add up unless the questions had become easier—and that proved to be the case.)

Next, Grade 1 bookkeeping … no, I will not be doing that.

[Bookkeeping YouTuber?] Masayuki Fukushima — YouTube



English translation of the text in the photograph

Upper left: TAC Bookkeeping Examination Course. Nissho Bookkeeping Grade 2, 2021 edition. “Marutto: Complete Prediction Question Collection.” From slightly easier to more difficult questions; from the computer-based examination to the unified examination. Includes a computer-based mock-examination program for all questions. Fully compatible with the new examination, both computer-based and unified. Master every important question pattern with 12 sets of predicted questions. The main volume, separate question sheets and separate answer sheets are detachable; an answer-sheet download service is included. TAC Publishing. Nissho bookkeeping examination preparation books: No. 1 in sales for 17 consecutive years (2004–2020).

Upper right: Japan Chamber of Commerce and Industry. [Nissho Bookkeeping] Revision of the examination subject classification table: Grade 2 sample questions concerning new topics.

Notes: These sample questions were prepared for bookkeeping instructors, concentrating on the revisions, to show examples of how the topics newly included in Grade 2 following revision of the examination subject classification table may be tested. They are not mock examination questions for candidates. In the actual examination, questions will cover a broad range together with topics that have traditionally been within the scope of Grade 2. Additional questions concerning the interim declaration and closing treatment of securities, and the closing treatment of companies including manufacturers, have been included (Questions 13–15). Japan Chamber of Commerce and Industry, Business Department. Copyright 2015, The Japan Chamber of Commerce and Industry. All rights reserved.

Lower left: Nissho Bookkeeping Grade 2, fourth edition. “The Book of Extremely Easy Solution Methods That Everyone Wanted!” By Nanami Takizawa. Includes a computer-based mock-examination program that can be taken in exactly the same environment as the actual examination. Anyone can solve both the unified and computer-based examinations. Full disclosure of the tips for solving questions. If you grasp the essence of a question, you can solve the actual examination smoothly! 55 easy solution patterns. Master methods for reliably solving “consolidation,” “tax effects” and “standard costs” as well. A succession of five-star reviews from successful candidates on Amazon.co.jp. Fully compatible with the new examination. TAC Publishing.

Lower right: For the computer-based examination and the 160th examination, held on February 27, 2022. “Ataru: TAC Last-Minute Predicted Mock Examination,” Nissho Bookkeeping Grade 2. Fully compatible with the new examination, both computer-based and unified. TAC’s own predicted questions: three unified-examination sets plus one computer-based-examination set. No. 1 in sales. Includes a computer-based mock-examination program that can be challenged in the same environment as the actual examination (Windows 8 or 10), scheduled to become available from early January. Includes an important journal-entry completion card usable on paper or a smartphone; video mini-lectures on selected difficult important problems; and an answer-sheet download service. Your ability to solve questions will improve rapidly! Finish your preparation immediately before the examination with a sense of the actual questions. “TAC’s Ataru really predicts well!” Edited by TAC Bookkeeping Examination Course. TAC Publishing.

United States, June 2008, Supreme Court, Quanta v. LG Electronics

Original Ameblo publication: 2022-03-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729470802.html

United States, June 2008, Supreme Court, Quanta v. LG Electronics

(1) Earlier U.S. case-law practice treated transfer within the United States as a fundamental prerequisite for "exhaustion." Quanta, however, focused not on whether the transfer occurred in the United States, but on whether it was authorized by the patentee (⇒ the U.S. Supreme Court's LEXMARK decision settled the issue).

(2) Patent rights covering method inventions are also subject to "exhaustion."

(3) The requirements for "exhaustion" of patent rights are not distinguished between product and method inventions.

(4) In a transfer of indirectly infringing products, where they "substantially embody" the patent, sale of the components by a licensee exhausts the patent rights. "Substantially embody" means both "(1) the components' only reasonable and intended use is to practice the patented invention" and "(2) the components practice the essential features of the patented invention."

(5) "Exhaustion" of patent rights resulting from an authorized sale could not be avoided, at least on the facts of that case. (The decision did not generally rule out avoiding "exhaustion" through a conditional license agreement.)

324a18_166eedf312b84aa9b36e2d0765082189.pdf (takaishihideki.com)

United States, May 2017, Supreme Court, IMPRESSION PRODUCTS v. LEXMARK

Original Ameblo publication: 2022-03-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729660332.html

United States, May 2017, Supreme Court, IMPRESSION PRODUCTS v. LEXMARK

U.S. patent rights are exhausted even for items sold outside the United States!! (Different from Japan.)

Exhaustion bars enforcement of patent rights against a recycler that obtains used cartridges sold by the patentee subject to a single-use condition, refills them with ink, and sells them (citing the U.S. Supreme Court's 2008 Quanta decision). U.S. patent rights are also exhausted for items sold outside the United States. (Boesch v. Graff, cited by the CAFC, showed that patent rights are not exhausted where the foreign sale is unrelated to the patentee.) Contractual obligations remain binding. (*Related decision: in copyright infringement as well, the U.S. Supreme Court in Kirtsaeng held that the first-sale doctrine under 17 U.S.C. § 109(a) applies to overseas transfers.)

Transfer of Indirectly Infringing Products and "Exhaustion" of Patent Rights (jpaa.or.jp)

United States, 1961, Supreme Court, ARO <Exhaustion>

Original Ameblo publication: 2022-03-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12729835938.html

United States, 1961, Supreme Court, ARO <Exhaustion>

⇒ The conduct in that case was held to be “repair.” (*Anti-patent compared with Japan.)

Whether the component is indispensable is not important.

Purchasing a patented apparatus includes a license to use it—that is, the right to maintain the claimed combination in a condition fit for use insofar as it may be affected by wear or breakage.

• In distinguishing “repair” from “reconstruction,” the durability and expense associated with replacing a component, and whether it is indispensable, are not important.

• Purchasing a patented apparatus includes a license to use it—that is, the right to maintain the claimed combination in a condition fit for use insofar as it may be affected by wear or breakage.

• “Reconstruction” is limited to “such a true reconstruction of the entity as to ‘in fact make a new article,’ after the entity, viewed as a whole, has become spent.”

<95B68F915F328341836283762D332E786477> (hokudai.ac.jp)

May 2002, CAFC, Husky v. R&D Tool & Engineering

Original Ameblo publication: 2022-03-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730022079.html

2002.05 CAFC Husky v. R&D Tool & Engineering

(1) Where the entire patented subject matter has been spent and reconstruction is necessary to make it usable again,

⇒ This constitutes “reconstruction” and infringes the patent. (Cotton-Tie Co. v. Simmons, 106 U.S. (16 Otto) 89 (1882))

(2) Where a worn-out component is replaced,

⇒ Under the rule laid down by the U.S. Supreme Court in Aro, replacement of the worn-out component is “repair” (unless that component is separately patented) and does not constitute “reconstruction.”

(3) Where a component that has not worn out is replaced to change the apparatus’s function,

⇒ This is akin to “repair” and does not infringe.

Judgment (English original): Husky Injection Molding Systems Ltd. v. R & D Tool & Engineering Co., 291 F.3d 780

May 2011, U.S. Supreme Court, Global-Tech v. SEB

Original Ameblo publication: 2022-03-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730261006.html

May 2011, U.S. Supreme Court, Global-Tech v. SEB

To establish induced infringement (35 U.S.C. § 271(b)), in addition to (1) the existence of direct infringement, (2) knowledge that the direct infringement would occur, or willful blindness to the fact of infringement, is required!!

⇒ When exporting copied products from Hong Kong to the United States, the alleged infringer did not tell the U.S. attorney preparing the opinion that the products had been copied.

Global-Tech Appliances, Inc. v. SEB S.A. - Wikipedia

May 2015, U.S. Supreme Court, Commil v. Cisco

Original Ameblo publication: 2022-03-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730261330.html

May 2015, U.S. Supreme Court, Commil v. Cisco

A good-faith belief that a patent is invalid does not prevent induced infringement (35 U.S.C. § 271(b)) from being established.

Read with Global-Tech, a good-faith belief in non-infringement may negate the knowledge required for induced infringement, but merely obtaining a non-infringement opinion does not automatically defeat liability. A belief that the patent is invalid is not a defense negating that knowledge.

13-896 Commil USA, LLC v. Cisco Systems, Inc. (05/26/2015) (govinfo.gov)

2005, CAFC, NTP v. Research in Motion (BlackBerry Case)

Original Ameblo publication: 2022-03-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730571370.html

August 2005, CAFC, NTP v. Research in Motion (BlackBerry Case)

Use of a product (system) invention occurs at “the place where control of the system is exercised and beneficial use of the system is obtained.”

For a method invention, each step must be performed within the United States, and “a process cannot be used ‘within’ the United States as required by § 271(a) unless each step is performed within the United States.”

⇒ No infringement of the method claims; infringement of the system claims.

“RIM’s customers located in the United States controlled transmission of information and benefited from the resulting exchange of information.”

⇒ Centillion v. Qwest (January 2011) and Georgetown Rail Equipment v. Holland (August 2017) are to the same effect for product (system) inventions.

U.S. CAFC Decision, NTP, Inc. v. Research In Motion, Ltd. | Latest IP Information | Itoh International Patent Office (itohpat.co.jp)

June 2014, U.S. Supreme Court; August 2015, CAFC, LIMELIGHT v. AKAMAI

Original Ameblo publication: 2022-03-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730744428.html

June 2014, U.S. Supreme Court, LIMELIGHT v. AKAMAI

For method inventions, the Court held that induced infringement under 35 U.S.C. § 271(b) requires direct infringement and relied in part on a comparison with § 271(f)(1) to reverse the CAFC en banc decision finding induced infringement.

(A case where customers performed part of the method invention. ⇒ Continued in the August 2015 CAFC en banc decision.)

2015.08 CAFC en banc　AKAMAI v. LIMELIGHT

★After the June 2014 Supreme Court decision, the issue was direct infringement (§ 271(a)), not induced infringement (§ 271(b)).

Where a method invention is divided among multiple actors, direct infringement is established if all steps are performed by or attributable to a single entity.

Examples: directing or controlling another party; forming a joint enterprise with another party.

20150825.pdf (jetro.go.jp)

Narrowing Amendments During Prosecution and the Doctrine of Equivalents: Global Case-Law Trends and Japanese Cases

Original Ameblo publication: 2022-03-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12730925337.html

<Narrowing Amendments During Prosecution and the Doctrine of Equivalents: Global Case-Law Trends and Japanese Cases>

Under Japanese case law, infringement under the doctrine of equivalents requires the following five conditions. (Supreme Court, February 24, 1998, “Ball Spline”; Supreme Court, March 24, 2017, “Maxacalcitol”)

1. The part of the patented invention’s configuration differing from the accused product or process is not an essential part of the patented invention. (Non-essential part)

2. Even if the differing part is replaced with the corresponding feature of the accused product or process, the purpose of the patented invention can be achieved and the same effects are produced. (Replaceability; identity of effects)

3. Replacing the differing part with the corresponding feature of the accused product or process could readily have been conceived at the time of manufacture or other relevant act involving the accused product or process. (Ease of replacement)

4. The accused product or process is not identical to the publicly known technology at the filing date of the patented invention, nor readily inferable from that publicly known technology.

5. There are no special circumstances, such as the accused product or process having been intentionally excluded from the claims during prosecution of the patented invention.

Earlier Japanese cases applied the so-called “file-wrapper estoppel” doctrine to claim limitations added by amendment in response to a notice of reasons for refusal for lack of novelty or inventive step, finding equivalence unavailable under the fifth requirement.

In contrast, two decisions have now found the fifth requirement satisfied and recognized infringement under the doctrine of equivalents for limitations added by amendment in response to a lack-of-inventive-step rejection. I introduce them below while comparing the situation in other countries (the United States, Germany, and the United Kingdom).

Tokyo District Court, 2017 (Wa) No. 18184, “Osteotomy Spreader,” held: “The written opinion contains no statement showing awareness of or suggesting the configuration of the engagement portion—that is, whether it is formed as part of the swinging member or by a member separate from the swinging member. Accordingly, … that statement cannot establish that, when constituent feature E was added by the Amendment at Issue filed together with the opinion, the plaintiff intentionally excluded from the claims a configuration in which the engagement portion is a member separate from the swinging member.” The court recognized infringement under the doctrine of equivalents (the fifth requirement was satisfied).

Tokyo District Court, 2016 (Wa) 25436, “Method for Producing L-Glutamic Acid,” held: “At the filing date, it cannot be found that the plaintiff, as applicant, could readily have identified a specific configuration using a mutant yggB gene derived from Corynebacterium callunae capable of solving the problem addressed by Invention 2 at Issue and recited it in the claims in a manner satisfying the support requirement and other disclosure requirements. … No special circumstances can be found. …” The court recognized infringement under the doctrine of equivalents (the fifth requirement was satisfied).

What is important here is that **the reference date for foreseeability was the filing date.** The judgment does not state the reason. However, even if reciting the feature in the claims "in a manner satisfying the support requirement and other disclosure requirements" would have been readily possible at the amendment date, amendments may be made only within the scope of the original specification. Setting the reference date at the "amendment date" would therefore be harsh on the applicant, which is presumably the reason.

The use of the filing date as the reference date for foreseeability is **consistent with the U.S. Supreme Court's May 2002 Festo decision. While adopting a flexible bar, Festo set out "three grounds for rebutting the presumption when prosecution history estoppel applies: (1) the subject matter was unforeseeable 'at the time of the application'; (2) the underlying reason for the narrowing amendment bears only a tangential relation to the subject matter; and (3) there is a reasonable explanation for why the subject matter could not have been described." (However, many subsequent CAFC decisions used the "amendment date" as the reference date for unforeseeability, and those decisions are said to have created the trend toward using that date. ("Prosecution History Estoppel, Equivalents at the Filing Date, and the Doctrine of Equivalents," Yasuyuki Echi, Annual Report of the Japan Association of Industrial Property Law (2015).))**

This tendency to recognize infringement under the doctrine of equivalents (on the premise of a **Flexible Bar**) for limitations added by amendment in response to a lack-of-inventive-step rejection had been recognized by the UK Supreme Court and the German Federal Court of Justice in the "Eli Lilly" litigation pending in various countries shortly before the two Japanese decisions above. It was therefore suggested that Japan might follow, and that is what actually happened.

The "Eli Lilly" Cases in the United States, United Kingdom, and Germany ⇒ Equivalence Recognized for Narrowed Claims in All Three

● UK Supreme Court, [2017] UKSC 48 (v. Actavis) — The first Supreme Court decision recognizing the doctrine of equivalents in the United Kingdom

⇒ Although the claims were narrowed during European prosecution, the amendment was held to have been intended to overcome an added-matter objection based on an impermissible intermediate generalization, and merely to satisfy the amendment requirements.

● German Federal Court of Justice, [2016] X ZR 29/15 (v. Actavis)

⇒ If an amendment limits the subject matter over the prior art, the doctrine of equivalents is excluded. However, an amendment prompted by formal requirements (added matter or clarity) is not deemed a selection decision by the patentee, and the doctrine of equivalents is not excluded.

● U.S. CAFC, August 9, 2019 (Eli Lilly and Company v. Hospira, Inc.)

⇒ Prosecution history estoppel arises where a patent applicant narrows claim scope during prosecution for a substantial reason relating to patentability. Such a narrowing amendment creates a presumption that all equivalents within the territory between the original and amended claims have been surrendered. The patentee may rebut that presumption, for example by proving that the reason for the amendment bears only a "tangential" relation to the equivalent in question.

Finally, I also introduce the Supreme Court's March 24, 2017, "Maxacalcitol" decision because it is an important precedent on the fifth requirement of the doctrine of equivalents. It does not, however, concern the "file-wrapper estoppel" discussed above, but rather **the dedication doctrine (typically, the doctrine that a feature disclosed in the specification but not claimed is deemed dedicated to the public and is unavailable under the doctrine of equivalents)**.

The Supreme Court held: "Where, at the filing date, the applicant **could readily have conceived** of the configuration of the accused product or process corresponding to the differing part of the claimed configuration but did not recite it in the claims, and where it can be said that, **viewed objectively and**

externally, the applicant indicated that it deliberately refrained from claiming that configuration despite recognizing it as an alternative to the configuration recited in the claims, special circumstances exist, such as the accused product or process having been intentionally excluded from the claims during prosecution of the patented invention. …”

Nevertheless, including the facts of “Maxacalcitol,” Japan has hardly any decisions (possibly none) denying the fifth requirement of the doctrine of equivalents under **the dedication doctrine**. Although it is a general principle stated by the Supreme Court, it is a dangerous, leaky boat for an alleged infringer to rely on.

End

[Patent ★] <Narrowing Amendments During Prosecution and the Doctrine of Equivalents: Global Case-Law Trends and Japanese Cases> — NAKAMURA & PARTNERS (nakapat.gr.jp)

“Infringement of a U.S. Patent by Importing into the United States … Products Made by a Process Covered by That Patent” (Takayuki Yahagi)

Original Ameblo publication: 2022-03-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12731096042.html

(Article Introduction)

“Infringement of a U.S. Patent by Importing into the United States, Selling There, or Otherwise Dealing in Products Made by a Process Covered by That U.S. Patent” (Takayuki Yahagi, Japanese Patent Attorney and New York Attorney)

United States, December 2019, CAFC, Syngenta v. Willowood

The “single-entity requirement” (that all steps recited in the claim be performed by, or in a manner attributable to, a single person) does not apply to 35 U.S.C. § 271(g), the “provision treating importation into the United States and similar acts involving products made by a process covered by a U.S. patent as infringement of that U.S. patent.”

Even products made outside the United States through a process divided among multiple persons infringe the U.S. patent under § 271(g) if imported into the United States.

(*Different from 35 U.S.C. § 271(a).)

35 U.S.C. § 271(a)

Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention within the United States, or imports any patented invention

into the United States during the term of the patent therefor, infringes the patent.

35 U.S.C. § 271(g)

Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product made by a process patented in the United States shall be liable as an infringer if the importation, offer to sell, sale, or use of the product occurs during the term of that process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of noncommercial use or retail sale of a product unless there is no adequate remedy under this title on account of the importation or other use, offer to sell, or sale of that product. For purposes of this title, a product made by a patented process is no longer considered to have been made by that process after—

(1) it is materially changed by subsequent processes; or

(2) it becomes a trivial and nonessential component of another product.

Infringement of a U.S. Patent by Importing into the United States, Selling There, or Otherwise Dealing in Products Made by a Process Covered by That U.S. Patent (jpaa.or.jp)

IP High Court, 2020 (Gyo-Ke) 10124, Method for Manufacturing … Ink Composition <Shoji> — *Not an Issue of “Obviousness upon Obviousness”

Original Ameblo publication: 2022-03-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12731264347.html

IP High Court, 2020 (Gyo-Ke) 10124, Method for Manufacturing a Solvent-Based Gravure Printing Ink Composition for Reverse Printing <Shoji>

*Not an issue of “obviousness upon obviousness”

“A person skilled in the art would be motivated … to use biomass-derived components as raw materials for Exhibit Ko 1 Invention 1. … This does not assess obviousness after adding to Exhibit Ko 1 Invention 1 a configuration of the kind alleged by the plaintiff. …”

(Excerpts from the judgment)

The plaintiff argues, concerning Difference 2, that … the Decision at Issue assessed obviousness after adding to Exhibit Ko 1 Invention 1 the feature of “using biomass-derived components as raw materials for the polyurethane-urea resin composition,” and that this … reasoning corresponds to “obviousness upon obviousness.”

However, … at the Priority Date at Issue, increasing the biomass content of products to at least 10% by mass was a general problem in the technical field of printing inks. In those circumstances, a person skilled in the art would have motivation to use biomass-derived components as raw materials for the polyurethane-urea resin composition of Exhibit Ko 1 Invention 1 and, further, to use biomass-derived sebacic acid as such a component. In light of this analysis, the assessment does not add a configuration of the kind alleged by the plaintiff to Exhibit Ko 1 Invention 1 before assessing obviousness, nor does its reasoning stand in the relationship of so-called “obviousness upon obviousness.”

The Scope of “Obviousness upon Obviousness” (The Role of a Third Prior-Art Document) (jpaa.or.jp)

090731_hanrei.pdf (courts.go.jp)

— Tokyo District Court, 2016 (Wa) 25436, Method for Producing L-Glutamic Acid <Presiding Judge Yamada> —

Original Ameblo publication: 2022-03-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12731540844.html

Tokyo District Court, 2016 (Wa) 25436, Method for Producing L-Glutamic Acid <Presiding Judge Yamada>

(1) A case finding infringement under the doctrine of equivalents for a method excluded by an amendment responding to a lack-of-inventive-step rejection (consistent with the global tendency to apply the flexible bar flexibly).

(2) An "offer for transfer" was established although the transferor and the person making the offer differed and the "transfer" occurred abroad.

◆ Full text of the judgment

[Summary of This Judgment and Some Observations]

1. Claims (Corrected Invention 2-2 at Issue)

"A coryneform bacterium having the ability to produce L-glutamic acid, whose L-glutamic acid-producing ability is improved relative to an unmodified strain through introduction of a mutant yggB gene, wherein the mutation in said mutant yggB gene substitutes threonine for alanine at position 100 and/or threonine or valine for alanine at position 111 in the amino acid sequence of SEQ ID NO: 6, 62, 68, 84, or 85."

2. Excerpts from the Judgment (1): Doctrine of Equivalents

(1) Three Differences Between Corrected Invention 2-2 at Issue and Defendant's Process 4

"Difference 1: The introduced mutant yggB gene is derived from Corynebacterium glutamicum (the amino acid sequence before mutation is SEQ ID NO: 6) in the strain with the type-19-mutation configuration, whereas in the strains used in Defendant's Process 4 (strains (12) and (13)), it is derived from Corynebacterium callunae (strain DSM20147).

Difference 2: The mutation introduced into the yggB gene substitutes threonine for alanine at position 100 of the amino acid sequence encoded by the yggB gene (A100T mutation) in the strain with the type-19-mutation configuration, whereas in the strains used in Defendant's Process 4 it substitutes threonine for alanine at position 98 of the amino acid sequence encoded by the yggB gene (A98T mutation).

Difference 3: In the type-19-mutation configuration, only the A100T mutation is introduced into the yggB gene, whereas in the strains used in Defendant's Process 4, in addition to the A100T mutation [sic], a mutation substituting isoleucine for valine at position 241 of the amino acid sequence encoded by the yggB gene (V241I mutation) is also introduced."

(2) First Requirement (*None of the three differences is an essential part.)

"Compared with the prior art described in Specification 2 at Issue, the distinctive technical concept (problem-solving principle) of Invention 2 at Issue, absent from the prior art, lies in providing a new technology for increasing glutamic-acid production capacity by focusing on the yggB gene of coryneform

bacteria, whose effect on glutamic-acid production was previously unknown, and modifying YggB protein, a type of mechanosensitive channel, using mutant yggB genes such as those with C-terminal mutations or mutations in transmembrane regions. …

Accordingly, none of Differences 1 through 3 between the type-19-mutation configuration and Defendant's Process 4 is an essential part of the patented invention. Defendant's Process 4 using strains (12) and (13) is therefore found to satisfy the first requirement for equivalence."

(3) Third Requirement (*Ease of replacement was recognized under the same framework as inventive-step analysis. A double standard for the third requirement of equivalence was argued, but no specific assessment was given.)

"…It is appropriate to find that a person skilled in the art could readily have conceived, as of July 2016 when manufacture using Defendant's Process 4 began, of replacing the features of the type-19-mutation configuration with those relating to Differences 1 and 2: namely, replacing Corynebacterium glutamicum with Corynebacterium callunae as the strain from which the mutant yggB gene is derived and, correspondingly, changing the position in the amino acid sequence encoded by the yggB gene at which alanine is replaced by threonine from position 100 to position 98.

The defendant argues that 'readily conceivable' under the third requirement should mean a degree of ease such that every person skilled in the art can recognize it as if it were expressly recited in the claims, and that such ease did not exist here. However, in light of the above circumstances, measured against the average technician in the industry of glutamic-acid fermentation using bacteria to which Invention 2 at Issue belongs—that is, a person skilled in the art—Differences 1 and 2 must be regarded as readily conceivable, and the defendant's argument on this point cannot be accepted. …"

(4) Fifth Requirement (*A case finding infringement under the doctrine of equivalents for a method excluded by an amendment responding to a lack-of-inventive-step rejection, consistent with the global tendency to apply the flexible bar flexibly.)

"…As a result of two amendments made in response to notices of reasons for refusal, … configurations using a mutant yggB gene derived from Corynebacterium callunae, as in Defendant's Process 4, ceased to fall literally within the technical scope of Invention 2 at Issue. Moreover, … at filing, Specification 2 at Issue mentioned Corynebacterium callunae only in paragraphs [0012] and [0013], and those portions were not amended in the above amendments. …

(a) Under the fifth requirement, equivalence cannot be asserted where special circumstances exist, such as the accused product or process having been intentionally excluded from the claims during prosecution of the patented invention. The reason is that, where the patentee has once acknowledged that a product or process is outside the technical scope of the patented invention, or has acted in a manner that can outwardly be understood that way, estoppel bars the patentee from later making a contrary assertion (see the 1998 and 2017 Supreme Court judgments).

(b) …Claim 1 as filed could encompass configurations using a mutant yggB gene derived from Corynebacterium callunae, such as Defendant's Process 4, but the amendments caused such configurations to cease to be literally included in Invention 2 at Issue.

(c) However, … the complete genome of Corynebacterium callunae strain DSM20147 and the amino acid sequence encoded by its yggB gene were not analyzed and made available until around March 2013 or later. At the Priority Date at Issue … or the filing date …, it was not possible to identify the amino acid sequence encoded by the yggB gene of Corynebacterium callunae. Accordingly, …**at the filing date, it cannot be found that the plaintiff, as applicant, could readily have identified a specific configuration using a mutant yggB gene derived from Corynebacterium callunae capable of solving the problem addressed by Invention 2 at Issue and recited it in the claims in a manner satisfying the support requirement and other disclosure requirements.**

(d) Furthermore, … claim 1 as filed did not identify any bacterial species more specifically than the general expression ‘a coryneform bacterium having the ability to produce L-glutamic acid.’ In particular, it did not describe a configuration using a mutant yggB gene derived from Corynebacterium callunae. References to Corynebacterium callunae in Specification 2 at Issue merely list it as an example of bacteria usable as the coryneform bacterium of Invention 2 at Issue ([0012], [0013]). Specification 2 at Issue contains no reference to a configuration using a yggB gene derived from Corynebacterium callunae either before or after the amendments.

(e) In light of the circumstances in (c) and (d), the filing and amendment history in (b), viewed objectively and externally, does not indicate an intention deliberately to exclude from the claims a configuration using a mutant yggB gene derived from Corynebacterium callunae. Nor does all the other evidence in this case establish, for Defendant’s Process 4, special circumstances under the fifth requirement, such as intentional exclusion from the claims during prosecution of the patented invention.”

3. Excerpts from the Judgment (2): Support and Enablement Requirements

Before correction, the support requirement was not satisfied because the claim included subject matter incapable of solving the problem. ⇒ Satisfied through the correction-based reply to the invalidity defense.

“Among the inventions recited in Invention 1-1 at Issue, at least the methods for producing arginine using coryneform bacteria with mutations introduced into the GDH, CS, ICDH, and PDH genes exceed the scope within which a person skilled in the art could recognize, from the detailed description of the invention in Specification 1 at Issue, that the above problem of constructing, through genetic recombination or mutation, mutant strains capable of producing amino acids in high yield could be solved. Nor, beyond the disclosures in Specification 1 at Issue, can common general technical knowledge at the filing date be found that would enable a person skilled in the art to solve that problem for arginine-production methods using mutations in those genes. …

Invention 1-1 at Issue before correction included inventions using coryneform bacteria with a particular nucleotide sequence introduced into the promoter sequence of the ICDH gene, PDH gene, or argininosuccinate synthase gene. Correction 1 at Issue removed those inventions from Corrected Invention 1-1 at Issue. Accordingly, neither a support-requirement violation nor an enablement-requirement violation concerning introduction of mutations into the promoters of the ICDH, PDH, and argininosuccinate synthase genes can be found for Corrected Invention 1-1 at Issue.”

4. Excerpts from the Judgment (3): Offers for Transfer

(1) An “offer for transfer” was established even though the transferor and the person making the offer differed, where they had a certain relationship. (2) An offer for transfer was established even though the “transfer” occurred abroad. (3) Patent Act Article 102(2) was applied using overseas sales as the basis. (There were special circumstances: all foreign sales were to Japanese buyers, and even though delivery itself occurred on shipment, subsequent importation into Japan by the buyers was contemplated.)

<In this case, all the Defendant’s Processes were used abroad, and the resulting products were imported into and sold in Japan.>

“…Although the transfer itself of the MSG at Issue in the CJ Indonesia Sales cannot be found to have taken place within Japan, … considering the relationship between the defendant and CJ Indonesia within the CJ Group; … the fact that purchase orders for CJ Indonesia Sales were sometimes submitted to the defendant and forwarded through it to CJ Indonesia; … the Commission Agreement at Issue between the defendant and CJ Indonesia providing for payment to the defendant of part of the revenue from CJ Indonesia Sales; … the defendant’s delivery of samples and collection of defective MSG at Issue in Japan in connection with CJ Indonesia Sales; and … the recording of expenses relating to CJ Indonesia Sales in the defendant’s

accounts, … it is appropriate to find that, during the periods in which the Defendant's Processes were used, the defendant jointly conducted sales activities for CJ Indonesia Sales with CJ Indonesia within Japan, and that the defendant made offers for transfer. Since … the MSG at Issue manufactured during those periods was manufactured by one of the Defendant's Processes (the Defendant's Products), the defendant's offers for transfer of the MSG at Issue during those periods constitute working of Invention 1 or Invention 2 at Issue by the defendant (Patent Act Article 2(3)(iii)). …

(a) The defendant argues that an 'offer for transfer' is an act performed by the seller, who will be the transferor, and that no offer for transfer exists where the person performing the offering act, such as advertising, differs from the person making the transfer. Thus, even if the defendant, which was not the seller, had some involvement in CJ Indonesia Sales, its acts did not constitute offers for transfer. However, in light of the purpose of treating offers for transfer as acts of working distinct from transfers, an offering act should be capable of being construed as an offer for transfer even if not performed by the seller/transferor, where circumstances exist such as its being performed by a person having a certain relationship with that seller. … CJ Indonesia and the defendant belong to the same corporate group and had a close relationship, including entering into the Commission Agreement at Issue and sharing profits from CJ Indonesia Sales. The fact that CJ Indonesia, rather than the defendant, was the party to the sales contracts does not prevent a finding that the defendant's … involvement constituted offers for transfer of the MSG at Issue.

(b) The defendant also argues that 'transfer' under the Patent Act means a transfer within Japan and that an 'offer for transfer,' as a preparatory act, likewise means an offer for a transfer within Japan; thus, its acts concerning CJ Indonesia Sales do not constitute offers for transfer. It is true that … the transfer to buyers of the MSG at Issue in CJ Indonesia Sales took place outside Japan. However, all CJ Indonesia Sales were to Japanese buyers, and even if delivery itself occurred on shipment, subsequent importation into Japan by those buyers was contemplated. In light of the purpose of treating offers for transfer as acts of working distinct from transfers, for goods such as the MSG at Issue in CJ Indonesia Sales that are sold to Japanese buyers as a result of sales activities in Japan and imported into Japan, it is inappropriate to reach different conclusions on whether those sales activities constitute offers for transfer in Japan solely according to whether transfer to the buyer occurs outside or inside Japan. … It is therefore appropriate to construe the defendant's and CJ Indonesia's joint sales activities in Japan concerning CJ Indonesia Sales as 'offers for transfer' by the defendant, and the defendant's argument cannot be accepted. …

The defendant argues that damages from the act of working consisting of 'offers for transfer' in connection with CJ Indonesia Sales should not be calculated from the revenue of those sales but should be confined to the scope peculiar to the 'offers for transfer.' However, … the defendant and CJ Indonesia are joint tortfeasors concerning CJ Indonesia Sales, so damages must take account of the profits not only of the defendant but also of defendant CJ Indonesia. … All CJ Indonesia Sales were to Japanese buyers, and importation into Japan after delivery to those buyers was contemplated. Thus, even if the 'transfer' itself occurred abroad, it is appropriate, for purposes of Article 102(2) of the Patent Act, to regard the defendants' profits calculated from the revenue of CJ Indonesia Sales as profits obtained through 'offers for transfer' within Japan. The defendant's argument cannot be accepted."

5. Some Observations on the Doctrine of Equivalents

(1) The First Requirement

The analysis follows the criteria of the Intellectual Property High Court Grand Panel decision in Maxacalcitol.

⇒ Even though there are three differences, the criteria are applied straightforwardly to each.

<Reference> [Patent ★★★] Supreme Court Decision Affirming the Intellectual Property High Court Grand Panel Judgment Finding Infringement under the Doctrine of Equivalents of a Patented Invention Relating to a Method for Producing a Chemical Substance (Maxacalcitol)

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E6%97%A5%E6%9C%AC%E8%AA%9E-%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E2%98%85%E3%80%91%E5%8C%96%E5%AD%A6%E7%89%A9%E8%B3%AA%EF%BC%88%E3%83%9E%E3%82%AD%E3%82%B5%E3%82%AB%E3%83%AB%E3%82%B7/

(2) The Third Requirement

The case-law and prevailing view is that the third requirement of equivalence (ease of replacement), although assessed at a different reference date, is harder to satisfy than obviousness in inventive-step analysis, and applies a standard requiring “a degree of ease such that, unlike under Article 29(2) of the Patent Act, every person skilled in the art can recognize it as if it were expressly recited in the claims” (Tomoji Yamada, “Significance and Function of the Third Requirement of the Doctrine of Equivalents,” Intellectual Property Management, Vol. 63, No. 5, 2013).

Applying that standard would seem likely to result in rejection of the third requirement, and hence equivalence, in many cases. A review of past decisions, however, shows extremely few cases that affirmed the first and/or second requirement but rejected only the third.

⇒ Among judgments rejecting ease of replacement under the third requirement, four held that the claimant must allege and prove the higher threshold, beyond obviousness in inventive-step analysis, of “a degree of ease such that, unlike under Article 29(2) of the Patent Act, every person skilled in the art can recognize it as if it were expressly recited in the claims.” (The three cases presented in “Case-Law Trends and Strategies Concerning the Doctrine of Equivalents,” Patent, Vol. 70, No. 1, p. 54, cited below, and Tokyo District Court, 2016 (Wa) No. 7763, Self-Laminating Rotatable Cable Marker Label with a Split Portion <Shimasue>.)

However, examining judgments affirming ease of replacement under the third requirement shows that many do not demonstrate matters to that extent but adopt the same framework as obviousness in inventive-step analysis. Conversely, many judgments rejecting ease of replacement adopt a different framework. A comprehensive examination thus reveals a tendency: decisions affirming the third requirement frequently use the inventive-step obviousness framework, while those rejecting it use a different framework and impose a higher threshold. Put another way, in cases affirming the third requirement, ease of replacement is accepted at approximately the same level as inventive-step obviousness. In cases rejecting it, however, courts require “a degree of ease such that, unlike under Article 29(2) of the Patent Act, every person skilled in the art can recognize it as if it were expressly recited in the claims,” and tend not to proceed to analyze whether a person skilled in the art could readily have conceived of it even without its being described in a publicly known document.

Against that background, this judgment (Tokyo District Court, 2016 (Wa) No. 25436 <Yamada>, Method for Producing L-Glutamic Acid) held: “**The defendant argues that ‘readily conceivable’ under the third requirement should mean a degree of ease such that every person skilled in the art can recognize it as if it were expressly recited in the claims, and that such ease did not exist here. However, in light of the above circumstances, measured against the average technician in the industry of glutamic-acid fermentation using bacteria to which Invention 2 at Issue belongs—that is, a person skilled in the art—Differences 1 and 2 must be regarded as readily conceivable**, and the defendant’s argument on this point cannot be accepted.” Without directly answering the defendant’s argument identifying a double standard for the third requirement, the court rejected it in one line as if the two standards were identical.

However, the Tokyo District Court’s decision in 2016 (Wa) No. 7763, Self-Laminating Rotatable Cable Marker Label with a Split Portion <Shimasue>, cited below, held: “**The third requirement that a ‘person**

skilled in the art' 'could readily have conceived of [the replacement] at the time of manufacture or other relevant act involving the accused product or process' differs from 'could easily have made the invention' based on publicly known inventions under Article 29(2) of the Patent Act or 'could readily have inferred' by a 'person skilled in the art' under the fourth requirement. It requires a degree of ease such that every person skilled in the art can recognize it as if expressly recited in the claims—that is, as substantially identical (see Tokyo District Court, October 7, 1998, 1991 (Wa) No. 10687, Hanrei Jiho No. 1657, p. 122)." It thus rejected the third requirement using a criterion clearly different from inventive-step analysis.

This judgment too raises concern about a double standard for the third requirement. In any event, the accumulation of future decisions will need close attention.

Reference: "Case-Law Trends and Strategies Concerning the Doctrine of Equivalents," Patent, Vol. 70, No. 1, p. 54

https://system.jpaa.or.jp/patents_files_old/201701/jpaapatent201701_054-067.pdf

(3) The Fifth Requirement

This judgment held: "…**At the filing date, it cannot be found that the plaintiff, as applicant, could readily have identified a specific configuration using a mutant yggB gene derived from Corynebacterium callunae capable of solving the problem addressed by Invention 2 at Issue and recited it in the claims in a manner satisfying the support requirement and other disclosure requirements.**" It thus recognized infringement under the doctrine of equivalents for a method excluded by an amendment responding to a lack-of-inventive-step rejection, consistent with the global tendency to apply the flexible bar flexibly.

Further, the criterion of whether it "**would readily have been possible to recite the configuration in the claims in a manner satisfying the support requirement and other disclosure requirements**" is the same criterion used in the series of Eli Lilly decisions worldwide discussed below (German Federal Court of Justice, UK Supreme Court, and U.S. CAFC) when recognizing the application of the doctrine of equivalents to features (compounds) excluded by amendments during prosecution. International harmonization thus appears to be taking place.

(Note) In the UK Supreme Court case ([2017] UKSC 48), the amendments during prosecution responded to the examiner's objections under Articles 83 and 84 EPC (disclosure and clarity) and Article 123(2) EPC (added matter). In the CAFC case (Eli Lilly v. Hospira, August 9, 2019), the amendment was made to avoid an anticipation rejection over Arsenyan. The German Federal Court of Justice (X ZR 29/15) set aside the judgment that had rejected equivalence and remanded the case to the court of appeal.

One reasonable explanation for using the "filing date" as the reference date for foreseeability is that, even if the product/process was foreseeable at the "amendment date," it could not be added by amendment if not disclosed in the specification, because that would introduce new matter. Using the filing date, when it could have been included in the specification, is therefore rational. If, instead, the prosecution history showed that the product/process was foreseeable at the amendment date and disclosed in the specification, yet a more restrictive amendment was made, it might be possible to conclude on a different rationale that there was intentional exclusion and the fifth requirement was not satisfied.

As related background, the U.S. Supreme Court's May 2002 decision in Festo v. Shoketsu Kinzoku stated the following criteria: "(1) Where claims are narrowed during prosecution, prosecution history estoppel applies, whether or not the narrowing is intended to avoid prior art, so long as it is intended to satisfy a requirement of patent law (developing the U.S. Supreme Court's Warner-Jenkinson decision). (2) If the patentee cannot explain the reason for a narrowing amendment, it is presumed to have been made for a substantial reason related to patentability. (3) Even where prosecution history estoppel applies following claim narrowing, equivalence is not automatically excluded (= flexible bar). (4) Three alternative grounds

for rebuttal where prosecution history estoppel applies: (a) the subject matter was unforeseeable at the '**filing date**'*; (b) the underlying reason for the narrowing amendment bears only a tangential relation to the subject matter; or (c) there is a reasonable explanation for why the subject matter could not have been described." However, many subsequent CAFC judgments used the "**amendment date**" as the reference date for unforeseeability, and those subsequent judgments are said to have created the trend toward using that date. ("Prosecution History Estoppel, Equivalents at the Filing Date, and the Doctrine of Equivalents," Echi, Annual Report of the Japan Association of Industrial Property Law (2015).)

[Related Case: Third Requirement]

Tokyo District Court, 2016 (Wa) No. 7763, Self-Laminating Rotatable Cable Marker Label with a Split Portion <Shimasue>

***Only the third requirement (conceivability of replacement at the start of manufacture) was rejected.**

***Ease of replacement was rejected under a framework different from inventive-step analysis.**

"…The third requirement that a 'person skilled in the art' 'could readily have conceived of [the replacement] at the time of manufacture or other relevant act involving the accused product or process' differs from 'could easily have made the invention' based on publicly known inventions under Article 29(2) of the Patent Act or 'could readily have inferred' by a 'person skilled in the art' **under the fourth requirement. It requires a degree of ease such that every person skilled in the art can recognize it as if expressly recited in the claims—that is, as substantially identical** (see Tokyo District Court, October 7, 1998, 1991 (Wa) No. 10687, Hanrei Jiho No. 1657, p. 122). …

Regarding the configuration of the Defendant's Product, even if it was well-known technology in the field of labels attached to articles to form a nonlinear separation line, including a U-shaped line, and divide the label into multiple portions along that line (…), it is difficult to say that the configuration was so easy that every person skilled in the art would recognize it as if expressly recited in the claims of Invention 1 at Issue. …

The plaintiff argues that no motivation is required for the configuration in which the 'first adhesive region 16′' in the Defendant's Product fixes the label at two points at its two corners, because that configuration falls within the technical scope of Invention 1 at Issue. The issue here, however, is whether the specific configuration of the Defendant's Product relating to its differences from Invention 1 at Issue can readily be conceived from the wording of the claims. That specific configuration necessarily includes where within the label the 'first adhesive region' is located. Thus, the mere facts that the Defendant's Product has a portion capable of constituting the 'first adhesive region' of Invention 1 at Issue and that forming a U-shaped separation line is well-known technology are insufficient to say that the configuration of the Defendant's Product would be recognized as if expressly recited in the claims of Invention 1 at Issue."

[Related Cases: Fifth Requirement]

(1) UK Supreme Court, [2017] UKSC 48 (Actavis v. Eli Lilly)

A UK Supreme Court decision recognizing the doctrine of equivalents. **Although the claims were narrowed during European prosecution, the amendment was held to be intended to overcome an added-matter objection based on an impermissible intermediate generalization and merely to satisfy the amendment requirements.⇒** Equivalence established.

(2) German Federal Court of Justice, X ZR 29/15 (Actavis v. Eli Lilly)

An amendment distinguishing the subject matter from the prior art may indicate a selection decision excluding other configurations from protection. By contrast, such a selection decision ordinarily cannot be inferred from **an amendment made to meet formal requirements (added matter or clarity). ⇒ The judgment excluding equivalence was set aside, and the case was remanded for findings on equivalent effect, ease of identifying the substitute, and ot**her matters.

(3) U.S. CAFC / Eli Lilly v. Hospira (Fed. Cir. Aug. 2019)

During prosecution, Eli Lilly had unnecessarily narrowed claim 12 of the ’209 patent to “pemetrexed disodium salt,” whereas Hospira sought approval to market “pemetrexed ditromethamine salt.”

The U.S. Supreme Court’s Festo decision (2002) adopted a flexible bar and set out the following three grounds for rebutting the presumption of prosecution history estoppel arising from a narrowing amendment during prosecution.

①Equivalent may have been unforeseeable at the time of the application.

②The rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question.

③Some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.

This CAFC decision is important as a case in which the presumption of prosecution history estoppel was rebutted before the U.S. CAFC and equivalence recognized for a claim narrowed during prosecution, on the ground of “no more than a tangential relation to the equivalent in question.”

This CAFC decision was probably not unrelated to the UK Supreme Court decision recognizing infringement under the doctrine of equivalents and the German Federal Court of Justice decision setting aside and remanding the judgment that had rejected equivalence in relation to family patents (the two cases above).

Japan too has recently seen a case recognizing infringement under the doctrine of equivalents for a limitation added by amendment: the Osteotomy Spreader case, Tokyo District Court, December 21, 2018, 2017 (Wa) No. 18184 <Presiding Judge Sato>, discussed below. (The appellate judgment, Intellectual Property High Court, 2019 (Ne) No. 10005 <Presiding Judge Tsuruoka>, found literal infringement.)

★In 2019, the CAFC recognized equivalence in three cases. Although some had wondered whether the U.S. doctrine of equivalents was dead, a signal of its revival may have been sent.

UCB, Inc. v. Watson Labs. Inc. (Fed. Cir. June 24, 2019)

Ajinomoto Co. v. USITC (Fed. Cir. Aug. 6, 2019)

Eli Lilly & Co. v. Hospira, Inc. (Fed. Cir. Aug. 9, 2019)

(4) Japan (Tokyo District Court, December 21, 2018, 2017 (Wa) 18184 <Presiding Judge Sato>)

“…Regarding the fifth requirement, the defendant argues as follows. Constituent feature E was added by the Amendment at Issue. The Written Opinion at Issue responding to the Notice of Reasons for Refusal states: ‘The present invention differs from the invention disclosed in Cited Document 1 … in comprising two sets of swinging members and in providing one swinging member with an engagement portion that engages the other.’ This can be understood as the plaintiff intentionally excluding from the patented invention a configuration, such as the Defendant’s Product, in which the engagement portion is a separate member. Therefore, infringement under the doctrine of equivalents is not established.

However, the Written Opinion at Issue contains statements including: ‘Cited Document 1 discloses a retractor assembly having a pair of jaws arranged to open and close through a rotatable connection at their ends’; ‘Such a configuration [court’s note: the configuration of the Invention at Issue] allows two sets of swinging members to open simultaneously, facilitating enlargement of an incision formed in a bone and preventing locally excessive pressing force on the cut surfaces of the incision’; ‘Merely combining two retractor assemblies detachably cannot yield the configuration of the present invention’; and ‘Cited Invention 1 provides no suggestion of the problem of reducing the pressing force acting on the cut surfaces of the incision, or of the action of the engagement portion in opening two retractor assemblies as an integrated unit.’

According to those statements, **the main point of the Written Opinion at Issue is to explain to the JPO examiner that Cited Reference 1 discloses a pair of swinging members, whereas the Invention at Issue combines two pairs of openable and closable swinging members and provides an engagement portion for engaging one swinging member with the other, enabling both to open simultaneously. The opinion contains no statement showing awareness of or suggesting the configuration of the engagement portion—that is, whether it is formed as part of the swinging member or by a member separate from it.** Accordingly, the statement identified by the defendant, 'comprising two sets of swinging members and providing one swinging member with an engagement portion that engages the other,' merely describes the configuration of the Invention at Issue in the context of that explanation. It cannot establish that, when constituent feature E was added by the Amendment at Issue filed together with the opinion, the plaintiff intentionally excluded from the claims a configuration in which the engagement portion is a member separate from the swinging member."

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E2%98%85%E3%80%91%E6%9D%B1%E4%BA%AC%EF%BC%88%E5%9C%B0%E8%A3%81%E3%80%81%E9%AB%98%E8%A3%81%EF%BC%89%E3%81%A7%E5%88%9D%E3%82%81%E3%81%A6%E3%80%81%E8%A3%9C/?fbclid=IwAR0jJ058kRFhMKK_KcJESCo89MkhyUawJwH-o6Lvtp-vMViNi5NPrILLTVY

(5) May 2002, U.S. Supreme Court, "Festo v. Shoketsu Kinzoku"

(1) Where claims are narrowed during prosecution, prosecution history estoppel applies, whether or not the narrowing is intended to avoid prior art, so long as it is intended to satisfy a requirement of patent law (developing the U.S. Supreme Court's Warner-Jenkinson decision).

(2) If the patentee cannot explain the reason for a narrowing amendment, it is presumed to have been made for a substantial reason related to patentability.

(3) Even where prosecution history estoppel applies following claim narrowing, equivalence is not automatically excluded (= flexible bar).

(4) Three grounds for rebuttal where prosecution history estoppel applies: (a) the subject matter was unforeseeable at the time of the application; (b) the underlying reason for the narrowing amendment bears only a tangential relation to the subject matter; or (c) there is a reasonable explanation for why the subject matter could not have been described.**⇒ On remand: prosecution history estoppel is a question of law for the judge.**

[Excerpts from Related Judgments: Recent Cases Recognizing Infringement under the Doctrine of Equivalents]

(1) IP High Court, 2009 (Ne) No. 10006, Hollow Golf Club Head (Iimura)

(1) Replaceability

…The purpose and effects (or problem-solving principle) of using a "stitching member (made of fiber-reinforced plastic)" are to increase the joint strength between the metal shell member and the fiber-reinforced-plastic shell member. … In the Defendant's Product, molding by heating and pressing with FRP lower shell member 9 applied is performed not only at the bonding interface of the metal shell member but also on the opposite side. Strip 8 is therefore integrally joined to the fiber-reinforced-plastic shell member (FRP upper shell member 9) also on the side opposite the metal shell member's bonding interface. … Thus, strength need not be secured by passing strip 8 repeatedly through the through-hole provided in the metal shell member. … Because the purpose and effects (or problem-solving principle) are common, replaceability exists.

(2) Ease of replacement …

(3) Whether the difference is a non-essential part

The purpose and effects of the Invention at Issue are … to increase the joint strength between the metal shell member and the fiber-reinforced-plastic shell member. In light of the claims and the detailed description in the Specification at Issue, the invention seeks to achieve that purpose by providing a through-hole in the joint portion of the metal shell member and passing a fiber-reinforced-plastic member through it. The important part for solving the problem lies in the configuration of joining "said fiber-reinforced-plastic shell member and said metal shell member" by passing the member "through said through-hole" to "the bonding-interface side of said metal shell member with said fiber-reinforced-plastic shell member and the opposite side." … "Being a stitching member" cannot be regarded as the central, characteristic part of the technical concept underlying the means for solving the problem addressed by the Invention at Issue.

(2) IP High Court, 2010 (Ne) No. 10014, Round Cover for Underground Structures (Nakano, Shoji)

(d) Whether the first requirement for applying the doctrine of equivalents is satisfied

The effect that "when closing the cover, the cover body can be smoothly accommodated within the receiving frame merely by dragging it with a crowbar or pushing it from behind" (Effect (1) at Issue) … and the effect that "rattling of the cover body can be prevented, as can entry of earth, sand, rainwater, and the like into the underground structure" (Effect (2) at Issue) … The respective convex curved portions of the cover body and receiving frame play the most important role in achieving Effect (1). … The appellant's argument that "the receiving frame need only have a recess, and a concave curved portion is unnecessary" is found justified, and the receiving frame's "concave curved portion" is not an essential part of the Invention at Issue. … In the description of the Specification …, whether the recess of the receiving frame is a "curved portion" is not at issue for producing Effect (2). … Thus, for producing Effect (2) as well, the receiving frame's recess being a "curved portion" is not an essential part.

(e) Whether the second requirement for applying the doctrine of equivalents is satisfied

…Although the demonstration in court depends greatly on the demonstrator's skill in opening and closing, Defendant's Product B is also found to produce Effect (1) to a certain degree, and there is no substantial difference depending on whether the receiving frame has a "concave curved portion" or a "recess." …

(3) IP High Court, 2010 (Ne) 10089, Method and Apparatus for Encrusting and Forming Food (Takizawa)

(c) Requirement (1) for infringement under the doctrine of equivalents

…Invention 1 at Issue is characterized by using the already provided sealing shutter to adjust the position of the outer skin material—a step closely related to, and important for, the subsequent bowl-forming and sealing steps—and by achieving that important step with a simple configuration without providing separate means.

In Invention 1 at Issue, relative movement bringing the shutter pieces and support member closer to the nozzle member and dough-holding member is important, but which side is raised or lowered is not technically important. Accordingly, the difference that Invention 1 at Issue lowers the nozzle member and dough-holding member toward the shutter pieces and support member, whereas Defendant's Method 2 raises the shutter pieces and support member toward the nozzle member and dough-holding member, is not an essential part of Invention 1 at Issue.

(d) Requirement (2) for infringement under the doctrine of equivalents

Defendant's Method 2, which does not lower the pressing member but instead raises the shutter pieces and support member toward the nozzle member and dough-holding member, rather than lowering the nozzle member and dough-holding member toward the shutter pieces and support member, can still adjust the position of the outer skin material so that it fits in a predetermined position. It produces the same effects as

Invention 1 at Issue: correcting variations in shape and positional displacement of the outer skin material in advance to permit more reliable forming ([0008], [0013]); placing the outer skin material more stably and holding it securely ([0011]); and greatly simplifying the apparatus configuration ([0012]). …

(4) Tokyo District Court, 2011 (Wa) No. 8085, Level for a Washing Machine (Takano)

To solve a technical problem not achievable by the prior art—providing a washing-machine level requiring no separate mounting parts, capable of inexpensive and accurate installation even on an uneven contact surface, and offering good visibility—Invention 4 at Issue integrally forms the case and engagement portion and integrally provides an external case outside the case that projects below both the case and the lid. This is found to be the characteristic part underlying the means of solution distinctive to Invention 4 at Issue.

Accordingly, … the configuration "the inner bottom surface of the mounting portion" is not an essential part of Invention 4 at Issue. …

The defendants argue that Invention 4 at Issue solves the problem of improving installation-level accuracy by bringing the lower end surface of the external case into contact with the inner bottom surface of the mounting portion as a reference surface. They therefore assert that the configuration "the inner bottom surface of the mounting portion" also embodies the substantive value of Invention 4 at Issue and is an essential part. However, as stated above, the inner bottom surface of the mounting portion is a configuration that gave rise to the technical problem because its unevenness impaired installation accuracy, not a configuration that solved the problem.

(5) IP High Court, 2013 (Ne) No. 10017, Open-Type Fermentation Treatment Apparatus (Shimizu)

(1) Essential part (first requirement)

…To eliminate problems such as outward scattering and collapse of the deposited material during scooping, the front and rear pair of plate-shaped scooping members are each directed inward at a predetermined angle relative to the axial direction of the rotating shaft (toward the long wall of the open fermentation tank). The outside of the inwardly inclined member contacts the outer-edge deposit on the long open-face side of the material accumulated ahead of it and scoops it diagonally inward. Arranging the inclined plates inward at predetermined angles in this manner is the characteristic part underlying Corrected Invention 2 at Issue. …

Because the agitator of Corrected Invention 2 at Issue rotates forward or backward as it travels reciprocally, the scooping portion may contact the outer-edge deposit in either the forward or backward direction perpendicular to the rotating shaft. The material must be scooped in either case. For this purpose, scooping members are arranged front and rear and inclined relative to the front-rear direction, with the outer surface of the front inclined plate facing diagonally forward to one side and the outer surface of the rear inclined plate facing diagonally backward to that side. Thus, the configuration in which the scooping members are inclined in both front and rear directions is also a characteristic part underlying Corrected Invention 2 at Issue. …

By contrast, Corrected Specification 2 at Issue contains no explanation of the technical significance of using two plates for the scooping member. … What matters is that the outer surfaces of the inclined plates contact the outer-edge deposit during forward and reverse rotation respectively. There is therefore no particular technical significance in the scooping member of Invention 2 at Issue being composed of two plates. There is no technical difference between directly welding two members into a V shape, as described in Corrected Specification 2 at Issue, and bending a single member into a V shape, so this point is not an essential part. Moreover, … the front and rear inclination angles need only be 10°–80° relative to the central axis of rotating shaft 5a, including a reverse-chevron shape. The scooping member is not limited to a flat plate, but need only contact the outer-edge deposit and scoop it inward. In light of these matters, its being formed from flat plates is likewise not an essential part.

(6) Tokyo District Court, 2012 (Wa) No. 31523, Flow-Control Valve (Hasegawa)

…Whereas the Invention at Issue installs the flow-control disk inside the water-flow chamber through a bushing fitted inside the coupling fitting …, Defendant's Product 3 … adopts a configuration in which the disk is installed in the chamber by press-fitting it into a V-shaped taper formed in the coupling fitting without a bushing. … It therefore does not literally satisfy the limitation.

Even the detailed description in the specification contains no disclosure of its specific configuration or the effects of providing a bushing. Moreover, … in light of the invention's technical significance … of enabling a single flow-control disk to accommodate diverse flow control by installing it inside the water-flow chamber, the disk must be fixed within the chamber of the above shape so that it remains in place without falling from the lower end and without water leaking between the disk and the chamber. … Fixing the disk to the chamber can be done either by directly joining them or by indirectly joining them through another member. The Invention at Issue adopts the latter, but the technical significance of interposing a bushing is not described in the specification. Furthermore, when manufacturing products, reducing the number of parts to lower manufacturing costs or reduce steps and shorten production time is something a person skilled in the art should naturally consider. (★There are also many cases rejecting the third requirement where added features produce new effects.)

Thus, a person skilled in the art reading the claims and detailed description of the Invention at Issue would be expected to attempt a design modification omitting the bushing and joining the flow-control disk directly to the water-flow chamber. As shown in the embodiment, the chamber cross-section and the disk are circular, and water flows from the upper end toward the lower end. It would therefore have been readily conceivable to form the inside of the coupling fitting as a V-shaped taper narrowing toward the lower end and directly press-fit the disk-shaped flow-control member into its circumferential portion, thereby fixing the two so that the disk neither falls from the lower end nor permits water leakage between the disk and the chamber.

(7) Osaka District Court, 2014 (Wa) No. 5210, Facial Mask Sheet (Takamatsu)

(a) Non-essential part

…Conventional sheets also had no cuts over the upper part of the nose …, and the prior art already achieved coverage of the region near the inner corners of the eyes corresponding to the upper nose. By contrast, the technical problem addressed by the Patented Invention at Issue was to fit snugly even over the nasal wings of the nose, the most prominent part of the face, because conventional facial mask sheets left large uncovered gaps around the nasal wings and the corresponding sheet portions lifted away. The Patented Invention at Issue arranges perforation-like cut lines within a "substantially trapezoidal region." Together with the nonwoven material's tendency to stretch laterally, this allows the sheet naturally to stretch and spread laterally along the nasal bridge and the angle of the nose, fitting snugly over the nasal wings without gaps.

Accordingly, the distinctive effect of the Patented Invention at Issue lies in achieving coverage of the nasal wings, difficult in the prior art, by arranging multiple rows of perforation-like cut lines in the nose portion. Thus, the absence of cut lines in the Defendant's Product in the area from the height of the inner eye corners to slightly below them is not a difference belonging to the essential part underlying that distinctive effect. …

(b) Replaceability

…The Defendant's Product is found to fit closely over the entire nose, including the nasal wings, even without perforation-like cut lines in the area from the height of the inner eye corners to slightly below them. It therefore can achieve the purpose of the Patented Invention at Issue and produces the same effects.

(8) Intellectual Property High Court (Grand Panel), 2015 (Ne) 10014, Maxacalcitol

<Second requirement> Although the carbon skeleton corresponding to Z in the Corrected Invention, within starting material A and intermediate C of the Appellants' Method, is a trans-vitamin D structure, whereas the carbon skeleton of Z in the starting material … and intermediate … of the Corrected Invention is a cis-vitamin D structure, the starting materials and intermediates in both methods perform the same function and effect: producing maxacalcitol by reacting a 20-position alcohol compound with a vitamin D structure with the same epoxy hydrocarbon compound, thereby proceeding through an intermediate consisting of a vitamin D structure into which a side chain having an epoxy group has been introduced through an ether bond in a single step. Replacing the above starting material and intermediate having a cis-vitamin D structure in the Corrected Invention with those having a trans-vitamin D structure in the Appellants' Method is therefore found to achieve the same purpose and produce the same effects as the Corrected Invention.

The appellants argue that the only effect described in the corrected specification is a reduction in the number of steps; that the effect of the Corrected Invention is to shorten, relative to the prior art, the steps for introducing the side chain of maxacalcitol when starting from a cis compound; and that efficiency through step reduction should be determined by the total number of manufacturing steps, so methods with different total numbers of steps do not have the same effects. However, … for a patented invention whose specification has no "Effects of the Invention" description, it is inappropriate to infer a limited set of effects solely by comparison with part of the prior art. … The Corrected Invention also encompasses a step converting a steroid ring structure into a vitamin D structure and does not particularly recognize a difference (reduction) in the total number of steps, including the presence or absence of that conversion step, as its distinction from the prior art. Its effect therefore cannot be identified as reducing the total number of steps required to produce a target substance such as maxacalcitol relative to the prior art.

(9) Osaka District Court, 2014 (Wa) No. 4916, Forefoot Support Pad (Takamatsu)

(2) First requirement (non-essential nature of the differing part)

In light of the technical significance of the Device at Issue, its essential effects lie in fitting a forefoot support pad beneath the bases of the toes, raising the toe pads and bases of the second through fourth toes to form a transverse arch, maintaining the arch of the foot and thus the longitudinal arch, and supporting the body at three points: the toe pads and ball-contact portions of the big and little toes, and the heel. … Because the big and little toes contact the ground and support the body, fitting the pad between the upper edges of their ball-contact portions and the lower edges of their toe pads is not indispensable to achieving those effects. … Thus, the difference between constituent feature (4) of the Device at Issue and the Defendant's Product—whether the pad's horizontal portion reaches the area up to the lower edge of the little toe pad—is not a difference in the essential part underlying the effects of the Device at Issue. … Accordingly, … the difference concerning the horizontal portion extending to the lower edge of the little toe pad and the upper surface of that portion and the side surface of the third convex portion being gently curved to fit closely beneath the base of the little toe … must be regarded as outside the essential part underlying the distinctive effects of the Device at Issue.

⇒ This judgment too identifies, in assessing the first requirement, the portion underlying the device's distinctive effects as the essential part. Its relationship between the first and second requirements is consistent with the Maxacalcitol Grand Panel decision.

(10) Tokyo District Court, 2015 (Wa) No. 6812, Juice-Extracting Juicer (Hasegawa)

According to the Specification at Issue, the presence of the pressure-discharge passage is not directly related to the problem the invention seeks to solve. Nevertheless, … the passage is intended to prevent some juice produced as ingredients are finally compressed and dehydrated at the bottom of the mesh drum from flowing over the waterproof cylinder and outside the housing. There is therefore room to regard

forming a juice-discharge passage at the lower edge of the waterproof cylinder on the bottom surface of the housing as an essential part of the invention. However, achieving that effect only requires the passage to exist at the lower edge of the waterproof cylinder; the effect does not differ according to the members used to form it. It is therefore appropriate to construe the differing portion as not an essential part of the Invention at Issue.

⇒ As one reason for finding the first requirement satisfied, this judgment also notes that the "pressure-discharge passage," absent from the Defendant's Product, is not directly related to the problem addressed by the invention, consistent with the Maxacalcitol Grand Panel decision. Even if the features relating to the difference between the invention and the accused product are connected with the invention's effects, the judgment maintains its conclusion that they are not an essential part because the effects "do not differ according to the members used to form [the passage]."

(11) Tokyo District Court, 2013 (Wa) 7478, Method for Manufacturing Semiconductor Chips

<First requirement> …The Specification and Other Documents at Issue state that there is no particular restriction on the technique for forming the "second dividing groove," and that etching, dicing, scribing, and other techniques may be used. Scribing is merely described as particularly preferable for reasons such as permitting a narrow line width. … Thus, the method of forming the "second dividing groove" is not particularly limited.

Nor are there circumstances in this case suggesting that the problem described in the Specification and Other Documents at Issue as unresolved by the prior art is objectively insufficient in light of the prior art at the filing date. … It is appropriate to find that the characteristic part constituting the invention's distinctive technical concept, absent from the prior art, lies in the following: when cutting into chips a wafer having a gallium nitride compound semiconductor laminated on a sapphire substrate, a first dividing groove—that is, a linear portion facilitating cutting—is formed by etching on the semiconductor-layer side, a second dividing groove—that is, a linear portion facilitating cutting—is formed by some method on the sapphire-substrate side, the positions of the two are aligned, and the line width on the sapphire-substrate side is made narrow. Whether the second dividing groove on the sapphire-substrate side, namely the linear portion facilitating cutting, is a hollow groove, and which method is adopted to form that linear portion, do not constitute that characteristic part.

(12) Tokyo District Court, 2017 (Wa) No. 18184, Osteotomy Spreader (Sato) *First-instance judgment

<Second requirement> The defendant argues that the Invention at Issue's effects include automatic disengagement from the other swinging member as one swinging member is closed, and that the Defendant's Product does not produce the same effects because merely closing one swinging member does not automatically disengage it from the other. However, the effect stated in the Specification and Other Documents at Issue is that "the present invention facilitates insertion of an implant while maintaining the incision in an enlarged state" (paragraph [0012]). This effect can be achieved by removing one pair of swinging members after enlarging the incision with two pairs. Automatic disengagement is not included in the invention's effects. …

<Fifth requirement> The main point of the Written Opinion at Issue is to explain to the JPO examiner that Cited Reference 1 discloses a pair of swinging members, whereas the Invention at Issue combines two pairs of openable and closable swinging members and provides an engagement portion for engaging one swinging member with the other, enabling both to open simultaneously. The opinion contains no statement showing awareness of or suggesting whether the engagement portion is formed as part of the swinging member or by a separate member. Accordingly, … that statement cannot establish that, when constituent feature E was added by the Amendment at Issue filed together with the opinion, the plaintiff intentionally excluded from the claims a configuration in which the engagement portion is a member separate from the swinging member.

(13) Tokyo District Court, 2017 (Wa) No. 29228, Fluid Supply Apparatus and … Program (Shibata)

The Defendant's Fuel-Dispensing Apparatus adds an amount to the storage medium after fueling based on the difference between the selected and actual fuel quantities. In substance, this can be described as settling after fueling against the amount deducted before fueling. …

In Invention 1 at Issue, settlement after fluid supply is performed by subtracting the amount corresponding to the flow quantity from the amount of the pre-supply deposit data and adding the resulting difference to the monetary-amount data. In the Defendant's Fuel-Dispensing Apparatus, the difference between the selected and actual fuel quantities is measured and multiplied by the unit price of fuel to determine the refund. Each invention has calculation means and payment-settlement means for performing those operations. However, these are differences in how, upon completion of fluid supply, the difference between the initially deposited amount and the amount corresponding to the fuel actually supplied is calculated. In light of the foregoing, they cannot be regarded as the characteristic part constituting the distinctive technical concept of Invention 1 at Issue that is absent from the prior art.

(14) Tokyo District Court, 2017 (Wa) No. 32839, Beauty Device (Tanaka)

<First and second requirements> In light of the technical concept of the Invention at Issue, even where the shaft holes in the branched portions do not communicate with the recess in the handle body, configuring the handle from a handle body having a recess and a handle cover covering that recess still solves the technical problem arising from the deficiencies of the conventional configuration. Replacing this feature therefore cannot be said to create a different overall technical concept from the Invention at Issue. Moreover, even a noncommunicating configuration without "communicating shaft holes," as in the New Defendant's Product, produces the same effects as the Invention at Issue: maintaining high molding accuracy and strength of the handle while improving assembly workability of the beauty device. Thus, the differing part between the Invention at Issue and the New Defendant's Product is not an essential part of the invention (first requirement satisfied), and replacing the invention's configuration with that of the New Defendant's Product still achieves the invention's purpose and produces the same effects (second requirement satisfied). …

<Fourth requirement> Shine has a configuration entirely different from the New Defendant's Product. Compared with that product, it must be evaluated as based on a different technical concept with an entirely different problem-solving principle.

(15) Osaka District Court, 2019 (Wa) No. 3273, Learning Aid <Sugiura>

Considering the Exhibit Ko 11 Invention and the Exhibit Otsu 6 Invention in addition to the prior art described in the Specification at Issue, the following aspects of the Invention at Issue were also present in the prior art: a learning aid comprising a computer for memorizing an original image having a corresponding word or phrase by associating the image with that word or phrase; the computer includes a recording unit (image file FV) storing multiple sets of image data, each consisting of the original image (corresponding to complete character 22 of the Exhibit Otsu 6 Invention; hereafter in this paragraph, parentheses identify corresponding features of that invention) and a related image (part-related animation 24); means for selecting image data to display from the multiple sets stored in the recording unit (reading the English-word data for one section as one unit); image-display means (display 7) for sequentially displaying the original image and its related image using the selected data; a recording unit (audio file FA) storing audio data of words or phrases corresponding to the original image and related image (English-word audio data and associative-sentence audio data, respectively); means for selecting the audio data of those words or phrases from the recording unit (reading the English-word data for one section as one unit); and means for playing the selected audio data (speaker 6); and the image-display means displays the original image and related image in synchronization with playback of the corresponding words or phrases (synchronized output processing).

On the other hand, complete character 22 and part-related animation 24 in the Exhibit Otsu 6 Invention do not have a relationship that can be described as an original image; a first related image having an outline similar to, or suggestive of, the original image and a corresponding word or phrase; and a second related image having an outline similar to, or suggestive of, both the original image and the first related image and a corresponding word or phrase. Their playback order is also complete character 22 followed by part-related animation 24, not first related image, second related image, and original image. In the Exhibit Ko 11 Invention as well, although the kanji character, ancient character, and pictograph have mutually similar outlines, their display order is not prescribed, no words or phrases correspond to the ancient character and pictograph, and the recited mnemonic does not include words or phrases corresponding to them.

Accordingly, the following aspects of the Invention at Issue are not described in either Exhibit Ko 11 or Exhibit Otsu 6, let alone in the prior art described in the Specification at Issue: recording on an image-set recording medium, as one unit of an image set, a set consisting of an original image, a first related image having an outline similar to or suggestive of the original image and a corresponding word or phrase, and a second related image having an outline similar to or suggestive of the original image and the first related image and a corresponding word or phrase; displaying the images on the image-display means in the order of first related image, second related image, and original image; recording on an audio recording medium audio data consisting of the word or phrase corresponding to the first related image, the word or phrase corresponding to the second related image, and the word or phrase corresponding to the original image, playing it through audio-playback means, and displaying the first related image, second related image, and original image in synchronization with playback of their corresponding words or phrases.

Those points must therefore be regarded as the essential parts of the Invention at Issue.

Plaintiff (patentee): Ajinomoto Co., Inc.

Defendant (alleged infringer): CJ Japan Corp.

[Patent ★★★] (1) A case finding infringement under the doctrine of equivalents for a method excluded by an amendment responding to a lack-of-inventive-step rejection (consistent with the global tendency to apply the flexible bar flexibly). (2) An “offer for transfer” was established although the transferor and the person making the offer differed and the “transfer” occurred abroad. — NAKAMURA & PARTNERS (nakapat.gr.jp)

★ Decisions affirming and denying directors' liability under Article 429(1) of the Companies Act in intellectual property litigation

Original Ameblo publication: 2022-03-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12731806502.html

Osaka District Court, 2019 (Wa) 3277 [Ground Reinforcement Method] [Navigation Device]

* Liability of a (nominal) director under Article 429(1) of the Companies Act was affirmed.

“Even a nominal director owes a duty to monitor and supervise the representative director ...; therefore, there was neglect of duty, and at least gross negligence is established in that regard.”

=Osaka District Court, 2019 (Wa) 5444 [Carbon Dioxide-Containing Viscous Composition]

* The defendant went bankrupt after the Grand Panel judgment. The director's liability under Article 429(1) of the Companies Act was affirmed.

“... Even after receiving a warning of patent infringement, Defendant P3 relied principally on explanations from NeoChemir, the manufacturer of Defendant's Product 14, and, without taking any of the approaches examined in (1), items (i) through (iv), above, continued the tort of patent infringement by selling Defendant's Product 14 until the court disclosed its provisional assessment, thereby causing damage to the plaintiff. Accordingly, P3 breached the duty of care of a prudent manager as a director ....”

※Tokyo District Court, 2019 (Wa) 30282 (an Unfair Competition Prevention Act case) also affirmed the director's liability under Article 429(1) of the Companies Act.

※Tokyo District Court, 2016 (Wa) 2720 <Shimasue> “Foreign Matter Removal Machine for Raw Seaweed”

⇒ Joint tort liability of the defendant's wholly owning parent company and the defendant director's liability under Article 429(1) of the Companies Act were denied. “The fact that settlement negotiations were underway in the prior litigation concerning the old products ... cannot be regarded as a circumstance supporting bad faith or gross negligence.”

Companies Act, Article 429 - Wikibooks

European Patent Practice (1) <Procedure> (From the lecture transcript of German patent attorney Kan Hasegawa)

Original Ameblo publication: 2022-03-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12731995194.html

From the lecture transcript of German patent attorney Kan Hasegawa

European Patent Practice (1) <Procedure>

On entry into the European phase,

• Not amending the description.

⇒ Fees are calculated based on the number of English-language pages and become higher.

• Not amending the claims with patentability in mind.

⇒ The results of the international search are not referred to very much.

• Prove the assignment of the priority right.

• File divisional applications early.

⇒ Maintenance annuities are calculated from the filing date of the parent application.

Profile | Random Notes on European Intellectual Property Practice (hasegawa-ip.com)

European Patent Practice (2) <Claim Drafting> (From the lecture transcript of German patent attorney Kan Hasegawa)

Original Ameblo publication: 2022-03-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12732158270.html

From the lecture transcript of German patent attorney Kan Hasegawa

European Patent Practice (2) <Claim Drafting>

(1) Prepare numerous dependent claims.

⇒ This can prevent the inefficiency of repeated rejections following amendments and new references.

(2) Multiple-multiple dependent claims

⇒ Europe is strict about added matter.

⇒ Even claim 2 + claim 3 may be found to constitute added matter.

⇒ Even for Japanese applications filed from April onward, including multiple-multiple-claim-like language in the description can reduce concerns about added matter in Europe.

(3) As a rule, only one independent claim per category is permitted. (The exceptions also merit study!!)

⇒ Possible drafting approaches: A + (b1 or b2), A + B

(4) Avoid references to external tangible objects.

⇒ References to external tangible objects tend to be disregarded.

[Takaishi] In Japan, I would think that these become features defining the invention in a subcombination claim. A difference in practice.

(5) Do not write effects into the claims.

⇒ An effect incorporated into a claim is unlikely to become a feature defining the invention and instead raises concerns about an irremediable failure to meet the enablement requirement.

[Takaishi] In Japan, effects incorporated into claims often become features defining the invention, so practice differs.

(6) Keep the features in an independent claim to a minimum.

⇒ They are difficult to delete later.

⇒ Features unrelated to the problem of the invention can sometimes be removed, but the approach is stricter than in Japan.

(7) Do not state numerical ranges as separate upper and lower limits. (For future amendments)

“5–20 wt%, preferably 10–15 wt%”

permits amendment to either

“10–20 wt%” or

“5–15 wt%.”

but

“The lower limit is 5 wt%, preferably 10 wt%. The upper limit is 20 wt%, preferably 15 wt%”

does not permit those amendments.

Profile | Random Notes on European Intellectual Property Practice (hasegawa-ip.com)

"Amendment to narrow scope of claim in process of prosecution and application of doctrine of equivalents (international trend in court cases and overview of Japanese court cases)"

Original Ameblo publication: 2022-03-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12732428611.html

"Amendment to narrow scope of claim in process of prosecution and application of doctrine of equivalents (international trend in court cases and overview of Japanese court cases)"

My article above has been posted in the “Court Decisions” section of the JPAA website.

Amendment-to-narrow-scope-of-claim-in-process-of-prosecution-and-application-of-doctrine-of-equivalents.pdf (jpaa.or.jp)

European Patent Practice (3) <Amendments> (From the lecture transcript of German patent attorney Kan Hasegawa)

Original Ameblo publication: 2022-03-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12732514394.html

From the lecture transcript of German patent attorney Kan Hasegawa

European Patent Practice (3) <Amendments>

Conditions under which “intermediate generalization” (= an amendment abstracting an embodiment and adding it to a claim) is permitted

- The feature is not related to the other features of the embodiment.

- The overall disclosure justifies the generalized isolation of the feature and its introduction into the claim.

[Takaishi] In Japan, too, for “intermediate generalization” (= an amendment abstracting an embodiment and adding it to a claim), the tendency is that portions unrelated to the problem of the invention may be left out, but portions related to that problem may not.

[Patents] Added Matter and the Problem of the Invention at Issue (Expansion Strategies When Filing Divisional Applications) - YouTube

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In Europe, amendments based solely on drawings are treated strictly.

[Takaishi] In Japan, too, for amendments based solely on drawings, both the question of whether the feature can be discerned at all and the limits of abstraction (generalization to a broader concept) are fairly strict. (This parallels identification of a cited invention from drawings.)

[Patents / Inventive Step / Novelty] <Identification of a Cited Invention> Can a Cited Invention Be Read from the Drawings in a Publication? (Shape, Relative Size, Positional Relationships, Dimensions, Arrangement, Direction, Presence) - YouTube

I successfully passed the 160th Unified Grade 2 Bookkeeping Examination (paper-based, February 27, 2022). (78 points)

Original Ameblo publication: 2022-03-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12732541808.html

I successfully passed the 160th Unified Grade 2 Bookkeeping Examination (paper-based, February 27, 2022). (78 points)

A perfect score in industrial bookkeeping.

In commercial bookkeeping,

I got partial credit on Questions 2 and 3 as intended.

I thought I had a perfect score on Question 1, but ...

⇒ I will compare my answers when the answers are released.

I studied using Masayuki Fukushima's YouTube videos and repeatedly worked through practice problems.

Masayuki Fukushima's YouTube videos go beyond the level needed to pass, but when you consider why you are taking the examination, I do not think it is right to discard everything unnecessary for passing.

To be honest, I passed Grade 3 using technique alone, so this time I reflected on that and went back to watch the Grade 3 YouTube videos.

As I also wrote on the day, the actual examination is far easier than TAC's predicted questions, and time is not tight.

In fact, I also tried taking the computer-based examination on March 5 (and passed that one too). Again, it was far easier than TAC's predicted questions, and time was not tight.

Everyone,

please do not be discouraged if TAC's predicted questions defeat you!!

Some examinees may have lost heart because the predicted questions are too difficult. But the actual examination is not that difficult, so please keep trying without giving up!!

(I suspect that although the time was shortened from 120 minutes to 90 minutes, the level of the predicted questions was not lowered. And because past papers after the time reduction have not been released, the available information seems likely to be skewed. However, the pass rate for the most recent unified examination has not fallen, so it would not make sense unless the questions had become easier—and that was indeed the case.)

And if you study until you pass, you will pass, so keep at it!!

Next, Grade 1 bookkeeping ... is not what I will be doing.

Next, I will work toward making a film.

[Bookkeeping YouTuber?] Masayuki Fukushima - YouTube

https://www.youtube.com/channel/UCGDec349YIziUytZzc3d7Yg

European Patent Practice (4) <Pitfalls in Novelty> (From the lecture transcript of German patent attorney Kan Hasegawa)

Original Ameblo publication: 2022-03-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733229989.html

From the lecture transcript of German patent attorney Kan Hasegawa

European Patent Practice (4) <Pitfalls in Novelty>

(1) Few exceptions to loss of novelty

⇒ There is no equivalent of Article 30(2) of the Japanese Patent Act!!

(2) Intended use

⇒ In principle, it does not limit the claim!

[Takaishi] Practice differs greatly from Japan.

Enforcement of “Use Inventions” (Direct and Indirect Infringement) (jpaa.or.jp)

(3) Selection inventions ★

⇒ Novelty is not recognized unless the selection is from two or more lists!!!!

[Takaishi] Practice differs greatly from Japan. In South Korea, too, a recent Supreme Court judgment took the same approach as Japan.

Supreme Court Judgment Holding That Inventive Step Is Not Denied Even for a Selection Invention If Difficulty in Arriving at Its Configuration Is Established | Case Law Database - Intellectual Property Information - South Korea - Asia - By Country/Region - JETRO (jetro.go.jp)

(Note) The EPO Guidelines for Examination (2023 edition, G-VI, 8; G-VI, 7 from the 2024 edition onward) state that a selection from a single list of specifically disclosed elements does not confer novelty, and that, where a selection from two or more lists of a certain length has to be made, the resulting combination not specifically disclosed in the prior art confers novelty. Novelty of a sub-range selected from a numerical range is assessed under separate criteria.

(4) Self-collision

⇒ There is no equivalent of Article 29-2 of the Japanese Patent Act!

(Note) Article 54(3) EPC includes in the state of the art, for the assessment of novelty, the content of European patent applications filed earlier and published later. However, there is no provision corresponding to the proviso to Article 29-2 of the Japanese Patent Act (the exception where the applicant is the same). An applicant’s own earlier application may therefore destroy the novelty of its own later application (self-collision).

<Narrowing Amendments During Prosecution and the Doctrine of Equivalents>

Original Ameblo publication: 2022-03-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733231414.html

<Narrowing Amendments During Prosecution and the Doctrine of Equivalents>

On the basis of the flexible bar, the tendency to recognize infringement under the doctrine of equivalents for limitations added by an amendment responding to a notice of reasons for rejection is a worldwide trend!

⇒ Pro-patent

Two Japanese decisions

UK Supreme Court, German Federal Court of Justice, and US CAFC “Eli Lilly cases”

[Patents ★] <Narrowing Amendments During Prosecution and the Doctrine of Equivalents (Worldwide Trends in Case Law and Introduction to Japanese Decisions)> - NAKAMURA & PARTNERS (nakapat.gr.jp)

IP High Court, 2019 (Gyo-Ke) 10046 <Otaka> [Circuit Breaker Mounting Structure] (1) Inventive step: yes; (2) Divisional application requirements: satisfied

Original Ameblo publication: 2022-03-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733232469.html

IP High Court, 2019 (Gyo-Ke) 10046 <Otaka> [Circuit Breaker Mounting Structure] (1) Inventive step: yes; (2) Divisional application requirements: satisfied

(1) The small size of the components was a reason for finding non-obviousness!!

“... It is difficult to consider that it would have been easy to conceive of additionally providing operating handles, projections, etc. on small components such as leaf springs and branch switches, in a structure that maintains their precision.”

(2) The matter in the divisional application is not directly related to the problem of the invention.

⇒ A divisional application generalizing the express disclosure in the parent application's original description, etc. to a broader concept is OK.

“Which part is the claw or the recess, and the specific manner of fitting ... are not directly related to solving the problem.”

IP High Court, 2020 (Gyo-Ke) 10103 [Multicolor Penlight] <Shoji>

Original Ameblo publication: 2022-03-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733403586.html

IP High Court, 2020 (Gyo-Ke) 10103 [Multicolor Penlight] <Shoji>

* The trial decision incorrectly identified the problem inherent in the primary reference.

* “Color rendering” in the primary reference and “color rendering” in the secondary reference have different meanings.

⇒ They do not provide a basis for motivation to combine.

“The ‘color rendering’ ... identified by the trial decision in relation to the problem of the Exhibit Ko 1 invention differs from the ‘color rendering’ identified as a technical matter disclosed in Exhibit Ko 2, namely ‘color rendering’ in the ordinary sense of whether the color of an illuminated object is close to its color when viewed in natural light.”

(Excerpts from the judgment)

... Exhibit Ko 1 cannot be found to disclose a problem inherent in the yellow color emission itself described as ‘yellow.’ ...

Since the Exhibit Ko 1 invention and the technical matter disclosed in Exhibit Ko 2 cannot be said to belong to exactly the same technical field, but only to closely related fields, to say that it would have been easy to arrive at Invention 1 at Issue by adopting the technical matter of Exhibit Ko 2 in the Exhibit Ko 1 invention requires corresponding motivation to adopt that technical matter ....

As a premise for finding motivation to adopt the technical matter disclosed in Exhibit Ko 2 in the Exhibit Ko 1 invention, and for finding that Invention 1 at Issue could readily have been conceived by doing so, the trial decision found that the Exhibit Ko 1 invention had a problem inherent in the yellow color emission itself described as “yellow” ... and that the Exhibit Ko 1 invention had the problem of improving color rendering in common with Exhibit Ko 2 .... However, ... the trial decision's finding that the Exhibit Ko 1 invention has a problem inherent in the yellow color emission itself described as “yellow” is incorrect; furthermore, the “color rendering” ... identified by the trial decision in relation to the problem of the Exhibit Ko 1 invention differs from the “color rendering” identified as a technical matter disclosed in Exhibit Ko 2, namely “color rendering” in the ordinary sense of whether the color of an illuminated object is close to its color when viewed in natural light .... Thus, the trial decision incorrectly identified the problem of the Exhibit Ko 1 invention that would provide a basis for motivation to adopt the technical matter disclosed in Exhibit Ko 2 in that invention, ... and such motivation cannot be found.

Tokyo District Court, 2018 (Wa) 36690 [Portable Information Communication Device] <Kokubu>

Original Ameblo publication: 2022-03-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733575323.html

Tokyo District Court, 2018 (Wa) 36690 [Portable Information Communication Device] <Kokubu>

NPE wins—royalty rate of 0.01%

Although not an SEP (standard-essential patent), the court considered “the defendant's” actual circumstances of licensing on a patent-family basis.

(The plaintiff had no licensing track record.)

Following Apple/Samsung, IP High Court, 2013 (Ne) 10043, the special characteristics of smartphones were taken into account.

(Excerpts from the judgment)

... Although the “Research Report on the Utilization of Patents, etc. Based on Intellectual Property Valuation—Survey of Intellectual Property (Asset) Values and Royalty Rates—Main Report, March 2010” prepared by Teikoku Databank, Ltd. (... “the Report”) ... and the aforementioned “Royalty Rates [5th Edition]” contain average royalty rates, etc. for electrical and other fields, the Report states that, in actual license negotiations in the electronics industry, the enormous number of patents related to a single device gives royalty-rate arrangements distinctive characteristics; the royalty rates exemplified there are far below the above averages. These circumstances are considered also to apply to the defendant's products, which are mobile phones (smartphones). It is therefore inappropriate to adopt the above average figures, etc. as prevailing industry royalty rates for the defendant's products. ...

The aforementioned statement by the defendant's employee explains that, under license agreements relating to the defendant's products other than those for standard-essential patents, the royalty rate per patent on a patent-family basis was ...%; of these, the agreement with Company C, which used a running-royalty arrangement, had an average royalty rate of approximately ...%; and, around 2010, in connection with sales of the defendant's products, the defendant paid total license fees of ... US dollars per unit, including patent license fees for standards relating to image processing and external output (... sales revenue per unit of the defendant's products was approximately ●(omitted)● yen). ...

Taking into overall account the circumstances that (ii) the invention at issue is not shown to be irreplaceable for the defendant's products; (iii) the extent of the defendant's benefit from practicing it is also unclear; ... and (iv) the plaintiff and defendant are not competitors, and although the plaintiff does not practice patented inventions itself and has a business policy of earning royalties by licensing them to other companies, it has never concluded a license agreement for any patented invention it holds, it is appropriate to find that the royalty rate receivable for manufacture and sale of the defendant's products in respect of the invention at issue is 0.01%.

Restrictions on “Multiple-Multiple Dependent Claims”—Revised Examination Guidelines, explanatory materials, videos, and public-comment results have been released.

Original Ameblo publication: 2022-03-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733615939.html

Restrictions on “Multiple-Multiple Dependent Claims”

The Japan Patent Office has released revised Examination Guidelines, explanatory materials, videos, and public-comment results.

Even “or” can create a multiple-multiple dependent claim.

⇒ Measures such as including claim-like language are needed to avoid added matter in Europe, where multiple-multiple dependent claims are not prohibited.

Restrictions on Multiple-Multiple Dependent Claims | Japan Patent Office, Ministry of Economy, Trade and Industry (jpo.go.jp)

IP High Court, 2019 (Ne) 10057 [Mixed Solution for Extracting Protein] <Otaka> = 2017 (Wa) 41474 <Tanaka>

Original Ameblo publication: 2022-03-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12733742753.html

IP High Court, 2019 (Ne) 10057 [Mixed Solution for Extracting Protein] <Otaka>

* “Extraction” was construed to mean separation into two layers.

⇒ Claim not satisfied

(Excerpts from the judgment)

Paragraph [0026] of the description at issue states: “If the ratio of protein to aqueous solvent in the protein-containing layer is higher than the ratio of protein to aqueous solvent in the liquid to be extracted, it can be said that protein has been extracted from the liquid to be extracted.” However, this merely states that extraction of protein from the liquid can be considered to have occurred where the ratio of protein to aqueous solvent in the protein-containing layer is higher than that in the liquid to be extracted. It cannot be understood as stating that “extraction” in “extracting protein” in Element B is limited to such cases. ...

The claims of the invention at issue contain no provision defining the meaning or method of “extraction” in “extracting protein.” ...

... Taken as a whole, the description at issue indicates that “extraction” in “extracting protein” in Element B means separating the liquid to be extracted, which contains protein, an aqueous solvent, etc., into at least two layers, so that a protein-containing layer is formed. ...

It cannot be found that the “extraction material” to which the defendant's product was added was separated into two layers by that product, with a protein-containing layer formed below. Nor can the defendant's product be found to have a configuration capable of ... “extracting protein.”

= [First instance] Tokyo District Court, 2017 (Wa) 41474 [Mixed Solution for Extracting Protein] <Tanaka>

(Excerpts from the judgment)

In a mixed solution “for extracting protein,” the amount of surfactant contained is construed ... as being limited to a level that does not require a step of removing the surfactant from the separated or otherwise treated target substance.

⇒ Claim not satisfied

IP High Court, 2020 (Ne) 10045 [Dot Pattern] <Kanno> Support requirement: not satisfied; amendment requirements: not satisfied (added matter)

Original Ameblo publication: 2022-03-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12734296412.html

IP High Court, 2020 (Ne) 10045 [Dot Pattern] <Kanno> **Support requirement: not satisfied; amendment requirements: not satisfied (added matter)**

* Mere consistency of the disclosure in the description with the claimed invention (i.e., that the two can be construed without contradiction) is insufficient as a disclosure ...

⇒ The description must be worded so that it should be understood as adopting that configuration!!

⇒ Support requirement: not satisfied (Claim 3)

* An amendment claiming a combination of two incompatible embodiments was found to constitute added matter. (Claim 1)

= IP High Court, 2013 (Gyo-Ke) 10346 [Method of Manufacturing a Crystal Oscillator] <Ishii>

= IP High Court, 2016 (Gyo-Ke) 10257 [Portable Information Communication Device] <Mori>

(Excerpts from the judgment)

<Portion concerning failure to meet the support requirement>

... Admittedly, it is clear that the orientation of a dot pattern can be recognized by providing dots or dot groups indicating its direction and arranging them without rotational symmetry; also, the “x, y coordinate flags” or “general code flags” shown in Figures 5 through 8 can be said to be arranged in positions without rotational symmetry, so it is possible for them to serve also as dots indicating the dot pattern's orientation. However, Description 3 at Issue is not worded so that it should be understood as adopting such a configuration, and cannot be said to disclose in the first place which selection of “ways of shifting from the original position” was used to configure Invention 3 at Issue ....

<Portion concerning added matter>

According to the appellant's argument, portion (i) of Amendment 1 at Issue is based on the dot pattern in Figure 105, while portion (ii) corresponds to the dot pattern in Figure 5; thus, Amendment 1 at Issue combines these two patterns. ... The two dot patterns employ incompatible methods of defining information, and combining them amounts to nothing less than creating an entirely new method of defining information.

Tokyo District Court, 2018 (Wa) 1233 [Support Structure for Concrete Foundations] <Kokubu> * Damages

Original Ameblo publication: 2022-03-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12734466536.html

Tokyo District Court, 2018 (Wa) 1233 [Support Structure for Concrete Foundations] <Kokubu> * Damages

Taisei Corporation v. Obayashi Corporation (patent infringement established)

Construction sites with negative marginal profit ⇒ Marginal profit calculated as zero

The effects of the invention had a somewhat limited influence on customer appeal.

⇒ Partial rebuttal of the presumption of damages under Article 102(2)

Damages were determined as the sum of the higher of the amounts under paragraphs (2) and (3) for each construction site where the invention was practiced.

(Excerpts from the judgment)

For Defendant's Structure 6, the marginal profit of the structure as a whole was negative, and the amount equivalent to revenue from completed construction under the above calculation would be below the cost of completed construction. However, the court determined that this did not immediately make those figures abnormal, and then set the marginal profit attributable to cast-in-place concrete piles at zero. ...

For the cast-in-place concrete piles involved in the practice at issue, the effects of the invention on customer appeal must be regarded as somewhat limited. This should be considered a circumstance warranting partial rebuttal of the presumption of damages under Article 102(2). ...

For each structure involved in the practice at issue, ... the greater of the damages calculated under Article 102(2) and (3) of the Patent Act is recognized as the plaintiff's damages.

IP High Court, 2020 (Gyo-Ke) 10016 [Barbed Suture Having ... Concave-Convex Barbs] <Kanno>

Original Ameblo publication: 2022-03-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12734640608.html

IP High Court, 2020 (Gyo-Ke) 10016 [Barbed Suture Having ... Concave-Convex Barbs] <Kanno>

<Addition and Substitution>

* The transition point in the cited invention is unclear ⇒ The transition point is a matter of design choice!!

“The configuration in the cited reference is unclear ⇒ A matter of design choice

The configuration in the cited reference is definite ⇒ Motivation to change it is required.”

Since that is the direction of the approach,

“The patentee should argue that the configuration in the cited reference is definite,

while the invalidation-trial requester will want to argue that it is unclear.”

“In the cited invention ... there is a transition region in which the direction of curvature changes. As a shape transitioning from a concave to a convex surface, transition through a region or transition at a point is one of the alternatives that a person skilled in the art may adopt.”

(Excerpts from the judgment)

In the cited invention, it is unclear at first glance whether a transition point is provided, and whether the concave portion extends between the connecting portion and a transition point and the convex portion between that transition point and the tip. At least, however, there is a transition region where the direction of curvature changes in the region transitioning from the concave to the convex portion. Since transition through a region or transition at a point can be understood as one of the alternatives available to a person skilled in the art for a shape transitioning from a concave to a convex surface, it would have been easy for such a person to replace the shape transitioning from the concave to the convex portion through the transition region of the cited invention's outer edge with a shape transitioning at a point, thereby arriving at the configuration of the amended invention relating to Difference 1.

[Patents] “Addition” and “Substitution” in Inventive-Step Assessment (Obviousness) - YouTube

<Article> “Overview of Actions to Revoke JPO Trial Decisions in 2020”

Original Ameblo publication: 2022-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735231953.html

<Article> “Overview of Actions to Revoke JPO Trial Decisions in 2020”

A compact compilation of recent important intellectual property judgments

<Example included>

IP High Court, 2019 (Gyo-Ke) 10174 [Aerosol Generation Device]

The claim language was narrowly construed in light of the problem.

⇒ Support requirement: satisfied

The claim is limited to configurations capable of solving the problem and therefore meets the support requirement.

(Excerpts from the judgment)

The support requirement is assessed by comparing the claims with the detailed description of the invention. As a premise for that comparison, however, when identifying the invention from the claims, if it is necessary to clarify the meaning or technical significance of features defining the invention stated in the claims, consideration of the description and drawings as necessary should not be precluded; the Lipase judgment cited by the parties cannot be construed as prohibiting this. In this case, in light of the description at issue, Claims 1 and 15 can be understood as found in (1) above. Comparing the claims and detailed description on that basis, the claimed invention is an invention disclosed in the detailed description and falls within the scope in which a person skilled in the art can recognize, from that disclosure, that the invention's problem can be solved.

(b) The plaintiff argues that allowing a narrow construction of the claims based on the detailed description when assessing support would mean that, however broadly worded the claims, they would never fail the support requirement, defeating its purpose, and would also allow infringement to be asserted on the basis of broad claims, creating an improper double benefit. However, even where the detailed description is considered in assessing support, a violation of the support requirement can still arise if the content of the invention recognized from the claims with reference to the detailed description is not supported by that description (for example, where the invention recognized from the claim language with reference to the detailed description includes both A and B, but only B appears in the examples, etc., A may be found unsupported). Thus, failure to meet the support requirement is not invariably avoided. Further, because the description and drawings are to be taken into account when determining the technical scope of a patented invention (Patent Act, Article 70(2)), the double benefit alleged by the plaintiff cannot be said to arise.

Overview of Actions to Revoke JPO Trial Decisions in 2020 (jpaa.or.jp)

South Korean Supreme Court Judgment of April 8, 2021, 2019 Hu 10609

Original Ameblo publication: 2022-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735232618.html

South Korean Supreme Court judgment

Delivered April 8, 2021, 2019 Hu 10609

Even when assessing inventive step for a “selection invention,” difficulty in arriving at its configuration is considered, as for ordinary inventions.

= The approach is now the same as Japanese case law!!

* The court below (High Court), like the Japanese Examination Guidelines, had held a “selection invention” unpatentable without a qualitatively different or remarkable effect.

https://system.jpaa.or.jp/patent/viewPdf/3920

<Article> “All Issues in Inventive Step” (Hideki Takaishi, January 2022)

Original Ameblo publication: 2022-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735233618.html

<Article> “All Issues in Inventive Step” (Hideki Takaishi, January 2022)

Recent hot topics are:

(1–1) ★ Inherent properties

(1–6) Publicly worked inventions

(2–4) ★★★ Incorporating effects into claims

(3–2) Differences between the problems of the invention at issue and the cited invention

(3–7) ★ Numerically limited inventions / parameter inventions

(3–9) ★★★ Disclaimer claims

⇒ Many patents have recently been granted with disclaimer claims: more than 1,000 in 2021 alone. There is room to incorporate them into patent filing strategies.

(Takaishi stepped down under the 6–8 rule, but the Japan Patent Attorneys Association's Patent Committee plans to study this in fiscal 2022.)

Comprehensive Coverage of All Issues in Inventive Step (jpaa.or.jp)

<Article> “Service of Process in US Civil Litigation and Responses by Japanese Companies” (Kazuma Segawa, Attorney Admitted in the District of Columbia)

Original Ameblo publication: 2022-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735377286.html

<Article> “Service of Process in US Civil Litigation and Responses by Japanese Companies” (Kazuma Segawa, Attorney Admitted in the District of Columbia)

2017 US Supreme Court: Water Splash

= Service by mail is permissible if the receiving state has not objected and otherwise-applicable law authorizes it.

⇒ In 2018, the Japanese government declared its objection to Article 10(a) of the Hague Convention.

⇒ Direct service by mail into Japan is not permitted.

(Service by email may be possible. Is a Japanese translation unnecessary?)

https://system.jpaa.or.jp/patent/viewPdf/3922

[Skit (Sword of Intellectual Property)] Incorporating Effects into Claims

Original Ameblo publication: 2022-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735378939.html

[Skit (Sword of Intellectual Property)] Incorporating Effects into Claims

In Japan, an effect incorporated into a claim becomes a feature defining the invention unless it necessarily results from the configuration.

⇒ It contributes to inventive step.

Because the claim is construed so as to produce the effect, the scope of rights (technical scope of the invention) is not narrowed.

Since products that do not produce the effect are outside the scope of rights (gist of the invention), the support requirement is also easier to satisfy.

(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

[Skit (Sword of Intellectual Property)] Incorporating Effects into Claims (Film Shooting on April 16 and 17, 2022) - YouTube

[Skit (Sword of Intellectual Property)] Broadening Further with a Divisional Application

Original Ameblo publication: 2022-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735379146.html

[Skit (Sword of Intellectual Property)] Broadening Further with a Divisional Application

After a decision to grant a patent, you can file a divisional application seeking an even broader patent.

(In the skit I say that the patent has been obtained, but I mean that a decision to grant has been obtained.)

⇒ At that point, portions unrelated to the problem of the invention can be left out when abstracting the specific disclosure of the embodiments, etc.

(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

[Skit (Sword of Intellectual Property)] Broadening Further with a Divisional Application (Film Shooting on April 16 and 17, 2022) - YouTube

[Skit (Sword of Intellectual Property)] Put Various Things in the Original Description

Original Ameblo publication: 2022-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735379875.html

[Skit (Sword of Intellectual Property)] Put Various Things in the Original Description

By including “material” for division, amendment, and correction in the original description, you can develop the claims while looking at competitors' products even after filing the patent application.

⇒ One possible patent filing strategy is therefore to disclose a great deal in the original description.

* However, the fifth requirement of the doctrine of equivalents may not be met where the applicant objectively manifested a deliberate decision to omit a disclosed alternative from the claims (Maxacalcitol, Supreme Court of Japan). Merely declining to file repeated divisional applications does not automatically defeat that requirement.

(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

[Skit (Sword of Intellectual Property)] Put Various Things in the Original Description (Film Shooting on April 16 and 17, 2022) - YouTube

[Skit (Sword of Intellectual Property)] Craft the Original Description Based on Case Law

Original Ameblo publication: 2022-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735380174.html

[Skit (Sword of Intellectual Property)] Craft the Original Description Based on Case Law

To embed “material” for division, amendment, and correction in the original description, understand the types of claims recognized in case law and anticipate future claims.

For example: parameters and numerical limitations, disclaimer claims, incorporation of effects and problems into claims, functional claims, uses, and subcombination claims.

(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

[Skit (Sword of Intellectual Property)] Craft the Original Description Based on Case Law (Film Shooting on April 16 and 17, 2022) - YouTube

<Article> “Protection of ‘Data (Structures)’ under Patent Law” (Tsutomu Shimohagiwara)

Original Ameblo publication: 2022-04-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735572831.html

<Article> “Protection of ‘Data (Structures)’ under Patent Law” (Tsutomu Shimohagiwara)

Eligibility as an invention—products include “computer programs, ‘etc.’”

Examination Guidelines—“data structures (the logical structure possessed by data, expressed by interrelationships among data elements)” may qualify as “computer programs, ‘etc.’”

⇒ This article examines specific cases and is useful in practice.

https://www.jstage.jst.go.jp/article/patentsp/74/26/74_121/_pdf/-char/ja

<Article> “Construction of Method Patent Claims in China—Focusing on Chinese Supreme Court Judgments”

Original Ameblo publication: 2022-04-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735724499.html

<Article> “Construction of Method Patent Claims in China—Focusing on Chinese Supreme Court Judgments” (Jun Lin, Chinese Patent Attorney and Attorney-at-Law; Chunfeng Hu, Chinese Patent Attorney)

(1) Dedication principle

A sequence disclosed only in the description, not in the claims

⇒ Outside the scope of protection

(Hot-Water Bottle Manufacturing Method case)

(2) Principle of limitation by sequence

Even if not stated in the claims, the claim is bound by a sequence directly and clearly understood from the description.

(Elastic Hinge Manufacturing Method case)

* The approach to interpreting method inventions appears close to Japan's. This explanation based on Chinese Supreme Court judgments is useful in practice.

Construction of Method Patent Claims in China—Focusing on Chinese Supreme Court Judgments (jpaa.or.jp)

European Patent Practice (1)(2)(3)(4) <ALL> (From the lecture transcript of German patent attorney Kan Hasegawa)

Original Ameblo publication: 2022-04-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735726237.html

From the lecture transcript of German patent attorney Kan Hasegawa—European Patent Practice (1)(2)(3)(4) <ALL>

European Patent Practice (1) <Procedure>

On entry into the European phase,

• Not amending the description.

⇒ Fees are calculated based on the number of English-language pages and become higher.

• Not amending the claims with patentability in mind.

⇒ The results of the international search are not referred to very much.

• Prove the assignment of the priority right.

• File divisional applications early.

⇒ Maintenance annuities are calculated from the filing date of the parent application.

European Patent Practice (2) <Claim Drafting>

(1) Prepare numerous dependent claims.

⇒ This can prevent the inefficiency of repeated rejections following amendments and new references.

(2) Multiple-multiple dependent claims

⇒ Europe is strict about added matter.

⇒ Even claim 2 + claim 3 may be found to constitute added matter.

⇒ Even for Japanese applications filed from April onward, including multiple-multiple-claim-like language in the description can reduce concerns about added matter in Europe.

(3) As a rule, only one independent claim per category is permitted. (The exceptions also merit study!!)

⇒ Possible drafting approaches: A + (b1 or b2), A + B

(4) Avoid references to external tangible objects.

⇒ References to external tangible objects tend to be disregarded.

([Takaishi] In Japan, I would think that these become features defining the invention in a subcombination claim. A difference in practice.)

(5) Do not write effects into the claims.

⇒ An effect incorporated into a claim is unlikely to become a feature defining the invention and instead raises concerns about an irremediable failure to meet the enablement requirement.

([Takaishi] In Japan, effects incorporated into claims often become features defining the invention, so practice differs.)

(6) Keep the features in an independent claim to a minimum.

⇒ They are difficult to delete later.

⇒ Features unrelated to the problem of the invention can sometimes be removed, but the approach is stricter than in Japan.

(7) Do not state numerical ranges as separate upper and lower limits (for future amendments).

“5–20 wt%, preferably 10–15 wt%”

permits amendment to either

“10–20 wt%” or

“5–15 wt%.”

but

“The lower limit is 5 wt%, preferably 10 wt%. The upper limit is 20 wt%, preferably 15 wt%”

does not permit those amendments.

European Patent Practice (3) <Amendments>

Conditions under which “intermediate generalization” (= an amendment abstracting an embodiment and adding it to a claim) is permitted

- The feature is not related to the other features of the embodiment.

- The overall disclosure justifies the generalized isolation of the feature and its introduction into the claim.

([Takaishi] In Japan, too, for “intermediate generalization” (= an amendment abstracting an embodiment and adding it to a claim), the tendency is that portions unrelated to the problem of the invention may be left out, but portions related to that problem may not.)

In Europe, amendments based solely on drawings are treated strictly.

([Takaishi] In Japan, too, for amendments based solely on drawings, both the question of whether the feature can be discerned at all and the limits of abstraction (generalization to a broader concept) are fairly strict. (This parallels identification of a cited invention from drawings.))

European Patent Practice (4) <Pitfalls in Novelty>

(1) Few exceptions to loss of novelty ⇒ There is no equivalent of Article 30(2) of the Japanese Patent Act!!

(2) Intended use ⇒ In principle, it does not limit the claim!

([Takaishi] Practice differs greatly from Japan.)

(3) ★ Selection inventions ⇒ Novelty is not recognized unless the selection is from two or more lists!!!!

([Takaishi] Practice differs greatly from Japan. In South Korea, too, a recent Supreme Court judgment took the same approach as Japan.)

(Note) The EPO Guidelines for Examination (2023 edition, G-VI, 8; G-VI, 7 from the 2024 edition onward) state that a selection from a single list of specifically disclosed elements does not confer novelty, and that, where a selection from two or more lists of a certain length has to be made, the resulting combination not specifically disclosed in the prior art confers novelty. Novelty of a sub-range selected from a numerical range is assessed under separate criteria.

(4) Self-collision ⇒ There is no equivalent of Article 29-2 of the Japanese Patent Act!

(Note) Article 54(3) EPC includes in the state of the art, for the assessment of novelty, the content of European patent applications filed earlier and published later. However, there is no provision corresponding to the proviso to Article 29-2 of the Japanese Patent Act (the exception where the applicant is the same). An applicant’s own earlier application may therefore destroy the novelty of its own later application (self-collision).

Profile | Random Notes on European Intellectual Property Practice (hasegawa-ip.com)

<Article> “Consideration of Publicly Known Designs in Assessing Design Similarity” (Professor Motoki Kato)

Original Ameblo publication: 2022-04-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12735909107.html

<Article> “Consideration of Publicly Known Designs in Assessing Design Similarity” (Professor Motoki Kato)

(Design infringement cases) The temporal reference point for publicly known designs considered when identifying the essential parts of a design

—Case law is divided on whether they are limited to those known by the filing date.

* Osaka High Court, 2020 (Ne) 211 held that designs becoming publicly known after the application for the registered design also affect identification of the essential parts.

Consideration of Publicly Known Designs in Assessing Design Similarity (jpaa.or.jp)



English translation of the figure

(Designs publicly known after the filing of the registered design also affect identification of the essential features!!) Osaka District Court, 2017 (Wa) 5109, “Training Equipment”; appeal: Osaka High Court, 2020 (Ne) 211 — appeal dismissed.

Left: registered design at issue (1536247). Right: accused design. Product marking: DOCTORAIR EMS SIX PAD.

Identification of essential features: “basic overall configuration” plus “the shape of each pad piece, the state of connection of each pad piece, and the shape and depth of the cuts between the pads.” Same as the first instance ⇒ dissimilar (no infringement).

(Excerpt from the judgment) “The appellant criticizes the original judgment for referring, when identifying the essential features, to publicly known designs subsequent to the design at issue. However, when identifying the essential features of a registered design, we consider that observing designs publicly known after the filing (including those that follow the registered design) makes it possible to determine whether the relevant configuration included in the registered design attracts the attention of consumers.” “A likelihood of confusion in a broad sense is not what the Design Act regulates.”

Slide 5.

<Article> “The Support Requirement for Parameter Inventions” (Hideki Takaishi, May 2021)

Original Ameblo publication: 2022-04-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12736081534.html

<Article> “The Support Requirement for Parameter Inventions” (Hideki Takaishi, May 2021)

The IP High Court Grand Panel judgment in Polarizing Film imposed an additional requirement for a “parameter invention” to satisfy support: that “the technical meaning of the relationship between the range indicated by the formula and the effect (performance) obtained” be recognizable.

⇒ However, since that Grand Panel judgment, the only decision assessing support by applying this additional requirement is the [Tomato-Containing Beverage case] (IP High Court, 2016 (Gyo-Ke) 10147)!!

⇒ Are there almost no “parameter inventions” in the sense used by the Grand Panel judgment!?

The Support Requirement for Parameter Inventions—Prompted by 2019 (Gyo-Ke) 10173 [Double-Sided Adhesive Tape Case]—(jpaa.or.jp)

<Article> [Brunnian Link Making Device] Case (Kazuo Shibata)

Original Ameblo publication: 2022-04-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12736258915.html

<Article> [Brunnian Link Making Device] Case (Kazuo Shibata)

An article examining “partial priority” in the greatest depth

Also explains the position in countries around the world

(1)…

(2) Where a new configuration added in the later application is not deprived of novelty or inventive step by prior art arising between the basic application's filing date and the actual filing date,

priority is recognized.

(Note) In 2019 (Gyo-Ke) No. 10132, the IP High Court held that Paris priority is denied only for the components not included in the basic application, and that, to invalidate the patent, those components must lack novelty or inventive step in light of the cited inventions (judgment, p. 33).

IP High Court Judgment of November 5, 2020, 2019 (Gyo-Ke) 10132 [Brunnian Link Making Device and Kit] Case (A case holding that a trial decision rejecting invalidation by recognizing priority for the entire scope was not erroneous in its conclusion because partial priority was recognized) (jpaa.or.jp)

<Article> [Designs] “Why Is the Assessment of Design Similarity Difficult to Understand?” (January 2021, Yuriko Kudo)

Original Ameblo publication: 2022-04-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12736431440.html

<Article> [Designs] “Why Is the Assessment of Design Similarity Difficult to Understand?” (January 2021, Yuriko Kudo)

Using specific refrigerator designs, this article considers that, although there is no contradiction between the Examination Guidelines' method of assessing similarity and the Good Design Award's evaluation, a difference emerges as to whether the subject evaluated is the product itself or the abstracted “design” (an idea apprehended from the standpoint of aesthetic impression).

Why Is the Assessment of Design Similarity Difficult to Understand? (jpaa.or.jp)

<Article> “The Influence of the Problem of the Invention at Issue in Patent Infringement Litigation” (September 2021, Japan Patent Attorneys Association Patent Committee)

Original Ameblo publication: 2022-04-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12736807031.html

<Article> “The Influence of the Problem of the Invention at Issue in Patent Infringement Litigation” (September 2021, Japan Patent Attorneys Association, Patent Committee)

Through a comprehensive examination of recent case law, this article confirms that the “problem of the invention” is important for both plaintiffs and defendants fighting patent infringement litigation, and is a key to winning or losing, while also introducing important judgments.

It extracts the essence of a report exceeding 100 pages and provides the information in a compact form.

The Influence of the Problem of the Invention at Issue in Patent Infringement Litigation (jpaa.or.jp)

<Article> “Inequitable Conduct after Therasense” (Satoshi Yoshida, Mineko Fukamachi)

Original Ameblo publication: 2022-04-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12736983682.html

<Article> “Inequitable Conduct after Therasense” (Satoshi Yoshida, Mineko Fukamachi)

The number of cases in which inequitable conduct is discussed after the Federal Circuit's Therasense judgment has remained stable.

Even under the stringent standard in the Therasense judgment, there is a certain number of cases in which inequitable conduct appears provable.

Even after Therasense, the inequitable-conduct defense remains viable.

Trends in Inequitable Conduct after Therasense—Has the US Patent Duty of Disclosure (IDS Violations) Been Relaxed?—(jpaa.or.jp)

<Article> IP High Court Judgment Holding That Filing a Correction Trial Is Unnecessary to Assert a Correction Rebuttal (Professor Hiroshi Yoshida)

Original Ameblo publication: 2022-04-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12737167417.html

<Article> “IP High Court Judgment Holding That Filing a Correction Trial Is Unnecessary to Assert a Correction Rebuttal” (April 2020, Professor Hiroshi Yoshida)

Correction rebuttal—many judgments hold filing unnecessary at a time when a correction trial/request is legally unavailable.

The [Optical Information Reading Device case] suggests a shift from the view that filing is conditionally unnecessary to the view that it is wholly unnecessary.

IP High Court Judgment Holding That Filing a Correction Trial Is Unnecessary to Assert a Correction Rebuttal—Will a Shift from Conditionally Unnecessary Filing to Wholly Unnecessary Filing Occur?—(jpaa.or.jp)

<Article> “Disclosure Requirements for Patent Descriptions in China” (March 2021, Jun Lin and Chunfeng Hu)

Original Ameblo publication: 2022-04-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12737365790.html

<Article> “Disclosure Requirements for Patent Descriptions in China” (March 2021, Jun Lin and Chunfeng Hu)

(Supreme People's Court of China)

Where the descriptions of the technical problem, technical concept, and beneficial effects in the patent description contradict one another,

the court may

make findings as to the technical problem the patent seeks to solve and the technical effects it seeks to achieve.

Disclosure Requirements for Patent Descriptions in China—Focusing on Chinese Supreme Court Judgments—(jpaa.or.jp)

<Article> Comparators and the Position of “Unpredictable Remarkable Effects” in Inventive-Step Assessment (2021, Hideki Takaishi)

Original Ameblo publication: 2022-04-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12737522502.html

<Article> “Supreme Court Judgment of August 27, 2019, 2018 (Gyo-Hi) 69, ‘... Eye Drops’ Case (Comparators and the Position of ‘Unpredictable Remarkable Effects’ in Inventive-Step Assessment)” (January 2021, Hideki Takaishi)

Although the prior judgment holding the configuration (medical use) obvious had become final and was binding, inventive step could still be recognized based on “unpredictable remarkable effects.” Compatible with the independent-requirement theory.

“Ultimately, the court below must be understood as having revoked the trial decision by immediately denying that the effects of the inventions at issue were unpredictable and remarkable, solely because it was known at the priority date that the other compounds at issue had effects equivalent to the compound at issue, on the premise that applying that compound to the uses of the inventions at issue could readily have been conceived, without adequately examining whether those effects, particularly their degree, were unpredictable and remarkable from the perspectives of whether a person skilled in the art could not have predicted them at the priority date as effects produced by the configurations of the inventions, and whether they were remarkable effects exceeding the range that such a person could have predicted from those configurations. Such a determination by the court below must be said to involve an unlawful error in the interpretation and application of law.”

⇒ After remand: IP High Court, 2019 (Gyo-Ke) 10118 <Mori>

“... Even where there is motivation to arrive at an invention's configuration, if, at the priority date, its effects are remarkable and exceed the range of effects that a person skilled in the art could have predicted as resulting from that configuration, the invention cannot be found to have been readily made by such a person. The prior judgment did not decide whether such unpredictable remarkable effects existed, and its binding effect (Administrative Case Litigation Act, Article 33(1)) does not extend to that issue ....”

⇒ Inventive step recognized based on “unpredictable remarkable effects”

Supreme Court Judgment of August 27, 2019, 2018 (Gyo-Hi) 69, “Eye Drops for Treating Allergic Eye Disease” Case—Comparators and the Position of “Unpredictable Remarkable Effects” in Inventive-Step Assessment (jpaa.or.jp)

<Article> “Intermediate Generalization—A Special EPC Patent Procedure” (November 2019, Christian Koster)

Original Ameblo publication: 2022-04-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738053161.html

<Article> “Intermediate Generalization—A Special EPC Patent Procedure” (November 2019, Christian Koster, German and European Patent Attorney)

At the EPO, intermediate generalization is in principle not allowed, but there are instances in which it is permitted.

⇒ By citing decisions allowing and disallowing it, this article proposes assessment criteria and approaches to argument—useful for European patent practice!!

Intermediate Generalization—A Special EPC Patent Procedure—(jpaa.or.jp)

<Article> “Judicial Assessment of Whether Computer Programs Qualify as Trade Secrets” (July 2019, Takayuki Ishimoto)

Original Ameblo publication: 2022-04-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738053378.html

<Article> “Judicial Assessment of Whether Computer Programs Qualify as Trade Secrets” (July 2019, Takayuki Ishimoto)

Where source code contains no distinctive processing, the subject protected as a trade secret is construed as the actual source code itself, and the scope of unauthorized use is narrow.

There are no decisions recognizing an algorithm as a trade secret.

Judicial Assessment of Whether Computer Programs Qualify as Trade Secrets (jpaa.or.jp)

<Article> “Analysis of Case Law Trends on the Extended Effect of Earlier Applications” (January 2019, Japan Patent Attorneys Association Patent Committee)

Original Ameblo publication: 2022-04-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738054292.html

<Article> “Analysis of Case Law Trends on the Extended Effect of Earlier Applications” (January 2019, Japan Patent Attorneys Association Patent Committee)

<Relationship between the extended effect of earlier applications and added matter>

In light of the purpose of the system, the scope of an earlier application's effect in excluding later applications ... should coincide with the standard for determining added matter, which governs whether amendment, correction, or division is permissible.

Exception—IP High Court, 2014 (Ne) 10080

As an exception, in the IP High Court case 2014 (Ne) 10080, “Method of Manufacturing Spinel-Type Lithium Manganate,” the court held: “... The description at issue does not expressly disclose spinel-type lithium manganate excluding forms that ‘substantially contain sodium or potassium in the crystal structure,’ nor can this be said to be a matter self-evident from the description; therefore, the technical matter ‘(excluding those substantially containing sodium or potassium in the crystal structure)’ cannot be said to be disclosed in the description.” It thus found the correction introducing a “disclaimer claim” to constitute added matter. However, since that case differs from a typical disclaimer-claim case excluding a single point in the structural formula of a chemical substance, careful examination is required before generalizing it. In any event, whether this approach is appropriate will be an issue for future examination.

Analysis of Case Law Trends on the Extended Effect of Earlier Applications (jpaa.or.jp)

<Article> Effectiveness of “Method for Producing an XX System” Claims (October 2018, Kansai Patent Study Group, Software Study Team)

Original Ameblo publication: 2022-04-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738237929.html

<Article> Effectiveness of “Method for Producing an XX System” Claims (October 2018, Kansai Patent Study Group, Software Study Team)

They include all the technical features of a system claim while reducing, compared with conventional approaches, the problems arising from the “in the course of business” requirement, working the invention abroad, and involvement of multiple actors.

⇒ A greater likelihood of obtaining a patent and greater effectiveness than system claims.

Effectiveness of “Method for Producing an XX System” Claims (jpaa.or.jp)

<Article> New Decision Recognizing US Patent Agent Privilege in State as Well as Federal Courts ... (Kenichi Hattori)

Original Ameblo publication: 2022-04-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738410610.html

<Article> “New Decision Recognizing US Patent Agent Privilege in State as Well as Federal Courts—Possibility of Expanded Privilege for Japanese Patent Attorneys” (July 2018, Kenichi Hattori)

Where advice on Japanese patent law is sought from a Japanese patent attorney,

⇒ the underlying law is Japanese law, and because Japanese patent attorneys have privilege, privilege is also recognized in US courts.

New Decision Recognizing US Patent Agent Privilege in State as Well as Federal Courts (jpaa.or.jp)

<Article> “Claim Satisfaction and the Clarity Requirement for Numerically Limited Inventions” (May 2018, Hideki Takaishi)

Original Ameblo publication: 2022-04-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12738586462.html

<Article> “Claim Satisfaction and the Clarity Requirement for Numerically Limited Inventions” (May 2018, Hideki Takaishi)

1. Numerical values (parameters) have multiple meanings.

2. Significant digits where a value falls slightly outside the numerical range

3. Elements outside the numerical range coexist in a single product.

4. Manufacturing tolerances

5. Changes over time after manufacture

6. Claims expressing degree—sufficiently, approximately, substantially

Claim Satisfaction and the Clarity Requirement for Numerically Limited Inventions (jpaa.or.jp)

IP High Court, 2020 (Gyo-Ke) 10057 [Electric Bed] <Kanno>

Original Ameblo publication: 2022-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739302480.html

IP High Court, 2020 (Gyo-Ke) 10057 [Electric Bed] <Kanno>

The technical fields of the primary and secondary references are far apart.

⇒ Motivation to combine denied (Claim 2)

Does being in a different technical field mean that a person skilled in the art would not know it?

If so, why is this an issue of motivation to combine?

If the technical field differs from that of the claimed invention, is suitability as the primary reference denied?

(Excerpts from the judgment)

The Exhibit Ko 1 invention concerns a medical bed 10 and addresses setting it at a preselected vertical height according to the patient's anticipated needs; it selects a “convenient height for getting into and out of bed 10” as the lower intermediate position (that height also prevents entrapment even if the caregiver's or patient's feet are present ...). In contrast, the Exhibit Ko 3 invention concerns ... a vehicle convertible-roof opening and closing device. In view of the risk of trapping an object when closing the roof, its problem is to provide such a device that automatically pauses just before the roof closes completely, allowing safety to be reliably checked; it additionally seeks to avoid causing discomfort to the operator.

The two technical fields are far apart and have in common only the abstracted problem of avoiding the risk of trapping objects. Extracting a common problem from different inventions in such different technical fields and attempting to apply specific solutions suited to their respective characteristics across those fields requires particular creativity .... There is no motivation to apply the Exhibit Ko 3 invention to the Exhibit Ko 1 invention ....

IP High Court, 2020 (Gyo-Ke) 10053 [Composition for Percutaneous and Transmucosal Absorption of Carbon Dioxide] <Kanno>

Original Ameblo publication: 2022-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739302910.html

IP High Court, 2020 (Gyo-Ke) 10053 [Composition for Percutaneous and Transmucosal Absorption of Carbon Dioxide] <Kanno>

The primary reference cannot be recognized as having the problem of the invention at issue.

⇒ Inventive step affirmed.

⇒ It is necessary to consider, above all, what problem can be recognized from the primary reference.

⇒ Difference 1 (“thickener content of 1–15 mass%”) is not obvious.

(Excerpts from the judgment)

The deliberate instruction in the Exhibit Ko 1 invention to “wait until [Babu] has completely dissolved” is understood to have the technical significance of waiting until a sufficient amount of carbon dioxide is generated from Babu and dissolved in the water. A person skilled in the art encountering Exhibit Ko 1 would therefore understand from that disclosure that its invention completely dissolves the Babu pieces and seeks to promote blood circulation through percutaneous absorption of carbon dioxide dissolved in the hot water. Such a person cannot be found to recognize a problem of “continuously retaining carbon dioxide in bubble form” in that invention. ... Exhibit Ko 1 expressly instructs one to “wait until [the Babu pieces] have completely dissolved.” Even if a person skilled in the art visually observed carbon dioxide bubbles being generated from Babu, it is difficult to find that the person would focus on carbon dioxide in bubble form, which is merely a process or means of producing dissolved carbon dioxide and cannot itself be said to contribute to percutaneous absorption. Nor is there sufficient evidence to establish, in the first place, that preventing carbon dioxide from escaping into the air without dissolving in the hot water is a problem of the Exhibit Ko 1 invention. The plaintiff argues that the problem of “continuously retaining carbon dioxide in bubble form” is self-evident or readily discoverable and that it is therefore unnecessary to determine whether it can be recognized from the Exhibit Ko 1 invention. However, ... in considering whether the invention at issue could readily have been conceived from that invention, it is necessary above all to consider what problem a person skilled in the art encountering the Exhibit Ko 1 invention could recognize from it. The plaintiff's argument must therefore be rejected.

IP High Court, 2012 (Gyo-Ke) 10252 [Thermostable Ribonuclease H] <Shibata>

Original Ameblo publication: 2022-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739303434.html

IP High Court, 2012 (Gyo-Ke) 10252 [Thermostable Ribonuclease H] <Shibata>

* Remarkable effects cannot be established from a publication distributed after filing.

* Identifying pre-filing inventions or common general technical knowledge based on knowledge disclosed in the patent description is impermissible, because it may result in assessing inventive step for the patent application with hindsight.

(Excerpts from the judgment)

In general, inventive step is assessed as of the filing date (or the claimed priority date where priority is claimed), not at the time of examination (Patent Act, Article 29(2)). The knowledge that may be considered in assessing inventive step is therefore knowledge available before filing; this applies equally to assessing whether the configuration is obvious and whether the effects are remarkable. Moreover, identifying pre-filing inventions or common general technical knowledge based on knowledge disclosed in the description of the patent application may result in assessing that invention's inventive step with hindsight, contrary to the purpose of that paragraph, and is impermissible.

<Article> “Markman Claim Construction in US Patent Infringement Litigation” (March 2017, York M. Faulkner, Aya Suzuki)

Original Ameblo publication: 2022-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739303686.html

<Article> “Markman Claim Construction in US Patent Infringement Litigation” (March 2017, York M. Faulkner, Aya Suzuki)

Claim construction when assessing whether the claim limitations are met in US patent infringement litigation—useful in practice!

ordinary and customary meaning

broadest reasonable interpretation (BRI)

Strategic considerations concerning two standards

075-081_Suzuki.mcd (jpaa.or.jp)

<Article> “Trends and Strategies in Case Law on the Doctrine of Equivalents” (January 2017, Japan Patent Attorneys Association, Patent Committee)

Original Ameblo publication: 2022-04-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739474765.html

<Article> “Trends and Strategies in Case Law on the Doctrine of Equivalents” (January 2017, Japan Patent Attorneys Association, Patent Committee)

The pros and cons of disclosing multiple problems and effects in the description

The pros and cons of describing the problem in broader conceptual terms

Cases addressing the second requirement from the standpoint of the quantity or degree of the effects in their holdings

Double standards for the third requirement

Trends and Strategies in Lower-Court Case Law on the Doctrine of Equivalents (jpaa.or.jp)

<Article> “The Scope of Rights for ‘Use Inventions’ (Direct and Indirect Infringement)” (January 2017, Hideki Takaishi)

Original Ameblo publication: 2022-04-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739651689.html

<Article> “The Scope of Rights for ‘Use Inventions’ (Direct and Indirect Infringement)” (January 2017, Hideki Takaishi)

Use inventions and direct infringement

(1) An approach limiting the definition of a use invention

(2) An approach construing the meaning of the claim wording “for ...” case by case

Viewing a use invention as a subcombination invention

Use inventions and indirect infringement

Enforcement of “Use Inventions” (Direct and Indirect Infringement) (jpaa.or.jp)

<Article> “The Reach of ‘Obviousness upon Obviousness’ (The Position of a Third Prior-Art Reference)” (December 2018, Hideki Takaishi)

Original Ameblo publication: 2022-04-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739825224.html

<Article> “The Reach of ‘Obviousness upon Obviousness’ (The Position of a Third Prior-Art Reference)” (December 2018, Hideki Takaishi)

* Where multiple secondary references must be combined to bridge multiple differences, if the differences are technically independent of one another, this is not a problem of “obviousness upon obviousness”!!

Cf. IP High Court, 2020 (Gyo-Ke) 10124 <Shoji>

The Reach of “Obviousness upon Obviousness” (The Position of a Third Prior-Art Reference) (jpaa.or.jp)

<Article> “License Agreements with Foreign Companies” (Yoshihiko Ryujin, Japanese Patent Attorney and New York Attorney)

Original Ameblo publication: 2022-04-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12739995913.html

<Article> “License Agreements with Foreign Companies” (Yoshihiko Ryujin, Japanese Patent Attorney and New York Attorney)

Explanation of patent licenses by type

Enforcement type

Technical-assistance type

Hybrid type

Joint-development type

Without delimiting the subject matter, it would be a waste if unexpected technology emerged.

Know-how licenses—use should become unrestricted after a certain period.

License Agreements with Foreign Companies—Secrets of Success and Pitfalls—(jpaa.or.jp)

<Issue> “Inventive-Step Assessment of Parameter Inventions” (2021 Annual Report of the Japan Association of Industrial Property Law, Hideki Takaishi)

Original Ameblo publication: 2022-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12740839685.html

<Issue> “Inventive-Step Assessment of Parameter Inventions” (2021 Annual Report of the Japan Association of Industrial Property Law, Hideki Takaishi)

The decisive issue in assessing inventive step for an invention whose scope is defined by a new “parameter” is whether it would have been obvious for a person skilled in the art at the filing date to focus on that “parameter.”

⇒ The key phrase is “the problem of the invention”!!

209-236_Annual Report of the Japan Association of Industrial Property Law_No.44-11_Takaishi.indd (takaishihideki.com)

<Article> “Is There a Double Standard between ‘the Technical Scope of an Invention’ and ‘Identification of the Gist of an Invention’?” (December 2015, Japan Patent Attorneys Association, Patent Committee)

Original Ameblo publication: 2022-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12740840040.html

<Article> “Is There a Double Standard between ‘the Technical Scope of an Invention’ and ‘Identification of the Gist of an Invention’?” (December 2015, Japan Patent Attorneys Association, Patent Committee)

With the PBP Supreme Court judgment, 2012 (Ju) 1204, there is a move toward a unified interpretation of identification of the gist of an invention (invalidity) and the technical scope of an invention (claim satisfaction).

... What about IP High Court, 2021 (Ne) 10020?

Is There a Double Standard between “the Technical Scope of an Invention” and “Identification of the Gist of an Invention”? (jpaa.or.jp)

<Article> “... Survey of Important Decisions Assessing the Clarity Requirement and Analysis of Decision Trends” (November 2021, Intellectual Property Management, Hideki Takaishi)

Original Ameblo publication: 2022-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12740840266.html

<Article> “... Survey of Important Decisions Assessing the Clarity Requirement and Analysis of Decision Trends” (November 2021, Intellectual Property Management, Hideki Takaishi)

A pro-patent tendency for the clarity requirement “as well”

Language expressing degree—clear in the sense of the range within which the problem can be solved

Even if the endpoints of a numerical range are not precisely determined, the clarity requirement is satisfied if the “variation” is slight.

1110_Case Law and Practice.indd (takaishihideki.com)

<Article> “Comprehensive Examination of Issues concerning Well-Known and Famous Indications and Applied Art Relating to ‘Product Configuration’” (September 2020, Hideki Takaishi and Tsubasa Yamamoto)

Original Ameblo publication: 2022-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12740840452.html

<Article> “Comprehensive Examination of Issues concerning Well-Known and Famous Indications and Applied Art Relating to ‘Product Configuration’” (September 2020, Hideki Takaishi and Tsubasa Yamamoto)

Most judgments adopt a strict standard for the copyrightability of “applied art.”

⇒ Even where copyrightability is recognized, protection is narrow.

Cases recognizing product shapes as “indications of goods or business” are not numerous, but are increasing.

Comprehensive Examination of Issues concerning Well-Known and Famous Indications and Applied Art Relating to “Product Configuration” (jpaa.or.jp)

<Issue> “Enablement and Clarity Requirements” (One Hundred Selected Patent Cases, 5th Edition, Hideki Takaishi)

Original Ameblo publication: 2022-05-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12740876923.html

<Issue> “Enablement and Clarity Requirements” (One Hundred Selected Patent Cases, 5th Edition, Hideki Takaishi)

Does the enablement requirement require that the invention be practicable in a way that solves its problem?

⇒ There is no inconsistency if the answer is YES, while recognizing that some cases appear to require only practicability because the problem of the invention is being able to manufacture it at all (as with a new substance).

<94BB97E19553914991E68CDC94C581408175825682518140 8EC08E7B89C2945C97768C8F82C696BE8A6D90AB97768C8F81768169323031392E3038816A2E786477> (takaishihideki.com)

<New YouTube Video> Reversal to a “Win” on Appeal (1-1): Claim Not Satisfied ⇛ Satisfied

Original Ameblo publication: 2022-05-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12741066096.html

<New YouTube Video> Reversal to a “Win” on Appeal (1-1): Claim Not Satisfied ⇒ Satisfied

★ IP High Court, 2009 (Ne) 10006, “Hollow Golf Club Head” case <Iimura>

⇒ Reversal finding infringement under the doctrine of equivalents (first requirement reversed)

★★★ IP High Court, 2017 (Ne) 10092, “... Device for Cooling Power Electronics” case <Takabe>

IP High Court, 2010 (Ne) 10031, “Kitchen Sink” case <Iimura>

Tokyo High Court, 2003 (Ne) 1223, “Method for Searching for a Stable Complex Structure of Ligand Molecules” case <Yamashita>

⇒ The problem of the invention was identified differently from the court below, broadening the literal construction!!

⇒ Reversal finding literal claim satisfaction

★ IP High Court, 2018 (Ne) 10016, “Nozzle for Spraying a Liquid as Fine Particles” case <Otaka>

IP High Court, 2011 (Ne) 10002, “(Cut) Rice Cake” <Iimura>

IP High Court, 2014 (Ne) 10082, “Method for Manufacturing 4H-Type Single-Crystal Silicon Carbide” <Takabe>

⇒ Literal construction was broadened in light of the invention's “problem”!!

⇒ Reversal finding literal claim satisfaction

IP High Court, 2010 (Ne) 10089, “Method and Apparatus for Encrusting and Forming Food” <Takizawa>

IP High Court, 2007 (Ne) 10025, “Seal Base Material” <Tsukahara>

IP High Court, 2005 (Ne) 10119, “Range Hood Filter Device” <Tsukahara>

IP High Court, 2008 (Ne) 10065, “Device for Automatically Creating Telephone Number Information” <Iimura>

⇒ Literal construction was broadened without directly relying on the invention's “problem”!! ⇒ Reversal finding literal claim satisfaction

★ IP High Court, 2017 (Ne) 10027, “Financial Instruments Transaction Management Method” case <Mori>

⇒ Changed findings identifying the accused method

IP High Court, 2012 (Ne) 10023, “Apparatus for Processing Material with a Laser” <Iimura>

⇒ Changed factual findings in the comparison

(3) [Patents] + Survey of Appellate Reversals (1-1): Claim Not Satisfied ⇒ Satisfied - YouTube

<New YouTube Video> Reversal to a “Loss” on Appeal (1-2): Claim Satisfied ⇛ Not Satisfied

Original Ameblo publication: 2022-05-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12741249961.html

<New YouTube Video> Reversal to a “Loss” on Appeal (1-2): Claim Satisfied ⇒ Not Satisfied

★ IP High Court, 2009 (Ne) 10033, “Heat-Dissipating Sheet Made of a Thermally Conductive Silicone Rubber Composition” case <Nakano>

⇒ Interpretation of numerical limitations—the underlying “treatment” discernible from the embodiments is important.

★ IP High Court, 2005 (Ne) 10047, “Chair-Type Air Massage Machine” case <Tsukahara>

⇒ Doctrine of equivalents applicable to a narrowed claim (the only such case in a Tokyo high court)

(Note) In this case, literal infringement was rejected, but infringement under the doctrine of equivalents was found for Accused Products 3 and 4. This does not mean that all of the patentee’s claims were dismissed.

⇒ Numerous cases at the Osaka District Court and Osaka High Court. Tokyo District Court, 2017 (Wa) 18184, “Osteotomy Spreader” <Sato>

★★★ IP High Court, 2020 (Ne) 10044, “Fluid Supply Device ... and Program” case <Tsuruoka>

* Merely stating “admitted” in an answer does not establish a “judicial admission.” The answer must be considered as a whole!!

* A configuration in which the invention's problem does not arise does not satisfy the claim!! (Narrow problem ⇒ narrow invention. Cf. IP High Court, 2017 (Ne) 10092)

★★★ IP High Court, 2017 (Ne) 10033, “Renovation Sliding Door Device” case <Tsuruoka>

<Appeal> Problem of the invention—“does not reduce the effective opening area”—“substantially the same height” = does not include a step

<First instance> Problem of the invention—“the degree ... of reduction of the effective opening area is substantially smaller than in the prior art”

⇒ The court below held that a height difference substantially smaller than in the prior art was “substantially the same height.”

(3) [Patents] + Survey of Appellate Reversals (1-2): Claim Satisfied ⇒ Not Satisfied - YouTube

<New YouTube Video> Reversal to a “Win” on Appeal (2-1): Invalid ⇛ Valid

Original Ameblo publication: 2022-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12741655979.html

<New YouTube Video> Reversal to a “Win” on Appeal (2-1): Invalid ⇒ Valid

★★ IP High Court, 2017 (Ne) 10086, “Beauty Roller” case <Tsuruoka>

= ★★ IP High Court, 2019 (Ne) 10009, “Roll Paper for Packaging Medication” case <Otaka>

⇒ A petitioner who lets a trial decision maintaining the patent become final without seeking revocation cannot raise an invalidity defense based on the same facts and evidence, absent special circumstances.

★ IP High Court, 2018 (Ne) 10006 [Capcom v. Koei] <Tsuruoka>

⇒ Unlike the court below, the appellate court recognized a teaching away.

★ IP High Court, 2013 (Ne) 10025, “Metal Wagon” case <Shimizu>

⇒ Unlike the court below, it did not delve into the technical significance of the features defining the invention.

★ IP High Court, 2009 (Ne) 10028, “Device for Correcting the Vertical Alignment of Steel Columns” case <Takizawa>

★ IP High Court, 2008 (Ne) 10085, “Method of Providing Access to an Internet Server” case <Takizawa>

⇒ Emphasis was placed on the difference between the “problems” of the invention at issue and the primary reference!!

(3) [Patents] + Survey of Appellate Reversals (2-1): Invalid ⇒ Valid - YouTube

<New YouTube Video> Reversal to a “Loss” on Appeal (2-2): Valid ⇛ Invalid

Original Ameblo publication: 2022-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12741656187.html

<New YouTube Video> Reversal to a “Loss” on Appeal (2-2): Valid ⇒ Invalid

IP High Court, 2005 (Ne) 10004, “Nucleic Acid Amplification Reaction Monitoring Device” <Nakano>

⇒ Circumstantial facts establishing the date of public availability

IP High Court (Grand Panel), 2005 (Ne) 10040 [Ichitaro]; IP High Court, 2017 (Ne) 10055, “Continuous Shellfish Fastener” <Mori>; IP High Court, 2018 (Ne) 10033, “Aerosol Can Product” <Otaka>; IP High Court, 2019 (Ne) 10066, “Information Management Program” <Mori>

⇒ There are no cases of rejection as untimely when submitted together with the statement of reasons for appeal.

★ IP High Court, 2016 (Ne) 10083, “Therapeutic Marker” case <Mori>

In light of the original judgment, a new secondary cited invention (Exhibit Otsu 9) and well-known technology were submitted on appeal,

and combined with the same primary invention. ⇒ No inventive step

★ IP High Court, 2014 (Ne) 10080 et al., “Method of Manufacturing Spinel-Type Lithium Manganate” case <Shimizu>

* In light of the original judgment, the primary and secondary cited inventions were switched ⇒ No inventive step

★ IP High Court, 2008 (Ne) 10088, “Method of Obtaining a Magnified Image by Reversing the Positional Relationship between the Objective Lens and the Sample” case <Iimura>

* “while bringing the sample to be observed into direct contact with the lens”—support requirement not satisfied

(3) [Patents] + Survey of Appellate Reversals (2-2): Valid ⇒ Invalid - YouTube

Osaka High Court, 2002 (Ne) 2776 [Object Embedded in Concrete] = Tokyo High Court, 2003 (Gyo-Ke) 65

Original Ameblo publication: 2022-05-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12741796809.html

Osaka High Court, 2002 (Ne) 2776 [Object Embedded in Concrete]

= Tokyo High Court, 2003 (Gyo-Ke) 65

The child application violates the divisional requirements because of an amendment's retroactive effect.

⇒ The grandchild application's filing date does not relate back to the parent application.

* A final finding of invalidity of the child application is irrelevant to whether the grandchild application's filing date relates back to the parent application.

Everything depends on whether the child application satisfies the divisional requirements!!

Tokyo High Court, 2001 (Gyo-Ke) 421 <Yamashita> [Drainage Channel Structure]

* All claims deleted by correction ⇒ No interest in maintaining the action

“All claims were deleted ... deemed never to have existed from the outset ....”

★ For a grandchild divisional application, when the child application receives a final notice of reasons for rejection for added matter, is an amendment deleting all claims OK!?

2015 (Wa) 8517 [Paddy Ridge Plastering Machine] <Shimasue> The judgment concerned a third-generation patent in a chain of original application ⇒ first generation ⇒ second generation ⇒ third generation. Although the second-generation application had been withdrawn, it was never disputed that the third generation's filing date could relate back to the first generation and original application.

Tokyo High Court, 1989 (Gyo-Ke) 135 <Takeda> [Aqueous Suspension Polymerization Method for Vinyl Chloride]

* Withdrawal of an application has no retroactive effect except under Article 39(5) of the Patent Act.

⇒ Withdrawal cannot cure a child's failure to meet the divisional requirements due to added matter.

⇒ At worst, amend to delete all claims; but if one prepares a claim that does not add matter at the time of division ...

99F18E381FDF9C6049256D39000E304 (courts.go.jp)

Tokyo District Court, 2019 (Wa) 25152 [Comment Distribution System] <Kokubu> (Dwango v. FC2)

Original Ameblo publication: 2022-05-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12742511150.html

2019 (Wa) 25152 [Comment Distribution System] <Kokubu> (Dwango v. FC2)

* To constitute “production” of a product invention, a product satisfying all the elements of the patented invention must be newly created within Japan.

⇒ No “production” within Japan

⇒ The elements are satisfied, but no infringement!!

(Excerpts from the judgment)

... “Production” as “working” a product invention (Patent Act, Article 2(3)(i)) is understood as the act of newly creating a “product” falling within the technical scope of the invention. Further, under the principle of territoriality, meaning that a patent right is effective only within the territory of the country concerned (see Supreme Court, Third Petty Bench judgment of July 1, 1997, 1995 (O) 1988, Minshu Vol. 51, No. 6, p. 2299; and Supreme Court, First Petty Bench judgment of September 26, 2002, 2000 (Ju) 580, Minshu Vol. 56, No. 7, p. 1551), it is appropriate to construe such “production” as limited to production within Japan. Accordingly, to constitute “production,” a product satisfying all the elements of the patented invention must be newly created within Japan. ... The “server” ... must be regarded as playing an important role as a component achieving the objective. From this standpoint too, ... the mere fact that the user terminals are located in Japan does not establish that most components of Defendant's System 1, the subject of “production,” are located within Japan ....

The defendant's service supported Japanese and appears to have been provided to users residing in Japan; ... it is also established that Defendant HPS, a Japanese corporation, was commissioned by Defendant FC2 to perform work relating to services operated by FC2, including the defendant's service. Nevertheless, ... no circumstances supporting an assessment that the result would be grossly inappropriate have been established, such as Defendant FC2, a US corporation, placing the video-distribution and comment-distribution servers outside Japan to evade liability for infringement of the patent at issue while substantially managing them from within Japan. ...

... Although the defendant's system is found to fall within the technical scope of the invention at issue, ... production of that system by the defendants within Japan after May 17, 2019, when the patent was registered, is not established, nor can the defendants be found to have worked the invention within Japan. Accordingly, infringement of the patent right by the defendants cannot be established.

IP High Court, 2021 (Ne) 10007 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda> Reversal Finding Literal Claim Satisfaction

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IP High Court, 2021 (Ne) 10007 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda> (First instance: Tokyo District Court, 2018 (Wa) 29802 <Tanaka>)

Construction of the claim language “multiple chambers”—the product invention limited by “capable of communication” was held not satisfied, while the method invention without that limitation was held satisfied.

⇒ Reversing the first-instance judgment that neither was satisfied!!

[Summary of This Judgment and Some Observations]

1. Claims (Claim 1 and Claim 10)

(Claim 1)

1A In an infusion container having multiple chambers partitioned by partition means capable of opening communication through external pressure,

1B one chamber is filled with a solution containing at least one substance selected from the group consisting of sulfur-containing amino acids and sulfites,

1C another chamber houses a trace-metal-element container containing a liquid that includes at least one trace metal element selected from the group consisting of iron, manganese, and copper,

1D the trace-metal-element container being a bag made of thermoplastic resin film,

1E An infusion preparation characterized by the foregoing.

(Claim 10)

10A In a multichamber infusion preparation,

10B a chamber containing a solution that includes at least one substance selected from the group consisting of sulfur-containing amino acids and sulfites, and

10C a separate chamber housing a trace-metal-element container containing a liquid that includes at least one trace metal element selected from the group consisting of iron, manganese, and copper,

10D the trace-metal-element container being a bag made of thermoplastic resin film,

10E A method of stabilizing an infusion preparation during storage, characterized by the foregoing.

2. Claim Construction in the First Instance, Tokyo District Court, 2018 (Wa) 29802 (Excerpts from the Judgment)

The court will determine ... whether the defendant's product and method have the configuration in Elements 1C and 10C of “a trace-metal-element container ... housed in a chamber.” ...

Because infusion solutions ordinarily do not contain trace metal elements such as copper, patients receiving long-term infusions develop so-called trace metal deficiency. However, storing the trace metal elements needed to prevent this in a mixture with the infusion solution causes quality deterioration through chemical

reactions. To prevent this, when one chamber is filled with an amino-acid infusion solution containing sulfur-containing amino acids and the trace-metal-element container is placed in that same chamber, a technical problem arises: the solution containing trace metal elements becomes unstable even though the amino-acid infusion solution and the trace metal elements are isolated from one another.

The inventions at issue should be regarded as solving this technical problem by adopting a configuration in which one of multiple chambers partitioned by partition means capable of opening communication is filled with a solution containing sulfur-containing amino acids, and a container containing trace metal elements is housed in a different chamber, thereby achieving the effect of providing an infusion preparation having a solution containing sulfur-containing compounds, characterized by the stable presence of the trace metal elements.

Accordingly, the distinctive technical configuration of the inventions at issue in terms of solving the problem lies in housing the trace-metal-element container not in the same chamber as the solution containing sulfur-containing amino acids, but in another chamber capable of communicating with it. On the premise of an infusion container having multiple chambers partitioned by partition means capable of opening communication, each of the multiple “chambers” is structured to be filled with and store a different infusion solution; the adopted technical configuration is therefore one in which the “chamber” housing the trace-metal-element container is structured to be filled with and store an infusion solution different from the solution containing sulfur-containing amino acids.

In other words, in the inventions at issue, “multiple chambers” in Element 1A and “multichamber” in Element 10A are construed as respective spaces structured to be filled with and store various infusion solutions. For a space provided in an infusion container to constitute the “chamber” in Elements 1C and 10C, one of those chambers, it must have a structure capable of being filled with and storing an infusion solution ....

Considering the defendant's product and method, ... the space between the outer and inner resin films of small chamber T does not communicate with the middle chamber and small chamber V during use. In light of this, that space cannot be found to have a structure capable of being filled with and storing an infusion solution, and cannot be regarded as a “chamber.”

3. Claim Construction in the IP High Court, 2021 (Ne) 10007 (Excerpts from the Judgment)

... Regarding the problem of the corrected inventions at issue ...

The corrected inventions at issue concern the following circumstances. Infusion containers having multiple chambers partitioned by partition means capable of opening communication are used in hospitals. Infusion solutions ordinarily lack trace metal elements, causing trace metal deficiency with long-term administration. However, storing trace metal elements mixed with infusion solutions causes quality deterioration, so they continue to be mixed immediately before infusion. In light of this, research began to create an infusion preparation using a container with multiple chambers partitioned by partition means capable of opening communication through external pressure, allowing trace metal elements to be mixed in at the time of use without the possibility of bacterial contamination, and offering excellent storage stability. It was then discovered that filling one chamber with an amino-acid infusion solution containing sulfur-containing amino acids and placing the trace-metal-element container in that same chamber creates the problem that the trace-metal-element solution is unstable even when the amino-acid infusion solution and trace metal elements are isolated. On that basis, the inventions aim to provide an infusion preparation having a solution containing sulfur-containing compounds, characterized by the stable presence of trace metal elements. ...

Corrected Inventions 1 and 2 at Issue address providing an infusion preparation having a solution containing sulfur-containing compounds, characterized by the stable presence of trace metal elements. More specifically, they are understood to address providing an infusion preparation using a container

having multiple chambers partitioned by partition means capable of opening communication through external pressure, with trace metal elements stored in advance in a form allowing their admixture at use, in which those elements remain stable even when one chamber is filled with a solution containing sulfur-containing compounds. Similarly, Corrected Inventions 10 and 11 at Issue address providing a method of stabilizing such an infusion preparation during storage. ...

... Regarding “chambers” ...

... In the infusion container of the appellee's product, the space formed by the fundamental series of members in its configuration can be described as the space formed by the series of members directly constituting the large and middle chambers and also constituting the exterior of small chambers T and V. ... Paragraph [0024] of the description at issue expressly states that the “chamber housing the trace-metal-element container” may or may not be filled with a solution, and paragraph [0033] expressly states that “in the infusion preparation of this embodiment, first chamber 4 of the infusion container shown in Figure 1 may or may not be filled with a solution.” Accordingly, in the corrected inventions at issue, whether a space is filled with an infusion solution is not an indispensable factor in determining whether it is a “chamber” ....

In Element 1A ..., the specification “partitioned by partition means capable of opening communication through external pressure” precedes “an infusion container having multiple chambers.” ... The appellee's product does not satisfy the requirement that the “chambers” be “capable of communication,” and therefore does not satisfy Element 1A ....

Unlike Element 1A ..., Element 10A ... does not require the “chambers” to be “capable of communication.” Accordingly, ... the appellee's method satisfies Element 10A ....

4. Some Observations

The first-instance judgment stated that it would determine “whether the defendant's product and method have the configuration in Elements 1C and 10C of ‘a trace-metal-element container ... housed in a chamber.’ ...” It then construed the “chambers” of the invention at issue, “on the premise of an infusion container having multiple chambers partitioned by partition means capable of opening communication,” as structures for filling with and storing different infusion solutions, solving the “technical problem that, when one chamber is filled with an amino-acid infusion solution containing sulfur-containing amino acids and the trace-metal-element container is placed in that same chamber, the trace-metal-element solution becomes unstable even though the amino-acid infusion solution and trace metal elements are isolated from one another.” It found non-satisfaction, holding: “Considering the defendant's product and method, ... the space between the outer and inner resin films of small chamber T does not communicate with the middle chamber and small chamber V during use. In light of this, that space cannot be found to have a structure capable of being filled with and storing an infusion solution, and cannot be regarded as a ‘chamber.’”

By contrast, unlike the first-instance judgment, the appellate judgment did not premise its analysis on the multiple chambers being capable of communication. It identified the invention's problem as “providing an infusion preparation having a solution containing sulfur-containing compounds, characterized by the stable presence of trace metal elements.” It then held that Element 1A (product invention) includes, before “an infusion container having multiple chambers,” the specification “partitioned by partition means capable of opening communication through external pressure,” and thus is not satisfied by the defendant's product, which is not “capable of communication.” Element 10A (method invention), however, does not require the “chambers” to be “capable of communication,” so it is satisfied even by the defendant's method that is not “capable of communication.”

Thus, the difference in conclusions between the first-instance and appellate judgments arose because, although Element 10A (method invention) did not require the “chambers” to be “capable of communication,” the first-instance court construed it as being “on the premise of an infusion container

having multiple chambers partitioned by partition means capable of opening communication," adopting a narrow construction that added a "capable of communication" limitation absent from the claim language. The appellate judgment, in contrast, pointed out that Claim 1 (product invention) has the defining feature "capable of communication," while Claim 10 (method invention) does not, and declined that narrow construction. Where multiple claims include one with the defining feature "capable of communication" and one without it (although not in a dependent relationship), the latter claim was held not to carry that limitation, resulting in non-satisfaction of the former and satisfaction of the latter. This is not a typical "claim differentiation" case, but it can be understood as a case making manifest the entirely possible difference in outcomes between claims with and without a defining feature, whether dependent or independent. (Of course, the result might have been the same had Claim 1 not existed and only Claim 10 been disputed. Still, varying defining features among multiple claims in this way—for example, establishing a relationship in which a limited dependent claim corresponds to a more specific "problem"—may reduce uncertainty arising from narrow construction.)

The appellate judgment first identified the problem as "providing an infusion preparation having a solution containing sulfur-containing compounds, characterized by the stable presence of trace metal elements," and then identified it "more specifically" as "providing an infusion preparation using a container having multiple chambers partitioned by partition means capable of opening communication through external pressure, with trace metal elements stored in advance in a form allowing their admixture at use, in which those elements remain stable even when one chamber is filled with a solution containing sulfur-containing compounds." I considered whether the result had changed (been reversed) because the first-instance and appellate judgments interpreted the invention's problem differently, as in the IP High Court judgment in 2017 (Ne) 10092, "Device for Cooling Power Electronics," cited below. However, insofar as I have examined the appellate judgment's logic, identifying the problem more specifically does not appear directly related to the conclusion that the method invention of Claim 10 should not be narrowly construed as including "capable of communication," which is absent from the claim language.

[Introduction to Related Decisions (Comprehensive Coverage of the Last 16 Years' Decisions Reversed on Appeal)]

≪(1) Claim Not Satisfied ⇒ Satisfied (Reversal in Favor of the Patentee)≫

(1) ★ IP High Court, 2009 (Ne) 10006, "Hollow Golf Club Head" case <Iimura>

"(1) Possibility of substitution ... The purpose and effects (or principle of solving the problem) are shared.

(2) Ease of substitution

(3) Whether the difference is a non-essential part

The purpose and effects of the invention at issue ... lie in increasing the bonding strength between the metal shell member and the fiber-reinforced-plastic shell member." ⇒ Infringement under the doctrine of equivalents: yes

First instance: Tokyo District Court, 2007 (Wa) 28614 <Abe>

"The invention at issue ... increases the bonding strength between the two shell members by using ... a stitching material in addition to adhesive bonding, because simply bonding the joint portion of the metal shell member to the joint portion of the fiber-reinforced-plastic shell member does not provide sufficient strength. ... Joining the metal shell member and the fiber-reinforced-plastic shell member with stitching material is the distinctive configuration for solving the problem, and that stitching material must be regarded as an essential part of the invention." ⇒ Infringement under the doctrine of equivalents: no (first requirement not satisfied)

(2) ★★★ IP High Court, 2017 (Ne) 10092, “Device for Cooling Power Electronics” case <Takabe>

“The cooling-fluid passage is a configuration for cooling the heat-dissipating bridge .... From the standpoint of cooling efficiency, the wall formed by the bottom surface of the heat-dissipating bridge must extend over the entire length of the cooling-fluid passage. In contrast, ... the rear bearing is not cooled by air passing through the cooling-fluid passage, ... and [the wall] need not necessarily extend over the entire cooling passage.”

⇒ The accused product's “rear-bearing bridge-side passage” does not extend along the entire longitudinal length, but literal claim satisfaction was found on reversal.

* Limiting the problem of the invention to cooling the “heat-dissipating bridge” broadened the invention!!

First instance: Tokyo District Court, 2016 (Wa) 13239 <Shibata>

“The claims prescribe that Invention 1 at Issue has multiple portions serving as paths for fluid, ... and can be said to prescribe that the ‘cooling-fluid passage (17)’ is the space in which the above longitudinal walls face one another.” ⇒ Claim not satisfied

(3) IP High Court, 2010 (Ne) 10031, “Kitchen Sink” case <Iimura>

“Element C1 ... addresses the prior-art problem that ... dedicated cooking plates had to be separately prepared ... for the upper and middle stepped portions. To solve that problem, the rear wall is formed so that the front-to-back distances of the upper and middle stepped portions are substantially equal, allowing the same plate to be selectively laid across either stepped portion.” ⇒ Claim satisfied

⇒ The accused product's “inclined surface” includes a vertical surface beyond the portion extending rearward, but literal claim satisfaction was found on reversal.

* Identifying the problem as eliminating the need to prepare dedicated cooking plates broadened the invention!!

First instance: Tokyo District Court, 2009 (Wa) 5610 <Shimizu>

* Being able to “enlarge the interior space” (paragraph [0018]) is a problem of the invention at issue.

“From the statement ‘...’ ([0018]), ... the ‘inclined surface extending rearward as it extends downward’ in Element C1 means an inclined surface having a certain area and angle of inclination, which, between the upper and middle stepped portions, extends rearward as it extends downward to form an ‘interior space’ with a certain rearward expanse.” ⇒ Claim not satisfied

(4) Tokyo High Court, 2003 (Ne) 1223, “Method for Searching for a Stable Complex Structure of Ligand Molecules” case <Yamashita>

* The problem of the invention at issue was identified differently from the court below. ⇒ Even numerous “dummy atoms” are OK.

“The core technical concept of the patented invention ... lies in searching for ligand molecules that bind stably in the hydrogen-bonding region of a biopolymer, focusing on hydrogen bonds, etc., and comparing the distances between dummy atoms placed at positions of heteroatoms capable of serving as hydrogen-bonding partners for hydrogen-bonding functional groups in the biopolymer with the distances between hydrogen-bonding heteroatoms in the ligand molecule, while simultaneously estimating the ligand molecule's active conformation. Although dummy atoms themselves are indispensable, their number is not directly related to this technical concept of the patented invention ....” ⇒ Reversal finding literal claim satisfaction

First instance: Tokyo District Court, 2001 (Wa) 21278 <Mimura>

“A ‘dummy atom’ in the patented invention is set as one atom for each hydrogen-bonding region of each atom capable of hydrogen bonding in the biopolymer.” ⇒ Claim not satisfied

(Reasons) (i) The description uses it to indicate a single point. (ii) The plaintiff's own paper also sets only one dummy atom. (iii) Numerous dummy atoms would fail to achieve the invention's purpose of speeding up calculation. (iv) If numerous dummy atoms are included, the disclosure requirements are violated.

(5) ★ IP High Court, 2018 (Ne) 10016, “Nozzle for Spraying a Liquid as Fine Particles” case <Otaka>

“Claim 4 ... contains no wording limiting the particle diameter of ‘fine particles’ to a particular numerical range. ... Reading the description ... as a whole, ... it does not state that being able to spray fine particles with a diameter of ‘10 μm or less’ has any particular effect. ... ‘Fine particles’ means particles with a small diameter; the numerical range of that diameter is not limited ....” ⇒ Reversal finding literal claim satisfaction

* The numerical value stated in the description was not what solved the invention's problem. ⇒ No numerical limitation!!

First instance: Osaka District Court, 2015 (Wa) 12965 <Takamatsu>

“The description at issue first points out the prior-art drawback that nozzles capable of spraying fine particles with a diameter of 10 μm or less clog extremely easily, then explains that the invention aims to solve that clogging problem, and further explains in the section on means for solving the problem ... that it ‘succeeds’ in spraying fine-particle droplets with a diameter of 10 μm or less. ... ‘Spraying a liquid as fine particles’ in the invention means that the thin-film flow of liquid pressed by high-speed air becomes fine droplets of 10 μm or less when it leaves the smooth or inclined surface.”—Limited to the numerical value in the description ⇒ Claim not satisfied

(6) IP High Court, 2011 (Ne) 10002, “(Cut) Rice Cake” case <Iimura> ⇒ Reversal finding literal claim satisfaction

≪Issue≫ Whether the claim “providing ... a groove on the peripheral side surface, which is the upright side face of the upper surface portion of this small rice-cake body, rather than the bottom resting surface or flat top surface of the cut rice cake” includes the accused product, which has “grooves” not only on the body's “peripheral side surface” but also on its “flat top surface.”

(i) There is no punctuation as in “rather than the bottom resting surface or flat top surface, on the peripheral side surface, which is the upright side face of the upper surface portion of this small rice-cake body.” (ii) “There is no passage in the detailed description ... explaining, for example, that forming cuts, etc. on the bottom resting surface or flat top surface prevents the above effects.” (iii) An amendment to “only on the peripheral side surface” was met with a notice of reasons for rejection on the ground of added matter, and the applicant withdrew it.

First instance: Tokyo District Court, 2009 (Wa) 7718 <Otaka> ⇒ Claim not satisfied

(i) “If the intention were not to exclude such an embodiment, the appropriate claim expression would have been ‘the ... peripheral side surface that is not the bottom resting surface or flat top surface.’” (ii) “The effect of being ‘capable of practical use without impairing the aesthetic appearance of the rice cake after grilling’ ... excludes embodiments with grooves on the bottom resting surface or flat top surface.” (iii) The applicant's written opinion, submitted with the withdrawal of the amendment and stating that the claim was not limited, did not affect the conclusion.

(7) IP High Court, 2014 (Ne) 10082, “Method for Manufacturing 4H-Type Single-Crystal Silicon Carbide” case <Takabe>

Neither the claims nor the description at issue contains language limiting the starting material charged into the crucible.

References “expressly stating that the material charged into the crucible is not limited to solid silicon carbide” (Exhibits Ko 14 and Ko 40-5)

Based on the descriptions in “books on semiconductor silicon carbide technology” (Exhibits Ko 3 and 25), the court found no fundamental difference between seeded sublimation recrystallization and the Lely method as to the starting material charged into the crucible.

“It cannot be said that interpretation should be limited only to the embodiments .... ‘Sublimation recrystallization’ ... also includes an embodiment using silicon and carbon as starting materials ... to form crystalline silicon carbide, and sublimating that silicon carbide to form single-crystal silicon carbide on the seed crystal.” ⇒ Reversal finding literal claim satisfaction

First instance: Tokyo District Court, 2011 (Wa) 23651 <Takano> ⇒ Claim not satisfied

“To solve a problem that could not be solved even by the improved Lely method introduced to obtain high-quality single-crystal silicon carbide, which uses silicon carbide powder as the raw material and performs sublimation recrystallization using a seed crystal, the invention adopted ... a method of heating and sublimating silicon carbide raw material, supplying it onto a seed crystal of single-crystal silicon carbide, and growing single-crystal silicon carbide on that seed crystal .... ‘Sublimation recrystallization’ ... means sublimating a polycrystalline solid raw material consisting of the same substance as the product (note: solid silicon carbide) and then crystallizing it to obtain a single-crystal product.”

(8) IP High Court, 2010 (Ne) 10089, “Method and Apparatus for Encrusting and Forming Food” case <Takizawa>

“Although the effects described assume that a pushing member enters the outer skin material to a certain depth, forms it into a ‘bowl shape,’ and then places the filling inside the bowl-shaped portion while the pushing member rises, they do not exclude other placement methods, and the claims impose no particular limitation on the manner of placement. ... If the pushing member enters the outer skin material to a certain depth, forms it into a ‘bowl shape’ (Element 1D), and supplies filling from the pushing member so that filling is placed in the outer skin material, ... the element is satisfied.” ⇒ Reversal finding claim satisfaction (another element satisfied by equivalence)

First instance: Tokyo District Court, 2009 (Wa) 1201 <Abe>

“The ‘pushing member’ in Invention 1 at Issue ... is contemplated to enter deeply into the outer skin material, to an extent requiring prevention of ‘the outer skin material stretching farther downward than necessary’ and ‘contraction of the outer skin material as the pushing member rises,’ and to form the outer skin material into a bowl shape while stretching its peripheral region. It means a member that forms the outer skin material into a ‘bowl’ shape with a depth approximately equal to the height of the formed product and discharges filling into the bowl-shaped portion formed by that member.”—The accused product's “nozzle member” does not constitute the “pushing member” ⇒ Claim not satisfied

(9) IP High Court, 2005 (Ne) 10119, “Range Hood Filter Device” case <Tsukahara>

Although there were grounds for invalidity, negligence in communicating or disseminating false facts under the Unfair Competition Prevention Act was denied because the claim was satisfied.

≪Caution≫ Negligence in communicating or disseminating false facts is not invariably denied simply because the patent is “invalid but the claim is satisfied”!!

“Given that Element (7) provides ‘formed into similar rectangular shapes in plan view,’ and that ‘similar shapes’ modifies ‘rectangular shapes in plan view,’ mere rectangularity cannot be construed as satisfying ‘similar shapes.’ However, construing ‘similar shapes’ with mathematical rigor would make even practicing the invention difficult. Ultimately, if the ratios of the lengths of the vertical and horizontal sides are approximately equal, the shapes can be considered similar.” ⇒ Reversal finding literal claim satisfaction (negligence in communicating or disseminating false facts denied)

First instance: Osaka District Court, 2005 (Wa) 1394 and 2005 (Wa) 3681 <Yamada>

“In ordinary usage, a square and a rectangle, or rectangles with markedly different length-to-width ratios, are not called ‘similar’ shapes .... Even considering the statement ... ‘The filter may have a similar shape corresponding to the planar shape of the metal filter or filter element. For example, the filter may be rectangular in plan view, corresponding to a rectangular metal filter or filter element’ ([0018]), ‘similar shapes’ cannot be understood as used in a sense different from ordinary usage.” ⇒ Claim not satisfied

(10) IP High Court, 2007 (Ne) 10025, “Seal Base Material” case <Tsukahara>

“Although the ‘core material’ ... is defined, insofar as the claim wording is concerned, as ‘consisting of transparent synthetic resin injected into the tubular body,’ its shape is not specifically prescribed. ... ‘Core material’ must exist inside the inner circumferential surface of the tubular body and inside the sheet body, but nothing further is prescribed. ... According to the description, ‘core material’ means a transparent synthetic resin injected in liquid form inside the sheet body within the tubular body and subsequently hardened by a solidification treatment ...; however, no wording ... indicating the limitation imposed by the original judgment ... that it must be located in the middle or center can be found. ... ‘Core’ also means ‘the essential part,’ and the synthetic resin here ... performs that function. Thus, even taking dictionary meanings into account, the original judgment's determination is inappropriate.” ⇒ Reversal finding literal claim satisfaction

First instance: Osaka District Court, 2005 (Wa) 3668 <Yamada>

“Linguistically, ‘core’ is also written with the character meaning ‘heart,’ and is generally understood from dictionaries to mean ‘the middle of an object: (1) the central (hard) portion of an object; (2) the essential part, foundation, or inherent nature; (3) fabric inserted in a collar, obi, etc. to maintain and arrange its shape; (4) in flower arrangement, the name of the principal central branch.’ Because the invention ... concerns a seal base material, ... ‘core’ is construed in sense (1), not (2), (3), or (4).” ⇒ Claim not satisfied

(11) IP High Court, 2008 (Ne) 10065, “Device for Automatically Creating Telephone Number Information” case <Iimura>

Other claim language and the technical level at filing (ISDN) led to reversal of the first-instance construction limited to the embodiments!!

“Given that the ‘connection signal’ in Element B ... should be understood as a broader concept encompassing both audible and inaudible signals, there is no basis for limiting the ‘response message’ in Element C to audible messages either. ... Since ISDN technology already existed at filing, and obtaining information returned from an ISDN network and determining telephone-number validity from it were known, a person skilled in the art encountering the description would not recognize the technical concept of the invention as being disclosed with ISDN technology excluded ....”—Not limited to voice messages!! ⇒ Reversal finding literal claim satisfaction

First instance: Tokyo District Court, 2007 (Wa) 32525 <Otaka> ⇒ Claim not satisfied

“In the description, ‘message’ is used to mean a voice announcement (voice communication) returned from an exchange. ... The expression ‘response message’ is not used, nor is there any disclosure or suggestion that the three types of telephone numbers can be identified and sorted using connection signals other than ‘voice messages.’”—Limited to voice messages

(12) ★ IP High Court, 2017 (Ne) 10027, “Financial Instruments Transaction Management Method” case <Mori>

* The identification of the accused method differs from that of the court below!! ⇒ Reversal finding literal claim satisfaction

“On Screen 2, the customer recognizes the ‘price interval’ between multiple orders and the ‘profit margin’ from the difference between the newly designated rate and the profit-taking rate, and after making changes as necessary can choose not to order by clicking ‘Back’ or ‘Cancel.’ Nevertheless, the customer can click

‘Order’ ... to place the order. The customer therefore inputs ‘information indicating the price interval’ and ‘information indicating the profit margin’ as buy/sell order application information ....”

First instance: Tokyo District Court, 2015 (Wa) 4461 <Shoji>

“Defendant's Service 1 ... has no field for inputting, as buy/sell order application information, the ‘profit margin’ when buying (selling) at a prescribed price and then selling (buying) at another price; it therefore does not receive and accept the ‘profit margin’ as buy/sell order application information.” ⇒ Claim not satisfied

(13) IP High Court, 2012 (Ne) 10023, “Apparatus for Processing Material with a Laser” case <Iimura>

* Claim construction is the same as in the court below. The accused product was found to use a “green laser”!!

“Considering that (i) the defendant's product uses a green laser, and even with a green laser, insufficient flow speed causing water to remain in the focus-cone tip region for a long time can lead over time to a thermal lens and damage to the nozzle wall, and (ii) measures to prevent nozzle-wall damage are required in the defendant's product, among other matters, the flow speed in the focus-cone tip region within its liquid reservoir can be said to be sufficiently high to suppress thermal-lens formation to the point where part of the laser beam does not damage the nozzle wall. The defendant's product therefore ... satisfies the element.” ⇒ Reversal finding literal claim satisfaction

First instance: Tokyo District Court, 2008 (Wa) 12409 <Otaka>

“‘Without a stagnation space’ means ... that the liquid flow speed is sufficiently high ... to suppress formation of a thermal lens that causes nozzle-wall damage .... ‘The liquid flow speed is sufficiently high’ means that the speed is high enough that ‘in the focus-cone tip region (56), thermal-lens formation is suppressed to the point where part of the laser beam does not damage the nozzle wall.’”—Causal relationship denied between the absence of damage and the configuration “without a stagnation space” ⇒ Claim not satisfied

≪(2) Claim Satisfied ⇒ Not Satisfied (Reversal against the Patentee)≫

(1) IP High Court, 2016 (Ne) 10031, “Oxaliplatin Solution Composition” case <Tsuruoka>

“The invention ... aims to provide an oxaliplatin solution composition containing fewer impurities ... than the Exhibit Otsu 1 invention, etc., and adopts as its solution a configuration containing a prescribed quantity of ‘oxalic acid ...’ as a ‘buffering agent’ .... The ‘buffering agent’ of the invention acts so that ... fewer impurities are produced than in the Exhibit Otsu 1 invention .... Dissociated oxalic acid naturally generated ... by decomposition of oxaliplatin naturally exists in the Exhibit Otsu 1 invention as well ....”

“In the embodiments too, the ‘buffering agent’ ... is added from outside .... Compared with ... Example 18(b), which is similar to the Exhibit Otsu 1 invention, ... only a significantly smaller quantity of impurities is produced ....”

⇒ The “buffering agent” does not include dissociated oxalic acid naturally generated by decomposition of oxaliplatin.

First instance: Tokyo District Court, 2015 (Wa) 12416 <Hasegawa>

No limitation in the claim. / Dissociated oxalic acid also functions as a buffering agent. / The embodiments are one factor to consider.

⇒ The “buffering agent” includes dissociated oxalic acid naturally generated by decomposition of oxaliplatin.

* Argument that including dissociated oxalic acid would negate novelty—the accuracy of the replication experiment was rejected.

(2) ★ IP High Court, 2009 (Ne) 10033, “Heat-Dissipating Sheet Made of a Thermally Conductive Silicone Rubber Composition” case <Nakano>

[Claim 1] “Thermally conductive inorganic filler ... 40 vol%–80 vol% of the total composition”

“The embodiments also show coupling treatment of the entire amount of thermally conductive inorganic filler before filling it into silicone rubber, and confirm the effect by comparison with entirely untreated filler. ... A person skilled in the art would understand ... that the entire amount undergoes coupling treatment ....”

⇒ If the entirely treated thermally conductive inorganic filler is “80 vol% or less,” the cured molded article can be prevented from becoming hard and brittle. Under the plaintiff's argument (that the amount excludes the coupling agent), even 1% surface-treated thermally conductive inorganic filler and 39–79% untreated filler would satisfy the claim, including configurations not producing the effects. ⇒ The numerical amount includes the coupling agent. ⇒ Claim not satisfied

First instance: Osaka District Court, 2006 (Wa) 11429 <Tanaka>

“Given the statement explaining the numerical limitation that ‘it is difficult to obtain high thermal conductivity below 40 vol%,’ what must be at least 40 vol% is the amount of the thermally conductive inorganic filler itself affecting thermal conductivity, not the amount including the coupling agent ....” ⇒ Accused product (GR-n) literally satisfies the claim

(3) IP High Court, 2006 (Ne) 10075, “Method of Inhibiting Decomposition of a Fluoroether Composition ...” case <Tanaka>

[Element D] A step of coating the inner wall surface of the container with a Lewis acid inhibitor that supplies electrons to the vacant orbital of a Lewis acid having a vacant orbital

[Accused method d] A step of coating the inner wall surface of the container ... with an epoxy phenolic resin lacquer

⇒ From the description, the purpose of the “Lewis acid inhibitor” was identified as inhibition through “neutralization.” Non-satisfaction was found even assuming that Lewis-acid inhibition could be achieved through a different causal mechanism.

IP High Court, 2008 (Gyo-Ke) 10276: “Enablement requirement not satisfied”—Since the concept of “Lewis acid” is unclear, the concept of a “Lewis acid inhibitor” donating electrons to that “Lewis acid's” vacant orbital is also unclear ....

First instance: Tokyo District Court, 2005 (Wa) 10524 <Shitara>

“Epoxy phenolic resin interacts with the vacant orbital of a Lewis acid, thereby blocking its potential reactive sites and inhibiting the Lewis-acid-induced decomposition of fluoroether compounds, such as sevoflurane, contacting that acid. It therefore constitutes ... the ‘Lewis acid inhibitor’ of the patented invention.” ⇒ Claim satisfied (no failure of enablement)

(4) ★ IP High Court, 2005 (Ne) 10047, “Chair-Type Air Massage Machine” case <Tsukahara>

The appellate court found no literal satisfaction ⇒ Doctrine of equivalents applied to a narrowed claim (the only such case in a Tokyo high court)

(Note) In this case, literal infringement was rejected, but infringement under the doctrine of equivalents was found for Accused Products 3 and 4. This does not mean that all of the patentee’s claims were dismissed.

⇒ Numerous cases at the Osaka District Court and Osaka High Court. Tokyo District Court, 2017 (Wa) 18184, “Osteotomy Spreader” <Sato>

“The description contains no suggestion of placing a bag on only one side of a leg and holding both legs together, or of a specific configuration for doing so; the embodiments and drawings disclose or depict only

configurations in which leg bags are arranged on both sides of each of the left and right legs. ... Considering also that, to achieve the objective ... of securely holding the legs with air bags, ... a configuration holding each leg from both sides with bags is more suitable, while holding both legs together with air-inflated bags is decidedly unstable, ‘the user's legs’ means ‘each of the left and right legs.’” ⇒ No literal satisfaction

First instance: Tokyo District Court, 2001 (Wa) 3485 <Iimura>

* The claim language is not limited to “a configuration in which leg bags are arranged on both sides of each of the left and right legs.” Nor is it limited by the embodiments, etc. ⇒ Literal satisfaction

(5) ★★★ IP High Court, 2020 (Ne) 10044, “Fluid Supply Device ...” case <Tsuruoka>

Problem of the invention—“Because the prepaid card cannot be seen, there is a risk that, after refueling, the user will forget that the prepaid card is inserted and leave the gas station with the card still there,” plus two other problems

((i) Whether a “judicial admission” was established) “... Whether an admission has been established should be examined in light of the party's answer as a whole .... Although the first-instance answer stated that satisfaction of Element 1C was ‘admitted,’ ... it should substantively be understood as arguing that the processing performed in the defendant's refueling device differs from the processing performed in Element 1C of Invention 1 at Issue ....”

((ii) No literal satisfaction) “... Unless the storage medium contemplates settlement combining ‘retention of the medium’ with ‘later deduction,’ the three problems at issue do not arise; consequently, the configuration of the invention cannot be said to achieve the effect of solving them. A storage medium that cannot contemplate settlement using that combination therefore does not constitute the ‘storage medium’ of the invention.” ⇒ Claim not satisfied

First instance: Tokyo District Court, 2017 (Wa) 29228 <Shibata>

* Judicial admission established for Element 1C

* Doctrine of equivalents satisfied for other elements

* Indirect infringement established for the program invention

(6) ★★★ IP High Court, 2017 (Ne) 10033, “Renovation Sliding Door Device” case <Tsuruoka>

Problem of the invention—“does not reduce the effective opening area”—“substantially the same height” = does not include a step

“‘Substantially the same height’ ... is understood as an expression intended also to include cases where dimensional or design tolerances, etc. prevent the two from being exactly ‘the same height.’ ... It does not include ... cases reaching a level that would be considered a ‘step’ .... The invention concerns ... ‘renovation,’ ... and interpreting ‘substantially the same height’ as including something deliberately installed during renovation ... that would be considered a ‘step’ would differ from a person skilled in the art's ordinary understanding. According to the evidence (Exhibits Otsu ...), ... step shapes with design dimensions of 3 mm or less are treated as ‘no step’ under barrier-free housing standards.” ⇒ Claim not satisfied

First instance: Tokyo District Court, 2014 (Wa) 7643 <Shoji>

Problem of the invention—“the degree ... of reduction of the effective opening area is substantially smaller than in the prior art”

“... Making the height ‘substantially the same’ is a configuration for achieving the effect of securing a large opening area .... In view of the above problem and effect, ... a difference substantially smaller ... than the height difference in the prior art ... can be regarded as ‘substantially the same height.’”

[Patents ★] Appeal in a Patent Infringement Injunction Action (Construction of “Multiple Chambers”—Product Invention Limited by “Capable of Communication” Not Satisfied, Method Invention without That Limitation Satisfied. Reversal of the First-Instance Finding That Neither Was Satisfied. Patentee Wins. - NAKAMURA & PARTNERS (nakapat.gr.jp)

<Article> “Injunctive Relief for Network-Related Inventions Whose Infringing Acts Span National Borders” (Ryu Yuasa, Patent Attorney; Patent Special Issue, Special Issue No. 26)

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12743218399.html

<Article> “Injunctive Relief for Network-Related Inventions Whose Infringing Acts Span National Borders” (Ryu Yuasa, Patent Attorney; Patent Special Issue, Special Issue No. 26)

(1) Internet Number case (IP High Court, March 24, 2010)

⇒ The invention at issue is not an invention of “access,” but of a “method of providing access.”

⇒ Although the server was in South Korea, patent infringement was found and an order to remove the server was issued.

(2) The 2001 WIPO recommendation that the use (location) of trademarks should be assessed by “commercial effect”

= It was recommended that whether use of a sign on the Internet is recognized as use in a particular country be determined by the presence or absence of “commercial effect.”

(3) The option of using site blocking to restrict access to services, etc. engaging in infringement

3834 (jpaa.or.jp)

Tokyo District Court, 2020 (Wa) 19924 <Sato> et al. [... Analgesic]—Use Invention Not Satisfied Because the Use Was Excluded; Correction Requirements Also Not Satisfied

Original Ameblo publication: 2022-05-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12743383652.html

Tokyo District Court, 2020 (Wa) 19924 <Sato>, 19932 <Sato>, 19918 <Tanaka>, 19919 <Kokubu> [Analgesic Containing Isobutyl GABA or Its Derivatives]

The use of the defendant's drug is a use excluded during prosecution.

⇒ The “use” limitation is not satisfied!!

“Even if there are cases in which it is difficult to determine what type of pain the patient is complaining of, ... that does not affect ... claim satisfaction.”

* Enablement requirement not satisfied

* Support requirement also not satisfied

* Correction requirements also not satisfied (without disclosure enabling practice so as to produce the effect, correction requirements for a use invention are not met) = IP High Court, 2020 (Gyo-Ke) 10135

(Excerpts from the judgment <(1) Claim satisfaction>)

Element 3B is “in the treatment of pain caused by inflammation or pain caused by surgery,” ... and Element 4B is “in the treatment of hyperalgesic pain due to inflammatory pain, or hyperalgesic or allodynic pain due to postoperative pain.” ... In the written submission ... filed with the JPO at the time of the correction, the plaintiff explained, among other things, that “in Corrected Inventions 3 and 4, the pain to be treated with the analgesic was limited to ‘pain caused by inflammation (inflammatory pain)’ and ‘pain caused by surgery (postoperative pain),’ which the advance notice of the trial decision found to satisfy the enablement and support requirements.” ... Thus, “pain caused by inflammation” and “pain caused by surgery” in Element 3B and “inflammatory pain” and “postoperative pain” in Element 4B all mean inflammatory or postoperative pain classified as nociceptive pain, and do not include neuropathic pain or fibromyalgia .... The defendant's drug has “neuropathic pain and pain associated with fibromyalgia as its indications and effects,” and does not target “pain caused by inflammation,” “pain caused by surgery,” “inflammatory pain,” or “postoperative pain”; it therefore does not satisfy Elements 3B and 4B. ...

The plaintiff argues that the defendant's drug, indicated for neuropathic pain, is used for pain caused by inflammation or surgery, on grounds including that tissue damage from inflammation or surgery causes neuronal sensitization, a functional abnormality of the nerves, leading to hyperalgesia and allodynia. However, even if neuronal sensitization can occur in nociceptive pain, this does not mean that the defendant's drug, indicated for “neuropathic pain and pain associated with fibromyalgia,” is used for pain caused by inflammation or surgery, etc. ...

The plaintiff argues that pain is a patient's subjective psychological state and that, in mixed pain, nociceptive and neuropathic pain constitute one pain in the same patient and cannot be distinguished. However, even if in actual clinical practice it is sometimes difficult to determine the type of pain a patient complains of, that does not alter the above conclusion concerning satisfaction of the claim elements.

(Excerpts from the judgment <(2) Enablement and support requirements>)

For a pharmaceutical use invention, merely identifying the substance, chemical structure, etc. generally makes it difficult to predict the usefulness of the use, and the drug cannot be used for that use. To satisfy

enablement, the detailed description must therefore disclose pharmacological test results enabling a person skilled in the art to understand the drug's usefulness. As held above, however, the description, etc. at issue contains no pharmacological test results enabling such a person to understand that the compound at issue is effective for treating hyperalgesic or allodynic pain due to neuropathic or psychogenic pain. ...

Even if hyperalgesia appearing in nociceptive pain, neuropathic pain, etc. can be said to be related to central sensitization caused by activation of spinal NMDA receptors, it is difficult to find that, at the patent filing date, it was common general technical knowledge that all hyperalgesia appearing in the nociceptive pain (inflammatory pain, postoperative pain, osteoarthritic pain associated with metastatic cancer, gout, burn pain, etc.) or neuropathic pain (trigeminal neuralgia, acute herpetic neuralgia, diabetic neuropathy, causalgia, etc.) described in the description, etc. resulted from functional nerve abnormalities consisting of sensitization of peripheral or central neurons. Still less can it be said that those passages, without pharmacological test results, enabled a person skilled in the art to recognize the compound's effectiveness in treating neuropathic pain.

(Excerpts from the judgment <(3) Correction requirements (for a use invention)>)

The correction relating to Invention 1 at Issue limits the targeted pain to “hyperalgesic or allodynic pain.” However, the description, etc. contains only test results relating to nociceptive pain. It does not disclose that the compound is effective for “hyperalgesic or allodynic pain due to neuropathy,” which is neuropathic pain, or “hyperalgesic or allodynic pain due to fibromyalgia,” included in psychogenic pain, nor is this self-evident from the description, etc. The same is true even considering common general technical knowledge at the patent filing date .... The correction relating to Invention 2 at Issue limits the pain treated by the analgesic to “hyperalgesic or allodynic pain due to neuropathy or fibromyalgia.” However, for the same reasons as above ..., this correction adds new matter not disclosed in the description, etc., and therefore fails the correction requirements ....

On the premise of the plaintiff's argument that Inventions 3 and 4 at Issue include “pain due to neuropathy” or “fibromyalgia,” the corrections relating to those inventions add new matter absent from the description and violate the correction requirements ....

IP High Court, 2020 (Ne) 10059 <Presiding Judge Honda> (Appeal) [Method of Manufacturing an Equol-Containing Extract ...]

Original Ameblo publication: 2022-05-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12743735915.html

IP High Court, 2020 (Ne) 10059 <Presiding Judge Honda> (Appeal) [Method of Manufacturing an Equol-Containing Extract ...]

The “filing date of the patent application for the patent at issue” could relate back to the priority date (also in relation to the defendant's method). (The conclusion differs from the original judgment on this point.)

Products publicly known only between the priority date and the parent application’s filing date were not considered; the product was held not to have been publicly known as of the priority date.

⇒ Article 104 of the Patent Act was applied!!

⇒ Reversal in favor of the patentee

(Passage concerning the “filing date of the patent application for the patent at issue”)

“A person skilled in the art encountering the above disclosure in Basic Applications A and B, together with the common general technical knowledge at the priority date, should be regarded as having been able to recognize that, even when ‘a raw material containing daidzeins’ other than ‘soybean hypocotyls’ is used as the fermentation material, allowing the ‘daidzeins’ in that material to be metabolized together with arginine by a microorganism capable of producing equol and ornithine, such as Lactococcus strain 20-92, can produce a powdered fermentation product for use as a food ingredient, containing at least 8 mg of ornithine and at least 1 mg of equol per gram of dry weight. The corrected invention at issue can therefore be read from Basic Applications A and B. Accordingly, it is at least an invention disclosed, or equivalent to one disclosed, in Basic Applications A and B, and should enjoy the effect of the priority claims based on those applications.

Accordingly, for application of Article 104 of the Patent Act, the patent at issue is deemed to have been applied for on the priority date .... In considering whether the product of the corrected invention was ‘not publicly known’ in Japan before the patent application under that Article, Exhibit Otsu B3 ..., published after the priority date, cannot be considered. ... The product of the corrected invention can be said to have been ‘not publicly known’ at the priority date. ... Since it has not been proven that the method of the corrected invention was not used to produce the appellees' raw material, the presumption under Article 104 cannot be found rebutted.”

(Passage concerning “not publicly known”)

“For a product to qualify as ‘publicly known’ under Article 104 of the Patent Act, there must, at the reference date, be facts known at least to an extent that gives a person skilled in the art a clue to manufacturing it. The product of the corrected invention cannot be said to have been disclosed in Exhibits Otsu B16 and B24, which were publicly known at the priority date, nor could the corrected invention readily have been conceived from either reference .... Thus, a person skilled in the art encountering Exhibit Otsu B16 or B24 at the priority date cannot be said to have obtained a clue to manufacturing the product of the corrected invention.

The appellees also argue that the product of the corrected invention is ‘publicly known’ because it is merely ‘992 mg’ of the fermentation product of ‘Example 1’ in Exhibit Otsu B16, in which ‘1–3 mg of equol is produced per gram of dry weight,’ with ‘8 mg’ of ornithine of ‘97.48%’ purity added as a

nutritional fortification additive (the international publication of Exhibit Otsu B67, WO2006/051940). However, ... the product of the corrected invention is ‘a powdered fermentation product containing ornithine and equol, in which at least 8 mg of ornithine and at least 1 mg of equol are produced per gram of dry weight of the fermentation product, used as a food ingredient.’ Even combining Exhibit Otsu B67 with Exhibit Otsu B16 does not yield a product in which ‘at least 8 mg of ornithine and at least 1 mg of equol were produced per gram of dry weight of the fermentation product.’ The appellees' argument therefore cannot be accepted.”

<Some Observations>

In this decision (the appellate judgment), the presumption concerning a process for producing a new substance under Article 104 of the Patent Act was recognized, and the patentee won.

Of that Article's requirements, “before the patent application,” where a priority claim is recognized, means before the priority date (the filing date of the basic application). In this case, the description of the basic applications disclosed only “soybean hypocotyls” as the fermentation material, not daidzeins other than soybean hypocotyls. On those facts, the first-instance judgment took a partial-priority approach: the “patent application” date was the priority date only for “an invention in which the fermentation material is soybean hypocotyls,” whereas for “an invention in which the fermentation material is daidzeins other than soybean hypocotyls,” the “filing date of the patent application for the patent” did not relate back to the priority date. The appellate judgment, by contrast, held that the problem-solving mechanism disclosed in the basic applications' descriptions applies equally whether the fermentation material is “soybean hypocotyls” or “daidzeins other than soybean hypocotyls.” Thus, even for “daidzeins other than soybean hypocotyls” as in the defendant's product, the “filing date of the patent application for the patent” was the priority date, and products becoming publicly known after that date were not “publicly known products” under Article 104.

In applying “publicly known product” under Article 104, the appellate judgment held: “Since the product of the corrected invention is ‘a powdered fermentation product containing ornithine and equol, in which at least 8 mg of ornithine and at least 1 mg of equol are produced per gram of dry weight of the fermentation product, used as a food ingredient,’ even combining Exhibit Otsu B67 with Exhibit Otsu B16 does not yield a product in which ‘at least 8 mg of ornithine and at least 1 mg of equol were produced per gram of dry weight of the fermentation product.’” Under this logic, narrowing the claim wording by amendment or correction so that “the defendant's product just barely falls within it,” irrespective of inventive step, makes it harder for past publicly known products to fall within “publicly known products” under Article 104. This should be kept in mind when enforcing a patented process for producing a new substance. Conversely, for defendants, the appellate judgment does not reject, in the first place, the very possibility of asserting a product combining products disclosed in two references as a “publicly known product.” Thus, a “publicly known product” under Article 104 may include one obtainable by combination, as in an inventive-step analysis, even if it was not known in a manner depriving it of novelty. In this sense, “publicly known product” under Article 104 is a concept encompassing inventive-step-like arguments for both patentees and accused infringers.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90953.pdf

2018 (Wa) 18555 <Tanaka> (First instance)

[Method of Manufacturing an Equol-Containing Extract ...]

* The “filing date of the patent application for the patent at issue” cannot relate back to the priority date (in relation to the defendant's method) ...

⇒ Article 104 of the Patent Act inapplicable because of products becoming publicly known between the priority date and the parent application's filing date

* Partial-priority approach ⇒ The defendant's method is an embodiment not covered by partial priority.

[New YouTube Video] Incorporating Effects into Claims (Inventive Step)

Original Ameblo publication: 2022-05-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12744262223.html

[New YouTube Video] Incorporating Effects into Claims (Inventive Step)

* Where an invention's “effect” is incorporated into a claim, the great majority of decisions recognize it as a feature defining the invention unless the configuration necessarily produces that effect.

* In the Examination Guidelines and the inventions in the decisions in which an “effect” stated in a claim was not recognized as a defining feature, the claimed “effect” does not further specify the product (its configuration, use, etc.), and is therefore not recognized as such a feature.

On the other hand, * in the great majority of inventions in decisions recognizing an “effect” stated in a claim as a defining feature, that claimed “effect” further specifies the product (its configuration, use, etc.).

* Further, the above-cited IP High Court decisions in 2017 (Gyo-Ke) 10041, “Hot-Pressed Member,” and 2020 (Gyo-Ke) 10015, “... Novel Formulation,” adopt a framework recognizing inventive step unless the claimed “effect” was one that a person skilled in the art could recognize at the priority date. Further case law is awaited on whether an “effect” can become a defining feature even without further specifying the product (its configuration, use, etc.).

(9) [Patents] Incorporating Effects into Claims (Inventive Step) - YouTube

[New YouTube Video] Offers to Assign (Etc.) (Place (Domestic or Overseas) + Timing (Offers Shortly before Expiration))

Original Ameblo publication: 2022-05-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12744437118.html

[New YouTube Video] Offers to Assign (Etc.) (Place (Domestic or Overseas) + Timing (Offers Shortly before Expiration))

(1) Must an act of “offering to assign” take place within Japan?

⇒ Japan—yes (IP High Court, 2010 (Ne) 10001, “Motor,” Presiding Judge Nakano—a case concerning international jurisdiction)

⇒ United States—not necessary? (Is it enough that the “assignment” takes place within the US?) (Transocean decision (2010))

(2) Can an “offer to assign” be established even if the “assignment” takes place abroad?

⇒ Japan—most academic views hold that no “offer to assign” is established.

* “Method of Producing L-Glutamic Acid” case—“all overseas sales were intended to be sales to buyers in Japan.” Special circumstances existed.

⇒ United States—not established unless the intended future place of sale is within the US (TAOS decision (2018))

* Meaning of (“domestic”) “assignment”—both “transfer of possession” and “transfer of ownership”?

⇒ If the product itself is abroad, does concluding the sales contract domestically still fail to establish a “domestic” assignment? (There is a similar US district court decision.)

(3) Where “assignment” is planned for after expiration of the patent term ⇒ Infringement established

(4) Other matters ⇒ A “general standard” for website presentations constituting “offers to assign” (IP High Court, 2015 (Ne) 10109)

(10) [Patents] Offers to Assign (Etc.) (Place (Domestic or Overseas) + Timing (Shortly before Expiration)) - YouTube

IP High Court, 2020 (Gyo-Ke) 10122 [Method of Improving Myocardial Performance in Fontan Patients Using a Udenafil Composition] <Kanno>

Original Ameblo publication: 2022-05-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12744630707.html

IP High Court, 2020 (Gyo-Ke) 10122 [Method of Improving Myocardial Performance in Fontan Patients Using a Udenafil Composition] <Kanno>

* Problem of the invention: “improving” exercise tolerance—a pharmaceutical use invention

(The description distinguishes “maintenance” from “improvement.”)

⇒ The description must enable a person skilled in the art to understand that it can be used for “improvement.”

Enablement requirement not satisfied

* Support requirement also not satisfied

(Excerpts from the judgment)

... A person skilled in the art encountering the application's description can be said to understand that the regimen at issue can bring about improved exercise tolerance. (The description distinguishes cases where peak-exertion VO2 values are “maintained” from those where they are “improved” ([0078]); a person skilled in the art can therefore be said to understand that mere “maintenance” of peak-exertion VO2 values is not included in “improvement.”) ...

The claimed invention ... is a pharmaceutical composition administering a specified amount of udenafil to Fontan patients, based on the hypothesis that administering a PDE5 inhibitor with a longer half-life than sildenafil prevents or improves the decline in aerobic capacity after Fontan surgery, to improve exercise tolerance measured by peak-exertion VO2 in patients who have undergone that surgery, and because the PDE5 inhibitor udenafil may be useful as once-daily treatment for various conditions. It is therefore a pharmaceutical use invention. To satisfy enablement, the application's detailed description must enable a person skilled in the art to understand that administering udenafil or a pharmaceutically acceptable salt thereof at 87.5 mg per dose, twice daily, can be used to improve exercise tolerance measured by peak-exertion VO2 in patients who have undergone Fontan surgery. ...

The plaintiff argues that some patients actually experienced substantial improvement in symptoms .... However, the description presents the test results in Example 3 as a whole. Considering that disclosure as a whole, it cannot be said that a person skilled in the art would understand that the regimen could be used to improve exercise tolerance measured by peak-exertion VO2 in patients who have undergone Fontan surgery ....

[Copyright Law—“Architecture” Not Copyrightable] IP High Court, 2021 (Ne) 10044 <Otaka>

Original Ameblo publication: 2022-05-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12744790766.html

[Copyright Law—“Architecture” Not Copyrightable] IP High Court, 2021 (Ne) 10044 <Otaka>

“Because the ‘architecture’ to which the plaintiff's slide belongs is analogous to applied art, its copyrightability is assessed ... by a standard similar to that for applied art.”

* Copyrightability as “applied art” also denied

= Osaka High Court, 2003 (Ne) 3575, “Grenier Dyne case”

[Copyright Law ★] A Case Denying Copyrightability Both as an Artistic Work and as an Architectural Work for “Mini Octopus,” an Octopus-Shaped Playground Slide Made by the Appellant (Plaintiff) - NAKAMURA & PARTNERS (nakapat.gr.jp)

[Copyright Law—“Architecture” Not Copyrightable] Osaka High Court, 2003 (Ne) 3575, “Grenier Dyne Case”

Original Ameblo publication: 2022-05-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12744978011.html

[Copyright Law—“Architecture” Not Copyrightable] Osaka High Court, 2003 (Ne) 3575, “Grenier Dyne Case”

“For an ordinary residence to be protected as an ‘architectural work’ under copyright law, ... it must independently be an object of aesthetic appreciation ... and possess artistic qualities as plastic art.”

= IP High Court, 2021 (Ne) 10044 <Otaka> “Octopus Slide”

Patent Attorneys' Copyright Information Room: What Is an Architectural Work?—The Grenier Dyne Case —| Innovations I BtoB Business Media (innovations-i.com)

IP High Court, 2020 (Gyo-Ke) 10150 [Equol-Containing Fermented Soybean Hypocotyl Product] <Honda>

Original Ameblo publication: 2022-05-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12745319527.html

IP High Court, 2020 (Gyo-Ke) 10150 [Equol-Containing Fermented Soybean Hypocotyl Product] <Honda>

(1) Novelty: yes

The fermentation materials and conditions differ between Table 3 of the description at issue and the test examples in the cited reference.

⇒ The amount of ornithine per gram of dry weight also changes.

IP High Court, 2019 (Ne) 10015 <Otaka>: narrow construction ⇒ Claim not satisfied

(2) Inventive step: yes

The factors considered when finding an invention obvious by applying a secondary cited invention to a primary cited invention also apply when determining whether it could readily have been invented by applying well-known technology to a cited invention.

(3) Divisional application requirements: satisfied

[(Corrected) Claim 1] A method of manufacturing ... at least 8 mg of ornithine and at least 1 mg of ... per gram of dry weight of the fermentation product

—Only the lower limit of “8–15 mg” in the original description was incorporated into the claim.

(Excerpts from the judgment)

<Violation of the delegated ministerial-ordinance requirement>

... The plaintiff points out that paragraph [0010] under [Problem to Be Solved by the Invention] in the description contains no mention of ornithine. However, ... Article 24-2 of the Regulations under the Patent Act concerns the “statement of the detailed description of the invention,” so it is sufficient that the matter can be understood from the description as a whole; the matters necessary to understand the invention's technical significance need not necessarily appear in the “Problem to Be Solved by the Invention” section.

<Divisional application requirements>

... Paragraph [0050] of the original description states: “Specific examples of the ornithine content in the equol-containing fermented soybean hypocotyl product are approximately 5–20 mg, preferably 8–15 mg, and more preferably 9–12 mg of ornithine per gram of dry weight of the equol-containing fermented soybean hypocotyl product.” It thus states a preference for 8–15 mg of ornithine per gram of dry weight. Configuration (iii) above can be said to be specified by the lower limit of the “8–15 mg” exemplified in the original description.

<Novelty>

... The plaintiff's argument assumes that Table 3 of the description shows conversion from arginine to ornithine well over 100% (approximately 159%). However, ... the fermentation materials and conditions differ. The fermentation product's dry weight can vary greatly with the solid content of the fermentation materials and culture medium, so changing the fermentation material also changes the amount of ornithine per gram of dry weight. Thus, the ornithine yield per gram of dry weight can vary greatly between using soybean hypocotyl solution and using soy milk as the fermentation material. The conversion rate from arginine to ornithine can also differ with culture conditions. Accordingly, it is inappropriate to rely on Table

3 of the description in estimating ornithine production in the test examples of Exhibit Ko 1. ... Because the composition of the BHI broth used as the medium in those examples is unspecified, the Exhibit Ko 1 invention does not necessarily produce at least 8 mg of ornithine per gram of dry weight .... It therefore cannot be said to “produce at least 8 mg of ornithine per gram of dry weight of the fermentation product.”

<Inventive step>

... When determining whether the claimed invention could readily have been made by applying a secondary cited invention to a primary cited invention, it is appropriate (i) to assess motivation to apply the secondary invention to the primary invention and arrive at the claimed invention by comprehensively considering suggestions within either invention, relationships between technical fields, commonality of problems, actions or functions, etc.; and (ii) also to consider factors obstructing application, unpredictable remarkable effects, etc. (see IP High Court judgment of April 13, 2018 [2016 (Gyo-Ke) 10182 and 10184]). This also applies when determining whether the claimed invention could readily have been made by applying well-known technology to a cited invention.

090780_hanrei.pdf (courts.go.jp)

[Trademark Rights] Osaka District Court, 2019 (Wa) 784, “Takoyaki Kobo Case”

Original Ameblo publication: 2022-05-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12745500719.html

[Trademark Rights] 2019 (Wa) 784, “Takoyaki Kobo Case”

Defendant's business: since 1994

Plaintiff's (trademark owner's) business: since 1997

Application filed in 2002

As of 2002, the defendant's sign was not found to have been “widely recognized among consumers” as indicating the defendant's goods or services.

⇒ Prior-use right not established

★ The importance of filing trademark applications

090322_hanrei.pdf (courts.go.jp)

Tokyo District Court, 2019 (Wa) 7470, 7476 [... Graphitic Carbon Material] <Sato>

Original Ameblo publication: 2022-06-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12745869166.html

Tokyo District Court, 2019 (Wa) 7470, 7476 [Graphitic Carbon Material Used as a Graphene Precursor] <Sato>

If a publicly worked product falls within the numerical limitation, public working is established even without recognition of that fact (not disputed).

The defendant's products (publicly worked products) were:

not subject to a prohibition on resale;

generally sold graphite powder;

outside the scope of nondisclosure agreements.

X-ray diffraction is not explained even in the description at issue.

(Excerpts from the judgment)

[Claim 1] ... A graphitic carbon material ... having Rate(3R) of 31% or more. Rate(3R) = P3 / (P3 + P4) × 100 ... (Equation 1), where P3 is the peak intensity of the (101) plane of the rhombohedral graphite layer (3R) measured by X-ray diffraction, and P4 is the peak intensity of the (101) plane of the hexagonal graphite layer (2H) measured by X-ray diffraction.

The defendant's products ... are graphite powders used in conductive materials, conductive paints, etc., and there is no indication that their resale was prohibited .... It is difficult to consider purchasers obligated to keep secret the physical properties of graphite powders such as those products. ... There is insufficient evidence that the defendants concluded nondisclosure agreements imposing such an obligation on customers. The plaintiff submits sample basic agreements ... as evidence, but those agreements merely prescribe confidentiality for “the other party's technical information and business secrets” ...; the sample basic agreements ... submitted by the defendant likewise cover only “business-related confidential matters.” The plaintiff also submits ... a confidentiality agreement ... concluded with Defendant Nippon Graphite Industries, but it concerns “consideration” of matters such as “joint technical development” ... and does not establish that product purchasers owe a confidentiality duty. It is difficult to regard the physical properties of generally sold graphite powder, such as the defendant's products ..., as automatically subject to such a duty. ...

The plaintiff argues that, even if the defendants sold their products ... before the applications at issue, neither the defendants nor their customers possessed technology allowing them to analyze the products and determine whether they fell within the claims of the inventions at issue. However, X-ray diffraction appears to be a general method of analyzing substances, as indicated by its mention without particular explanation in the descriptions, etc. It is found that measurement and analysis could have been outsourced to an external provider. ...

090941_hanrei.pdf (courts.go.jp)

Tokyo District Court, 2020 (Wa) 8506 [Work Gloves for Electrical Work] <Sato>

Original Ameblo publication: 2022-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746044679.html

Tokyo District Court, 2020 (Wa) 8506 [Work Gloves for Electrical Work] <Sato>

“The plaintiff ... argues, on the premise that the “irregularities” must have been intentionally formed, that they are merely “surface roughness” inevitably arising in manufacture. However, ... the irregularities on the surface of the Exhibit Otsu 1 gloves ... cannot be said to have arisen inevitably in manufacture, but were intentionally formed.”

⇒ Does public working require intentional formation?

Even exclusive sales amount to “disclosure to a third party” and constitute public working. (* No evidence establishing a nondisclosure agreement)

The surface irregularities of the publicly worked product were intentionally formed.

Other matters not limited by the claim language are not differences.

(Excerpts from the judgment)

[Claim 1] ... Work gloves for electrical work, characterized by irregularities formed along the fibers and mesh portions of the fabric body.

The plaintiff argues that Tohoku Electric Power was a joint developer because the design of the Exhibit Otsu 1 product was based on its workers' requests. However, Tohoku Electric Power merely collected its workers' opinions and requests about revising the size of the previous product and conveyed the results to Defendant Yotsugi. There is no other sufficient evidence that Tohoku Electric Power jointly developed the Exhibit Otsu 1 product with Yotsugi. ...

The plaintiff argues that Tohoku Electric Power was the exclusive purchaser of the Exhibit Otsu 1 product and would not disclose the Exhibit Otsu 1 invention to third parties under commercial custom. However, there is no evidence establishing such a custom. Yotsugi sold the product to Tohoku Electric Power and transferred ownership, and there is insufficient evidence that Tohoku Electric Power had a duty not to disclose the configuration of its purchased products to third parties. In fact, the product was used by Tohoku Electric Power's on-site workers, so the invention's content must be regarded as having been disclosed to third parties ....

The plaintiff argues, on the premise that the “irregularities” in Element H must have been intentionally formed, that they are merely “surface roughness” inevitably arising in manufacture. However, ... the surface of the Exhibit Otsu 1 gloves displays a mesh-like pattern formed by the knit fabric in the intermediate portion, with irregularities along the fibers and mesh portions of the fabric body. They therefore cannot be said to have arisen inevitably in manufacture, but must be regarded as intentionally formed. ...

The plaintiff argues ... . However, ... Element E ... is not limited to ... .

090942_hanrei.pdf (courts.go.jp)

IP High Court, 2020 (Gyo-Ke) 10004 [Agent for Treating or Preventing Osteoporosis] <Kanno>

Original Ameblo publication: 2022-06-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746221883.html

IP High Court, 2020 (Gyo-Ke) 10004 [Agent for Treating or Preventing Osteoporosis] <Kanno>

= IP High Court, 2020 (Gyo-Ke) 10038 <Kanno>

* Limiting the treated patients (50 or more and less than 80) is obvious.

The deliberation results report classifies renal impairment using creatinine clearance as the indicator: “80 or more,” “50 or more and less than 80,” “30 or more and less than 50,” and “less than 30.”

(Excerpts from the judgment)

... Since Condition (4) at Issue merely selects from osteoporosis patients the group satisfying all Three Conditions at Issue and confirms safety in that group, the Three Conditions and Condition (4) can be understood as independent conditions serving different purposes. The plaintiff argues that the Four Conditions are organically combined into a single whole, but ... that argument cannot be accepted. ...

... A person skilled in the art encountering Exhibit Ko 7's express exclusion of patients with severe renal impairment would recognize that the treated patients in the Exhibit Ko 7 invention include a substantial number with mild or moderate renal impairment .... Further, ... it is clear that safety confirmation in patients with renal impairment was also required for osteoporosis drugs. Thus, a person skilled in the art encountering the Exhibit Ko 7 invention would naturally focus on the treated patients' renal function; doing so is nothing exceptional. ...

Exhibit Ko 10 defines patients with “mild” renal impairment as those with “GFR 50–79 ml/min,” treating patients with creatinine clearance of 50–79 ml/min as mildly impaired. ... The deliberation results report ... classifies renal impairment by creatinine clearance along those values as “80 or more,” “50 or more and less than 80,” “30 or more and less than 50,” and “less than 30” .... Accordingly, selecting from the treated patients of the Exhibit Ko 7 invention those with ... “50 or more and less than 80 ml/min” would present no difficulty to a person skilled in the art.

090548_hanrei.pdf (courts.go.jp)

IP High Court, 2020 (Gyo-Ke) 10123 [Fuel Cell System] <Honda>

Original Ameblo publication: 2022-06-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746440268.html

IP High Court, 2020 (Gyo-Ke) 10123 [Fuel Cell System] <Honda>

* It is not obvious to change a cited invention detecting a malfunction into a configuration checking periodically.

⇒ Inventive step: yes (rejection decision revoked)

(Difference)

The “prescribed condition” for adjusting gas flow is:

Claimed invention—“periodically”

Cited invention—“output voltage below approximately 0.4 V”

(Excerpts from the judgment)

It is difficult to say that a person skilled in the art could readily conceive of performing “periodically,” irrespective of whether the actual output has changed to or above the threshold, the cited invention's operation “when the fuel cell output voltage falls below 0.4 V,” which specifically detects a condition indicative of fuel-cell malfunction .... Exhibit Ko 3 ... contains descriptions other than ... “when [the voltage] falls to a range below approximately 0.4 V,” but the other characteristic parameters listed likewise remain within the category of detecting a condition indicative of fuel-cell malfunction. Reference to the well-known matter ... of periodically increasing the fuel cell's moisture level does not alter this conclusion.

090621_hanrei.pdf (courts.go.jp)

<South Korea> Manufacturing According to a Prior Reference “Necessarily” Produces the Same Product as the Patented Invention ⇛ No Novelty

Original Ameblo publication: 2022-06-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746441185.html

<South Korea>

If it is proven that manufacture according to the production method described in the prior reference “necessarily” produces the same product as the patented invention, novelty is denied.

Supreme Court, 2017 Hu 1304

Japan takes the same approach, but proving “necessity” is difficult.

⇒ The hurdle is high already at the stage of showing that the replication experiment follows the same manufacturing method as the prior reference.

Subsequently Submitted Technical Materials (Experimental Certificates) and Patentability Assessment | Literature Information | J-GLOBAL Science and Technology Link Center (jst.go.jp)

<Trademarks> IP High Court, 2021 (Gyo-Ke) 10113, “Sleep Consultant” (Shoji)

Original Ameblo publication: 2022-06-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746755250.html

<Trademarks> IP High Court, 2021 (Gyo-Ke) 10113, “Sleep Consultant” (Shoji)

The mark consisting of the horizontally written words “Sleep Consultant” is a necessary and appropriate indication in trade describing the quality of the designated services, and when used for those services, traders and consumers generally recognize it as indicating the quality

of the services.

⇒ Falls under Article 3(1)(iii) of the Trademark Act

[Trademark Law ★] A Case Upholding the JPO's Rejection Decision, Finding That the Mark Consisting of the Horizontally Written Words “Sleep Consultant” Is a Necessary and Appropriate Indication in Trade Describing the Quality of Designated Services Including Class 41 “Instruction in Arts, Crafts, Sports or Knowledge; Arranging, Conducting or Organizing Seminars; Providing Electronic Publications; Producing Books,” and Is Generally Recognized by Traders and Consumers as Indicating Service Quality When Used for Those Services, Thus Falling under Article 3(1)(iii) of the Trademark Act - NAKAMURA & PARTNERS (nakapat.gr.jp)

[New YouTube Video] ++ Doctrine of Equivalents (Integrated Edition) + Five Judgments Recognizing Equivalence since the 2020 Recording Added!!

Original Ameblo publication: 2022-06-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746775127.html

[New YouTube Video] ++ Doctrine of Equivalents (Integrated Edition) + Five Judgments Recognizing Equivalence since the 2020 Recording Added!!

In addition to the four previous videos (first and second requirements, third requirement, fifth requirement, and introduction to decisions recognizing equivalence),

five judgments recognizing equivalence since the 2020 recording have been added!!

(13) 2016 (Wa) 21762

(14) 2017 (Wa) 29228

(15) 2017 (Wa) 32839

(16) 2016 (Wa) 25436

(17)´ IP High Court, 2021 (Ne) 10040

[Patents] ++ Doctrine of Equivalents (Integrated Edition) + Judgments Recognizing Equivalence since the 2020 Recording Added#DoctrineOfEquivalents, #Maxacalcitol, #Estoppel, #Dedication, #DoubleStandard, #DOE [Patents] ++ Doctrine of Equivalents (Integrated Edition) + Judgments Recognizing Equivalence since the 2020 Recording Added (1) (First and Second Requirements) Maxacalcitol Grand Panel Judgment + α (2) (Third Requirement) Double Standard (3) (Fifth Requirement) (i) Dedication doct...www.youtube.com

[US Patents] January 2022 CAFC: Nature Simulation v. Autodesk

Original Ameblo publication: 2022-06-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12746939374.html

[US Patents] January 2022 US CAFC: Nature Simulation v. Autodesk

Definiteness was assessed using the claims, specification, prosecution history, and the understanding of a person of ordinary skill, including the examiner-proposed amendment that led to allowance. Examiner involvement alone does not conclusively establish definiteness.

⇒ The first-instance finding of indefiniteness was reversed.

(Judge Dyk dissented.)

“Search for multiple neighboring triangles”

“Modified Watson method”

January 2022 Federal Circuit Newsletter (Japanese).pdf (knobbe.com)

[US Patents] 1961 US Supreme Court: ARO v. Convertible Top Replacement

Original Ameblo publication: 2022-06-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747115379.html

[US Patents] 1961 US Supreme Court: ARO v. Convertible Top Replacement

⇒ The conduct in that case was held to be “repair.”

* “Reconstruction” occurs in cases of “such a true reconstruction of the entity as to "in fact make a new article," after the entity, viewed as a whole, has become spent.”

US Supreme Court Sets a High Standard: Proving Inducement of Patent Infringement Requires Knowledge or Willful Blindness - News | Morrison & Foerster (mofo.jp)

Opinion (365 U.S. 336 (1961), U.S. Reports, Library of Congress):
https://tile.loc.gov/storage-services/service/ll/usrep/usrep365/usrep365336/usrep365336.pdf

[US Patents] June 2008 US Supreme Court: Quanta v. LG Electronics

Original Ameblo publication: 2022-06-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747281272.html

[US Patents] June 2008 US Supreme Court: Quanta v. LG Electronics

Patent rights for method inventions are also “exhausted.”

For assignment of a product subject to indirect infringement, where it “substantially embodies” the patent, the licensee's sale of the component exhausts the patent right.

= Close to the requirements for indirect infringement (in Japan).

Transfer of Indirectly Infringing Products and “Exhaustion” of Patent Rights (jpaa.or.jp)

[US Patents] May 2017 US Supreme Court: IMPRESSION PRODUCTS v. LEXMARK

Original Ameblo publication: 2022-06-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747464347.html

[US Patents] May 2017 US Supreme Court: IMPRESSION PRODUCTS v. LEXMARK

After the patentee sold the products subject to a single-use condition, they were refilled with ink, etc. and sold.

⇒ Exhaustion established (citing the Supreme Court's Quanta judgment)

US patent rights are also exhausted for products sold outside the United States (* different from Japan!!).

The contract's binding effect as a contractual obligation is recognized.

324a18_166eedf312b84aa9b36e2d0765082189.pdf (takaishihideki.com)

[US Patents] April 2007 US Supreme Court: KSR v. Teleflex

Original Ameblo publication: 2022-06-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747733493.html

[US Patents] April 2007 US Supreme Court: KSR v. Teleflex

While endorsing the TSM test (teaching-suggestion-motivation test), the Court held that the CAFC's rigid TSM test was erroneous.

Any need, problem, etc. can also be incorporated into the TSM test.

070430.pdf (jetro.go.jp)

(57) [US Patents] Non-Obviousness (35 USC §103) (Corresponding to “Inventive Step” in Japan) - YouTube

[US Patents] March 2010 US CAFC: Jeffrey Griffin v. Heidi Marrin

Original Ameblo publication: 2022-06-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747737217.html

[US Patents] March 2010 US CAFC: Jeffrey Griffin v. Heidi Marrin

Even stating the intended use “for permitting a user to write thereon without the use of a marking implement” in the preamble does not establish novelty.

(In this case, the intended use stated in the preamble of the product claim was held not to limit the claim's scope and therefore did not establish novelty.)

2008 yokoben 2 (2008.3.30).pdf (ebiaya.com)

[US Patents] July 2010 US CAFC: In re Giacomini, et al.,

Original Ameblo publication: 2022-06-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12747998820.html

[US Patents] July 2010 US CAFC: In re Giacomini, et al.,

Under 35 USC §102(e), even an earlier application unpublished at the priority date has an effect excluding later applications once it is subsequently published or patented. Where the present application's priority date falls between the earlier application's provisional and nonprovisional filing dates, the reference date for the earlier application's effect in excluding later applications is its provisional filing date.

■ Patents / §102(e) / Determining the Effective Prior-Art Date of a Patent Claiming Priority to a Provisional Application | NGB Corporation

[US Patents] November 2012 US CAFC: Voter Verified v. Premier

Original Ameblo publication: 2022-06-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12748362948.html

[US Patents] November 2012 US CAFC: Voter Verified v. Premier Election

A document publicly accessible on the Internet can qualify as a “printed publication” even without evidence of indexing. In this case, the reference rendered claim 49 obvious.

https://law.justia.com/cases/federal/appellate-courts/cafc/11-1553/11-1553-2012-11-05.html

IP High Court, 2020 (Ne) 10057 <Otaka>, “Ricoh Case” ⇛ First-Instance Finding of an Antimonopoly Act Violation Changed!!

Original Ameblo publication: 2022-06-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12748421034.html

IP High Court, 2020 (Ne) 10057 <Otaka>, “Ricoh Case”

⇒ The first-instance judgment finding an Antimonopoly Act violation and treating the injunction and damages claims as an abuse of rights was changed!!

“Even when remanufactured cartridges are installed in the plaintiff's printers, the remaining-toner display shows ‘?’ together with ‘Printing is possible.’ Users can therefore readily recognize that the remaining amount is not displayed because the cartridge is remanufactured, and are not found to harbor concerns that printing functionality is impaired .... Some users choose remanufactured products in light of the above functional difference—the absence of a remaining-toner display—and the price difference from genuine products.”

“By devising the shape of the electronic components, it is technically possible to manufacture components outside the technical scope of Inventions 1 through 3 at Issue, replace the plaintiff's electronic components with them, avoid infringement of the patents, and enable remaining-toner display.”

<Conclusion>

⇒ “It cannot be found that the sole purpose was to exclude recycled products from the market.”

“It cannot be found that the appellant, by an unreasonable and unnecessary act in the form of the rewriting restriction at issue, forced the appellees to remove the plaintiff's electronic components installed in the plaintiff's products and replace them with the defendants' components, thereby preventing the above exhaustion. Considering comprehensively the above findings and all other circumstances appearing in this case, the appellant's exercise against the appellees of injunction and damages claims based on the patents in relation to the defendants' electronic components cannot be said to contravene the Antimonopoly Act as interference with a competitor's transactions (Articles 19 and 2(9)(vi) of that Act; paragraph 14 of the General Designation). Nor can it be said to impede ‘the development of industry,’ the purpose of the Patent Act, or depart from the purpose of the patent system. Accordingly, it cannot be regarded as an abuse of rights.”

https://www.ip.courts.go.jp/app/hanrei_jp/list?filter%5Bkeyword1%5D=&filter%5Bkeyword2%5D=&filter%5Bkeyword3%5D=&filter%5Bkeyword4%5D=&filter%5Bkeyword5%5D=&filter%5Bkeyword6%5D=&filter%5Bkeyword7%5D=&filter%5Bkeyword8%5D=&filter%5Bkeyword9%5D=&filter%5BjudgeGengoFrom%5D=&filter%5BjudgeYearFrom%5D=&filter%5BjudgeMonthFrom%5D=&filter%5BjudgeDayFrom%5D=&filter%5BjudgeGengoTo%5D=&filter%5BjudgeYearTo%5D=&filter%5BjudgeMonthTo%5D=&filter%5BjudgeDayTo%5D=&filter%5BjikenGengo%5D=%E4%BB%A4%E5%92%8C&filter%5BjikenYear%5D=2&filter%5BjikenCode%5D=%28%E3%83%8D%29&filter%5BjikenNumber%5D=10057&filter%5BgenshinCourtName%5D=&filter%5BgenshinCourtType%5D=&filter%5BgenshinBranchName%5D=&filter%5BgenshinJikenGengo%5D=&filter%5BgenshinJikenYear%5D=&filter%5BgenshinJikenCode%5D=&filter%5BgenshinJikenNumber%5D=&filter%5BjudgeResult%5D=&filter%5Bshinketsu%5D=&filter%5BappealResult%5D=&action_search=%E6%A4%9C%E7%B4%A2

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E7%89%B9%E8%A8%B1%E6%A8%A9%E4%BE%B5%E5%AE%B3%E8%A8%B4%E8%A8%9F%EF%BC%88%E7%8B%AC%E5%8D%A0%E7%A6%81%E6%AD%A2%E6%B3%95%E9%81%95%E5%8F%8D%E3%81%8C/

[US Patents] June 2011 US Supreme Court: Microsoft v. i4i

Original Ameblo publication: 2022-06-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12748530204.html

[US Patents] June 2011 US Supreme Court: Microsoft v. i4i

In a patent invalidity defense, the accused infringer must present “clear and convincing evidence” and bears the burden of proving invalidity!!

* At the USPTO examination stage, rejection is based on a “preponderance of the evidence”!! (Double standard)

https://www.jetro.go.jp/ext_images/world/n_america/us/ip/news/pdf/110610.pdf

[US Patents] April 2015 US CAFC: INEOS v. BERRY PLASTICS

Original Ameblo publication: 2022-06-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12748709831.html

[US Patents] April 2015 US CAFC: INEOS v. BERRY PLASTICS

Even if the claimed numerical range overlaps the range disclosed in the prior art, the claim may avoid anticipation by showing that the claimed range is critical to the operability of the invention.

⇒ The conclusion in this case was negative.

(Japan: inventive step was recognized in the Tokyo High Court cases 1994 (Gyo-Ke) 30 and 1990 (Gyo-Ke) 269.)

https://system.jpaa.or.jp/patents_files_old/201002/jpaapatent201002_046-067.pdf

[US Patents] August 2013 US CAFC: Hamilton Beach v. Sunbeam

Original Ameblo publication: 2022-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749228503.html

[US Patents] August 2013 US CAFC: Hamilton Beach v. Sunbeam

The patent was invalid under the on-sale bar because the supplier of the patented product accepted an order to manufacture it more than one year before the patented invention's priority date!!

(* A commercial offer for sale can arise through communications such as emails preceding a contract. The on-sale bar applies to suppliers too!!)

http://www.unitedgips.com/articles/dc201309.pdf

[US Patents] July 2016 US CAFC: Medicines v. Hospira

Original Ameblo publication: 2022-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749228735.html

[US Patents] July 2016 US CAFC: Medicines v. Hospira

The on-sale bar under former 35 USC §102(b) requires the subject matter to be the subject of a commercial sale (or offer for sale), satisfying Uniform Commercial Code §2-106. Merely commissioning manufacture does not trigger the on-sale bar.

Cf. August 2013 US CAFC: Hamilton Beach v. Sunbeam

https://www.oliff.com/wp-content/uploads/2018/03/2014-1469-OBJP.pdf

[US Patents] January 2019 US Supreme Court: Helsinn v. Teva

Original Ameblo publication: 2022-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749228965.html

[US Patents] January 2019 US Supreme Court: Helsinn v. Teva

A commercial sale to a third party under a confidentiality obligation more than one year before patent filing destroys novelty under the on-sale bar of amended 35 USC §102(a).

Cf. August 2013 US CAFC: Hamilton Beach v. Sunbeam

https://www.jetro.go.jp/ext_images/_Ipnews/us/2019/20190123.pdf

[US Patents] 2017 US CAFC en banc: Aqua Products v. Matal

Original Ameblo publication: 2022-06-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749421119.html

[US Patents] October 2017 US CAFC en banc: Aqua Products v. Matal

For the patentability of claims amended during inter partes review (IPR), the petitioner bears the burden of proving lack of patentability.

(This differed from prior PTAB practice. Eleven judges participated, with five separate opinions.)

http://tokugikon.jp/gikonshi/288/288tokusyu4.pdf

[US Patents] April 2021 US CAFC: Raytheon Technologies v. GE

Original Ameblo publication: 2022-06-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749588004.html

[US Patents] April 2021 US CAFC: Raytheon Technologies v. GE

If a reference was not self-enabling at the priority date, and no other prior art or evidence establishes that a person skilled in the art could have made and used the claimed invention, the invention at issue cannot be held obvious based on that reference.

⇒ The USPTO decision, which had not properly assessed this enablement issue, was reversed (★ the reference was a NASA technical memorandum—an imaginary engine).

On the other hand, a non-enabling reference's technology could logically provide a basis for motivation to improve other enabling prior art.

http://tatsuoyabe.aki.gs/Raytheon%20Tech%20v%20GE%20Fed%20Cir%202021-04-16.htm

[US Patents] May 2018 US CAFC: TAOS v. Intersil

Original Ameblo publication: 2022-06-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749759608.html

[US Patents] May 2018 US CAFC: TAOS v. Intersil

It is not enough that an offer for sale was made within the United States; the offer does not infringe unless the intended future place of sale is within the United States.

（Transocean Offshore Deepwater Drilling v. Maersk Contractors USA, 617 F.3d 1296 (Fed. Cir. 2010)）

https://chosakai.or.jp/intell/pat/contents19/201904/201904_12.pdf

[US Patents] 1998 US CAFC: Ethicon v. U.S. Surgical Corp.

Original Ameblo publication: 2022-06-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12749932420.html

[US Patents] 1998 US CAFC: Ethicon v. U.S. Surgical Corp.

Even if only some claims concern a joint invention, the joint inventor also has rights in the other claims concerning another inventor's sole invention and can license them.

Pay attention to joint inventorship when filing or entering the national phase in the United States.

US inventorship requirements are looser than Japan's.

https://ryujinpatent.com/docs/report.pdf

[US Patents] May 2001 US CAFC: Mycogen Plant v. Monsanto

Original Ameblo publication: 2022-06-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750168565.html

[US Patents] May 2001 US CAFC: Mycogen Plant v. Monsanto

Infringement under §271(g) arises only if the manufacturing process was used when the US patent had issued and remained validly in force.

⇒ No infringement

* Monsanto Co. v. Syngenta Seeds, Inc., 503 F.3d 1352, 1360 (Fed. Cir. 2007), explained the Mycogen judgment.

https://system.jpaa.or.jp/patent/viewPdf/3849

[Article] “Prima Facie Evidence in Applications to Suspend Imports and Exports” (Tomohiko Inui, Chief Intellectual Property Investigator, Customs Clearance Department, Tokyo Customs)

Original Ameblo publication: 2022-06-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750168772.html

[Article]“Prima Facie Evidence in Applications to Suspend Imports and Exports” (Tomohiko Inui, Chief Intellectual Property Investigator, Customs Clearance Department, Tokyo Customs; Senior Patent Attorney) (Patent, 2021 No. 6)

Prima facie evidence of infringement required by Customs.

* Differences from a complaint

(1) No prayer for relief

(2) An expert opinion can substitute for prima facie evidentiary materials.

(3) No in camera procedure, etc.

https://system.jpaa.or.jp/patent/viewPdf/3807

[Article] “Study on Pleading and Proof to Rebut Presumed Damages in Patent Infringement Litigation,” Intellectual Property Management Vol. 72

Original Ameblo publication: 2022-06-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750444902.html

[Article] “Study on Pleading and Proof to Rebut Presumed Damages in Patent Infringement Litigation” (Intellectual Property Management Vol. 72, No. 2, 2022)

Analysis of case law over the last 13 years

142 cases in which the patentee won under paragraph (1) or (2)

78 cases (55%) in which the defendant argued for rebuttal of the presumption

⇒ 43 cases (55%) in which the presumption was (partly) rebutted

Frequent grounds for recognized rebuttal were competing products, contribution ratios, etc.

https://cir.nii.ac.jp/crid/1520291856318296960

IP High Court, 2019 (Gyo-Ke) 10174 [Aerosol Generation Device] <Mori>

Original Ameblo publication: 2022-06-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750619436.html

IP High Court, 2019 (Gyo-Ke) 10174 [Aerosol Generation Device] <Mori>

Even the Lipase judgment does not prohibit considering the description and drawings as necessary to clarify the meaning, etc. of defining features when assessing the support requirement!!

* The claim language was construed in light of the problem of the invention.

⇒ Support requirement: satisfied

(Excerpts from the judgment)

The support requirement is assessed by comparing the claims with the detailed description of the invention. As a premise for that comparison, however, when identifying the invention from the claims, if it is necessary to clarify the meaning or technical significance of the features defining the invention stated in the claims, consideration of the description and drawings as necessary should not be precluded. The Lipase judgment cited by the parties cannot be construed as prohibiting this. ...

The plaintiff argues that allowing a narrow construction of the claims based on the detailed description when assessing support would mean that, however broadly worded the claims, they would never fail the support requirement, defeating its purpose, and would also allow infringement to be asserted on the basis of broad claims, creating an improper double benefit. However, even where the detailed description is considered in assessing support, a violation of the support requirement can still arise if the content of the invention recognized from the claims with reference to the detailed description is not supported by that description (for example, where the invention recognized from the claim language with reference to the detailed description includes both A and B, but only B appears in the examples, etc., A may be found unsupported). Thus, failure to meet the support requirement is not invariably avoided. Further, because the description and drawings are to be taken into account when determining the technical scope of a patented invention (Patent Act, Article 70(2)), the double benefit alleged by the plaintiff cannot be said to arise.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89665.pdf

IP High Court, 2021 (Gyo-Ke) 10056 [Information Processing Device Case] <Shoji>

Original Ameblo publication: 2022-06-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750794789.html

IP High Court, 2021 (Gyo-Ke) 10056 [Information Processing Device Case] <Shoji>

* The other component of the subcombination claim does not limit the configuration of the claimed invention in any way.

⇒ Not a feature defining the invention!!

⇒ The trial decision finding lack of novelty was upheld, identifying the gist of the invention after excluding elements specifying only server processing.

(Excerpts from the judgment)

In a subcombination invention, the gist of the invention must be identified by understanding what significance matters concerning the “other apparatus” stated in the claim have in defining the claimed invention in terms of shape, structure, components, composition, actions, functions, nature, characteristics, conduct or operation, use, etc. (collectively, “structure, functions, etc.”). Where those matters specify only the “other apparatus” and do not specify any structure, functions, etc. of the claimed invention, they have no significance in defining that invention, so it is appropriate to exclude them when identifying its gist ....

The wording in Element (B), “as first information including information serving as the basis for the server's extraction of second and third information,” merely specifies processing at the server (Elements (C1) and (C2)), namely that the server receiving notification of the first information extracts the second and third information from it. It does not specify that the first information itself includes any special information differing from an ordinary publication for extracting the second and third information. Thus, this wording in Element (B) of the amended invention at issue specifies server processing, not the content of the publication-notification means provided in the information processing device. It is therefore appropriate to exclude that wording when identifying the features defined by Element (B), and the trial decision's identification as (B') is not erroneous.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90915.pdf

IP High Court, 2020 (Gyo-Ke) 10128 [Safety Confirmation System] <Shoji>

Original Ameblo publication: 2022-06-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750962655.html

IP High Court, 2020 (Gyo-Ke) 10128 [Safety Confirmation System] <Shoji>

A difference was overlooked ⇒ JPO decision revoked

In the claimed invention, the lighting device has a transmitter and follows safety-notification rules corresponding to the ID of the identified installation location.

The cited invention has a detector ID for the lighting device, but cannot identify the installation location, so additional information is necessary.

090864_hanrei.pdf (courts.go.jp)

Amendments deleting features from independent claims upon entry into the European phase face strict requirements. The same applies to divisional applications.

Original Ameblo publication: 2022-06-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12750963164.html

<Blog of German Patent Attorney Kan Hasegawa>

Under the European Patent Office Guidelines, an amendment of this kind that deletes features from an independent claim as filed is not allowed unless three requirements are satisfied (GL H-V, 3.1; T 0331/87).

(* Here, “as filed” means at the time the PCT application was filed.)

The practice in Japan of “filing a divisional application with a challenging claim that deletes several features from original claim 1 of the parent application” is, in principle, not possible at the European Patent Office. (GL C-IX, 1.4)

In Europe, deleting features from independent claims as filed is extremely difficult | Random Thoughts on European Intellectual Property Practice (hasegawa-ip.com)

IP High Court, 2019 (Gyo-Ke) 10108 [Control Channels in a Communication Network System] <Kanno>

Original Ameblo publication: 2022-07-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12751142341.html

IP High Court, 2019 (Gyo-Ke) 10108 [Control Channels in a Communication Network System] <Kanno>

① An example in which a correction abstracting an embodiment and incorporating it into the claims was held not to add new matter.

The specific disclosure in Figure 4 was abstracted.

The relationship between the problem addressed by the invention and the corrections was not a focus of attention.

⇒ Although the correction did not add new matter, it substantially changed the scope of the claims. The court therefore upheld the JPO decision refusing the correction and dismissed the plaintiff's claim.

② A correction adding claim language was held to constitute a substantial change in the scope of the claims.

(Excerpts from the judgment)

① ... Taking Figure 4 together with the above statements in the description, it can be said that the following is tantamount to being disclosed regarding the proportions of control-channel candidates available for scheduling that are restricted by the tree structure: in the embodiment in Figure 4, at aggregation level 1, the highest level, the 24 control channels are restricted to four candidates (a candidate proportion of one-sixth); at aggregation level 2, a relatively lower level, the 12 control channels are restricted to four candidates (a candidate proportion of one-third); and at aggregation level 4, the six control channels are restricted to four candidates (a candidate proportion of two-thirds); while the three control channels at aggregation level 8 are not restricted (a candidate proportion of one).

② ... Corrected claim 1 adds the concept of "control-channel candidates available for allocation to user equipment," which was not in the claims before correction, and then adds the following matters: "performing allocation to user equipment by making the proportion of control-channel candidates available for allocation to user equipment at each level lower than said highest level greater than the proportion of control-channel candidates available for allocation to user equipment at said highest level," and "the lower the level in the tree structure, the greater the proportion of control-channel candidates available for allocation to user equipment." As a result, the defining features of the invention now include making the proportion of control-channel candidates available for allocation to user equipment greater at lower levels in the tree structure, whereas the method before correction had made no particular provision regarding allocation at the relatively lower levels represented by the tree structure .... Accordingly, Corrections 1 through 3 substantially change the scope of the claims and cannot be regarded as complying with Article 126(5) of the Patent Act.

090287_hanrei.pdf (courts.go.jp)

IP High Court, 2020 (Gyo-Ke) 10037 [Gaming Machine] <Otaka>

Original Ameblo publication: 2022-07-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12751507838.html

IP High Court, 2020 (Gyo-Ke) 10037 [Gaming Machine] <Otaka>

* Even where the passages come from the same primary cited document, new technical matters cannot be asserted in an action to revoke the JPO decision.

“This changes, at the stage of this litigation, ... the grounds for refusal stated in the JPO decision ... and the assertion itself should not be permitted simply because the primary reference is the same.” — ★ Does binding effect not extend to this?

Claimed invention: the jackpot is revealed “when the button is pressed for the first time.”

Cited reference: each time the button is pressed, a character with a higher expected chance appears; finally, a school doctor with a 100% expected chance appears.

⇒ Because they differ, novelty affirmed (inventive step was not discussed).

(Excerpts from the judgment)

... The defendant's above assertion is nothing other than an assertion that the amended claimed invention lacks novelty based on an invention relating to Technical Matter A that differs from the cited invention identified in the JPO decision as the invention described in Cited Document 1. It changes the grounds for refusal of the application stated in the JPO decision at the stage of this litigation. Allowing such a change in the grounds for refusal would deprive the appellant of the opportunity to defend itself in the proceedings for an appeal against a decision of refusal (Articles 159(2) and 50 of the Patent Act). Therefore, the assertion itself should not be permitted simply because the primary reference is the same ....

090211_hanrei.pdf (courts.go.jp)

[Trademark] IP High Court, 2021 (Gyo-Ke) No. 10100 (Presiding Judge Otaka)

Original Ameblo publication: 2022-07-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12751664456.html

[Trademark] IP High Court, 2021 (Gyo-Ke) No. 10100 (Presiding Judge Otaka)

The registered trademark consisting of the standard characters “Scrum Master” written horizontally is a necessary and appropriate indication in trade as a description of the quality of the designated services in Class 41 and other classes.

⇒ Violation of Article 3(1)(iii) of the Trademark Act.

⇒ The JPO decision partially maintaining the registration in the invalidation trial was partially revoked.

[Trademark Act ★] A case concerning a registered trademark consisting of the standard characters “Scrum Master” written horizontally, in which the court held that the mark fell under Article 3(1)(iii) of the Trademark Act because it is a necessary and appropriate indication in trade as a description of the quality of designated services including Class 41 “teaching of arts, sports or knowledge; education, training and workshops; planning, management or implementation of qualification examinations; planning, management or holding of seminars,” and is generally recognized by traders and consumers as indicating the quality of services when used for those designated services; the court partially revoked the JPO decision partially maintaining the registration in the invalidation trial - NAKAMURA & PARTNERS (nakapat.gr.jp)

Osaka High Court, 2002 (Ne) 2481 — A case in which a Chinese judgment was not recognized as effective in Japan

Original Ameblo publication: 2022-07-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12751836979.html

Osaka High Court, 2002 (Ne) 2481

A case in which a Chinese judgment was not recognized as effective in Japan because it did not satisfy the “reciprocity” requirement of Article 118(iv) of the Code of Civil Procedure.

If a contract with a foreign party provides for Japanese jurisdiction, “reciprocity” is necessary to enforce the judgment in the other party's country.

⇒ If arbitration is chosen instead, effectiveness is recognized in China as well under the New York Convention.

https://higashimachi.jp/column/283/

IP High Court, 2016 (Gyo-Ke) 10078 [System for Managing Combined Execution of Instruction Threads] <Mori>

Original Ameblo publication: 2022-07-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752023242.html

IP High Court, 2016 (Gyo-Ke) 10078 [System for Managing Combined Execution of Instruction Threads] <Mori>

The symbol “(S, C)” in the claim wording “type (S, C),” added by amendment, was narrowly interpreted as “(service type, computation type),” avoiding an addition of new matter.

★ The JPO's argument: if the intention was to specify the types of instruction threads, ... the wording should have been “type (computation type, service type).”

⇒ To be safe, claim language should describe matters in words, not symbols!!

(Excerpts from the judgment)

When the meaning of the terms used in the claims is interpreted in light of the original description and other documents, the wording “type (S, C),” used for instruction-thread types in amended claims 6–8, can be understood to mean “service type” and “computation type.” ... This amendment changes “type” of instruction threads in claim 6 before amendment, which did not state what kinds of types existed, to “type (S, C),” meaning “type (service type, computation type)” described in the original description and other documents, and does not go beyond the matters described in the original description and other documents.

087286_hanrei.pdf (courts.go.jp)

[Trademark] IP High Court, 2020 (Ne) 10062 “2UNDR Case” — Parallel imports of genuine goods

Original Ameblo publication: 2022-07-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752185573.html

[Trademark] IP High Court, 2020 (Ne) 10062 “2UNDR Case” — Parallel imports of genuine goods

Three requirements in the Supreme Court's Fred Perry judgment of February 27, 2003: ① genuine nature of the goods; ② substantial identity of the trademark owners inside and outside Japan; ③ no substantial difference in the quality guaranteed.

The agency agreement had already been terminated; the territory was limited to Singapore; and the goods were sold as imperfect goods. ⇒ Requirements ①, ② and ③ were satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90384.pdf

[Unfair Competition Prevention Act] Tokyo District Court, 2015 (Wa) 30656 — Unused confidential information and calculation of damages

Original Ameblo publication: 2022-07-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752363981.html

[Unfair Competition Prevention Act] Tokyo District Court, 2015 (Wa) 30656

Even with legitimate access authority, acquiring the information for the purpose of using it in the business of a new employer falls under Article 2(1)(iv) of the Unfair Competition Prevention Act.

For unused confidential information, damages under Article 5(3) of the Unfair Competition Prevention Act were calculated by discounting licensing fees relating to expected future profits to their present value.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90709.pdf

Osaka District Court, 2020 (Wa) 7486 [Apparatus and Method for Instantaneous Removal of Blood from a Fish by Injecting High-Pressure Water into the Hemal Arch] <Sugiura>

Original Ameblo publication: 2022-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752842092.html

Osaka District Court, 2020 (Wa) 7486 [Apparatus and Method for Instantaneous Removal of Blood from a Fish by Injecting High-Pressure Water into the Hemal Arch] <Sugiura>

Joint inventorship affirmed ⇒ Claim for transfer of an ownership share granted.

Feature ①: although prompted by seeing the defendant's prototype, it was based on the plaintiff's conception and its embodiment.

Feature ②: although the defendant's idea was adopted, the plaintiff also made a creative contribution.

(Excerpts from the judgment)

The inventions at issue concern an apparatus and method for dispatching live fish that enable blood to be removed instantly, simply and reliably from fish of any size. They are recognized as a fish-bleeding apparatus and method characterized by ① bleeding fish by injecting pressurized high-pressure liquid from the hemal arch in the fish's tail into blood vessels, including arteries or veins (hereinafter “Characteristic Feature ①”), and ② making the nozzle tip tapered in order to achieve a close-contact sealing structure at the hemal arch accommodating fish of all sizes while suppressing damage to the nozzle tip (hereinafter “Characteristic Feature ②”). ...

Although Characteristic Feature ① of the inventions was prompted by the plaintiff's exposure to the foot-operated prototype made by the defendant, it may be said to be based on the plaintiff's conception and its embodiment, against the background of many years working at a fisheries company and, in particular, practical experience dispatching live fish. Therefore, not only the defendant but also the plaintiff should be regarded as having contributed creatively to the completion of Characteristic Feature ① of the inventions. ...

As to Characteristic Feature ②, although it was ultimately completed as an invention based on the defendant's idea, not only the defendant but also the plaintiff should be regarded as having contributed creatively during the process of conceiving a solution to the problem and embodying it. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90980.pdf

IP High Court, 2010 (Gyo-Ke) 10265 [Socks] <Takizawa>

Original Ameblo publication: 2022-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752842372.html

IP High Court, 2010 (Gyo-Ke) 10265 [Socks] <Takizawa>

* Wording such as “substantially,” which was not in the original priority description, was added to the description, but it “does not affect the V-shape or structure” of the socks. “... Compared with the invention described in the original priority description, ... the scope of rights under claims 1 and 3 has not ... been broadened.”

⇒ Priority affirmed.

* Under this judgment, adding new matter to a description constitutes a ground for invalidity of claims that are broadened thereby. In practice, it should be noted that, since the Artificial Nipple case, there has been no judgment finding invalidity based on new matter added to the description without a change to the claims.

(Excerpts from the judgment)

For example, the statement “In the explanation of Figure 1 above, ‘substantially the same number’ means that a difference of approximately 10% of the number of knitting needles involved in knitting is permissible between the decrease or increase in the number of needles when the needle cylinder rotates in the forward direction and the decrease and increase in the number of needles when it rotates in the reverse direction” (paragraph [0016] of the corrected description), and the statement “The decreases in the number of needles in the forward and reverse directions are substantially the same” (paragraph [0018]), are not in the original priority description. However, “substantially” here does not refer to the V-shape in either case; it refers to the difference between the decrease or increase in the number of needles when the needle cylinder rotates forward and the decrease or increase when it rotates in reverse. Since the V-shape is defined by connecting lines HJ and HM, or NT and VN, which are the turning ends upon forward rotation, differences in increases or decreases in needle numbers between forward and reverse rotation do not affect the V-shape or structure. Accordingly, it cannot be said that the scope of rights under claims 1 and 3 of the corrected invention is broader than that of the invention described in the original priority description.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81619.pdf

[Trademark Rights] Tokyo District Court, 2019 (Wa) 8117 — Prior-use right not established

Original Ameblo publication: 2022-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12752842584.html

[Trademark Rights] Tokyo District Court, 2019 (Wa) 8117

“Even taking into account that approximately eight and a half years had elapsed from the start of sales of the defendant's goods to the filing date of the plaintiff's trademark application ..., ... the evidence is insufficient to establish that [the mark] was widely recognized among ... consumers ...; ... a prior-use right is ... not recognized.”

⇒ Prior-use rights in trademarks are almost never recognized!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90475.pdf

“On the Validity of Non-Compete Agreements” (Ministry of Economy, Trade and Industry)

Original Ameblo publication: 2022-07-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753000334.html

“On the Validity of Non-Compete Agreements” (Ministry of Economy, Trade and Industry)

Factors making a finding of validity more likely:

• The non-compete period is no longer than one year.

• The scope of prohibited conduct is limited by the nature of the work, job category or similar factors.

• Compensatory measures are provided (including measures, such as high remuneration, that can be regarded as “deemed compensation”).

https://www.meti.go.jp/policy/economy/chizai/chiteki/pdf/handbook/reference5.pdf

[Article] “Comparison of Trends in Judgments on Addition of New Matter with JPO Examination Guidelines and Other Materials” (2017.10)

Original Ameblo publication: 2022-07-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753171944.html

[Article] “Comparison of Trends in Judgments on Addition of New Matter with JPO Examination Guidelines and Other Materials” (FY2016 Patent Committee, New Matter Addition Study Team) (2017.10)

“Where it is apparent from the original description and other documents that the matter to be deleted is unrelated to solving the problem addressed by the invention and is an optional additional matter, the amendment often does not add any new technical significance.”

https://system.jpaa.or.jp/patent/viewPdf/2908

IP High Court, 2020 (Gyo-Ke) 10015 [Novel Formulations for Stabilizing Immunogenic Compositions and Inhibiting Precipitation] <Tsuruoka>

Original Ameblo publication: 2022-07-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753184291.html

IP High Court, 2020 (Gyo-Ke) 10015 [Novel Formulations for Stabilizing Immunogenic Compositions and Inhibiting Precipitation] <Tsuruoka>

* After determining that the effect incorporated into the claims was a defining feature of the invention, the court held that it was not readily conceivable.

* The court rejected the “ease of discovering the problem of inhibiting silicone-induced aggregation” addressed by the invention. ⇒ Inventive step affirmed.

[Claim 1] A formulation comprising a polysaccharide–protein conjugate comprising ... that inhibits silicone-induced aggregation of the protein conjugate.

(Excerpts from the judgment)

In light of the ... disclosures in the description, the technical significance of the defining feature that the formulation of the invention produces the effect of inhibiting silicone-induced aggregation is understood as follows. ① Free pneumococcal conjugates are involved in silicone-induced aggregation regardless of pneumococcal serotype. ② Because the formulation of the invention has the composition in (i)–(iii), the pneumococcal CRM conjugates and aluminum salts bind in solution, leaving a relatively reduced amount of free pneumococcal CRM conjugates. ③ Being in the state described in ② inhibits silicone-induced aggregation arising through the mechanism in ①. ...

The defining feature of the invention relating to Difference 4, namely, “inhibiting silicone-induced aggregation of polysaccharide–protein conjugates contained in a siliconized container,” means that silicone-induced aggregation involving free pneumococcal CRM conjugates is inhibited because pneumococcal CRM conjugates and aluminum salts bind, reducing the amount of free pneumococcal CRM conjugates in solution to the intended level. In contrast, ... a person skilled in the art encountering Publicly Known Invention 1 would merely recognize that its formulation contains pneumococcal CRM conjugates adsorbed onto aluminum phosphate; it would not have been easy to recognize the presence or absence, and amount, of free pneumococcal conjugates in its formulation solution in relation to the problem of silicone aggregation involving free pneumococcal conjugates. Moreover, the amount of free pneumococcal CRM conjugates in the formulation of the invention may vary according to the amount of pneumococcal CRM conjugates of the six serotypes added to the 7vPnC of Publicly Known Invention 1, and also according to the ease with which each added serotype adsorbs onto aluminum salts. Thus, a person skilled in the art could not predict from Publicly Known Invention 1 even whether free pneumococcal CRM conjugates would be present in a solution of a formulation having the composition of the invention. Consequently, neither could that person predict whether silicone-induced aggregation involving free pneumococcal CRM conjugates would be inhibited in a formulation having the composition of the invention.

... The plaintiff ... argues that Difference 4 is substantially a point of identity and is not a difference. However, ... it cannot necessarily be said, as the plaintiff argues, that one could understand that aggregation might occur but would ordinarily be inhibited; much less can one definitively determine whether that aggregation is induced by silicone. In contrast, the invention expressly identifies silicone-induced aggregation as the cause of aggregation of 13vPnC and makes inhibition of that aggregation a defining feature of the invention. In this respect, there is a difference from Publicly Known Invention 1. ...

B. Ease of discovering the problem of inhibiting silicone-induced aggregation

The plaintiff argues that silicone-induced aggregation in protein formulations was known and that a person skilled in the art understood protein aggregation to be the driving force behind polysaccharide–protein conjugate aggregation. Therefore, it argues, silicone-induced aggregation was foreseeable in a 13-valent pneumococcal CRM conjugate formulation whose protein content was increased by adding six types of pneumococcal CRM conjugates to Publicly Known Invention 1. However, the publicly known documents ... on which the plaintiff relies merely describe aggregation associated with structural instability of polysaccharide–protein conjugates whose carrier protein is CRM or tetanus toxin (TT). Thus, these documents do not establish that silicone-induced aggregation of polysaccharide–protein conjugates was recognized as a problem by persons skilled in the art at the priority date.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90325.pdf

IP High Court, 2008 (Gyo-Ke) 10304 [Oxygen Absorbent for Incorporation into Resin] <Takizawa>

Original Ameblo publication: 2022-07-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753325997.html

IP High Court, 2008 (Gyo-Ke) 10304 [Oxygen Absorbent for Incorporation into Resin] <Takizawa>

* Enablement requirement for a use invention

⇒ The purpose, constitution and effects of the invention must be described sufficiently to substantiate the usefulness of the use.

⇒ A description sufficient to substantiate that the invention produces its intended functions and effects for the relevant resins generally is necessary.

(Excerpts from the judgment)

... In an invention such as the present invention, concerning a composition used for a specific purpose (incorporation into resin) and consisting of known substances at specified composition ratios, merely identifying the substances constituting the composition and their composition ratios generally does not enable a person skilled in the art to predict the usefulness of that use, and the composition cannot readily be put into practice for that use. Accordingly, for such an invention to satisfy the enablement requirement, it is appropriate to construe the requirement as demanding that the detailed description state the purpose, constitution and effects of the invention sufficiently to substantiate the usefulness of that use.

Furthermore, because the invention specifies its use merely as “for incorporation into resin,” and because the invention must be described in a manner satisfying the enablement requirement, the detailed description should be construed as requiring a description sufficient to substantiate that applying the invention's oxygen absorbent is useful for resins generally to which an oxygen absorbent is applied; that is, that the invention produces its intended functions and effects for such resins generally.

037906_hanrei.pdf (courts.go.jp)

IP High Court, 2016 (Gyo-Ke) 10212 [Contact Terminal] <Takabe>

Original Ameblo publication: 2022-07-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753522862.html

Trial and Appeal Practitioners Study Group 2021, Case 10, p. 122

IP High Court, 2016 (Gyo-Ke) 10212 [Contact Terminal] <Takabe>

* Failure to satisfy divisional-application requirements: an essential structure cannot be deleted.

The parent application's description does not describe a contact terminal without an insulating ball; the insulating ball interposed between the plunger pin and the coil spring is an essential component.

(Excerpts from the judgment)

Invention 1 at issue includes contact terminals without an insulating ball, in which the “spherical portion comprising the spherical surface of a ball,” located between the large-diameter portion of the plunger pin and the coil spring and pressing the outer surface of the plunger pin's large-diameter portion against the inner peripheral surface of the main housing, is conductive. ... Each of the configurations in claims 1 through 9 of the parent application includes an insulating ball interposed between the large-diameter portion of the plunger pin and the coil spring. ... The parent application's description does not describe a contact terminal without an insulating ball, and the insulating ball interposed between the plunger pin and the coil spring is understood to be an essential component. ... The requirements for a divisional application cannot be regarded as satisfied.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

IP High Court, 2019 (Gyo-Ke) 10026 [Fluid-Pressure Cylinder and Clamping Device] <Tsuruoka>

Original Ameblo publication: 2022-07-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753746056.html

Trial and Appeal Practitioners Study Group 2021, Case 1, p. 12

IP High Court, 2019 (Gyo-Ke) 10026 [Fluid-Pressure Cylinder and Clamping Device] <Tsuruoka>

The matter deleted by amendment is the principal means of solving the invention's problem.

⇒ Violation of amendment requirements.

— If the principal and subordinate roles of components are expressly stated, the principal component is held to be essential, making an amendment/division deleting it impossible.

(Excerpts from the judgment)

The amendment includes, with respect to an “opening/closing valve mechanism” having a “valve body,” deletion from pre-amendment claim 1 of the defining feature “comprising a valve seat against which this valve body can abut, a fluid-pressure introduction chamber that maintains said valve body advanced toward said output member by the fluid pressure of said fluid chamber, and a fluid-pressure introduction passage communicating said fluid chamber with said fluid-pressure introduction chamber,” and the new introduction of the defining feature “including ... an elastic member that elastically biases said large-diameter shaft portion of said valve body toward said fluid chamber and maintains said valve body advanced toward said fluid chamber.” Therefore, amended Invention 1 also includes a configuration that uses only an elastic member, without a fluid-pressure introduction chamber and passage for utilizing the fluid pressure of the fluid chamber, as the configuration maintaining the valve body advanced toward the output member ....

... In Embodiment 2, the hydraulic-pressure introduction chamber 53 and hydraulic-pressure introduction passage 54 can be said to be components linked to the effects of the invention. ...

... The configuration of Embodiment 2 uses biasing by hydraulic pressure, provided through the hydraulic-pressure introduction chamber 53 and passage 54, as its principal means, and uses biasing by compression coil spring 53a as a supplementary means .... It must be said that one cannot derive from such a configuration a configuration that deliberately eliminates the principal hydraulic-biasing components and provides biasing solely through the compression coil spring, which is merely supplementary. This is all the more so considering ... that, in Embodiment 2, the hydraulic-pressure introduction chamber 53 and passage 54 are described in connection with the effects of the invention. ...

A configuration that maintains the valve body advanced toward the output member solely by an elastic member, without providing a fluid-pressure introduction chamber and passage in the opening/closing valve mechanism, cannot be regarded as a technical matter derivable by a person skilled in the art from all the statements in the original description and other documents taken together.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

Support requirement for an invention specified in terms synonymous with its problem

Original Ameblo publication: 2022-07-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753746354.html

Trial and Appeal Practitioners Study Group 2021, Case 2, p. 33

Support requirement for an invention specified in terms synonymous with its problem

... Whether this can constitute a means of solving the problem is determined in light of the technical content; ... thus, a specification that can also be construed as synonymous with the problem may itself constitute a means of solving the problem in some cases, while another problem-solving means may be required in others.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

I held a training seminar entitled “Cinematographic Works” at the Shunjukai Patent Attorneys' Association, so I am sharing an edited, shortened version.

Original Ameblo publication: 2022-07-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753894074.html

I held a training seminar entitled “Cinematographic Works” at the Shunjukai Patent Attorneys' Association, so I am sharing an edited, shortened version.

Film: “The Treasure of Intellectual Property Village — Intellectual Property Sword® vs. the Damas Pirates”

The theatrical run is August 5–14 (Ikebukuro).

Please come and support us!!

Social gatherings will be held on Tuesday, August 9, and Friday, August 12.

Please join those as well!!

https://twitter.com/CAL000000/status/1547158906463477760

https://www.youtube.com/watch?v=SJwIKfSieT4

How the technical concept underlying motivation affects assessment of effects

Original Ameblo publication: 2022-07-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12753983437.html

Trial and Appeal Practitioners Study Group 2021, Case 3, p. 41

How the technical concept underlying motivation affects assessment of effects

“When the problems addressed by the claimed invention and the cited invention differ ... the resulting effect differs from that of the claimed invention, so ... it becomes easier to affirm an unpredictable, remarkable effect on the basis that the effect is different in kind ....”

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

IP High Court, 2018 (Gyo-Ke) 10175 <Takabe> [Access Port]

Original Ameblo publication: 2022-07-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754160520.html

Trial and Appeal Practitioners Study Group 2021, Case 7, p. 80

IP High Court, 2018 (Gyo-Ke) 10175 <Takabe> [Access Port]

Support requirement satisfied.

⇒ The judgment identified the problem of the invention more abstractly than the JPO decision did.

Inventive step denied.

⇒ In principle, a primary cited invention cannot be identified from multiple cited documents.

= IP High Court, 2019 (Gyo-Ke) 10064

Cf. the IP High Court decision in 2018 (Gyo-Ke) 10122, which exceptionally permitted this.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

IP High Court, 2017 (Gyo-Ke) 10006, 10015 [Run-Flat Tire] <Takabe> — Clarity requirement satisfied

Original Ameblo publication: 2022-07-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754330332.html

Trial and Appeal Practitioners Study Group 2021, Case 8, p. 96

IP High Court, 2017 (Gyo-Ke) 10006, 10015 [Run-Flat Tire] <Takabe> — Clarity requirement satisfied

The clarity requirement is satisfied even if the calculation method causes a minute difference.

The intersection temperature differs by only 1°C depending on how the lines are drawn. ... It cannot be regarded as so unclear as to unduly prejudice third parties' interests.

(Excerpts from the judgment)

[Claim 1] ... A run-flat tire ... in which the temperature at the intersection of extrapolated line A and ... extrapolated line B is at least 170°C ....

... The temperature of 170°C specified as the intersection temperature of extrapolated lines A and B was derived by focusing on the variation in the dynamic storage modulus of the reinforcing rubber composition from 180°C to 200°C, and this intersection temperature differs by only 1°C depending on how the lines are drawn. Accordingly, the claim language specifying the constitution of the rubber composition by the intersection temperature of extrapolated lines A and B cannot be regarded as so unclear as to unduly prejudice third parties' interests.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

IP High Court, 2017 (Gyo-Ke) 10172 <Takabe> [Antiviral Agent]

Original Ameblo publication: 2022-07-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754497179.html

Trial and Appeal Practitioners Study Group 2021, Case 9, p. 106

IP High Court, 2017 (Gyo-Ke) 10172 <Takabe> [Antiviral Agent]

Pharmacological test results were omitted from the divisional application.

⇒ Support requirement not satisfied.

2015 (Wa) 23087 <Sato> and the IP High Court decision in 2017 (Ne) 10105 <Takabe> are to the same effect.

Even when chemical structures are extremely similar, particular characteristics or physical properties may be wholly dissimilar.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2021_houkokusyo_honpen.pdf

<Trademark> Osaka District Court, 2020 (Wa) 8061 — “Hashtag (#) + brand name” recognized as trademark use

Original Ameblo publication: 2022-07-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754655352.html

<Trademark> Osaka District Court, 2020 (Wa) 8061

“Hashtag (#) + brand name” was recognized as trademark use!!

Although the indication was “Charmant Sac ‘style,’” the court held that its purpose was to guide users to the defendant's website and promote sales of the defendant's goods and other products by facilitating searches for information relating to the brand name.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90606.pdf

IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno>

Original Ameblo publication: 2022-07-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754825876.html

IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno>

The absence of a “groove” can be discerned from the drawings in the description ⇒ A claim correction excluding the configuration “in which a groove is formed” is permitted.

(The first court decision in which “non”-existence could be read from drawings.)

⇒ A “groove” is an essential component of the primary reference, and there is a teaching away from its removal. Inventive step affirmed.

(Excerpts from the judgment)

<Addition of new matter>

Correction 1 merely excludes from the invention of claim 1 before correction the conceptually encompassed “silicon wafer in which a groove along said planned cutting line is formed in the silicon single-crystal structure portion,” or a groove-essential apparatus. Thus, Correction 1, whose purpose is to narrow the scope of the claims, does not add a new technical matter to the “laser processing apparatus” of the invention of claim 1. Even in light of the description, ... Figures 1 and 3 are plan views depicting planned cutting lines on workpiece 1, while neither Figure 2, a cross-sectional view along line II–II in Figure 1, nor Figure 4, a cross-sectional view along line IV–IV in Figure 3, shows a groove being formed. ... In Figures 1 through 4, “planned cutting lines” are depicted but “grooves” are not. If the invention before correction presupposed the presence of “grooves,” it would be unnatural to depict “planned cutting lines” yet deliberately omit “grooves.”

<Inventive step>

It is inconceivable that a person skilled in the art encountering Exhibit Ko 11 would eliminate from substrate 201 the grooves 203 that generate the internal stress used to cut a semiconductor wafer. There is not only no motivation to adopt as the workpiece a substrate 201 having no grooves along the break lines and modify it to form a processing-altered region inside substrate 201, whose surface has no grooves; rather, there is a teaching away from such a modification ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91261.pdf

IP High Court, 2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe>

Original Ameblo publication: 2022-07-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12754826208.html

IP High Court, 2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe>

<JPO decision>

Because this is an existing product optimized for its function, a corresponding motivation is required to modify it.

⇒ Inventive step affirmed.

<This judgment>

There is motivation to move the numerical values of the publicly worked product toward those of the invention, but the required extent of the change is unknown.

⇒ Inventive step affirmed.

(Excerpts from the judgment)

Difference 1B: dynamic air permeability. In Invention 1 it is “1,300 mm/s or less,” whereas in the cited invention it is “1,498 mm/s.”

Difference 1C: yarn pull-out resistance. In Invention 3 it is “146–200 N/cm/cm,” whereas in Cited Invention 1 it is “53 N/cm/cm.”

<JPO decision (conclusion: inventive step affirmed; upheld)>

Even if the problem is well known, the invention of Exhibit Ko 1 is an “existing product” optimized for its function, so a corresponding motivation is considered necessary to modify it. It cannot be said that there is motivation to modify its boiling-water shrinkage, individual filament fineness, yarn pull-out resistance and cover factor, which influence dynamic air permeability, within the ranges specified by Invention 1 to bring the dynamic air permeability into the specific range of “1,300 mm/s or less”; nor is there evidence showing this to be possible.

<This judgment>

(b) Increasing the cover factor

... It can be said that, at the priority date, a person skilled in the art would attempt to increase the cover factor of Cited Invention 1 above 2,131 in order to reduce yarn slippage at the sewn boundaries during airbag inflation and deployment and reduce dynamic air permeability after loading. However, the evidence does not establish the relationship between the degree of increase in cover factor and the degree of decrease in dynamic air permeability after loading; nor does it indicate that common general technical knowledge on this point existed at the priority date. Therefore, it is unknown how far the cover factor of 2,131 in Cited Invention 1 must be raised to reduce its dynamic air permeability after loading from 1,498 mm/s ... to 1,300 mm/s or less. It is conceivable that the cover factor would need to be raised above the upper limit of the 2,100–2,500 range described ... as more preferable in Invention 1 “from the standpoint of compatibility between deployment performance and productivity.” Moreover, because the cover factor is calculated from the mean total yarn fineness and mean weave density in the warp and weft directions ..., changes to the cover factor can also affect the total yarn fineness. ...

(c) Increasing yarn pull-out resistance

... It can be said that, at the priority date, a person skilled in the art had motivation to increase the yarn pull-out resistance in Cited Invention 1 to reduce yarn slippage at sewn boundaries during airbag inflation and deployment and reduce dynamic air permeability after loading. However, the evidence does not establish how far the mean warp/weft yarn pull-out resistance of 53 N/cm/cm in Cited Invention 1 must be raised to reduce its dynamic air permeability after loading from 1,498 mm/s ... to 1,300 mm/s or less. It is also unknown whether raising it to 200 N/cm/cm, the upper limit of that mean value in Invention 1, stated ... to ensure that “localized stress concentration in the constituent yarns no longer occurs and airbag rupture is not caused,” would suffice. It is conceivable that it might need to be raised above that upper limit.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86260.pdf

IP High Court, 2013 (Gyo-Ke) 10275 [Vulcanized Rubber Composition] <Ishii>

Original Ameblo publication: 2022-07-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755163026.html

IP High Court, 2013 (Gyo-Ke) 10275 [Vulcanized Rubber Composition] <Ishii>

Even without recognizing the invention's problem, inventive step is denied if the invention's "configuration" can readily be conceived.

"It is sufficient to be able to explain rationally how the configuration of Invention 1 is reached; there is no need to follow the same thought process as that actually leading to Invention 1, such as recognizing its problem."

(Excerpts from the judgment)

The defendant argues that Exhibits Ko 1 through Ko 3 do not disclose the problem of Invention 1, namely improving the balance of rolling-resistance characteristics, handling stability and durability in a vulcanized rubber composition containing chemically modified microfibrillated cellulose, and provide no suggestion of using rubber components such as natural rubber to solve that problem; therefore, it cannot be said that a person skilled in the art could readily have conceived the configuration of Invention 1. ... However, ... the statements in Exhibit Ko 3 can be understood to show that solving the problem of improved dispersibility by using modified microfibrillated cellulose applies generally to hydrophobic media, such as various polymers conventionally used as materials for different products. Thus, there is motivation to replace the styrene-butadiene copolymer in Invention A of Exhibit Ko 3 with a well-known rubber component such as natural rubber. In assessing the obviousness of Invention 1, it is sufficient to be able to explain rationally how its configuration is reached from Invention A of Exhibit Ko 3; there is no need to follow the same thought process as that actually leading to Invention 1, such as recognizing its problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84497.pdf

IP High Court, 2018 (Gyo-Ke) 10108 [Waste Treatment Method] <Takabe>

Original Ameblo publication: 2022-07-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755339448.html

IP High Court, 2018 (Gyo-Ke) 10108 [Waste Treatment Method] <Takabe>

* Inherent as a self-evident problem of the cited invention.

“Even if not ... expressly stated in Cited Reference 1 ... it is inherent as a self-evident problem .... The cited invention and the technology of Exhibit Ko 2 share the problem to be solved of preventing leaching of heavy metals from waste.”

(Excerpts from the judgment)

... It is recognized that the possibility that the “organic waste” treated in the cited invention may also contain heavy metals, and prevention of their leaching, are matters that a person skilled in the art would naturally consider in the technical field of the cited invention. Even though this is not expressly stated in Cited Reference 1, which focuses on separation of treated waste from liquid, it is inherent as a self-evident problem of the cited invention .... The cited invention and the technology of Exhibit Ko 2 share the problem to be solved of preventing leaching of heavy metals from waste ....

... Exhibit Ko 2 does not state that a tobermorite structure is formed as a layer on the solid matter of said organic waste .... It is not established that it was well-known technology for a tobermorite structure to be “formed” as a “layer” “on the solid matter of said organic waste”; ... the configuration of the claimed invention relating to Difference 2′ cannot be reached by applying the technology of Exhibit Ko 2 to Cited Invention 1.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88951.pdf

IP High Court, 2012 (Gyo-Ke) 10005 [Glucosamine-Containing Poultice] <Shiotsuki>

Original Ameblo publication: 2022-07-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755495414.html

IP High Court, 2012 (Gyo-Ke) 10005 [Glucosamine-Containing Poultice] <Shiotsuki>

The cited invention limits the crosslinking agent to one suitable for solving problems specific to vitamin C.

⇒ Even if glucosamine and vitamin C are known as skin-whitening agents, their physicochemical properties, such as chemical structures, are not necessarily similar.

⇒ Modification is difficult.

(Excerpts from the judgment)

... Cited Invention A limits the crosslinking agent to one suitable for solving problems specific to using vitamin C or its derivatives as an active ingredient, and concerns a poultice characterized by a particular combination of active ingredient and crosslinking agent. ... Even though glucosamine and vitamin C ... have both long been known as typical skin-whitening agents ..., glucosamine does not have physicochemical properties, such as chemical structure, similar to those of vitamin C. Therefore, their interactions with a metal crosslinking agent in a poultice cannot be considered similar.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82592.pdf

IP High Court, 2017 (Gyo-Ke) 10147 [Crystalline Polymorphs of ... Thiazolecarboxylic Acid] <Takabe>

Original Ameblo publication: 2022-07-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755662988.html

IP High Court, 2017 (Gyo-Ke) 10147 [Crystalline Polymorphs of ... Thiazolecarboxylic Acid] <Takabe>

* Under the state of the art at filing, the existence of crystalline polymorphs of the compound could be recognized.

⇒ For pharmaceuticals, searching for a crystal form with optimal bioavailability (usefulness in vivo) is a general technical problem.

⇒ Readily conceivable (inventive step denied).

(Excerpts from the judgment)

... For pharmaceuticals having crystalline polymorphs, it was common general technical knowledge among persons skilled in the art at the priority date that, to solve the above technical problem, they would naturally investigate recrystallization conditions and seek and attempt to obtain a crystal form considered optimal in view of various factors, including bioavailability (usefulness in vivo), stability in the crystalline state and formulation characteristics. ... The existence of crystalline polymorphs of the compound ... could be recognized. Accordingly, a person skilled in the art has motivation to investigate recrystallization conditions for the crystals of the cited invention ... to obtain a crystalline polymorph superior in stability and suitability for formulation ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88133.pdf

IP High Court, 2016 (Gyo-Ke) 10152 [Charge Control Agent] <Mori>

Original Ameblo publication: 2022-07-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755885240.html

IP High Court, 2016 (Gyo-Ke) 10152 [Charge Control Agent] <Mori>

<Novelty>

Reproduction of the cited reference rejected.

— Identity of the starting material and manufactured substance denied.

The defendant had been selling an iron complex compound under the product name “T-77” since before the patent application ... relating to the invention of Exhibit Ko 1, but has never sold a product named “Aizen Color T-77” ....

(Excerpts from the judgment)

[Claim 1] ... A charge control agent ... having an electrical conductivity of 110 μS/cm or less when the metal complex compound is dispersed at 1% by weight in ion-exchanged water ....

<Clarity requirement>

... The electrical conductivity difference between measurement samples 1 and 2, prepared under different dispersion conditions, is only 1 μS/cm. Thus, these experimental results can be said to show that no marked difference can arise in the measured electrical conductivity even when different dispersion methods are used.

<Novelty>

... The defendant had been selling an iron complex compound under the product name “T-77” since before the patent application ... relating to the invention of Exhibit Ko 1, but has never sold a product named “Aizen Color T-77” .... It cannot be found that the Chinese corporation that performed the Exhibit Ko 4 experiment purchased “Aizen Color T-77” around April 1999 and kept it until the time of that experiment .... The starting material used in the Exhibit Ko 4 experiment cannot be found to be the same product as the “Aizen Color T-77” described in Exhibit Ko 1.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87017.pdf

We have published an “Open Innovation” page on the NAKAMURA & PARTNERS website.

Original Ameblo publication: 2022-07-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12755890686.html

We have published an “Open Innovation” page on the NAKAMURA & PARTNERS website.

For an operating company to maintain and grow its existing business while making its “next move” toward further future growth, one effective approach is to collaborate with startups taking on new businesses.

https://www.nakapat.gr.jp/ja/practices-details/open-innovation/

IP High Court, 2015 (Gyo-Ke) 10081 [Crystals of Pitavastatin Calcium Salt] <Takabe>

Original Ameblo publication: 2022-07-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756022957.html

IP High Court, 2015 (Gyo-Ke) 10081 [Crystals of Pitavastatin Calcium Salt] <Takabe>

* The court did not accept the permissible error stated in the Commentary on the Japanese Pharmacopoeia.

⇒ Identity between the cited reference and the invention denied.

"... It cannot be said to have been common general technical knowledge among persons skilled in the art that values within ±0.2° could be regarded as identical."

(Excerpts from the judgment)

... Based on the statements in the Commentary on the 14th Japanese Pharmacopoeia ..., the JPO decision held that diffraction angles within ±0.2° could be regarded as identical. ...

The criterion of a permissible error "within ±0.2°" stated in the Commentary on the 14th Japanese Pharmacopoeia and in the 16th Japanese Pharmacopoeia cannot be construed as applicable generally to numerical diffraction-angle values measured by powder X-ray diffraction in patented inventions. Moreover, among patent applications specifying crystalline forms by numerical diffraction-angle values from powder X-ray diffraction measurements, some state only particular values in the claims without stating a permissible-error range, while others state such a range. The permissible-error ranges in the latter applications vary and are not limited to ±0.2° .... Therefore, the statements in the Commentary on the 14th Japanese Pharmacopoeia or the 16th Japanese Pharmacopoeia do not establish that, at the priority date, it was common general technical knowledge among persons skilled in the art that numerical diffraction-angle values measured by powder X-ray diffraction could be regarded as identical if they were within ±0.2°, when determining the identity of patented inventions. Accordingly, Invention 1 and the crystals of Exhibit Ko 3 cannot be regarded as identical.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85691.pdf

IP High Court, 2015 (Gyo-Ke) 10256 [Backflow Prevention Device] <Shimizu>

Original Ameblo publication: 2022-07-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756023264.html

IP High Court, 2015 (Gyo-Ke) 10256 [Backflow Prevention Device] <Shimizu>

* The mere possibility that a device having the same structure as the cited invention could perform the same operation as the invention at issue does not establish identity between the cited invention and the invention at issue.

... This means only that such operation is possible ...; it cannot be found ... that Exhibit Ko 2 describes the above operation.

(Excerpts from the judgment)

... The experimental report (Exhibit Ko 38-1) means only that a backflow prevention device having a structure similar to that shown in Figure 2 of Exhibit Ko 2 can be made to operate such that valve (23) does not open even when water solenoid valve (7) is closed, in a state without a pressure drop in the water supply. That experimental report does not establish that Exhibit Ko 2 describes shutoff device (16) of its invention as performing the above operation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86704.pdf

IP High Court, 2017 (Gyo-Ke) 10113 [... Foamable Composition] <Tsuruoka>

Original Ameblo publication: 2022-08-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756387433.html

IP High Court, 2017 (Gyo-Ke) 10113 [... Foamable Composition] <Tsuruoka>

① The court recognized errors in the examples and found the enablement requirement satisfied.

* A case in which post-filing reproduction tests could not negate enablement.

* Reproduction-test results were submitted showing inability to solve the problem in an extreme case.

⇒ The premise was erroneous because the alcohol concentration is inherently subject to limitations.

② Although the numerical range's upper limit was not incorporated into the claims, the support requirement was satisfied because a practical upper limit could be contemplated.

(Extract from the judgment: ① Enablement requirement)

... For the composition invention, the description is found to provide specific disclosures enabling a person skilled in the art to produce and use the composition based on the description and common general technical knowledge at the filing date of the parent application; for the method invention, it similarly enables use of the method. ... Even considering the statement above the table, “The prepared solutions were evaluated for whether foam was generated and, if so, the generated foam was described as follows,” it is reasonable to consider that foam was generated in Examples 33–36 in light of their compositions and the entries in the “Foam evaluation/description/characteristics” column. Accordingly, it is appropriate to find that a person skilled in the art would understand “No” in the “Foam generation” column as likely a typographical error. Therefore, the plaintiff's arguments concerning the descriptions of Examples 33–36 are difficult to accept. ...

The plaintiff argues that, in an experiment it performed, no foam formed in a composition containing 99.5 v/v% ethanol and only 0.01 wt% bis-PEG-12 dimethicone as surfactant. However, compliance with the enablement requirement should be determined from the detailed description of the invention, premised on common general technical knowledge at filing. Unless those experimental results are recognized as common general technical knowledge at the time of filing the parent application of the patent, compliance or noncompliance cannot be proved on the basis of experimental results merely obtained after filing. Even setting this point aside, ... the invention may contain a second surfactant and a foam stabilizer in addition to alcohol, bis-PEG-[10-20] dimethicone or a mixture of bis-PEG-[10-20] dimethicones, and water. Thus, the alcohol concentration is inherently subject to limitations, and the plaintiff's argument, which fails to take such limitations into account, is erroneous in its premise.

(Extract from the judgment: ② Support requirement)

... The plaintiff argues ... that, when the concentration of lower alcohol is 99.99 wt% or close to that value, the problem of providing a foamable composition capable of forming stable foam cannot be solved. However, ... Invention 1 may contain a second surfactant and a foam stabilizer in addition to alcohol, bis-PEG-[10-20] dimethicone or a mixture of bis-PEG-[10-20] dimethicones, and water. Accordingly, Invention 1 should be understood as contemplating ... a practical upper limit on the alcohol concentration. ...

The plaintiff's argument is based on an erroneous premise ... that does not take account of ... the detailed description of the invention ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88083.pdf

IP High Court, 2015 (Gyo-Ke) 10052 [Treatment of Diseases Using Nalmefene ...] <Shitara>

Original Ameblo publication: 2022-08-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756568549.html

IP High Court, 2015 (Gyo-Ke) 10052 [Treatment of Diseases Using Nalmefene ...] <Shitara>

* An argument that reproduction tests established compliance with the enablement requirement was rejected.

The description of the application ... contains absolutely no statement objectively substantiating the usefulness of the compound for the ... use ....

Considering ... pharmacological test results ... after filing ... is not permitted.

(Excerpts from the judgment)

... Even if there are generally cases in which pharmacological test results or similar information are stated in the description and written opinions or pharmacological test results may be submitted after filing to supplement them, ... the detailed description of the invention in this application merely states the use of a compound of formula R–A–X to prevent or treat hepatitis B virus infection and contains absolutely no statement objectively substantiating the compound's usefulness for that use. Considering pharmacological test results submitted after filing or test results in the basic application even in such a case must be regarded as impermissible ... in light of the purpose of the patent system.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85819.pdf

IP High Court, 2018 (Gyo-Ke) 10134 [Liquid-Crystal Medium] <Mori>

Original Ameblo publication: 2022-08-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756753730.html

IP High Court, 2018 (Gyo-Ke) 10134 [Liquid-Crystal Medium] <Mori>

* “The threshold voltage can be reduced” is neither stated in the description nor part of common general technical knowledge among persons skilled in the art at the filing date.

⇒ Reproduction-test results confirming this technical finding cannot be considered when assessing the support requirement.

(The same as in other court decisions. The same applies to enablement.)

(Excerpts from the judgment)

The plaintiff argues ... concerning experiments. However, ... the description does not state that the threshold voltage can be reduced by decreasing K1 in a display using an n-type liquid-crystal compound; nor are the experimental results recognized as having been common general technical knowledge of the parties at the filing date of the patent. Therefore, those experimental results cannot be used as a reference to consider, in assessing the support requirement, the proposition that the threshold voltage can be reduced by decreasing K1 in a display using an n-type liquid-crystal compound ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88790.pdf

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

Original Ameblo publication: 2022-08-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12756938357.html

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

A person skilled in the art can recognize it as a general problem.

⇒ Inventive step denied.

(Excerpts from the judgment)

... A person skilled in the art is recognized as able to understand that the problem of reverse thrust force (a reverse-thrust load condition) ... occurs in screw compressors generally, and can recognize that it also occurs in the invention of Exhibit Ko 1 .... Thus, for that invention as well, ... motivation arises to provide a nonpressurized path to eliminate reverse-thrust loading in order to solve such a problem .... Accordingly, even if Exhibit Ko 1 does not directly mention the technical problem of reverse thrust force (a reverse-thrust load condition), or its elimination, motivation arises to provide a nonpressurized path in its invention to solve that problem ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90385.pdf

<Article> “Issues under Patent Law and the Consistent Thread of the ‘Problem’” (2019, Hideki Takaishi)

Original Ameblo publication: 2022-08-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12757118748.html

<Article> “Issues under Patent Law and the Consistent Thread of the ‘Problem’” (2019, Hideki Takaishi)

I examined, issue by issue, how the outcome of various issues under patent law is affected by whether the invention's problem is understood at a higher conceptual level (abstractly) or a lower conceptual level (specifically).

Inventive step

Support requirement

Addition of new matter

Other issues

https://system.jpaa.or.jp/patent/viewPdf/3401

<Article> “Application of Article 105(1) of the Patent Act — Focusing on ‘Necessity’ and ‘Legitimate Grounds’”

Original Ameblo publication: 2022-08-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12757694039.html

<Article> “Application of Article 105(1) of the Patent Act — Focusing on ‘Necessity’ and ‘Legitimate Grounds’”

Document production orders have rarely been granted on infringement-of-claim-elements issues in patent litigation, but the IP High Court judgment in 2015 (Ne) 10029 interpreted “necessity” flexibly, which offers hope for the future.

The inspection system was introduced after this article was written, but no order has yet been issued.

https://www.takaishihideki.com/_files/ugd/324a18_cde148ad4ec84f3995b471bcd42fe2a5.pdf

<Article> “The Significance of ‘Effects Different in Kind’ in Assessing Inventive Step” (2016, Hideki Takaishi)

Original Ameblo publication: 2022-08-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12757694241.html

<Article> “The Significance of ‘Effects Different in Kind’ in Assessing Inventive Step — An Integrated Understanding of the ‘Problem’ and ‘Effects Different in Kind’ in Assessing Obviousness” (2016, Hideki Takaishi)

Setting a unique problem contributes to inventive step.

Ventilation-Fan Filter

X-Ray Fluoroscopy Apparatus

In terms of the court decisions, an effect different in kind means a problem different in kind!!

https://www.takaishihideki.com/_files/ugd/324a18_0e3af17bb2dc412da006b117716f98ac.pdf

<Article> “... The ‘Problem’ in the Support Requirement” (2019.6, Intellectual Property Management, Hideki Takaishi)

Original Ameblo publication: 2022-08-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12757694399.html

<Article> “... The ‘Problem’ in the Support Requirement” (2019.6, Intellectual Property Management, Hideki Takaishi)

The standard for the support requirement: the Polarizing Film Grand Panel judgment.

⇒ The outcome depends on the level of abstraction at which the invention's problem is understood.

The trend shifted toward a pro-patent approach with the Pyrimidine Grand Panel judgment, and this continues as of 2022.

https://www.takaishihideki.com/_files/ugd/324a18_110e4c29caba4d1d860db7cc446055cd.pdf

<Article> “Criteria for Determining ‘Substantial Change’ in Corrections to Claims” (2009, Hideki Takaishi and Shogo Nakamura)

Original Ameblo publication: 2022-08-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12757838483.html

<Article> “Criteria for Determining ‘Substantial Change’ in Corrections to Claims” (2009, Hideki Takaishi and Shogo Nakamura)

Under the statutory wording, even a “narrowing” may constitute a “substantial ... change.”

⇒ (According to the court decisions,) this is determined by whether the purpose or functions and effects of the invention or device are substantially the same before and after correction.

https://www.jpaa.or.jp/old/activity/publication/patent/patent-library/patent-lib/200912/jpaapatent200912_086-098.pdf

<Article> “Transfer of Indirectly Infringing Products and ‘Exhaustion’ of Patent Rights” (2015, Hideki Takaishi)

Original Ameblo publication: 2022-08-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758020332.html

<Article> “Transfer of Indirectly Infringing Products and ‘Exhaustion’ of Patent Rights” (2015, Hideki Takaishi)

Product invention (iPhone Grand Panel judgment)

⇒ Corresponds to a case in which “a patented product lacking identity with the original was newly manufactured.”

⇒ No exhaustion.

Method invention (Ink Tank Grand Panel judgment)

⇒ Exhaustion applies to an indirectly infringing product.

U.S. Quanta

⇒ Exhaustion applies if the invention is substantially embodied.

https://system.jpaa.or.jp/patents_files_old/201507/jpaapatent201507_062-077.pdf

IP High Court, 2020 (Gyo-Ke) 10077 [5-HT1A Receptor Subtype Agonists] <Otaka>

Original Ameblo publication: 2022-08-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758168407.html

IP High Court, 2020 (Gyo-Ke) 10077 [5-HT1A Receptor Subtype Agonists] <Otaka>

= Same year and case type, Nos. 10078 and 10082; Nos. 10079 and 10083; Nos. 10080 and 10084.

“The risk of various adverse events” does not constitute a “special circumstance” negating enablement.

The support requirement is also satisfied.

“Unless it is clear ... that administration should be avoided ..., it is sufficient that a person skilled in the art can understand that it has a therapeutic effect.”

(Excerpts from the judgment)

It is recognized that, at the filing date, it was common general technical knowledge that 5-HT1A receptor partial agonists generally had therapeutic effects on depressive episodes in bipolar disorder through their antidepressant action. ... In light of the realities of pharmaceutical development, the contents of the pharmaceutical approval-review system, and the fact that examination of the Patent Act's disclosure requirements (enablement and support) should be conducted with regard to the Act's purpose, under the first-to-file principle, of encouraging inventions and thereby contributing to industrial development through their protection and utilization, the following is sufficient for a pharmaceutical-use invention, which is a product invention, to be capable of being “worked” through “the act of using that product”: unless there are special circumstances, such as it being clear that administration should be avoided because administering the drug to patients suffering from the disease targeted by the pharmaceutical use creates a risk of serious side effects or adverse events, a person skilled in the art can understand from the detailed description and common general technical knowledge at filing that the drug has a therapeutic effect on the target disease ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90854.pdf

<Copyright> Tokyo District Court, 2018 (Wa) 38486 <Kokubu>

Original Ameblo publication: 2022-08-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758372254.html

<Copyright> 2018 (Wa) 38486 <Kokubu>

Breach of a license agreement.

⇒ Claim for contractual penalties.

JPY 66.09 million awarded!!

“... Given these circumstances, even considering that the contractual penalty under the agreement was ten times the ordinary licensing fee, the contractual penalty agreement cannot be said ... to violate public policy.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90283.pdf

IP High Court, 2011 (Gyo-Ke) 10127 [Swing Clamp] <Shiotsuki>

Original Ameblo publication: 2022-08-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758441320.html

IP High Court, 2011 (Gyo-Ke) 10127 [Swing Clamp] <Shiotsuki>

Claims 1 and 2 use the same claim wording as the basic application.

⇒ Priority is recognized!! (But inventive step is still denied.)

Added claim 3 adds new matter.

*Claim Differentiation

⇒ Assessed claim by claim, priority is denied only for the added claim as adding new matter.

(Excerpts from the judgment)

The claims for Invention 3 specify “in the swing clamp of claim 1 or 2,” thereby referring to the configuration of Invention 1 or 2 (a dependent claim). However, as to the guide grooves of the clamp rod, Invention 1 merely imposes the limitations “a plurality arranged at approximately equal intervals circumferentially,” “a plurality provided in the second sliding portion (12),” and “said plurality of guide grooves (26) each comprise a swing groove (27) and a straight groove (28) provided in succession from the other axial end to the one axial end, said plurality of swing grooves (27) being arranged parallel to one another and said plurality of straight grooves (28) being arranged parallel to one another.” Likewise, Invention 2 merely imposes a limitation on the number of clamp-rod guide grooves: “three or four of said guide grooves (26) are provided.”

Accordingly, Inventions 1 and 2 do not specify the inclination angle of the guide grooves. The fact that the defining feature of Invention 3 relating to that angle, “the inclination angle is within the range of 10 to 30 degrees,” is not disclosed in the descriptions (including drawings) of the first through third basic applications does not mean that Inventions 1 and 2 were specified, filed and registered as including that matter as a defining feature. This reasoning becomes clearer if, for example, one assumes that claim 3 (Invention 3) is deleted from the claims. Therefore, in light of the claims for Inventions 1 and 2 (claims 1 and 2), the patent application can be said to have been filed “based on an invention described in the description or drawings ... originally attached to the application” of the earlier application within the meaning of Article 41(1) of the former Patent Act. There is no reason why the plaintiff should lose the benefit of priority for Inventions 1 and 2, and the earliest priority date (... the filing date of the first basic application) may be used as the reference date for applying Article 29 of the Patent Act.

However, as determined regarding Grounds for Revocation 1 and 2 above, even using that date as the reference date, the patents for Inventions 1 and 2 are invalid for lack of inventive step based on the invention of Exhibit Ko 12 and other evidence.

https://www.ip.courts.go.jp/app/hanrei_jp/detail?id=2857

IP High Court, 2005 (Gyo-Ke) 10737 [Bactericide] <Mimura>

Original Ameblo publication: 2022-08-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758441586.html

IP High Court, 2005 (Gyo-Ke) 10737 [Bactericide] <Mimura>

"To enjoy the benefit of priority ... for a chemical substance, it is insufficient merely to show a chemical structural formula or production method in the first-country application ... documents and thereby demonstrate theoretical producibility; ... it must be possible actually to confirm that the chemical substance exists in reality."

(Excerpts from the judgment)

To enjoy the benefit of priority under the Paris Convention, ... one completed invention must be ascertainable from the entirety of the first-country application documents on which priority is based. Moreover, the claimed invention concerns a chemical substance. To enjoy the benefit of Paris Convention priority for a chemical substance, it is insufficient merely to show a chemical structural formula or production method in the first-country application documents and thereby demonstrate theoretical producibility; it must be possible actually to confirm from those application documents as a whole that the chemical substance exists in reality ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33861.pdf

IP High Court, 2021 (Ne) 10022 [Webpage Browsing Method] <Shoji>

Original Ameblo publication: 2022-08-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12758894838.html

IP High Court, 2021 (Ne) 10022 [Webpage Browsing Method] <Shoji>

“Area corresponding to an access point” = the location where the access point is installed and a certain area in its vicinity.

⇒ Reversed; claim elements not satisfied.

The first instance (2017 (Wa) 24942) found the claim elements satisfied.

= The area corresponding to the geographical extent of the physical network or similar infrastructure used by the access point assigning the IP address.

(Excerpts from the judgment)

... “Area corresponding to an access point” and similar expressions should be construed as “the location where the access point is installed and a certain area in its vicinity.” In principle, “a certain area in its vicinity” should be construed, assuming a dial-up connection, as the area in which communication is available at the same local-call rate, namely a unit charging area. ... The defendant's methods do not identify “the location where the access point is installed and the area in its vicinity”; thus, they do not use a database or the like providing a one-to-one correspondence between “IP address” and “area corresponding to an access point” (the access point's installation location and its vicinity), nor do they identify “the area to which the access point belongs” (the access point's installation location and its vicinity) ....

★ Extract from the first-instance judgment: Tokyo District Court, 2017 (Wa) 24942 <Sato>

“‘Area corresponding to an access point’ and similar expressions in Constituent Element 1B1 and other elements mean ‘the area corresponding to the geographical extent of the physical network or similar infrastructure used by the access point assigning the IP address.’”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91201.pdf

Tokyo District Court, 2017 (Wa) 3569 [Solenoid] <Shimasue>

Original Ameblo publication: 2022-08-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12759081720.html

Tokyo District Court, 2017 (Wa) 3569 [Solenoid] <Shimasue>

* “Sealingly fitted” requires the end member itself to produce an effect preventing corrosion of the solenoid.

⇒ The claim element is not satisfied even if the effect is produced in combination with an O-ring.

⇒ Reversed on appeal (IP High Court, 2018 (Ne) 10034).

* Both the first instance and the appeal concern the interpretation of “sealingly fitted.”

(Excerpts from the judgment)

[Claim 1] ... A solenoid characterized by providing ... an end member made of corrosion-resistant material that is sealingly fitted into the mounting hole and closes its opening ....

... Because the degree of sealing required by “sealingly fitted” is not uniquely and clearly determined by the above alone, it should be interpreted taking into account the statements outside the claims and the drawings in the description (Article 70(2) of the Patent Act ...). ... The invention has a structure advantageous for corrosion resistance and is intended, among other things, to achieve high reliability and a long service life (paragraph [0014]). As the means to that end, it uses an end member made of corrosion-resistant material, sealingly fitted into the mounting hole in the housing member to close its opening, to inhibit ingress of the external atmosphere (fluids such as moisture and water) (paragraphs [0015] and [0016]). Its effect is to enable improved corrosion resistance of the solenoid (paragraph [0046]). Accordingly, the degree to which the end member is sealingly fitted into the mounting hole must inhibit ingress of the external atmosphere sufficiently to produce the effect of improving the solenoid's corrosion resistance. ...

... The defendant's product with the O-ring removed is not recognized as having the effect of inhibiting water ingress into the mounting hole .... In response, the plaintiff argues that the experiments in Exhibits Otsu 14 and 15 are meaningless because they show results under extreme conditions wholly different from those in which the defendant's product is actually used. However, as stated above, normal use of the defendant's product requires that the control valve remain free of corrosion for at least about ten years even in an environment exposed to sea breezes. Accordingly, experiments involving 400 hours of saltwater spray (Exhibit Otsu 14), or large amounts of water and vibration (Exhibit Otsu 15), cannot be said to show results under extreme conditions wholly different from normal use.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87629.pdf

Appeal: IP High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

Original Ameblo publication: 2022-08-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12759244637.html

Appeal: IP High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

* “Sealingly fitted” does not require the end member itself to produce an effect preventing corrosion of the solenoid.

⇒ The claim element is satisfied because the effect is produced in combination with the O-ring.

⇒ The first instance found non-satisfaction (2017 (Wa) 3569 <Shimasue>).

* In both the first instance and the appeal, interpretation of “sealingly fitted” was at issue. ⇒ Opposite conclusions.

(Excerpts from the judgment)

[Claim 1] ... A solenoid characterized by providing ... an end member made of corrosion-resistant material that is sealingly fitted into the mounting hole and closes its opening ....

... The degree to which mechanical parts must be “fitted” so as to “seal tightly” to constitute “sealingly fitted” in the invention is not necessarily uniquely specified by the claims. Turning to the description to interpret the term, it states: “characterized by comprising an end member made of corrosion-resistant material that is sealingly fitted into said mounting hole and closes the opening thereof” (paragraph [0015]); and “As a result, the components of the solenoid housed inside the mounting hole and located farther inward than the end member are not exposed to the outside, and ingress of the external atmosphere (fluids such as moisture and water) is inhibited by the end member, making it possible to improve corrosion resistance in the state assembled to the mating housing member” (paragraph [0016]). In light of these statements, ... “sealing” in “sealingly fitted” refers to a degree that “inhibits” ingress of the external atmosphere (fluids such as moisture and water) ....

It is undisputed between the parties that the defendant's product ... has a sealing member at the outer end of the plate and, when housed in said mounting hole, has a configuration ... that seals between the body and the mounting hole to inhibit ingress of external air, moisture and other substances. ...

According to the results of the experiments in Exhibits Otsu 1 and 14, Ko 49 and 58, and Otsu 19 and 20, ingress of the external atmosphere (moisture, water and the like) is completely suppressed in the defendant's product having an end member and sealing member (O-ring). Accordingly, by fitting end member (H) into the opening at the upper side of the body, the defendant's product inhibits ingress of the external atmosphere; and by including the sealing member, it produces the further effect of sealing between the body and the mounting hole to inhibit such ingress more strongly. Therefore, the defendant's product also satisfies ... the wording “‘sealingly’ fitted.” ...

In response, the appellee argues, on the premise ... that “sealingly fitted” must inhibit ingress of the external atmosphere sufficiently for the end member itself to prevent corrosion of the solenoid, that the test results show that the defendant's product with the O-ring removed fails to inhibit ingress into the mounting interior. However, ... the appellee's interpretation of “sealingly fitted” in Constituent Element B6 is erroneous, so the argument lacks its premise and cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91122.pdf

U.S. Supreme Court judgment, 2022.6.13, ZF Automotive v. Luxshare

Original Ameblo publication: 2022-08-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12759414470.html

U.S. Supreme Court judgment

2022.6.13

ZF Automotive v. Luxshare

*The Court held that 28 U.S.C. § 1782 did not apply to the private commercial arbitral panel or the ad hoc investment-arbitration panel at issue.

⇒ The provision covers adjudicative bodies vested with governmental authority by one or more nations.

⇒ This case involved arbitration by a nongovernmental dispute-resolution body.

When conducting international arbitration in Japan, should arbitration be conducted in a court in order to use USC 1782 ...?

https://www.youtube.com/watch?v=QIypezEBrT8

[Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036 <A case recognizing the outer box and container as an indication of goods or business>

Original Ameblo publication: 2022-08-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12759592659.html

[Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036

<A case recognizing the outer box and container as an indication of goods or business>

Overall warm colors with an orange tint.

Text and designs placed at the top and bottom.

⇒ The orange hue leaves a strong impression on consumers.

Two horizontal red lines, one at the top and one at the bottom.

⇒ In particular, the silver border on the upper red line catches consumers' eyes.

https://bran-design.jp/topics/column/1044/

Tokyo District Court, 2021 (Wa) 3816 [Vitamin D Derivative Crystals and Method for Producing Them] <Shibata>

Original Ameblo publication: 2022-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760124170.html

2021 (Wa) 3816 [Vitamin D Derivative Crystals and Method for Producing Them] <Shibata>

There is no evidence directly substantiating that the defendant uses the method in the reference synthesis example. Even from the statements in the description and the Nissan Chemical description alone, a method that does not pass through the starting material of the reference synthesis example can be envisaged.

Although the defendant refused to disclose its manufacturing method, the claim elements were not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91016.pdf

2022.01 U.S. CAFC — Evolusion v. Juggernaut

Original Ameblo publication: 2022-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760124380.html

2022.01 U.S. CAFC — Evolusion v. Juggernaut

Where identical claim language is used in another claim, the language is construed as having a consistent meaning unless it clearly has a different meaning in that other claim.

(The same applies even if the embodiments contain a particular limiting element.)

https://www.oliff.com/wp-content/uploads/2022/02/2021-1987-OB.pdf

<Trademark> IP High Court, 2021 (Gyo-Ke) 10010 (Otaka)

Original Ameblo publication: 2022-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760124486.html

<Trademark> IP High Court, 2021 (Gyo-Ke) 10010 (Otaka)

The defendant's registered trademark consisting of the standard characters “Pearl Apatite,” with designated goods including Class 1 “chemicals” and Class 3 “cosmetics, soaps,” does not fall under Article 4(1)(xvi) of the Trademark Act because it is not “likely to mislead as to the quality of the goods.”

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e5%95%86%e6%a8%99%e6%b3%95%e2%98%85%e3%80%91%e3%80%8c%e3%83%91%e3%83%bc%e3%83%ab%e3%82%a2%e3%83%91%e3%82%bf%e3%82%a4%e3%83%88%e3%80%8d%e3%81%ae%e6%a8%99%e6%ba%96%e6%96%87%e5%ad%97%e3%81%8b/

Tokyo District Court, 1998 (Wa) 8345 [Ear-Hanging Apparatus for Cultured Shellfish] <Mimura>

Original Ameblo publication: 2022-08-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760289169.html

Tokyo District Court, 1998 (Wa) 8345 [Ear-Hanging Apparatus for Cultured Shellfish] <Mimura>

* Divisional applications and amendments are permitted within the same scope.

= Tokyo District Court, 2003 (Wa) 9215 <Mimura>

[Fastener and Cord-Fastening Apparatus]

“For a divisional application to be recognized ... as lawful, ... it must be made within the scope in which the original application could be amended.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13449.pdf

Tokyo High Court, 1998 (Gyo-Ke) 298 — Generalizing the CD-ROM embodiment to “disk recording and/or reproduction apparatus”

Original Ameblo publication: 2022-08-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760461922.html

Tokyo High Court, 1998 (Gyo-Ke) 298

The CD-ROM embodiment could be generalized and corrected to “disk recording and/or reproduction apparatus.”

⇒ No addition of new matter.

— In view of the purpose of the device, its technical subject matter was a versatile device applicable to any type of “disk recording and/or reproduction apparatus” or similar equipment.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12020.pdf

Tokyo District Court, 2003 (Wa) 3552 [Quartz Crystal Resonator] <Takabe>

Original Ameblo publication: 2022-08-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760644885.html

Tokyo District Court, 2003 (Wa) 3552 [Quartz Crystal Resonator] <Takabe>

(Claim 1) ... A quartz crystal resonator ... provided with ... a holding-container outer-surface positioning piece having a curved surface conforming to the shape of the outer surface of the holding container ....

* Construction of the claim phrase “a curved surface conforming to ...”

⇒ A shape producing the effect is sufficient; it need not coincide with the shape of the outer surface of the holding container.

(Excerpts from the judgment)

[Claim 1] ... A quartz crystal resonator characterized by being provided with ... a holding-container outer-surface positioning piece having a curved surface conforming to the shape of the outer surface of the holding container ....

The purposes of the invention are ① to prevent the quartz crystal resonator body from tilting during manufacture and causing the lead weld to come off, and ② to enable grounding of the holding container during mounting so that the quartz crystal resonator can be used with high resistance to noise. To those ends, it is characterized by i) positioning and molding the quartz crystal resonator body using an outer-surface positioning piece and a holding-container top-surface positioning piece (Constituent Element D), and ii) using said outer-surface positioning piece or holding-container top-surface positioning piece as an external terminal for grounding the resonator body (Constituent Element E).

Accordingly, the outer-surface positioning piece in Constituent Element B must also have a shape that enables positioning without tilting the quartz crystal resonator and can serve as an external grounding terminal; any shape meeting those conditions achieves the purpose. That is, the outer-surface positioning piece must have a curved surface conforming to the holding container's outer surface so that the resonator does not tilt during molding, and must contact the holding container so as to serve as an external grounding terminal. However, a shape capable of supporting the resonator is sufficient, and coincidence with the shape of the outer surface is not required.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E3%80%8C%E8%96%AC%E5%89%A4%E5%88%86%E5%8C%85%E7%94%A8%E3%83%AD%E3%83%BC%E3%83%AB%E3%83%9A%E3%83%BC%E3%83%91%E3%80%8D%E4%BA%8B%E4%BB%B6%EF%BC%8D/

Osaka District Court, 2002 (Wa) 6178 [Artificial Kidney Perfusion Agent for Bicarbonate Dialysis] <Komatsu>

Original Ameblo publication: 2022-08-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12760813127.html

Osaka District Court, 2002 (Wa) 6178 [Artificial Kidney Perfusion Agent for Bicarbonate Dialysis] <Komatsu>

(Claim 7) ... An artificial kidney perfusion agent ... consisting of granules in which a plurality of sodium chloride particles are bonded through said coating layer ....

* Construction of the claim phrase “consisting of”

⇒ It is sufficient that granules are formed to an extent producing the effects.

⇒ Claim elements satisfied.

(Excerpts from the judgment)

... The invention selects a powdered form for Agent A used in an artificial kidney perfusion agent, rather than a solution form with problems concerning transport costs, storage space, disposal of containers and the like. To solve problems such as contamination by foreign matter and variation in component composition when a known granulation method is adopted to powder Agent A, it forms a uniform-composition “coating” containing as essential components the electrolyte compounds specified in its claims (claim 7), and uses that coating layer as a binder to bond sodium chloride particles together. This enables Agent A to be obtained with each component proportion at a substantially constant, specified value ....

... Accordingly, the “coating layer” in Constituent Elements A and B of the invention requires only that the surfaces of the sodium chloride particles be coated sufficiently to produce the above functions and effects (the uniformity asserted by the defendants likewise need only be satisfied to that extent), and does not require complete (100%) or nearly complete coverage. Similarly, “consisting of” in Constituent Element B requires only that granules in which a plurality of sodium chloride particles are bonded through the coating layer be formed sufficiently to produce those functions and effects; it does not require the complete absence of individual sodium chloride particles.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10298.pdf

Osaka District Court, 2016 (Wa) 2688 [Coated Copper Wire for Ball Bonding]

Original Ameblo publication: 2022-08-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761079089.html

Osaka District Court, 2016 (Wa) 2688 [Coated Copper Wire for Ball Bonding]

* The permissible range of impurities is the range within which the problem of the invention can be solved.

⇒ The permissible Pd content is approximately 2%.

“If the admixture of palladium is within approximately 2% ..., the problem-solving principle of the inventions, utilizing the relative melting points of the metals, remains applicable ....”

(Excerpts from the judgment)

... When palladium is used for the intermediate coating layer, ... the melting point rises above approximately 1,064°C as the palladium content increases, and exceeds copper's intrinsic melting point of approximately 1,085°C when the palladium content exceeds approximately 2% .... In light of this, if more than approximately 2% palladium (Pd) from the inner coating layer mixes into the surface coating layer formed of gold (Au), the problem-solving principle of the inventions, which utilizes the relative melting points of the metals, ceases to apply. Conversely, if palladium admixture is within approximately 2%, the melting point of the gold-palladium alloy is lower than that of copper (Cu), and the alloy's melting point reflects the intrinsic melting points of gold (Au) and palladium (Pd) as described above. Thus, the problem-solving principle utilizing the relative melting points of the metals remains applicable. Accordingly, where palladium (Pd) is used for the intermediate coating layer, a “skin layer of gold (Au)” need not consist exclusively of gold (Au), but, as the defendant argues in the alternative, it should be construed as requiring that palladium (Pd) admixture be no more than approximately 2%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88033.pdf

Tokyo District Court, 2002 (Wa) 16268 [Copper-Based Alloy for Electrical Connectors] <Iimura>

Original Ameblo publication: 2022-08-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761079288.html

Tokyo District Court, 2002 (Wa) 16268 [Copper-Based Alloy for Electrical Connectors] <Iimura>

① Statements in the description.

② The extremely low predictability of how changes in constituent elements or added amounts affect an alloy's properties.

③ Arguments during prosecution.

“Consisting essentially of ...”

⇒ Inclusion of elements affecting the alloy's characteristics is not permitted.

(Excerpts from the judgment)

... In light of the facts that ② alloys generally have extremely low predictability as to how changes in constituent elements or added amounts affect their properties, and ③ during prosecution, the plaintiff stated that increasing other elements in a Cu-Ni-Si-based alloy worsens electrical conductivity and bending characteristics, and that an alloy containing 0.39% tin (Sn) cannot be adopted because it reduces conductivity and therefore should be excluded from the technical scope of the invention, “consisting essentially of ...” in Constituent Element A should be construed as permitting, besides nickel (Ni), silicon (Si), magnesium (Mg) and copper (Cu), elements specifically described in the description and elements that a person skilled in the art could readily conceive based on its statements. It cannot, however, be construed as permitting elements beyond that scope that affect the alloy's characteristics. ... The zinc (Zn) and tin (Sn) in the defendant's product exceed in content the magnesium (Mg) specified in Constituent Element A, and cause differences in alloy characteristics by improving stress-relaxation resistance while reducing electrical conductivity. Accordingly, the defendant's product containing zinc (Zn) and tin (Sn) does not satisfy Constituent Element A.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10491.pdf

Tokyo District Court, 2003 (Wa) 9102 [Nonaqueous Secondary Battery] <Iimura>

Original Ameblo publication: 2022-08-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761336015.html

Tokyo District Court, 2003 (Wa) 9102 [Nonaqueous Secondary Battery] <Iimura>

[Claim 1] ... A nonaqueous secondary battery characterized by ... being eccentric.

Based on the active expression “make eccentric” in the description and other factors, the claim wording “being eccentric” was construed as excluding displacement of the degree inevitably arising during manufacture.

⇒ Claim element not satisfied. Equivalence not established.

[Claim 1] ... A nonaqueous secondary battery characterized by ... being eccentric.

(Excerpts from the judgment)

... In light of 〈1〉 the fact that a slight displacement inevitably arises in the center pin due to springback (see Exhibits Ko 26-1 and 26-2), and 〈2〉 the active expression “make eccentric” used for the center-pin tube in the detailed description of the invention, it is clear that “being eccentric” does not encompass a displacement of the degree of springback-induced bending back of the winding-end side relative to the winding-start end that inevitably results from bending metal.

http://matlaw.info/hank-r04.htm

IP High Court, 2005 (Ne) 10052 [Electronically Detectable and Deactivatable Marker] <Tsukahara>

Original Ameblo publication: 2022-08-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761511689.html

IP High Court, 2005 (Ne) 10052 [Electronically Detectable and Deactivatable Marker] <Tsukahara>

* Based on the meaning of “through-hole” in the description ...

⇒ The “cracks” in the defendant's product were formed accidentally when thinning the insulating layer to create a thin polyethylene portion, and therefore do not constitute the “through-hole” of Constituent Element J.

[Claim 1] ... A resonance label ... in which a predetermined short-circuit path is formed by at least one through-cut or through-hole (11) provided in said insulating layer (1) ....

(Excerpts from the judgment)

... In light of the statements in Description 2, Invention 2 is characterized by specifically cutting open a certain location in the insulator between electrodes by some method to form cuts or holes of certain sizes and spacing, so as to cause discharge at a specified location and deactivate the label. Accordingly, ... “through-cut or through-hole” should mean an opening formed by cutting open the insulating layer between the electrodes. The original judgment found that “cracks arise in the aluminum and polyethylene portions when the crater-shaped portion of the defendant's product is formed.” Those cracks are formed accidentally when thinning the insulating layer to create a thin polyethylene portion, so the “cracks” found by the original judgment cannot be said to constitute the “through-hole” of Constituent Element J.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9540.pdf

Tokyo High Court, 2003 (Ne) 1223 [Method for Searching for Stable Complex Structures of Biological Macromolecules and Ligand Molecules] <Yamashita>

Original Ameblo publication: 2022-08-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761687090.html

Tokyo High Court, 2003 (Ne) 1223 [Method for Searching for Stable Complex Structures of Biological Macromolecules and Ligand Molecules] <Yamashita>

Indirect infringement established for an exclusively used product.

"... Insufficient to establish that a use not employing ... is, according to common social understanding, an economic, commercial or practical use."

* Even if an exclusive license is established over the entire scope, the patentee retains the right to seek an injunction.

= Supreme Court, 2004 (Ju) 997 is to the same effect.

(Excerpts from the judgment)

Although SYBYL ... contains various tools necessary for molecular design, the findings made thus far readily establish that FlexX plays an extremely important, central role in molecular design. From the content and functions of Method B found above, it is clear that molecular design without using FlexX is hardly conceivable.

The expression "a product used exclusively for working that invention" in Article 101(ii) of the Patent Act means a product having no use other than use in the method invention. To rebut proof that it is "a product used exclusively for working that invention," it is insufficient merely to state that there is, in the abstract, a use other than use in the method invention; it is necessary to allege and prove facts sufficient to establish that the other use is, according to common social understanding, an economic, commercial or practical use .... However, as to SYBYL, ... even if it includes software other than FlexX, using SYBYL for purposes other than molecular design is not conceivable in practice. Given the importance of FlexX in molecular design described above, examination of all the evidence in this case reveals no evidence sufficient to establish that a use not employing FlexX is, according to common social understanding, an economic, commercial or practical use. ... When using FlexX (Method B), a method of searching for stable complexes using only hydrophobic interactions cannot be regarded as an economic, commercial or practical use according to common social understanding; FlexX (Method B) is used exclusively for a method of searching for stable complexes whose interactions include hydrogen bonding ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10483.pdf

Tokyo District Court, 2003 (Wa) 6742 [Narrow-Necked Bottle with Packaging Label] <Takabe>

Original Ameblo publication: 2022-09-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12761864534.html

Tokyo District Court, 2003 (Wa) 6742 [Narrow-Necked Bottle with Packaging Label] <Takabe>

[Claim 1] ... A narrow-necked bottle with a packaging label, characterized by ... incorporating an ultraviolet absorber into, or applying it to, a heat-shrink film ....

⇒ “Ultraviolet absorber” was narrowly construed as something maintaining transparency; the defendant's white product was held not to satisfy the claim element.

(Excerpts from the judgment)

... The description identifies as effects of the device that applying an ultraviolet absorber enables use of a transparent bottle and allows its contents to be inspected from outside the transparent bottle. ... Moreover, in a supplemental statement of reasons for the appeal against refusal, the applicant obtained the utility model right by emphasizing that the device differs from prevention of ultraviolet light through a light-shielding function described in Cited Document 3 ..., or by adding colorants or pigments or depositing aluminum as illustrated in Cited Document 4 ..., in that it prevents ultraviolet light while maintaining label transparency. Taken together, these circumstances indicate that “ultraviolet absorber” in the device is limited to substances that allow label transparency to be maintained when incorporated. ... The titanium oxide contained in the defendant's white ink is white and does not maintain transparency; for this reason as well, it cannot be considered an “ultraviolet absorber” in the device.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10471.pdf

Osaka District Court, 1992 (Wa) 6690 [Transfer Printing Sheet] <Komatsu>

Original Ameblo publication: 2022-09-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12762056605.html

Osaka District Court, 1992 (Wa) 6690 [Transfer Printing Sheet] <Komatsu>

* Surfactants and defoaming agents are distinct, parallel concepts in the description.

⇒ A silicone compound in the defendant's product may have been added as a defoaming agent or as a surfactant.

⇒ In Product A, its use is as a defoaming agent.

⇒ Claim element not satisfied.

[Claim 1] ... A transfer printing sheet ... using, as at least part of the incorporated surfactant, at least one surfactant selected from the group consisting of ... .

(Excerpts from the judgment)

... In the corrected description, defoaming agents and surfactants are used as distinct, parallel concepts; ... silicone compounds are also used as defoaming agents; ... and silicone-compound additives are sometimes distinguished from surfactants. Accordingly, even if a silicone compound is added to the defendant's product, it is not necessarily always a surfactant: it may be added as a defoaming agent or as a surfactant. In determining whether the claim elements are satisfied, it is therefore necessary to examine whether it is added as a defoaming agent or as a surfactant .... Given that a silicone compound may be added in either capacity, configuration b, which is clearly a defoaming agent, does not satisfy Constituent Element ②, which is clearly a surfactant ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11137.pdf

IP High Court, 2021 (Ne) 10007 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda>

Original Ameblo publication: 2022-09-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12762336405.html

IP High Court, 2021 (Ne) 10007 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda>

First instance: Tokyo District Court, 2018 (Wa) 29802 <Tanaka>

Construction of the claim wording referring to multiple “chambers”: the product invention with the limitation “capable of communicating” was not satisfied, while the method invention without that limitation was satisfied.

The original judgment, which found both unsatisfied, was reversed.

Although the product and method claims were not in a dependency relationship, the presence or absence of “capable of communicating” led to differing conclusions on non-satisfaction and satisfaction. This decision can be viewed as consistent with the idea of “claim differentiation.”

⇒ Patentee prevailed.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E3%80%91%E7%89%B9%E8%A8%B1%E6%A8%A9%E4%BE%B5%E5%AE%B3%E5%B7%AE%E6%AD%A2%E8%AB%8B%E6%B1%82%E6%8E%A7%E8%A8%B4%E4%BA%8B%E4%BB%B6%EF%BC%88%E8%A4%87%E6%95%B0%E3%81%AE/

IP High Court, 2019 (Ne) 10009 [Roll Paper for Packaging Medicine into Individual Doses] <Otaka>

Original Ameblo publication: 2022-09-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12762337041.html

IP High Court, 2019 (Ne) 10009 [Roll Paper for Packaging Medicine into Individual Doses] <Otaka>

The wording “used in ...” means “capable of being used in ...,” and is satisfied even without actual use in “...”.

Osaka District Court, 2018 (Wa) 3461

For the claim “a roll of packaging paper mountable in ...,” satisfaction of “mountable” was not even at issue!

⇒ The IP High Court decision in 2019 (Ne) 10031 <Mori>, involving a different defendant, is to the same effect.

* In the “Antenna” case, 2018 (Wa) 13400, “for ...” was construed as requiring actual use. ⇒ Claim element not satisfied.

(Excerpts from the judgment)

According to the claims of the corrected invention (claim 1), it is a product invention concerning “roll paper for packaging medicine into individual doses” (Constituent Element E) comprising the configurations in Constituent Elements A through D. Constituent Element A describes matters concerning the medicine packaging apparatus; Constituent Elements B and D describe matters concerning the “hollow core tube,” “roll paper” and “plurality of magnets” of the “roll paper for packaging medicine into individual doses” (collectively, “the roll paper and associated components”); and Constituent Element C describes matters concerning both. In Constituent Element A, the roll paper is described as “used in” a medicine packaging apparatus.

As to “used in” in Constituent Element A ..., the Japanese auxiliary “rareru” expresses possibility as well as the passive voice. In view also of the fact that claims for a product invention should be construed as specifying the product's structure, characteristics and the like, it is natural to construe this as meaning “capable of being used in.”

Next, the description contains neither a definition of “used in” in the wording “used in a medicine packaging apparatus” in Constituent Element A, nor any statement conflicting with the above interpretation.

Accordingly, “used in” in Constituent Element A should be construed as meaning “capable of being used in.”

* In Osaka District Court, 2018 (Wa) 3461, a separate case involving the same defendants, the claim wording was “a roll of packaging paper mountable in a medicine packaging apparatus equipped with magnetic detection means ...,” and satisfaction of “mountable” was not even at issue.

Separate case: Osaka District Court, 2018 (Wa) 3461 (February 18, 2021):
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90185.pdf

This judgment (IP High Court, 2019 (Ne) 10009, June 27, 2019):
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88768.pdf

IP High Court, 2019 (Ne) 10031 (October 10, 2019), involving a different defendant:
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89026.pdf

Tokyo District Court, 2002 (Wa) 9503 [Nucleic Acid Amplification Reaction Monitoring Apparatus]

Original Ameblo publication: 2022-09-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12762620891.html

Tokyo District Court, 2002 (Wa) 9503 [Nucleic Acid Amplification Reaction Monitoring Apparatus]

A case in which statements in the same applicant's later application were not taken into account.

⇒ Infringement.

* Although the obligation to refrain arising from the granted injunction covered the defendant's product as a whole, the analysis computer and color printer were excluded from destruction because they were general-purpose products.

(Excerpts from the judgment)

The defendant argues that, in the later application's description, it was emphasized that the apparatus of the later invention was superior in using no optical fibers and using a CCD camera as its optical system, whereas the apparatus described in the U.S. application on which the patent's priority claim was based used optical fibers. On that basis, the defendant argues that the technical scope of the invention is limited to apparatuses using optical fibers and no CCD camera as their optical system, and that a contrary assertion in this case is impermissible as violating good faith and related principles.

However, the technical scope of the invention must be determined based on the claims in its description. In doing so, the detailed description and drawings may be considered, but there is no rational reason to consider statements in the description of the later application, which is separate from this patent application. Further, even if the description of the later application gives a different explanation of the meaning of “optical system” in the invention, this cannot be said, in this case, to violate the principle of estoppel or good faith.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11162.pdf

Osaka District Court, 2003 (Wa) 13703 [Hair Treatment Promoting Apparatus] <Yamada>

Original Ameblo publication: 2022-09-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12762820516.html

Osaka District Court, 2003 (Wa) 13703 [Hair Treatment Promoting Apparatus] <Yamada>

Construction of the claim wording “semicircular.”

⇒ In relation to the two effects stated in the description, whether the semicircular arc is “perfect” is immaterial.

⇒ The term includes approximately semicircular shapes that are substantially the same and produce the invention's effects, even if not perfectly semicircular.

⇒ Claim element satisfied.

(Excerpts from the judgment)

... In light of the effects to be produced by the configurations in Constituent Elements B and C, the “semicircular” heater and heating apparatus in Constituent Element B do not refer only to a “perfect” semicircular arc with a central angle of 180 degrees. If the shape is substantially the same and can produce those effects, the term should also encompass approximately semicircular arcs, such as those whose central angle is slightly less than 180 degrees or whose radius varies slightly from portion to portion.

That is, ... because the object being heated (the hair of the person undergoing treatment) is not a perfect hemisphere, no matter how “perfect” the heater's semicircular arc is, it is impossible in principle and practice to heat that person's hair strictly uniformly and without unevenness. Accordingly, it is also self-evident that whether the heater's semicircular arc is “perfect” has no significance.

Moreover, as to the shape of the heating apparatus, the purpose of reducing the space required during operation is ... to improve the working efficiency of practitioners in hairdressing and beauty salons, so this likewise does not require a “perfect” semicircular arc.

Therefore, “semicircular” in Constituent Element B should be construed, as above, as not limited to a perfect semicircular arc but also including approximately semicircular arcs that are substantially the same and produce the stated effects.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9372.pdf

Tokyo High Court, 2004 (Gyo-Ke) 4 [Pipe-Mounting Fitting for Balconies] <Tsukahara>

Original Ameblo publication: 2022-09-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763042070.html

Tokyo High Court, 2004 (Gyo-Ke) 4 [Pipe-Mounting Fitting for Balconies] <Tsukahara>

An amendment deleting a constituent element that is not necessarily associated with the invention from a technical perspective does not add new matter, even if an embodiment without that element is not disclosed in the original description.

= Tokyo High Court, 1998 (Gyo-Ke) 298

= IP High Court, 2019 (Gyo-Ke) 10046

= IP High Court, 2014 (Gyo-Ke) 10087 [Rack Conveying Apparatus]

https://www.youtube.com/watch?v=caYkLhd5rYM

Tokyo High Court, 2001 (Gyo-Ke) 392 [Biaxially Oriented Polyamide Film and Method for Producing It] <Sato>

Original Ameblo publication: 2022-09-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763186807.html

Tokyo High Court, 2001 (Gyo-Ke) 392 [Biaxially Oriented Polyamide Film and Method for Producing It] <Sato>

Novelty is affirmed even if a product of the invention happens to be manufactured according to a documentary reference (Article 29(1)(iii) of the Patent Act).

* The general principle is the same for public working (Article 29(1)(ii) of the Patent Act). — Tokyo District Court, 2012 (Wa) 11800 <Takano> is to the same effect.

(Excerpts from the judgment)

... It goes without saying that the mere possibility that, in the cited invention, a product having the physical properties of Invention 1 might happen to be manufactured without any particular intention does not establish that the reference discloses a method of manufacturing such a product to an extent enabling a person skilled in the art readily to practice it. (Of course, the reference need not necessarily disclose a method allowing stable industrial manufacture ..., but ... the mere possibility that a product having the physical properties of Invention 1 might happen to be manufactured does not establish that Invention 1 is disclosed in the reference or lacks novelty ....)

* For public working, Tokyo District Court, 2012 (Wa) 11800 <Takano> is to the same effect.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10126.pdf

IP High Court, 2020 (Gyo-Ke) 10004; IP High Court, 2020 (Gyo-Ke) 10056

Original Ameblo publication: 2022-09-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763366759.html

IP High Court, 2020 (Gyo-Ke) 10004

Patients receiving administration have creatinine clearance of at least 50 but less than 80 ml/min (mild renal impairment).

IP High Court, 2020 (Gyo-Ke) 10056

Patients receiving administration have creatinine clearance of at least 30 but less than 50 ml/min (moderate renal impairment).

⇒ Knowledge at filing that adverse reactions in patients with mild or moderate renal impairment were the same as in persons with normal renal function. Inventive step denied in both cases.

(Excerpts from the judgment)

... Since Condition (4) merely singles out, from among osteoporosis patients, a group satisfying all three conditions and confirms safety for that group, the three conditions and Condition (4) can be understood as independent conditions with different purposes. The plaintiff argues that the four conditions form an organically integrated whole, but ... this cannot be accepted. ...

... A person skilled in the art encountering Exhibit Ko 7, which expressly states that patients with severe renal impairment are excluded, would recognize that a considerable proportion of the patients receiving administration under the invention of Exhibit Ko 7 have mild or moderate renal impairment .... Furthermore, ... it is clear that confirmation of safety in patients with renal impairment was required for osteoporosis drugs as well. Thus, for a person skilled in the art encountering that invention, focusing on the renal function of the target patients is not exceptional, but something that person would naturally do. ...

Exhibit Ko 10 defines patients with “mild” renal impairment as patients with “GFR 50–79 ml/min,” treating those with creatinine clearance of 50–79 ml/min as having mild renal impairment. ... The review-results report ... classifies renal impairment using creatinine clearance as an indicator, along these values, into “80 or above,” “50 or above but below 80,” “30 or above but below 50,” and “below 30.” ... Accordingly, selecting ... persons with “50 or above but below 80 ml/min” from the patients receiving administration under the invention of Exhibit Ko 7 involves no difficulty whatsoever for a person skilled in the art.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90548.pdf

Tokyo District Court, 2018 (Wa) 35053 “2UNDR Case”

Original Ameblo publication: 2022-09-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763615474.html

[Trademark] Parallel imports of genuine goods permitted

Tokyo District Court, 2018 (Wa) 35053 “2UNDR Case”

Following the Supreme Court's Fred Perry judgment.

① The Japanese goods have no special quality or other attributes compared with goods in other countries.

② The territorial sales restriction is unrelated to maintenance or control of quality.

③ Men's underwear whose quality does not immediately deteriorate during transport.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89801.pdf

Tokyo High Court, 2000 (Gyo-Ke) 120 [Nickel Electrode Active Material for Alkaline Storage Batteries] <Yamashita>

Original Ameblo publication: 2022-09-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763883604.html

Tokyo High Court, 2000 (Gyo-Ke) 120 [Nickel Electrode Active Material for Alkaline Storage Batteries] <Yamashita>

* For a product invention, disclosure of a “manufacturing method” is necessary if a person skilled in the art cannot readily manufacture the product.

* The IP High Court decision in 2005 (Gyo-Ke) 10205 is to the same effect.

* The IP High Court decision in 2005 (Gyo-Ke) 10280 is to the same effect.

⇒ The description does not distinguish the manufacturing method sufficiently from those in the references.

⇒ Enablement requirement not satisfied.

(Excerpts from the judgment)

Even for a product invention, if disclosure of the product's purpose, constitution and effects alone does not enable a person skilled in the art readily to manufacture it, the “purpose, constitution and effects of the invention” cannot be said to be described “to an extent enabling a person having ordinary knowledge in the technical field to which the invention pertains readily to work it,” unless a method of manufacturing the product is also disclosed. ... Even if the description states that a product not existing in the prior art has actually been obtained and exhibits particular functions and effects, that establishes only novelty and inventive step. In addition to Article 29(1) and (2) on novelty and inventive step, Article 36(4) of the former Patent Act, as discussed above, also requires that a person skilled in the art be able readily to work the invention. The plaintiff's argument is, in essence, that a patent should be granted for something novel and inventive even if a person skilled in the art cannot work it; this misunderstands the requirements for protecting inventions under the Patent Act ....

The manufacturing method of the invention is not the same as the technologies in the publications of Exhibits Otsu 1 and 2, but insufficient disclosure leaves it indistinguishable from those technologies .... Thus, the description gives only vague operations, pH and temperature ranges, without specific guidance necessary to manufacture the powder or nickel hydroxide powder containing it. Even if a person skilled in the art attempts manufacture according to it, an unreasonably large amount of trial and error would be necessary while success remains uncertain. In such circumstances, that person cannot be said readily to be able to manufacture nickel hydroxide powder containing the powder at issue, and the description cannot be regarded as providing disclosure “to an extent enabling a person having ordinary knowledge in the technical field to which the invention pertains readily to work it” ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12035.pdf

Tokyo District Court, 2002 (Wa) 1943 [Finely Powdered Fossil Coral] Case

Original Ameblo publication: 2022-09-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12763885700.html

<Unfair Competition Prevention Act — Communication or Dissemination of False Facts>

Tokyo District Court, 2002 (Wa) 1943 [Finely Powdered Fossil Coral] Case

Satisfaction of the U.S. patent's claim elements was determined under U.S. law, and non-satisfaction was found.

Warnings sent from Japan by email and letter to a U.S. corporation (the plaintiff's business partner) were held to violate the Unfair Competition Prevention Act (communication or dissemination of false facts).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10784.pdf

IP High Court, 2021 (Gyo-Ke) 10136, 10138 [Soldering Apparatus] <Honda>

Original Ameblo publication: 2022-09-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764056199.html

IP High Court, 2021 (Gyo-Ke) 10136, 10138 [Soldering Apparatus] <Honda>

<JPO decision>

Readily conceivable if a “solder piece designated F1” is used as the solder piece in the invention of Exhibit Ko 1.

<This judgment>

Without knowledge of the claimed invention's problem and functions and effects, there is no motivation to use a particular solder piece (F1) in the cited invention.

⇒ Inventive step affirmed (a type of selection invention).

[Claim 1] (The portion relating to “Difference 2,” held not readily conceivable)

“... A soldering apparatus configured such that said heating means is positioned to transfer heat through said nozzle to said solder piece abutting the tip of said terminal; said solder piece before melting receives that heat transfer and melts while abutting the terminal tip; the molten solder piece tends to round into an approximately spherical shape but, because it is constrained by the inner wall of said nozzle and the terminal tip, necessarily remains short of a true sphere and stops while resting on said terminal, without moving in the direction in which the solder piece was supplied; in this stopped state, heat transmitted from the nozzle to the molten solder piece is transferred from the molten solder piece to said terminal to heat it; and, after the terminal is heated by this heating, the molten solder piece flows out.”

<JPO Decision, Invalidation No. 2019-800094> (The portion finding “Difference 2” readily conceivable)

The JPO decision held that “if a solder piece with a flux content of 1.0 mass% (wt%), the standard designated F1, is used as the solder piece of the invention of Exhibit Ko 1,” it “... cannot become a true sphere,” and is therefore readily conceivable. The relevant passage is quoted below.

“Regarding ... the flux (rosin) content of the solder in the invention of Exhibit Ko 1, Exhibit Ko 15 ... states that solder contains 1–4 wt% rosin, and Exhibit Ko 10 ... states that the Japanese Industrial Standard for flux-cored solder designates as F1 a flux content of 1.0 mass%, with a permissible range of 0.5 mass% or more but less than 1.5 mass%. Considering these statements, soldering with solder having a flux content of approximately 1 wt% is recognized as something a person skilled in the art could readily have done. Accordingly, we consider the case where a solder piece having a flux content of 1.0 mass% (wt%), the standard designated F1, is used in the invention of Exhibit Ko 1. ...

By using solder designated F1 under the standard in the invention of Exhibit Ko 1, when the solder piece is heated and melts at the abutment position, it cannot become a true sphere because it is constrained by the inner wall of the through-hole at the soldering iron tip and the tip of the pin. ...”

<Extract from this judgment> (The portion finding “Difference 2” not readily conceivable)

The court rejected obviousness, holding that, because the problem of the claimed invention was not known, there was no motivation to use a particular solder piece (designated F1) in the cited invention (the invention of Exhibit Ko 1). The passage follows.

“... Invention 1 ensures that the solder piece before melting abuts both the nozzle's inner wall and the terminal tip, and that the molten solder piece necessarily remains short of a true sphere while resting on the

terminal and stops without moving downward. Heat conduction from the nozzle and other mechanisms sufficiently heat the solder piece and terminal, thereby enabling soldering at an appropriate temperature and producing the effect of preventing defective soldering. In contrast, Exhibit Ko 1 ... neither describes nor suggests that the molten solder necessarily stops without becoming a true sphere; that is, that the solder piece and terminal are sufficiently heated because the solder continues to abut the nozzle's inner wall after melting. Thus, without knowing the problem to be solved by the configuration in which the molten solder necessarily does not become a true sphere, or the functions and effects produced by that configuration, a person skilled in the art encountering Exhibit Ko 1 has no motivation deliberately to adopt solder having a flux content of 1 wt% to obtain that configuration ....”

<Some observations>

The JPO decision held that the difference would substantially disappear if a particular solder piece (designated F1) were used in the cited invention (the invention of Exhibit Ko 1). In contrast, this judgment rejected the existence of motivation to use that particular solder piece in the cited invention in the first place, and affirmed inventive step.

Generally, where multiple options exist for a component used in the cited invention, the obviousness of choosing one option is at issue as a so-called selection invention.

The JPO decision also reasoned, “Regarding ... the flux (rosin) content of the solder in the invention of Exhibit Ko 1, Exhibit Ko 15 ... states that solder contains 1–4 wt% rosin, and Exhibit Ko 10 ... states that the Japanese Industrial Standard for flux-cored solder designates as F1 a flux content of 1.0 mass%, with a permissible range of 0.5 mass% or more but less than 1.5 mass%.” In this way it sought to demonstrate what the judgment calls “motivation deliberately to adopt solder having a flux content of 1 wt%.” However, this judgment found that the JPO decision had merely presented the available options and had not fully demonstrated obviousness or motivation for focusing, among them, on “solder having a flux content of 1 wt %” (designated F1).

The JPO presumably regarded this as a mere selection from well-known technology and therefore a matter of design choice. Recent court decisions, however, tend to emphasize whether attention could have been directed to the problem of the invention. This judgment likewise resolved the issue with the wording that, “without knowing the problem ... or the functions and effects produced by that configuration, ... there is no motivation deliberately to adopt solder having a flux content of 1 wt% to obtain that configuration ....”

On this point, one might consider whether it is possible to affirm the obviousness of using “solder having a flux content of 1 wt%” (designated F1) in the invention of Exhibit Ko 1 even without necessarily knowing the problem and functions and effects of the invention at issue. Moreover, the description itself states, “[Problem to Be Solved by the Invention] [0007] In view of the above problems, this invention aims to prevent defective soldering.” If the problem is the general one of “preventing defective soldering,” it may have been possible to argue that this was known. Close examination of the judgment shows that it does not identify the invention's problem more specifically than that general problem. If the problem is identified specifically, the next question is whether, under the state of the art at filing, a person skilled in the art could recognize that the problem could be solved (the support requirement). Thus, generally, a party asserting patent invalidity might consider contesting the invention's problem, also as groundwork for arguments concerning support or addition of new matter.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91387.pdf

I will speak at “Sugoi Chizai EXPO” (October 6–7, 2022) on “20 Selected Important Patent Decisions”

Original Ameblo publication: 2022-09-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764070920.html

I will speak at “Sugoi Chizai EXPO” (October 6–7, 2022) on “20 Selected Important Patent Decisions.”

This video is a six-minute trailer for the full 40-minute presentation.

Register for Sugoi Chizai EXPO, watch the full presentation too, and pick up some useful knowledge!!

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(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and Attorney admitted in California, USA)

https://www.youtube.com/watch?v=o4dEMjPq6OM

IP High Court, 2020 (Ne) 10059 [Equol-Containing Extract and Method for Producing It] <Honda>

Original Ameblo publication: 2022-09-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764221143.html

IP High Court, 2020 (Ne) 10059 [Equol-Containing Extract and Method for Producing It] <Honda>

Appeal in an action seeking an injunction against patent infringement (a case in which the production method was presumed under Article 104 of the Patent Act. Priority was recognized, and the date of “the patent application for the patent at issue” was held to be the priority date. The patentee prevailed on reversal.)

[Summary of the Judgment and Some Observations]

1. Claims (Patent No. 6275313, claim 1)

<Before correction>

“A method for producing a fermented product containing ornithine and equol, comprising subjecting a fermentation starting material containing at least one daidzein species selected from the group consisting of daidzein glycosides, daidzein and dihydrodaidzein, and arginine, to fermentation treatment with a microorganism having ornithine-producing and equol-producing abilities.”

<After correction>

“A method for producing a powdered fermented product containing ornithine and equol, comprising adding arginine to at least one daidzein species selected from the group consisting of daidzein glycosides, daidzein and dihydrodaidzein; and

subjecting a fermentation starting material containing said daidzein species and said arginine to fermentation treatment with a microorganism having ornithine-producing and equol-producing abilities,

wherein said fermentation treatment produces at least 8 mg of ornithine and at least 1 mg of equol per 1 g dry weight of said fermented product; and

said fermented product is used as a food ingredient;

said production method.”

2. The principal issue in this litigation: Article 104 of the Patent Act

The principal issue in this case is “whether the appellees' starting material is presumed under Article 104 of the Patent Act to have been produced by the method of the corrected invention (Issue 1-1).”

Article 104 of the Patent Act provides that, where a patent has been granted for an invention of a process for producing a product, if that product was not publicly known in Japan before the patent application, an identical product is presumed to have been produced by that process.

This judgment examined each requirement of Article 104 as follows.

2-1. “Invention of a process for producing a product”

As to ① “invention of a process for producing a product,” the court held: “The patent at issue is a case in which a patent has been granted for a process for producing a product (the product of the corrected invention) that is ‘a powdered fermented product containing ornithine and equol, in which at least 8 mg of ornithine and at least 1 mg of equol are produced per 1 g dry weight of the fermented product, and which is used as a food ingredient.’”

2-2. “An identical product”

As to ② “an identical product,” the court held: “The appellees have neither admitted nor denied, and have not clarified, whether their starting material constitutes the above product of the corrected invention. They shall therefore be deemed to have admitted that their starting material constitutes that product (Article 159(1) of the Code of Civil Procedure).”

Accordingly, “if the product of the corrected invention was not publicly known in Japan before the patent application for the patent at issue, the appellees' starting material is presumed to have been produced by the method of the corrected invention.” Thus, the date of “the patent application for the patent at issue” is decisive. Specifically, the main issue became whether the corrected invention was described in the application documents of the basic application supporting the priority claim for the patent (“the basic application”), or was an invention tantamount to being described there.

2-3. Date of “the patent application for the patent at issue”: whether priority is available

As to ③ the date of “the patent application for the patent at issue,” the court held: “The corrected invention is recognized as having been described, or being tantamount to having been described, at least in Basic Applications A and B, and should be entitled to the benefit of priority based on them. Accordingly, for application of Article 104 of the Patent Act, the patent is deemed to have been applied for on June 13, 2007, its priority date. Thus, when examining whether the product of the corrected invention was ‘not publicly known’ in Japan before the patent application under that Article, Exhibit Otsu B3 (International Publication WO 2007/066655, internationally published June 14, 2007), published after the priority date, cannot be considered.”

The principal disputed issue in this case is whether the corrected invention is recognized as having been described, or being tantamount to having been described, at least in Basic Applications A and B, and whether it is entitled to the benefit of priority based on them. The original judgment examined the issue using the same framework as the appellate judgment but found that the benefit of priority was unavailable. The appellate judgment reached the opposite conclusion on this point. Details are discussed in Section 3 below.

2-4. The requirement “not publicly known”

As to ④ “not publicly known,” the court held: “For a product to be regarded as ‘publicly known’ under Article 104 of the Patent Act, at least facts must have been known at the reference date to an extent enabling a person skilled in the art to obtain a clue to its manufacture. The product of the corrected invention cannot be said to have been described in Exhibits Otsu B16 and B24, which were publicly known at the priority date, and the corrected invention cannot readily be conceived from Exhibit Otsu B16 or B24 .... Accordingly, it cannot be said that a person skilled in the art encountering either document at the priority date could have obtained a clue to manufacturing the product of the corrected invention.

“The appellees also argue that the product of the corrected invention is ‘publicly known’ because it merely adds ‘8 mg’ of ornithine of ‘97.48%’ purity, a nutritional fortification additive (International Publication WO 2006/051940, Exhibit Otsu B67), to ‘992 mg’ of the fermented product of ‘Example 1’ in Exhibit Otsu B16, in which ‘1–3 mg of equol is produced per 1 g dry weight.’ However, ... the product of the corrected invention is ‘a powdered fermented product containing ornithine and equol, in which at least 8 mg of ornithine and at least 1 mg of equol are produced per 1 g dry weight of the fermented product, and which is used as a food ingredient.’ Even combining Exhibits Otsu B16 and B67 does not yield a product ‘in which at least 8 mg of ornithine and at least 1 mg of equol have been produced per 1 g dry weight of the fermented product.’ Therefore, that argument cannot be accepted.”

Thus, according to this judgment, “publicly known product” in Article 104 is construed differently from “publicly known invention” in Article 29(1)(i) of the Patent Act. This judgment requires that “at least facts

were known at the reference date to an extent enabling a person skilled in the art to obtain a clue to manufacturing the product."

Regarding this requirement, for example, Tokyo District Court, 1970 (Wa) No. 7935 also held: "As to the meaning of 'the product ... publicly known in Japan' in Article 104 of the Patent Act, this court considers that the product need not necessarily exist in reality, but at least facts must be known to an extent enabling a person having ordinary knowledge in the technical field to obtain a clue to its manufacture." The presumption under Article 104 was recognized in that judgment.

Osaka District Court, 1997 (Wa) No. 11617 also held: "From the standpoint of whether the above likelihood exists, 'not publicly known' in that Article should be construed as meaning not merely that the product does not exist in reality, but that there are also no facts known to an extent enabling a person having ordinary knowledge in the technical field to obtain a clue to its manufacture." (The presumption under Article 104 was not recognized in that judgment.)

Tokyo High Court, 1979 (Ne) No. 825 held: "The appellee argues that Article 104 of the Patent Act cannot apply because some compounds among the target substances of the patented invention were already publicly known before its patent application. Even if there were such publicly known compounds, however, as stated above, the appellee manufactures and sells dipyridamole, dipyridamole is encompassed within the target substances of the patented invention, and that target substance was not publicly known in Japan before the patent application. Therefore, there is no impediment to applying that Article." (In that judgment, the presumption under Article 104 applied, but was rebutted because the appellee's methods did not fall within the technical scope of the patented invention.)

In the context of whether the product was "publicly known" under Article 104, this judgment stated that "at least facts must have been known at the reference date to an extent enabling a person skilled in the art to obtain a clue to its manufacture. The product of the corrected invention cannot be said to have been described in Exhibits Otsu B16 and B24, which were publicly known at the priority date, and the corrected invention cannot readily be conceived from Exhibit Otsu B16 or B24." If the judgment thereby held that a product readily conceivable from a publicly known invention constitutes a "publicly known" product under Article 104, it goes a step further than earlier decisions. Details are discussed below in the observations, but despite using the same wording as "publicly known" invention in Article 29(1)(i), the interpretation is entirely different, and its appropriateness warrants further examination.

2-5. The Article 104 presumption was not rebutted in this case

As to ⑤ the absence of rebuttal of the Article 104 presumption, the court held: "It cannot be said to have been proved that the method of the corrected invention was not used to produce the appellees' starting material; therefore, the presumption under Article 104 cannot be regarded as rebutted."

3. Date of "the patent application for the patent at issue": whether priority is available

3-1. Original judgment (Tokyo District Court, 2018 (Wa) No. 18555 <Presiding Judge Tanaka>)

The court held that "the patent application date for the patent at issue" could not go back to the priority date (in relation to the defendant's method). ⇒ Article 104 did not apply because of a product publicly known between the priority date and the parent application's filing date. (* A partial-priority approach. ⇒ Partial priority does not extend to the defendant's method.)

"With regard to application of Article 104 ..., if the 'fermented product containing ornithine and equol' was not publicly known in Japan before the patent application for the patent at issue, the defendant's starting material would be presumed to have been produced by the method of the invention. ... We examine the specific date meant by 'the patent application for the patent at issue.' ... That date could be viewed as the priority date .... However, the fermentation starting material in the method of the invention is 'at least one daidzein species selected from the group consisting of daidzein glycosides, daidzein and dihydrodaidzein,' and the description also discloses various daidzein species .... In contrast, the only fermentation starting

material disclosed in the description ... of the basic application for priority ... is ‘soybean hypocotyl,’ and no daidzein species other than soybean hypocotyl are disclosed. Accordingly, for the invention whose fermentation starting material is soybean hypocotyl, the date of ‘the patent application for the patent at issue’ is the priority date ..., whereas for the invention whose fermentation starting material is a daidzein species other than soybean hypocotyl, that date is the parent application's filing date .... The defendant's method ... uses a daidzein species other than soybean hypocotyl as the fermentation starting material. ...

“Accordingly, for the invention in respect of which this defendant's method would be subject to the production-method presumption, the date of ‘the patent application for the patent at issue’ should be the parent application's filing date ..., not the priority date .... At the parent application's filing date, the ‘fermented product containing ornithine and equol’ is recognized as having been publicly known in Japan; thus, the defendant's starting material is not presumed to have been produced by the method of the invention ....”

3-2. This appellate judgment (IP High Court, 2020 (Ne) No. 10059 <Presiding Judge Honda>)

The court held that “the patent application date for the patent at issue” could go back to the priority date (also in relation to the defendant's method). ⇒ Since products publicly known between the priority date and the parent application's filing date are not considered, Article 104 applies.

“A person skilled in the art encountering the above statements in Basic Applications A and B, considered together with common general technical knowledge at the priority date, could recognize that, even when a ‘starting material containing daidzein species’ other than ‘soybean hypocotyl’ is used as the fermentation starting material, a powdered fermented product used as a food ingredient and containing at least 8 mg of ornithine and at least 1 mg of equol per 1 g dry weight can be produced by causing the daidzein species in the fermentation starting material to be metabolized together with arginine by a microorganism capable of producing equol and ornithine, such as Lactococcus strain 20-92. Therefore, the corrected invention can be read from Basic Applications A and B. Accordingly, the corrected invention is recognized as having been described, or being tantamount to having been described, at least in Basic Applications A and B, and should be entitled to the benefit of priority based on them.

“Thus, for application of Article 104 of the Patent Act, the patent is deemed to have been applied for on the priority date .... Therefore, in examining whether the product of the corrected invention was ‘not publicly known’ in Japan before the patent application under that Article, Exhibit Otsu B3 ..., published after the priority date, cannot be considered. ... The product of the corrected invention can be regarded as ‘not publicly known’ at the priority date. ... It cannot be said to have been proved that the method of the corrected invention was not used to produce the appellees' starting material; therefore, the Article 104 presumption cannot be regarded as rebutted.”

4. Some observations

This appellate judgment is a rare case in which the production method for a new substance was presumed under Article 104 of the Patent Act and the patentee prevailed.

Among the requirements of that Article, “before the patent application” means before the priority date where priority is recognized. In this case, the fermentation starting material disclosed in the basic application's description was only “soybean hypocotyl,” with no daidzein species other than soybean hypocotyl disclosed. On those facts, the first-instance judgment adopted a partial-priority approach: only for the “invention whose fermentation starting material is soybean hypocotyl” did the “patent application” date become the priority date, while for the “invention whose fermentation starting material is a daidzein species other than soybean hypocotyl,” the date of “the patent application for the patent at issue” did not go back to the priority date. In contrast, the appellate judgment held that the problem-solving mechanism disclosed in the basic application's description applied equally whether the fermentation starting material was “soybean hypocotyl” or “a daidzein species other than soybean hypocotyl.” Thus, even for a method of

producing a fermented product using “a daidzein species other than soybean hypocotyl” as the starting material, as in the defendant's product, the date of “the patent application for the patent at issue” was the priority date, and products publicly known after that date did not constitute “publicly known products” under Article 104.

In applying “publicly known product” in Article 104, the appellate judgment held: “Since the product of the corrected invention is ‘a powdered fermented product containing ornithine and equol, in which at least 8 mg of ornithine and at least 1 mg of equol are produced per 1 g dry weight of the fermented product, and which is used as a food ingredient,’ even combining Exhibits Otsu B16 and B67 does not yield a product ‘in which at least 8 mg of ornithine and at least 1 mg of equol have been produced per 1 g dry weight of the fermented product.’” Under this reasoning, narrowing claim language by amendment or correction so that “the defendant's product just barely falls within it,” irrespective of inventive step, makes it harder for previously known products to fall within “publicly known product” under Article 104. This should be kept in mind when enforcing a patent on a process for producing a new substance. Conversely, from the defendant's perspective, the appellate judgment does not reject the very possibility of asserting as a “publicly known product” a combination of products described in two documents. In other words, even if the product is not known in a manner depriving it of novelty, “publicly known product” under Article 104 may include a product realized by combining known products as in an inventive-step analysis. In this sense, under this judgment, “publicly known product” under Article 104 can be regarded as a concept encompassing arguments akin to inventive step from both the right holder's and alleged infringer's perspectives; whether that is appropriate requires further examination.

5. <Reference> Action to revoke a JPO decision decided two months before this appellate judgment (IP High Court, 2020 (Gyo-Ke) No. 10150 <Presiding Judge Honda>)

5-1. Divisional-application requirements satisfied — Only the lower limit of “8–15 mg” in the original description was incorporated into the claim.

“[Claim 1 (after correction)] A method for producing ... at least 8 mg of ornithine and at least 1 mg of equol per 1 g dry weight of the fermented product ....

“... Paragraph [0050] of the original description states: ‘Specific examples of the ornithine content in an equol-containing fermented soybean-hypocotyl product include approximately 5–20 mg, preferably 8–15 mg and more preferably 9–12 mg, of ornithine per 1 g dry weight of the equol-containing fermented soybean-hypocotyl product.’ Thus, it states a preference for 8–15 mg of ornithine per 1 g dry weight of the fermented product, and configuration ③ above can be said to be specified by the lower limit of the ‘8–15 mg’ exemplified in the original description.”

5-2. Novelty affirmed

“... The plaintiff's argument is premised on conversion from arginine to ornithine far exceeding 100% (approximately 159%) in [Table 3] of the description, but ... the fermentation starting materials and conditions differ. The dry weight of a fermented product may vary greatly according to the solid content of the starting material and medium, so changing the starting material also changes the amount of ornithine per 1 g dry weight. Thus, ornithine production per 1 g dry weight may vary greatly between use of a soybean-hypocotyl solution and use of soy milk as the starting material. Different culture conditions may also produce different conversion rates from arginine to ornithine. Accordingly, [Table 3] of the description cannot appropriately be used as the premise for estimating ornithine production in the test examples of Exhibit Ko 1. ... Since those examples do not specify the composition of the BHI broth used as the medium, the invention of Exhibit Ko 1 does not necessarily produce at least 8 mg of ornithine per 1 g dry weight of the fermented product .... Accordingly, that invention cannot be regarded as ‘producing at least 8 mg of ornithine per 1 g dry weight of the fermented product.’”

5-3. Inventive step affirmed — Applying well-known technology also requires motivation for combination and other considerations

“When determining whether the claimed invention could readily have been made by applying a secondary cited invention to a primary cited invention, it is appropriate ① to assess whether motivation exists to apply the secondary invention to the primary invention and reach the claimed invention, taking comprehensively into account suggestions in either cited invention, the relationship between their technical fields, commonality of problems, functions and operations, and other factors, and ② to consider together whether factors impede the application and whether unpredictable, remarkable effects exist (see IP High Court judgment of April 13, 2018 [2016 (Gyo-Ke) Nos. 10182 and 10184]). The same applies when determining whether the claimed invention could readily have been made by applying well-known technology to a cited invention.”

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e7%89%b9%e8%a8%b1%e6%a8%a9%e4%be%b5%e5%ae%b3%e5%b7%ae%e6%ad%a2%e8%ab%8b%e6%b1%82%e6%8e%a7%e8%a8%b4%e4%ba%8b%e4%bb%b6%ef%bc%88%e7%89%b9%e8%a8%b1%e6%b3%9510/

<Article> A Study of Judicial Determinations on Priority (Intellectual Property Management, Vol. 72, No. 4, 2022)

Original Ameblo publication: 2022-09-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764402671.html

<Article> A Study of Judicial Determinations on Priority (Intellectual Property Management, Vol. 72, No. 4, 2022)

Since the Artificial Nipple case, there have been six court decisions disputing priority in cases involving added embodiments or partial deletion of defining features, and priority was affirmed in all six!!

Was the Artificial Nipple case unusually strict ...?

The article also explains decisions in other categories.

https://pbs.twimg.com/media/EyWxEH_UcAMF6hH?format=jpg&name=large

* In the Artificial Nipple case, another company filed an application for a spiral shape between the first application and the priority-claiming application. If priority were recognized, that company's working would constitute patent infringement. The patentee had secured rights to nonspiral shapes through a divisional application, then refused to delete the added spiral-shaped embodiment in an effort to maximize the scope of its rights.

Trade Secrets (Keeping Information Confidential) — Choosing a Strategy for Protecting Corporate Technical Information

Original Ameblo publication: 2022-09-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764473407.html

We have posted the article “Trade Secrets (Keeping Information Confidential) — Choosing a Strategy for Protecting Corporate Technical Information” on the NAKAMURA & PARTNERS website.

① Technical value and nature

② Economic value

③ Differences in legislation and practical operation among the relevant countries

④ Consistency with the company's business strategy for the relevant products and services

Determine the strategy accordingly.

https://www.nakapat.gr.jp/ja/practices-details/trade-secrets/

IP High Court, 2008 (Gyo-Ke) 10196 [Die-Bonding Material and Bonding Method] <Nakano>

Original Ameblo publication: 2022-09-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12764566225.html

IP High Court, 2008 (Gyo-Ke) 10196 [Die-Bonding Material and Bonding Method] <Nakano>

* In identifying the gist of the invention, “synthesized from ... and ...” was construed to mean “only,” i.e., a closed form. ⇒ Inventive step affirmed.

⇒ The description contained working and comparative examples comparing and distinguishing characteristics on the premise of compositional differences from other monomers.

(Excerpts from the judgment)

... It is clear that Inventions 1–12 do not have as a defining element that “the peel strength at the stage when the semiconductor element is bonded to the support member using the die-bonding material is at least 0.5 kgf/5 mm × 5 mm chip” (...). Accordingly, enablement of the “invention” is not at issue with respect to the matter identified by the JPO decision, and the decision's above determination is erroneous in its premise ....

The defendant argues, based on statements in the plaintiff's written answer in the trial proceedings, which were based on the description before correction, that “a peel strength of at least 0.5 kgf/5 mm × 5 mm chip” is one of the substantive defining elements of the invention. However, that answer was premised on the claims before correction, and, regardless of what it says, it does not newly add a defining feature absent from the claims. Therefore, the defendant's argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-point_pdf-37234.pdf

IP High Court, 2019 (Gyo-Ke) 10142 [Roll Product Package] <Mori>

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765254603.html

IP High Court, 2019 (Gyo-Ke) 10142 [Roll Product Package] <Mori>

“The portion on which a consumer hooks a finger is highly likely to tear ...; it is unreasonable to say that making the film in such a highly tear-prone portion resistant to tearing is not a problem addressed.”

* The invention's problem was identified specifically!!

Support requirement not satisfied.

(Excerpts from the judgment)

... Solving the problem that “the film is resistant to tearing” by placing the film and roll products within the invention's numerical limitations is indispensable to the invention. If this is not recognized as within the scope in which a person skilled in the art can recognize that the problem can be solved based on the detailed description and common general technical knowledge, the support requirement is violated ....

The plaintiff argues that the invention does not aim to prevent tearing outside the packaging bag, such as breakage of the handle. However, ... when a consumer carries a gusseted package, the portion of the finger hole in the handle on which the consumer hooks a finger is highly likely to tear. It is therefore unreasonable to say that making the film in such a highly tear-prone portion resistant to tearing is not a problem addressed by the invention. ...

Even if the sensory evaluation establishes that the film at the joined portion of the roll product package resists tearing when carried by the handle, it does not establish that the film at the contact portion also resists tearing when a caramel-wrapped package without a handle is carried using the plaintiff's gripping method ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89538.pdf

Tokyo High Court, 2001 (Ne) 959 [Substituted Purines (Acyclovir)] <Yamashita>

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765255180.html

Tokyo High Court, 2001 (Ne) 959 [Substituted Purines (Acyclovir)] <Yamashita>

The above acts of extracting acyclovir from the plaintiff's formulation, purifying it and recrystallizing it.

⇒ Insofar as they are regarded as merely using, transferring or otherwise dealing with acyclovir while preserving its identity, exhaustion applies.

⇒ They cannot be characterized as “production.”

— No infringement.

(Excerpts from the judgment)

... Insofar as the above acts of extracting acyclovir from the plaintiff's formulation, purifying it and recrystallizing it are regarded as merely using, transferring or otherwise dealing with the acyclovir contained in the plaintiff's formulation sold by Appellant Glaxo while preserving its identity, the effect of the patent right ... has ceased through exhaustion and does not extend to those acts. It extends only ... to cases evaluated as production of acyclovir, the subject of working the patented invention .... Because the acts should be regarded as mere use, they cannot be considered new acts of production insofar as they are viewed from the standpoint of the subject of working the patented invention ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12158.pdf

Tokyo High Court, 2004 (Ne) 1589 <Tsukahara> [Liquid-Crystal Composition] = First instance: Tokyo District Court, 2002 (Wa) 25697

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765255500.html

Tokyo High Court, 2004 (Ne) 1589 <Tsukahara>

= First instance: Tokyo District Court, 2002 (Wa) 25697 <Mimura>

[Liquid-Crystal Composition]

Claim wording “consisting of ...” ⇒ Ordinarily used to exclude other third components.

The detailed description explains that components other than those incorporated into the claims are undesirable.

⇒ Claim element not satisfied.

(Excerpts from the judgment)

... The wording “consisting of A and B” is ordinarily used to exclude third components other than A and B. Thus, absent special circumstances, such as an express statement in the claims or detailed description that third components other than A and B are added, that wording cannot be construed, like “using A and B,” as not excluding third components. ... Moreover, the detailed description says nothing about additionally mixing an achiral agent other than those represented by general formula (I), and states: “Compounds having a –CN group or a carboxylic-acid ester structure as a functional group are unsuitable as the achiral component of this invention from the standpoint of maintaining a high voltage-holding ratio in the resulting liquid-crystal element. Similarly, chiral compounds having functional groups such as CN or ester groups are generally undesirable as the chiral component of this invention because of their high adsorptivity and also from the standpoint of voltage-holding ratio”; ... and “Table 3 shows that the compound of formula (X) [court's note: a chiral-agent compound], although an ester compound, has a significantly greater molecular weight than the components of Mixture A and approximately the same adsorptivity as fluorinated compounds, and is therefore preferably used as a component of the composition of this invention.” ... These statements preclude construing the “liquid-crystal composition” in Constituent Element D of the patented invention as including, besides the achiral compound represented by general formula (I), a compound containing an ester group (–COO–) as a third component.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9803.pdf

[Design] IP High Court, 2021 (Gyo-Ke) 10067 — The articles of the design at issue and the cited design differ. ⇒ Novelty affirmed.

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765255975.html

[Design] IP High Court, 2021 (Gyo-Ke) 10067

JPO decision: both articles and designs similar.

Judgment: the “injector cartridge” of the design at issue is a different article from the cited design's “syringe barrel.” ⇒ JPO decision revoked.

* Might ease of creation under Article 3(2) of the Design Act (adaptation to another article) become an issue? (As of the posting date, the design has not been registered.)

https://www.tokkyoteki.com/2022/01/2022-01-12-r3-gyo-ke-10067.html

[YouTube Shorts] [Patent] Comparison of Exhaustion Doctrines in Japan and the United States

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765257178.html

[YouTube Shorts] [Patent] Comparison of Exhaustion Doctrines in Japan and the United States

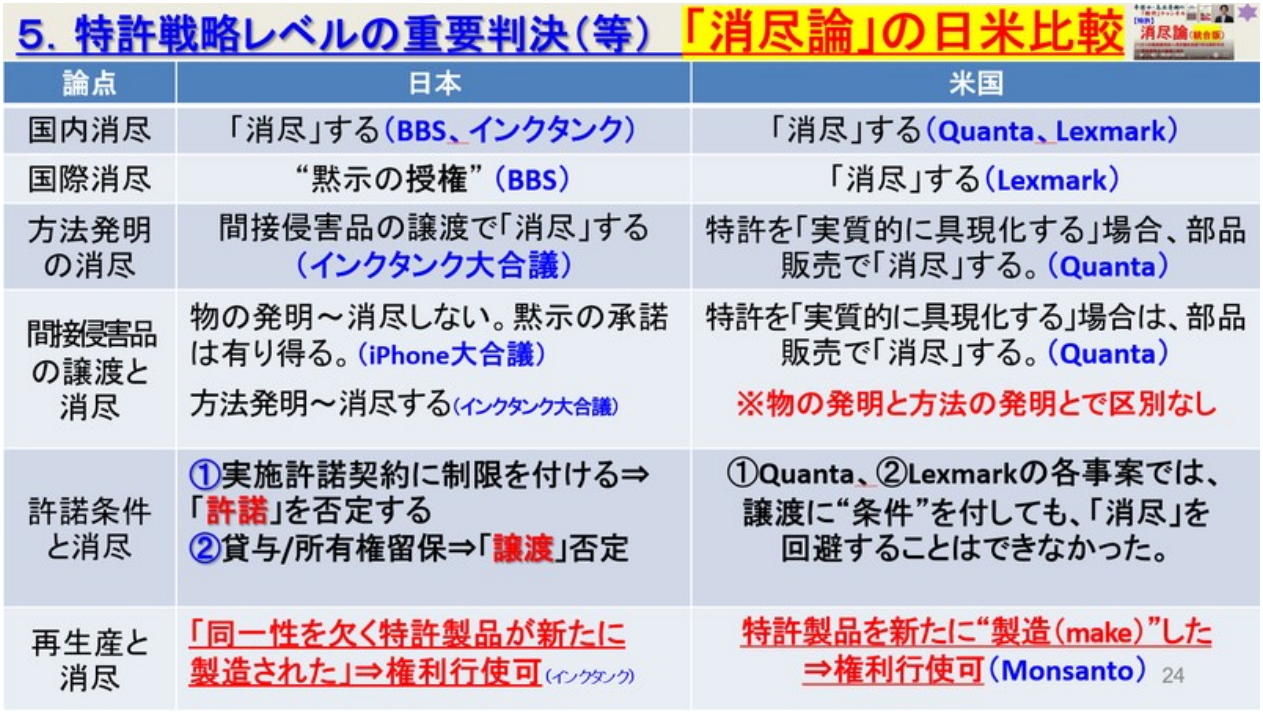
International exhaustion: opposite outcomes on whether exhaustion applies.

(Japan uses an implied-authorization approach.)

Transfer of indirectly infringing products: opposite outcomes on whether exhaustion applies.

(In Japan, product inventions are not exhausted [iPhone Grand Panel judgment]. Method inventions are exhausted if the Ink Tank Grand Panel judgment remains applicable.)

https://youtu.be/uwMtinDHKrE



5. 特許戦略レベルの重要判決(等) 「消尽論」の日米比較

論点	日本	米国
国内消尽	「消尽」する(BBS、インクタンク)	「消尽」する(Quanta、Lexmark)
国際消尽	“黙示の授権”(BBS)	「消尽」する(Lexmark)
方法発明の消尽	間接侵害品の譲渡で「消尽」する(インクタンク大合議)	特許を「実質的に具現化する」場合、部品販売で「消尽」する。(Quanta)
間接侵害品の譲渡と消尽	物の発明～消尽しない。黙示の承諾は有り得る。(iPhone大合議) 方法発明～消尽する(インクタンク大合議)	特許を「実質的に具現化する」場合は、部品販売で「消尽」する。(Quanta) ※物の発明と方法の発明とで区別なし
許諾条件と消尽	①実施許諾契約に制限を付ける⇒「許諾」を否定する ②貸与/所有権留保⇒「譲渡」否定	①Quanta、②Lexmarkの各事案では、譲渡に“条件”を付しても、「消尽」を回避することはできなかった。
再生産と消尽	「同一性を欠く特許製品が新たに製造された」⇒権利行使可(インクタンク)	特許製品を新たに“製造(make)”した⇒権利行使可(Monsanto) 24

English translation of the figure

5. Important judgments and other matters at the patent-strategy level: Japan–US comparison of the doctrine of exhaustion.

Issue	Japan	United States
Domestic exhaustion	Exhaustion occurs (BBS; Ink Cartridge).	Exhaustion occurs (Quanta; Lexmark).
International exhaustion	“Implied authorization” (BBS).	Exhaustion occurs (Lexmark).

Issue	Japan	United States
Exhaustion of method inventions	Exhaustion occurs through transfer of products constituting indirect infringement (Ink Cartridge, Grand Panel).	Exhaustion occurs upon sale of components if they “substantially embody” the patent (Quanta).
Transfer of products constituting indirect infringement and exhaustion	Product inventions: no exhaustion; implied consent may exist (iPhone, Grand Panel). Method inventions: exhaustion (Ink Cartridge, Grand Panel).	Exhaustion occurs upon component sales if they “substantially embody” the patent (Quanta). No distinction between product inventions and method inventions.
License conditions and exhaustion	(1) Restrictions in a license agreement ⇒ deny “authorization.” (2) Lease/retention of title ⇒ deny “transfer.”	In Quanta and Lexmark, “conditions” imposed on transfer could not prevent exhaustion.
Reproduction and exhaustion	“A patented product lacking identity was newly manufactured” ⇒ patent enforcement permitted (Ink Cartridge).	A patented product was newly “made” ⇒ patent enforcement permitted (Monsanto).

Slide 24.

[YouTube Shorts] [Patent] The “Resolution” of an Invention

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765257595.html

[YouTube Shorts] [Patent] The “Resolution” of an Invention

Invention: “technical comprehension” + “writing ability.”

— There is no added value in patenting a specific example.

On the other hand, excessive broadening lowers the invention's resolution and fails the disclosure requirements.

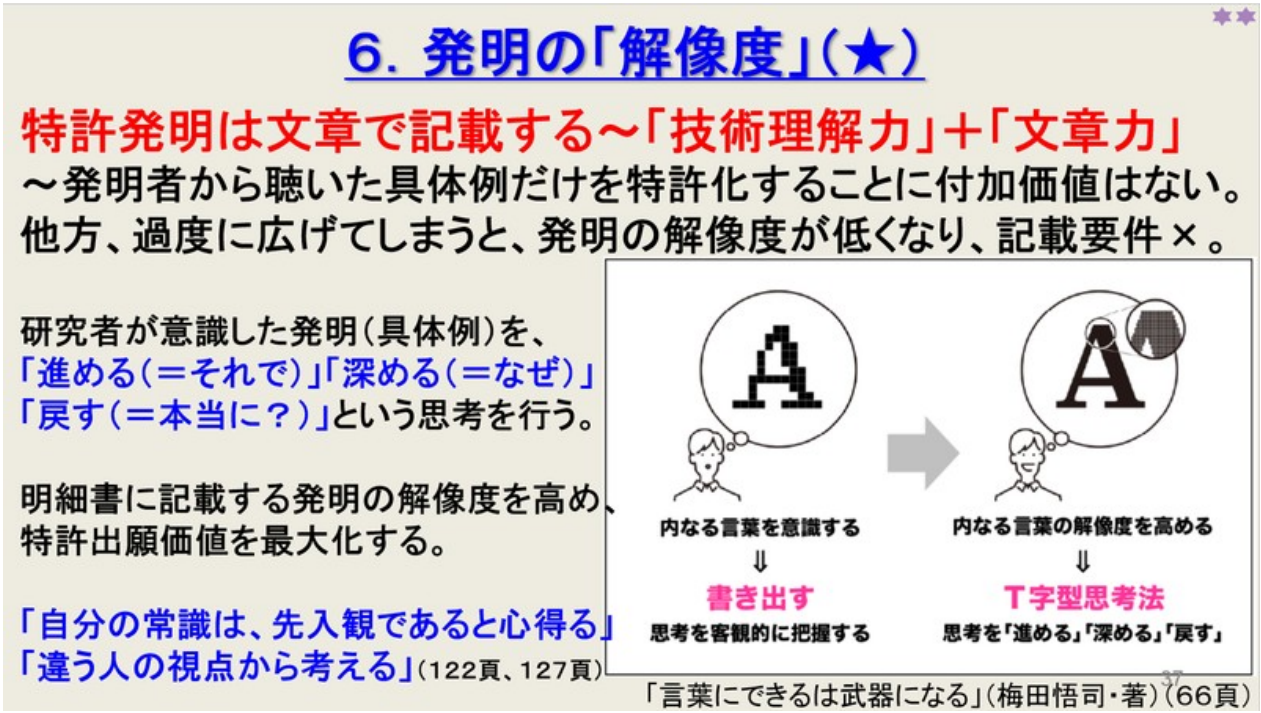
“Move forward (= so what?)”

“Go deeper (= why?)”

“Step back (= really?)”

Repeat this thought process!!

https://www.youtube.com/shorts/5q1T6n04tdw



English translation of the figure

6. The “resolution” of an invention (★). A patented invention is described in words — “technical understanding” + “writing ability.”

There is no added value in patenting only the specific example heard from the inventor. On the other hand, if it is broadened excessively, the resolution of the invention decreases and the description requirements are not satisfied.

For the invention (specific example) of which the researcher is conscious, carry out the thinking processes “advance (= and then?),” “deepen (= why?)” and “go back (= really?).” Increase the resolution of the invention described in the specification and maximize the value of the patent application.

“Recognize that your common sense is a preconception.” “Think from the viewpoint of a different person.” (Pages 122 and 127.)

Diagram, left: Be conscious of the words within you → Write them out → Grasp your thoughts objectively.
Diagram, right: Increase the resolution of the words within you → T-shaped thinking → “Advance,” “deepen” and “go back” in your thinking.

“Being Able to Put It into Words Becomes a Weapon” (by Satoshi Umeda), page 66. Slide 37.

[YouTube Shorts] [Patent] What Is a Pioneer Invention?

Original Ameblo publication: 2022-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765309770.html

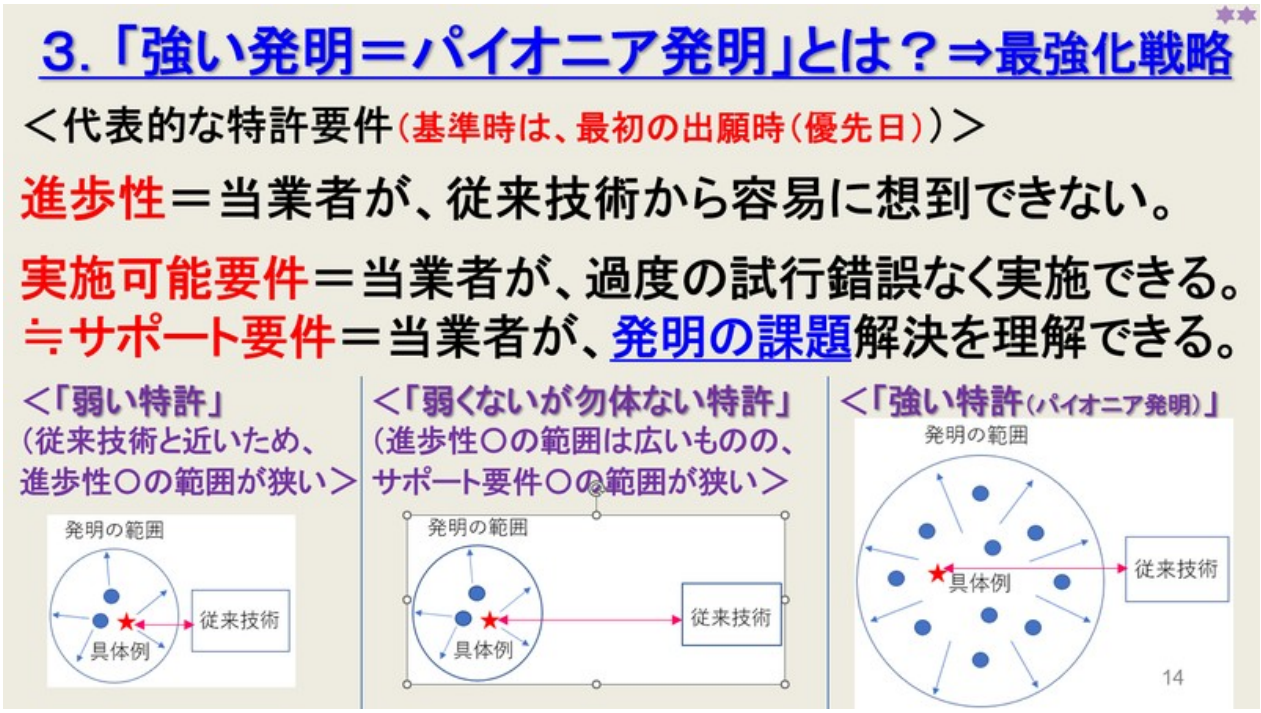
[YouTube Shorts] [Patent] What Is a Pioneer Invention?

Support requirement = a person skilled in the art can understand how the invention solves its problem.

A “patent with wasted potential”: a broad scope satisfies inventive step, but only a narrow scope satisfies support.

A “strong patent (pioneer invention)”: both the scope satisfying inventive step and the scope satisfying support are broad.

(1) [Patent] What Is a Pioneer Invention? #shorts - YouTube



English translation of the figure

3. What is a “strong invention = pioneer invention”? ⇒ Strategy for making it strongest.

Representative patentability requirements (reference time: the first filing date (priority date)). Inventive step: a person skilled in the art cannot easily conceive it from the prior art. Enablement requirement: a person skilled in the art can work it without excessive trial and error. Approximately equal to the support requirement: a person skilled in the art can understand the solution of the problem of the invention.

Left: “Weak patent” — because it is close to the prior art, the range in which inventive step is satisfied is narrow. Center: “Patent that is not weak but is unsatisfactory” — although the range in which inventive step is satisfied is broad, the range in which the support requirement is satisfied is narrow. Right: “Strong patent (pioneer invention).”

Labels in each diagram: scope of the invention; specific example; prior art. Slide 14.

Tokyo District Court, 2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

Original Ameblo publication: 2022-09-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765426895.html

2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

* The invention's problem was narrowly construed.

— The problem section is interpreted in light of solving the problems of the prior art.

<Problem of the invention>

Incorrect: merely being able to extract proteins.

Correct: being able to extract proteins even with a very small amount of surfactant.

⇒ Support requirement not satisfied.

(Excerpts from the judgment)

... Paragraph [0006] merely states the invention's purpose as “providing a liquid cosmetic capable of extracting proteins,” without referring to the presence or amount of surfactant, or its effect on protein extraction. However, [0006], together with [0005], is positioned in the description as discussing the “Problem to Be Solved by the Invention,” and [0005] states: “Since surfactants may burden the skin and cause roughness or similar problems, there has been demand for a method using no surfactant or only an extremely small amount.” Accordingly, it is reasonable to interpret the purpose in [0006] as premised on solving the prior-art problem stated in [0005]. ...

The problem of the invention cannot be construed merely as providing a liquid cosmetic capable of extracting proteins; it is to provide a liquid cosmetic capable of extracting proteins even without surfactant or with only a very small amount ....

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90979.pdf

Tokyo High Court, 2002 (Gyo-Ke) 58 “Sewing Machine” (Yamashita)

Original Ameblo publication: 2022-09-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765606867.html

Tokyo High Court, 2002 (Gyo-Ke) 58 “Sewing Machine” (Yamashita)

The fact that the claimed invention and the reference address different problems is not itself a difference, but may affect inventive step!!

“Different purposes for providing a component common to both inventions may lead to a finding that the configuration relating to a difference is not readily conceivable, but ... the difference in those purposes ... does not constitute a difference between the inventions.”

It is said that inventive-step assessments were strict fifteen years ago, and that many judgments allowed combination where the primary and secondary cited inventions shared a problem, even if the claimed invention and cited invention addressed different problems .... Yet, as in the Sewing Machine judgment, the general principle stated was that “it is possible to find that the configuration relating to the difference is not readily conceivable”!!

(Excerpts from the judgment)

Points of identity and difference between the claimed invention and Cited Invention 1 should be identified by focusing on whether Cited Invention 1 has the configurations of the claimed invention, not on the purposes for providing those configurations. For example, if all configurations are identical, the two should be regarded as the same invention even if the purposes for providing some configurations differ. Where there is a structural difference between inventions, different purposes for providing a configuration common to both may lead to a finding that the configuration relating to the difference is not readily conceivable. Even then, however, the difference in purpose does not constitute a difference between the inventions.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11278.pdf

[Unfair Competition Prevention Act; Copyright] Kyoto District Court, 2020 (Wa) 1874

Original Ameblo publication: 2022-09-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765826633.html

[Unfair Competition Prevention Act; Copyright] Kyoto District Court, 2020 (Wa) 1874

Infringement notice to YouTube ⇒ Video removed.

“Even if the expression of a technique or method ... is protected under copyright law, the scope is relatively narrow.” ⇒ No similarity.

“An idiosyncratic view that a video explaining the same or a similar knitting method ... infringes copyright ....” ⇒ Gross negligence found.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91029.pdf

[YouTube Shorts] The Extent to Which a Patent “Co-Owner” May Freely Grant Licenses and Take Similar Actions

Original Ameblo publication: 2022-09-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765827100.html

[YouTube Shorts] Patents That Management Should Know About

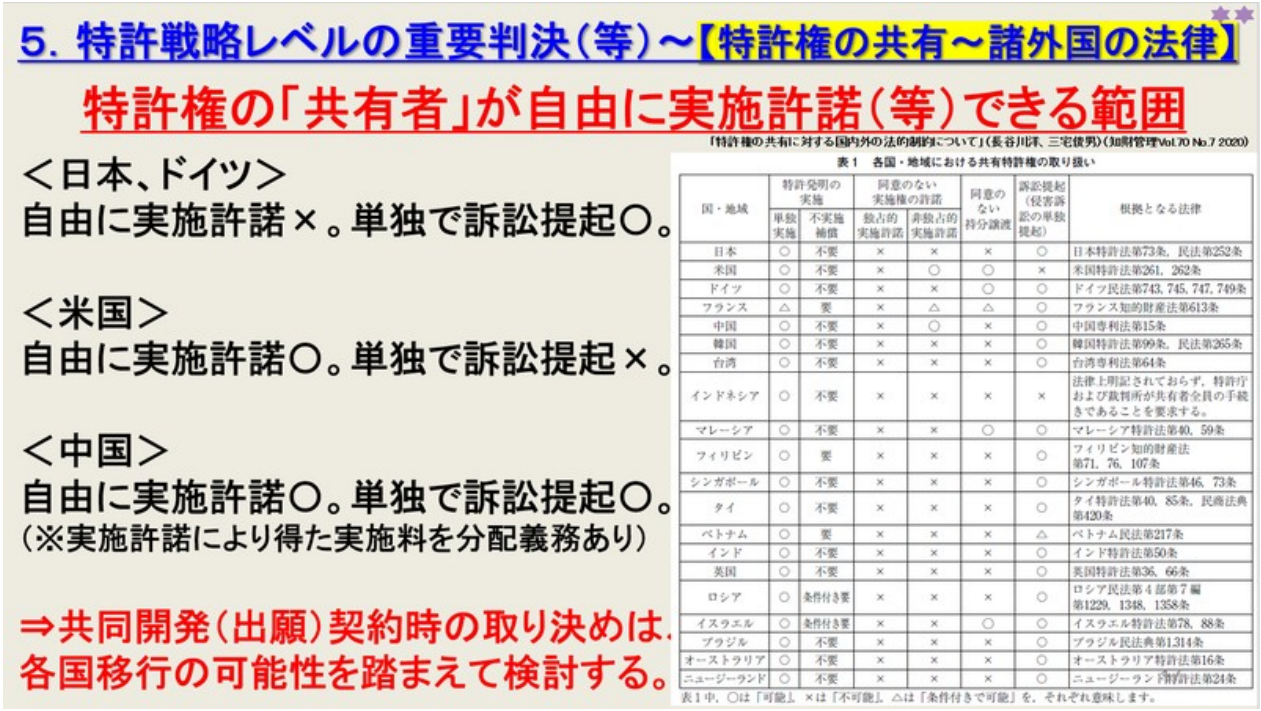
The extent to which a patent “co-owner” may freely grant licenses and take similar actions

<Japan, Germany> Free licensing: no. Bringing suit alone: yes.

<United States> Free licensing: yes. Bringing suit alone: no.

<China> In the absence of a different agreement among the co-owners, a co-owner may independently grant a non-exclusive license. Royalties received must be distributed among the co-owners. Bringing suit alone: yes.

[Patent] CGC Revision and Intellectual Property #shorts - YouTube



English translation of the figure

5. Important judgments and other matters at the patent-strategy level — co-ownership of patent rights: laws of various countries. The extent to which a patent “co-owner” can freely grant licenses and take similar actions.

Japan and Germany: freely granting licenses — no; filing suit alone — yes. United States: freely granting licenses — yes; filing suit alone — no. China: freely granting licenses — yes; filing suit alone — yes. (There is an obligation to distribute royalties obtained through licensing.)

Arrangements in joint development (application) agreements should be considered with the possibility of proceeding in each country in mind.

Table 1. Treatment of co-owned patent rights in various countries and regions. “○” means possible; “×” means not possible; “△” means conditionally possible. Column abbreviations below: Working = independent working of the patented invention; Compensation = compensation for non-working;

Exclusive / Non-exclusive = granting that type of license without consent; Share = transfer of a share without consent; Suit = bringing an infringement action alone.

Country/region	Working	Compensation	Exclusive	Non-exclusive	Share	Suit
Japan	○	Unnecessary	×	×	×	○
United States	○	Unnecessary	×	○	○	×
Germany	○	Unnecessary	×	×	○	○
France	△	Required	×	△	△	○
China	○	Unnecessary	×	○	×	○
South Korea	○	Unnecessary	×	×	×	○
Taiwan	○	Unnecessary	×	×	×	○
Indonesia	○	Unnecessary	×	×	×	×
Malaysia	○	Unnecessary	×	×	○	○
Philippines	○	Required	×	×	×	○
Singapore	○	Unnecessary	×	×	○	○
Thailand	○	Unnecessary	×	×	×	○
Vietnam	○	Required	×	×	×	△
India	○	Unnecessary	×	×	×	○
United Kingdom	○	Unnecessary	×	×	○	○
Russia	○	Conditionally required	×	×	×	○
Israel	○	Conditionally required	×	×	○	○
Brazil	○	Unnecessary	×	×	×	○
Australia	○	Unnecessary	×	×	○	○
New Zealand	○	Unnecessary	×	×	○	○

Legal provisions shown in the original table: Japan — Patent Act Article 73; Civil Code Article 252. United States — Patent Act Sections 261 and 262. Germany — Civil Code Sections 743, 745, 747 and 749. France — Intellectual Property Code Article 613. China — Patent Law Article 15. South Korea — Patent Act Article 99; Civil Act Article 265. Taiwan — Patent Act Article 64. Indonesia — not expressly provided in legislation; the patent office and courts require all co-owners to participate in proceedings. Malaysia — Patents Act Sections 40 and 59. Philippines — Intellectual Property Code Sections 71, 76 and 107.

Singapore — Patents Act Sections 46 and 73. Thailand — Patent Act Sections 40 and 85; Civil Code Article 420. Vietnam — Civil Code Article 217. India — Patents Act Section 50. United Kingdom — Patents Act Sections 36 and 66. Russia — Civil Code Part IV, Division VII, Articles 1229, 1348 and 1358. Israel — Patents Law Sections 78 and 88. Brazil — Civil Code Article 1,314. Australia — Patents Act Section 16. New Zealand — Patents Act Section 24.

For China, in the absence of a different agreement among the co-owners, a co-owner may independently grant a non-exclusive license. Royalties received must be distributed among the co-owners.

NAKAMURA & PARTNERS Has Been Rated Outstanding in the Asialaw Rankings

Original Ameblo publication: 2022-09-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12765847676.html

NAKAMURA & PARTNERS, the firm to which I belong, has been rated Outstanding as a leading Japanese intellectual property firm in the Asialaw 2022/23 Rankings.

I extend my deepest gratitude to everyone involved.

I am truly grateful to belong to such an outstanding firm.

https://www.nakapat.gr.jp/ja/awards-jp/

Current page (Awards): https://www.nakapat.gr.jp/en/awards/

IP High Court, 2010 (Gyo-Ke) 10122 <Iimura>

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766436325.html

IP High Court, 2010 (Gyo-Ke) 10122 <Iimura>

"Even where the configuration relating to a difference includes a configuration limited by a numerical range, the method of assessment is no different; the technical significance of the invention, the content of its solution to the problem, its functions and effects, and other matters should be considered comprehensively, including configurations relating to other differences ...."

https://www.takaishihideki.com/_files/ugd/324a18_ed5f0d7975c342ecb2530c6041d32cc5.pdf

[YouTube Shorts] CGC (Corporate Governance Code) Revision and Intellectual Property

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766436484.html

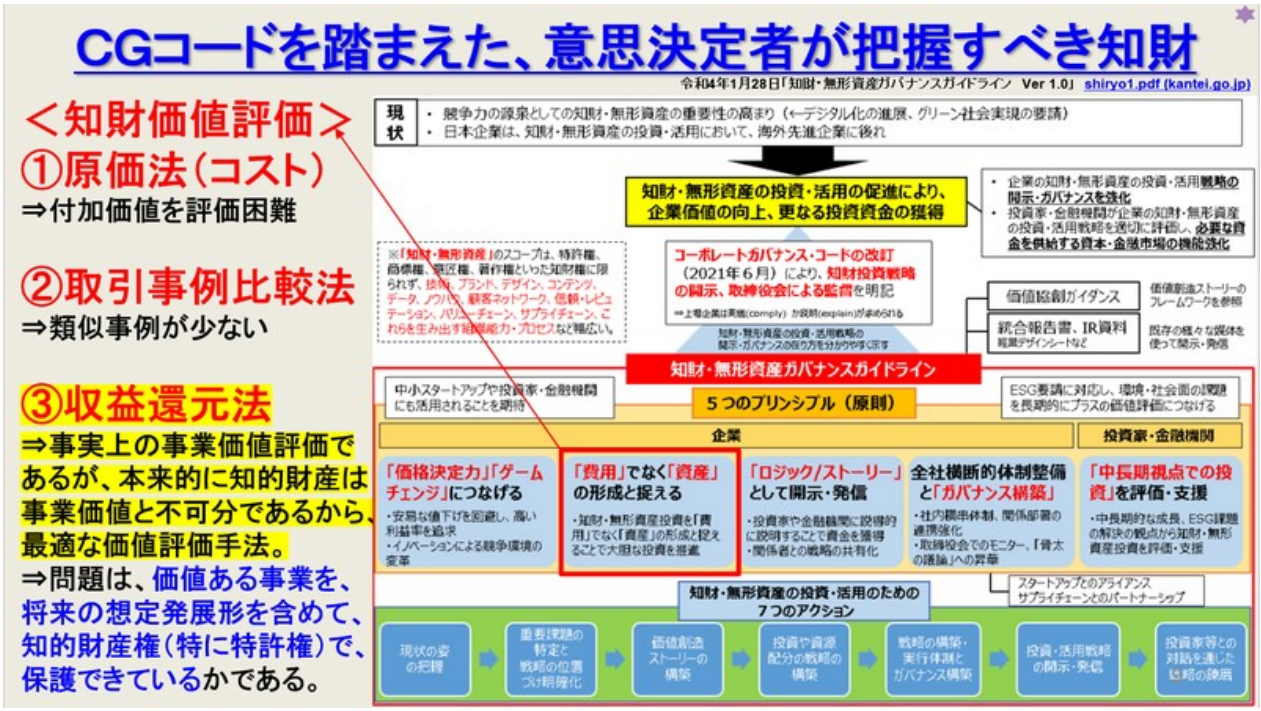
[YouTube Shorts] CGC (Corporate Governance Code) Revision and Intellectual Property

Regard intellectual property as an “asset,” not a “cost”!!

Intangible assets account for a majority of U.S. companies' enterprise value.

Accumulating in Japanese companies intellectual property and intangible assets that drive increases in enterprise value.

Mutual understanding between corporate management and investors.



English translation of the figure

Intellectual property that decision-makers should understand in light of the Corporate Governance Code.

Intellectual property valuation: (1) Cost approach — added value is difficult to evaluate. (2) Comparable-transaction approach — there are few similar cases. (3) Income approach — in substance it evaluates business value; however, because intellectual property is inherently inseparable from business value, it is the optimal valuation method. The question is whether the valuable business, including its anticipated future forms of development, is protected by intellectual property rights (particularly patents).

Current situation: The importance of intellectual property and intangible assets as sources of competitiveness is increasing, driven by progress in digitalization and calls to realize a green society. Japanese companies lag behind leading overseas companies in investment in and use of intellectual property and intangible assets.

Promoting investment in and use of intellectual property and intangible assets → increasing corporate value and obtaining further investment funds.

Strengthen disclosure and governance of companies' strategies for investing in and using intellectual property and intangible assets. Strengthen the functions of capital and financial markets so that investors and financial institutions appropriately evaluate those strategies and provide the necessary funds.

The scope of "intellectual property and intangible assets" is broad: it is not limited to intellectual property rights such as patents, trademarks, design rights and copyright, but also includes technology, brands, designs, content, data, know-how, customer networks, trust and reputation, value chains, supply chains, and the organizational capabilities and processes that create these.

Revision of the Corporate Governance Code (June 2021) expressly requires disclosure of intellectual property investment strategies and supervision by boards of directors. Listed companies are required to comply or explain.

Guidelines on Governance of Intellectual Property and Intangible Assets: clearly show how disclosure and governance should operate for investment in and use of intellectual property and intangible assets. Guidance for Collaborative Value Creation: consult the value-creation-story framework. Integrated reports, investor-relations materials, management-design sheets and other existing media: use various media for disclosure and communication.

Five principles. Companies: (1) Connect investment and use to "pricing power" and "game changing": avoid easy price reductions and pursue high profit margins; transform the competitive environment through innovation. (2) Treat them as formation of "assets," rather than "costs": promote bold investment by treating investment in intellectual property and intangible assets as asset formation. (3) Disclose and communicate as "logic/stories": obtain funds by explaining persuasively to investors and financial institutions; share strategies among stakeholders. (4) Establish cross-company structures and "governance": strengthen cooperation among internal horizontal structures and related departments; have the board monitor, raising the discussion to an "outside" perspective. Investors and financial institutions: (5) Evaluate and support "investment from a medium- to long-term perspective": evaluate and support intellectual property and intangible-asset investment from the standpoint of medium- and long-term growth and resolution of ESG issues.

The guidelines are expected to be used by small and medium-sized enterprises, startups, investors and financial institutions as well. Respond to ESG demands and connect environmental and social issues to positive value creation over the long term. Alliances with startups; partnerships with supply chains.

Seven actions for investment in and use of intellectual property and intangible assets: grasp the current situation → identify important issues and clarify the positioning of the strategy → build a value-creation story → build a strategy for allocating investment and resources → build the strategy, implementation structure and governance → disclose and communicate the investment/use strategy → refine it through dialogue with investors and others.

January 28, 2022, Guidelines on Governance of Intellectual Property and Intangible Assets, Version 1.0. shiryo1.pdf (kantei.go.jp).

https://www.youtube.com/shorts/_LC19RQjb-A

Legal Information and Newsletter from NAKAMURA & PARTNERS

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766437228.html

NAKAMURA & PARTNERS, the firm to which I belong, provides the latest legal information on its website and issues an email newsletter once a month. Anyone can subscribe, and it is free, so please sign up if you are interested!!

⇒ Introductions to IP court decisions (patents, trademarks and more), and legislative amendments.

(We also provide legal information in English.)

https://a00.hm-f.jp/index.php?action=PR1&a=824&f=1&g=1&fa_code=8fe73c7022f1ceee96f26d999a2f7c6f

IP High Court, 2021 (Gyo-Ke) 10037 [Display Device Supportable with One Hand] <Kanno>

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766437447.html

IP High Court, 2021 (Gyo-Ke) 10037 [Display Device Supportable with One Hand] <Kanno>

* No basis for narrowly construing the corrected claim.

"There is no basis for narrowly interpreting 'any angle' as meaning an angle within the range from approximately 120 to approximately 170 degrees ...; according to its ordinary meaning, it includes the range from 0 to 360 degrees."

⇒ Correction not permitted.

(Excerpts from the judgment)

... It is clear that the intermediate left-right spread fixing means in configuration e, which "fixes" the two display panels "by a stopper" at an angle between approximately 120 and approximately 170 degrees, is a means of "temporary fixing," while the arbitrary-angle holding means in configuration C, which "holds" the two panels "by frictional force," is a means of "semi-fixing." They are naturally understood as separate means using different fixing mechanisms. ... There is therefore no basis for narrowly interpreting "any angle" in the arbitrary-angle holding means as meaning an angle between approximately 120 and approximately 170 degrees; ... according to its ordinary meaning, it should be understood as including the range from 0 to 360 degrees. ... Such a configuration is not described in the description before correction. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90896.pdf

[YouTube Shorts] Doctrine of Equivalents (Summary, 2022 Edition)

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766437620.html

[YouTube Shorts] Doctrine of Equivalents (Summary, 2022 Edition)

Established in approximately 10% of cases in which equivalence was asserted.

Mostly mechanical cases, but chemical cases include “Maxacalcitol” and “L-Glutamic Acid.”

“L-Glutamic Acid”: the key is whether “it would readily have been possible to describe it in the claims in a form satisfying the support requirement and other disclosure requirements”!

https://www.youtube.com/shorts/qhRWFayidrI

IP High Court, 2020 (Gyo-Ke) No. 10150 [Equol-Containing Fermented Soybean-Hypocotyl Product] <Honda>

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766437786.html

IP High Court, 2020 (Gyo-Ke) No. 10150 [Equol-Containing Fermented Soybean-Hypocotyl Product] <Honda>

⇒ No violation of the requirements under the delegated ministerial ordinance.

Article 24-2 of the Regulations under the Patent Act concerns “the content of the detailed description of the invention” ...; matters necessary to understand the invention's technical significance need not be stated under the heading “Problem to Be Solved by the Invention.”

[Claim 1 (after correction)] A production method ... producing at least 8 mg of ornithine and at least 1 mg of equol per 1 g dry weight of the fermented product ....

(Excerpts from the judgment)

... The plaintiff's argument is premised on conversion from arginine to ornithine far exceeding 100% (approximately 159%) in [Table 3] of the description, but ... the fermentation starting materials and conditions differ. The dry weight of a fermented product may vary greatly according to the solid content of the starting material and medium, so changing the starting material also changes the amount of ornithine per 1 g dry weight. Thus, ornithine production per 1 g dry weight may vary greatly between use of a soybean-hypocotyl solution and use of soy milk as the starting material. Different culture conditions may also produce different conversion rates from arginine to ornithine. Accordingly, [Table 3] of the description cannot appropriately be used as the premise for estimating ornithine production in the test examples of Exhibit Ko 1. ... Since those examples do not specify the composition of the BHI broth used as the medium, the invention of Exhibit Ko 1 does not necessarily produce at least 8 mg of ornithine per 1 g dry weight of the fermented product .... Accordingly, that invention cannot be regarded as “producing at least 8 mg of ornithine per 1 g dry weight of the fermented product.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90780.pdf

[YouTube Shorts] Functional Claims

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766437896.html

[YouTube Shorts] Functional Claims

“Where the claims ... are stated in abstract, functional terms,” “a configuration that a person skilled in the art can implement from the description and drawings falls within the technical scope.”

⇒ Could an Article 36 violation be avoided by construing the invention within the scope that satisfies the support requirement!?

https://www.youtube.com/shorts/CiyifuCSLEg

IP High Court, 2019 (Gyo-Ke) 10108 [Control Channels in a Communication Network System] <Kanno>

Original Ameblo publication: 2022-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766438181.html

IP High Court, 2019 (Gyo-Ke) 10108 [Control Channels in a Communication Network System] <Kanno>

Correction adding claim wording: substantial change.

“Corrected claim 1 adds the concept of ‘control-channel candidates available for allocation to user equipment,’ which was not in the claims before correction ....”

(Excerpts from the judgment)

... Taking Figure 4 together with the above statements in the description, it can be said that the following is tantamount to being disclosed regarding the proportions of control-channel candidates available for scheduling that are restricted by the tree structure: in the embodiment in Figure 4, at aggregation level 1, the highest level, the 24 control channels are restricted to four candidates (a candidate proportion of one-sixth); at aggregation level 2, a relatively lower level, the 12 control channels are restricted to four candidates (a candidate proportion of one-third); and at aggregation level 4, the six control channels are restricted to four candidates (a candidate proportion of two-thirds); while the three control channels at aggregation level 8 are not restricted (a candidate proportion of one).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90287.pdf

[Foreign-server issue] IP High Court, 2018 (Ne) 10077 (Dwango v. FC2, INC.) <Presiding Judge Honda>

Original Ameblo publication: 2022-09-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766606829.html

[Foreign-server issue] IP High Court, 2018 (Ne) 10077 (Dwango v. FC2, INC.) <Presiding Judge Honda>

Reversed on appeal: claim limitations found satisfied

＋

The court held that, for the defendant (US-based FC2), which distributed a “program for displaying comments on videos” from servers outside Japan to viewers in Japan, “viewed substantively and as a whole, the distribution is assessed as having taken place in Japan.”

Facts identified by the court in finding that FC2's distribution of the program took place in Japan.

① It begins and ends through access by users in Japan, and it is difficult to distinguish the portions within and outside Japan.

② It is controlled by users in Japan.

③ It is directed toward users in Japan.

④ The resulting effects arise in Japan.

(Excerpts from the judgment)

…If, for patent infringement to be established for inventions capable of transmission over a network, such as Inventions 1-9 and 1-10 at issue, the provision in question had to be completed entirely within Japanese territory even in a formal sense, a person seeking to work such an invention could easily avoid liability for patent infringement by moving some equipment, such as servers, overseas. In today's digital society, in which numerous useful network-related inventions exist, permitting such evasive conduct would be gravely contrary to justice. On the other hand, even if not all elements of an act of working a patented invention are formally completed within Japanese territory, if, viewed substantively and as a whole, the act can be assessed as having taken place within Japanese territory, extending the effect of a Japanese patent right to it is not considered contrary to the territoriality principle described above.

Accordingly, with respect to the provision in question, it is appropriate to interpret it as constituting “provision” under the Japanese Patent Act where, considering such circumstances as whether the portions of that provision occurring outside and inside Japanese territory can be clearly and readily distinguished, whether control of that provision takes place within Japanese territory, whether that provision is directed to customers or others located within Japanese territory, and whether the effects of the patented invention obtained through that provision arise within Japanese territory, the provision can, viewed substantively and as a whole, be assessed as having taken place within Japanese territory.

c Applying this to the present case, the distribution at issue begins and is completed when users located within Japanese territory access the websites for the appellees' respective services (Exhibits Ko 3–5, 44, 46 and 47; Exhibits Hei 1–3), and it is difficult to distinguish clearly and readily the portions of that distribution occurring outside and inside Japanese territory. Control of the distribution is exercised by users located within Japanese territory, and the distribution is directed to users located within Japanese territory who wish to watch videos. Furthermore, it is only through the distribution at issue that users located within Japanese territory can watch the videos associated with Inventions 1-9 and 1-10, including adding comments, and the effects of Inventions 1-9 and 1-10 obtained through that distribution arise within

Japanese territory. In light of these circumstances, even if some portion of the distribution takes place outside Japanese territory, viewed substantively and as a whole, it is appropriate to assess it as having taken place within Japanese territory.

d In view of the foregoing, the distribution at issue constitutes “provision” under Article 2(3)(i) of the Japanese Patent Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91418.pdf

IP High Court, 2021 (Ne) 10049, 10069 [Blowgun dart] <Honda> Loses on reversal (claim limitations not satisfied)

Original Ameblo publication: 2022-09-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766769837.html

IP High Court, 2021 (Ne) 10049, 10069 [Blowgun dart] <Honda> Loses on reversal (claim limitations not satisfied)

*Resolution of the three problems addressed by the invention “may” be impeded.

⇒ The “elliptical” claim limitation is restricted to shapes having the same curvature at both ends in the longitudinal direction.

⇒ No literal satisfaction of the limitations; no equivalence.

⇒ Patentee loses on reversal (first instance: 2019 (Wa) 2675).

*The same three problems are identified in the first-instance and appellate judgments.

(Excerpts from the judgment)

⋯Given that the invention of Claim 1 describes the tip as “spherical,” and the specification also distinguishes between “spherical” and “elliptical,” it is understood at least that “elliptical” in the invention at issue … is not a term with a broad meaning that could include a circle…. …

The problems the invention seeks to solve are understood to be, in addition to the problems arising in the prior art from the presence of a “barb” at the tip of the dart—① when removing a dart from the target, only the round-nail pin remains in the target and only the film is pulled out, and ② in a double penetration, when the rear dart is pulled out, the film slips off the round-nail pin and the rear dart's pin remains inside the front dart's film …—③ an uneven vertical center of gravity caused by displacement between the head and cylindrical portion of the dart tip and overlap of the film…. …If a shape with differing curvatures is used, depending on the specific shape, a separate possibility arises that the tip with differing curvatures may remain in the target or, in a double penetration, in the front dart's film, potentially impeding resolution of the pin-separation problem…. …If a shape with differing curvatures is used, depending on the specific shape, it may become difficult to adjust its position relative to the cylindrical portion, or the features of having no unevenness in the vertical center of gravity and a relatively heavy tip may not be fully realized, potentially impeding resolution of the center-of-gravity problem…. …

⋯“Elliptical” in Claim Elements B and D is understood to include a geometrical ellipse and shapes approximating an ellipse with the same curvature at both longitudinal ends, such as the shape in the embodiment of the invention, but not shapes with differing curvatures…. …The tip of the pin in the defendant's product is “a tip whose longitudinal section traces an arc such that the front portion is a gently curved shape and the rear portion is substantially conical, whose junction with the rear cylindrical portion has upper and lower corners, and whose shape connects those rear corners with a straight line” … and should be described as a shape obtained by further cutting off one end of a shape with differing curvatures to a certain extent. It therefore does not fall within “elliptical” in Claim Elements B and D.

https://twitter.com/CAL000000/status/1575259059611062272

“Act on the Protection of Personal Information” has been posted on the Nakamura & Partners website.

Original Ameblo publication: 2022-09-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766857221.html

“Act on the Protection of Personal Information” has been posted on the Nakamura & Partners website.

When personal information has leaked, it is important not only to identify the cause and prevent recurrence, but also to disclose information appropriately.

In addition to reporting to the Personal Information Protection Commission and notifying the affected individuals, a press release or similar disclosure may be necessary in some cases.

https://www.nakapat.gr.jp/ja/practices-details/personal-information-protection/

Appeal: IP High Court, 2020 (Ne) 10029 [Cellulose powder] <Otaka>

Original Ameblo publication: 2022-09-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12766940966.html

Appeal: IP High Court, 2020 (Ne) 10029 [Cellulose powder] <Otaka>

Support requirement satisfied (opposite to the first instance!!)

One document was submitted at first instance to rebut the BATTISTA paper cited in the specification, but two additional documents were submitted on appeal, reversing the original judgment.

A publicly known document published 11 years after the BATTISTA paper was decisive!!

=IP High Court, 2019 (Gyo-Ke) 10160 <Otaka>

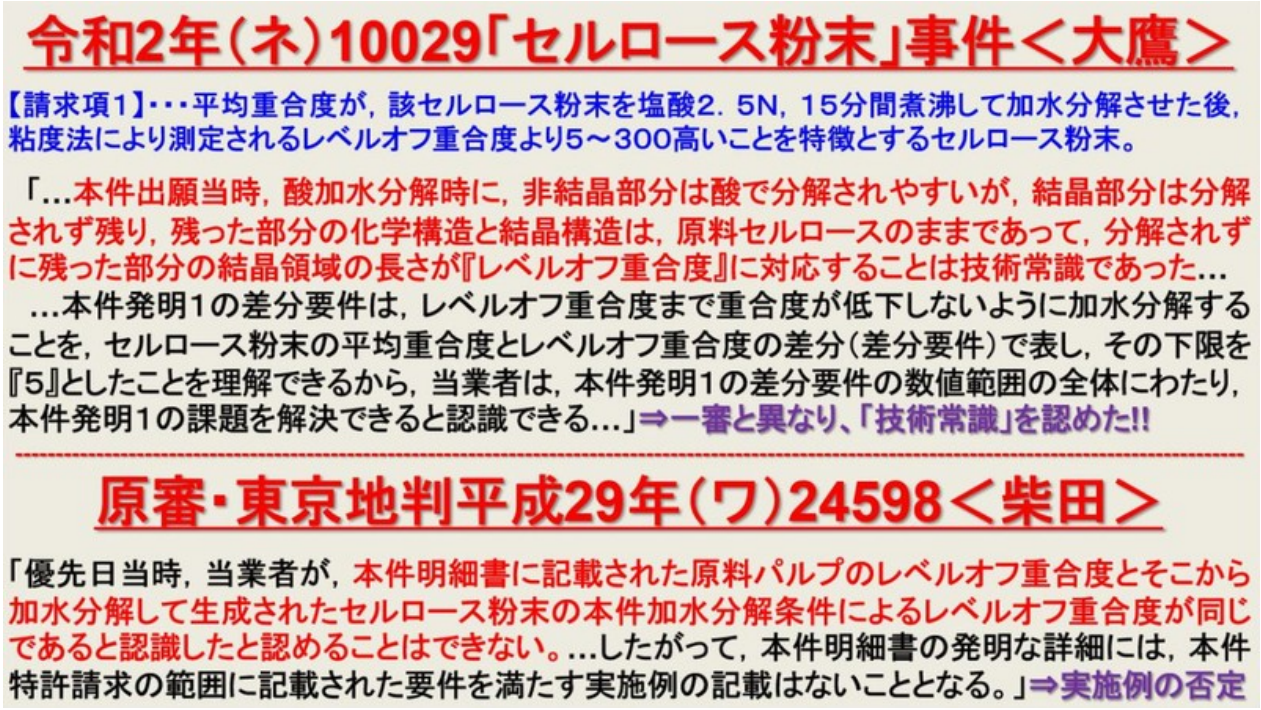
<First instance> Tokyo District Court, 2017 (Wa) No. 24598 <Shibata>

[Claim 1] …Cellulose powder characterized in that its average degree of polymerization is 5–300 higher than the leveling-off degree of polymerization measured by viscometry after the cellulose powder is hydrolyzed by boiling in 2.5 N hydrochloric acid for 15 minutes.

(Excerpts from the judgment)

The specification states the leveling-off degree of polymerization of the respective raw-material pulps (commercial SP pulp, commercial KP pulp, etc.) for the cellulose powders of Examples 2–7 and Comparative Examples 1–11…. …At the time of filing, it was common general technical knowledge that, during acid hydrolysis, the amorphous portions are readily decomposed by acid but the crystalline portions remain undecomposed, that the chemical and crystal structures of the remaining portions are those of the original cellulose, and that the length of the crystalline regions of the undecomposed portions corresponds to the “leveling-off degree of polymerization.” In light of this, the leveling-off degree of polymerization of the cellulose powders in the above examples and comparative examples in the specification can be understood to be approximately equal to that of the raw-material pulp…. Moreover, Table 4 of the specification states the average degree of polymerization of the cellulose powders of Examples 2–7 and Comparative Examples 1–11. A person skilled in the art reading the specification is therefore considered able to ascertain whether those cellulose powders satisfy the difference requirement. Table 4 also shows the mean yield pressure [MPa], tablet water-vapor adsorption rate Ka, hardness [N], and disintegration time [seconds] for cylindrical compacts of the cellulose powders of Examples 2–7, in which the “average degree of polymerization,” “mean particle L/D (major-axis/minor-axis ratio),” “mean particle diameter,” “apparent specific volume,” “apparent tapped specific volume,” “angle of repose,” and “difference between the average degree of polymerization and the leveling-off degree of polymerization” (difference requirement) all lie within the numerical ranges of Invention 1, and for cylindrical compacts of the cellulose powders of Comparative Examples 1–11, in which any one of these lies outside those ranges. All the cellulose powders of Examples 2–7 have an angle of repose of 55° or less, tablet hardness of 170 N or more, and disintegration time of 130 seconds or less. Here, an angle of repose exceeding 55° markedly worsens flowability …; tablet hardness is a practical physical-property value indicating moldability, and 170 N or more is preferred …; and disintegration time is a practical physical-property value indicating disintegrability, and 130 seconds or less is preferred…. Thus, the cellulose powders of Examples 2–7 can be described as cellulose powders combining moldability, flowability, and disintegrability in a well-balanced manner. Accordingly, a person skilled in the art … can recognize that the cellulose powders of Examples 2–7 can solve the problem of Invention 1…. …

…From the statements … in the specification …, it can be understood that, if cellulose powder is hydrolyzed down to the leveling-off degree of polymerization, the L/D of the cellulose particles before drying tends to decrease, the cellulose particles aggregate in the subsequent drying step, the L/D of the resulting cellulose powder becomes smaller, and a smaller L/D reduces moldability. It can also be understood that the difference requirement of Invention 1 expresses hydrolysis that does not reduce the degree of polymerization to the leveling-off degree of polymerization in terms of the difference between the average degree of polymerization of the cellulose powder and its leveling-off degree of polymerization (the difference requirement), with a lower limit of "5." A person skilled in the art is therefore found able to recognize that the problem of Invention 1 can be solved throughout the numerical range of its difference requirement.…



English translation of the figure

IP High Court, 2020 (Ne) 10029, "Cellulose Powder" <Otaka>.

[Claim 1] … Cellulose powder characterized in that its average degree of polymerization is 5–300 higher than its level-off degree of polymerization, measured by a viscosity method after the cellulose powder is hydrolyzed by boiling in 2.5 N hydrochloric acid for 15 minutes.

"… At the time of the application at issue, it was common general technical knowledge that, during acid hydrolysis, the noncrystalline portions are readily decomposed by acid while the crystalline portions remain without decomposition; that the chemical and crystalline structures of the remaining portions are the same as those of the raw-material cellulose; and that the length of the crystalline regions of the portions remaining without decomposition corresponds to the 'level-off degree of polymerization.' …

… It can be understood that the feature constituting the difference in Invention 1 at issue expresses hydrolysis such that the degree of polymerization has not decreased to the level-off degree of polymerization by the difference between the average degree of polymerization and the level-off degree of polymerization of the cellulose powder (the feature constituting the difference), and sets its lower limit at '5.' A person skilled in the art can therefore solve the problem of Invention 1 at issue throughout the numerical range of the feature constituting the difference in Invention 1 at issue. …" ⇒ Unlike the first instance, "common general technical knowledge" was recognized!!

First instance: Tokyo District Court, 2017 (Wa) 24598 <Shibata>.

“At the priority date, a person skilled in the art could not recognize that the level-off degree of polymerization of the raw-material pulp described in the specification at issue was the same as the level-off degree of polymerization under the hydrolysis conditions at issue of the cellulose powder produced by hydrolyzing that pulp. … Accordingly, the detailed description of the invention in the specification at issue contains no description of an example satisfying the features recited in the claims at issue.” ⇒ The examples were denied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90773.pdf

Tokyo District Court, 2019 (Wa) 7038, 9618 <Kokubu> Graphitic carbon material used as a graphene precursor

Original Ameblo publication: 2022-10-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12767455613.html

Tokyo District Court, 2019 (Wa) 7038, 9618 <Kokubu>

[Graphitic carbon material used as a graphene precursor]

Since before the patent application's filing date: ① product names/numbers were the same; ② there were no major changes to the manufacturing processes and no changes to product specifications; ③ pre-filing samples included products within the invention's numerical range.

⇒ Public working established (no novelty).

(Excerpts from the judgment)

⋯(c) Whether Nippon Graphite and the other parties had manufactured and sold the respective Nippon Graphite products falling within the technical scope of the inventions at issue since before the patent application

⋯Most factors thought to affect an increase in rhombohedral graphite layers can be said to relate to graphite-product manufacturing processes and the specifications the manufactured products must satisfy. However, even all the evidence presented in this litigation does not establish specifically which operations under which conditions not only increase rhombohedral graphite layers but cause what degree of fluctuation in Rate (3R), the proportion of rhombohedral graphite layers in the sum of rhombohedral and hexagonal graphite layers.… Nippon Graphite Industries has manufactured the respective Nippon Graphite products since before the patent application, and from before the application to the present there have been no major changes to their manufacturing processes or to the specification values serving as shipment criteria.… The plaintiff sued Nippon Graphite and the other parties in March 2019 on the basis of the Nippon Graphite product results, and it cannot be said that a particularly long period had elapsed since the patent application of September 9, 2014.

Accordingly, Nippon Graphite and the other parties have manufactured and sold graphite products bearing the respective names of the Nippon Graphite products from before the patent application to the present. During this period, there have been no changes to the manufacturing processes or specification values of these products that are thought to influence increases or decreases in rhombohedral graphite layers. The Nippon Graphite products manufactured and sold during this period are therefore found to have undergone the same manufacturing processes and satisfied the same specifications. No other circumstances are found to have existed that would affect increases or decreases in their Rate (3R), and … at present, Nippon Graphite Products 1–3 fall within the technical scope of the respective inventions, while Nippon Graphite Products 4 and 5 fall within that of Invention 1. In light of these circumstances, it is appropriate to find that Nippon Graphite and the other parties had manufactured and sold such Nippon Graphite products since before the patent application. …The fact that Nippon Graphite Products 4 and 5 sampled in 2008, before the patent application, had Rate (3R) values of 31% or more also supports this conclusion….

Although Sample Results ③ for Nippon Graphite Product 2 differ from the Exhibit Otsu A18 Results, Nippon Graphite Product 2 is earthy graphite, and the peaks around diffraction angles of 43–44°, where the respective (101) peaks of rhombohedral graphite layers (3R) and hexagonal graphite layers (2H) are said to appear, are not necessarily clear. …Where peaks are unclear, PDXL's automatic analysis function may converge on an unreasonable solution or diverge. Given also the variation between Sample Results ③ and the Exhibit Otsu A18 Results for Nippon Graphite Product 1, which is likewise earthy graphite, the

difference between Sample Results ③ and the Exhibit Otsu A18 Results for Nippon Graphite Product 2 cannot be said to alter the above finding that Nippon Graphite and the other parties had manufactured and sold Nippon Graphite Product 2 falling within the technical scope of the inventions since before the patent application.…

The plaintiff argues that, even if third parties acquired products implementing the inventions from the defendants, Nippon Graphite and the other parties, or Chuetsu Graphite, they could not have learned the configurations or compositions of the inventions. However, …at the time of the patent application, persons skilled in the art performed X-ray diffraction measurements to determine the crystal structure of substances and calculated peak areas (integrated intensities) by analyzing the resulting diffraction profiles. The cost, effort, and time involved in commissioning an outside specialist organization to perform such analysis are not found to prevent a determination that the inventions had been publicly worked.…

The plaintiff argues that identical product names and numbers for products sold before the patent application and those sold recently do not establish that the products are identical. However, it is a fact judicially known to this court that product quality is frequently controlled by product names and numbers. In addition to this circumstance, …considering that the defendants, Nippon Graphite and the other parties, and Chuetsu Graphite made no major changes to product manufacturing processes and no changes to product specifications before and after the patent application, and that pre-filing product samples include those with a Rate (3R) of 31% or more or 40% or more, …it is appropriate to find that the defendants, Nippon Graphite and the other parties, and Chuetsu Graphite had manufactured and sold products falling within the technical scope of Invention 1 or the respective inventions since before the patent application.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90726.pdf

IP High Court, 2019 (Ne) 10078 <Kanno> [Construction method for a roof chimney penetration and waterproof structure for a roof chimney penetration]

Original Ameblo publication: 2022-10-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12767455826.html

IP High Court, 2019 (Ne) 10078 <Kanno>

[Construction method for a roof chimney penetration and waterproof structure for a roof chimney penetration]

Construction in circumstances visible from outside

⇒ Public working

“The neighboring land on the side … where the stove chimney projects from the roof of A's residence … is higher than A's residence … and the chimney is sufficiently visible from that parking lot.”

(Excerpts from the judgment)

Regarding the argument that the work at A's residence was not carried out “publicly,” the appellant contends that the work cannot be described as publicly performed because A's residence is surrounded by walls and vegetation and cannot readily be viewed from outside; it is surrounded by mountains and has few neighboring residents; and the work took place on the roof, making its details difficult to ascertain from outside. However, …the neighboring land on the side where the stove chimney projects from A's roof (the front side of the chimney) was a parking lot at the time of the work … and is found to be higher than the property of A's residence…. The chimney is sufficiently visible from that parking lot, and there is no indication that the work was performed in a manner intended to prevent third parties from seeing it.… The construction method and waterproof structure used at A's residence … are not complex, and a person skilled in the art … is found able to understand these inventions technically.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90037.pdf

IP High Court, 2019 (Gyo-Ke) 10043 “High-contrast tire pattern” <Tsuruoka>

Original Ameblo publication: 2022-10-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12767626006.html

IP High Court, 2019 (Gyo-Ke) 10043 “High-contrast tire pattern” <Tsuruoka>

*A case in which combining a secondary reference solving a different problem from the primary reference was found obvious “for another reason.”

⇒ No inventive step for an invention with numerical limitations.

*Exhibit Ko 2 contains no concept of increasing contrast, but even so, a combination with the Exhibit Ko 1 invention would be attempted for another reason.

(Excerpts from the judgment)

[Difference 2] Invention 3 contains the feature that “the blade wall has a mean roughness Rz of 5 μm to 30 μm over at least one-quarter of its area, and the blade wall having this mean roughness is located in the bottom quarter of the blade height,” whereas the Exhibit Ko 1 invention does not specify the mean roughness of the wall-like structure formed by numerous narrow grooves 4.…

…Improving the distinguishability of an indication mark is one means of improving a tire's appearance; if there is a means of further improving the appearance of the tire in the Exhibit Ko 1 invention, that would be desirable.… Because Exhibit Ko 2 is stated to have the purpose of improving appearance, a person skilled in the art encountering the Exhibit Ko 1 invention would be expected to consider the matters described in Exhibit Ko 2.…

The matters described in Exhibit Ko 2 are considered suitable for further improving the appearance of the tire in the Exhibit Ko 1 invention, including the indication-mark portion. A person skilled in the art therefore has sufficient motivation to attempt to combine the matters described in Exhibit Ko 2 with the Exhibit Ko 1 invention.

…Exhibit Ko 2 contains no concept of increasing contrast, but even so, it is clear from the foregoing that a combination with the Exhibit Ko 1 invention would be attempted for another reason.

https://l.facebook.com/l.php?u=https%3A%2F%2Fwww.nakapat.gr.jp%2Fja%2Flegal_updates_jp%2F%25E3%2580%2590%25E7%2589%25B9%25E8%25A8%25B1%25E2%2598%2585%25E3%2580%2591%25E6%2590%258D%25E5%25AE%25B3%25E8%25B3%25A0%25E5%2584%259F%25E7%25AD%2589%25E8%25AB%258B%25E6%25B1%2582%25E4%25BA%258B%25E4%25BB%25B6%25EF%25BC%2588%25E7%25B5%2584%25E6%2588%2590%25E5%2580%25A4%25E3%2582%2592%25E6%25BA%2580%25E3%2581%259F%25E3%2581%2597%2F%3Ffbclid%3DIwAR3EKUrGhA7uuZTs0qatg9wFcPCvhF8vpKUaO4DvTTwfas2aTmBgED7Brfc&h=AT3n55XPPiKBxLOmq9jLdDy_ZgNFWFEti4GMqgBTb_AlID_SnHPYqW8ETJu3uEGy0yFbdRy0G0jQEIxvkDdbrSfN7DcKcCSQQY_8PMOmQyWu_VflY6SybfqlK3EdOZasFrxK&__tn__=H-R&c[0]=AT03iRTaJKc5aJVMSXBVy3CbvVLt2GpHLTMp5Mjylo7qe243AO61rA20mYPO2Q6qAFsFWTIbKXhKqRSYpAFyJuPyHvuQVOrlbSKobJAQqQiTK6uQJc76OgdDVOr1JmPVAQ3n

Tokyo District Court, 2013 (Wa) 30271 <Action seeking remuneration for an employee invention>

Original Ameblo publication: 2022-10-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12767795620.html

Tokyo District Court, 2013 (Wa) 30271 <Action seeking remuneration for an employee invention>

*Different problems addressed by the invention at issue and the reference do not affect the determination of novelty.

"Even if the inventions solve different technical problems, if the technical matters ultimately disclosed are identical, they are identical as inventions … this does not affect the determination of novelty."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87250.pdf

[Copyright] IP High Court, 2021 (Ne) 10028 “Idle RPG” case <Otaka>

Original Ameblo publication: 2022-10-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12767964960.html

[Copyright] IP High Court, 2021 (Ne) 10028 “Idle RPG” case <Otaka>

Game data were copied, but … this did not constitute reproduction or adaptation.

“Even if most of the defendant's source code is common to the plaintiff's source code, the program represented by the plaintiff's source code is not recognized as a copyrightable work. Accordingly, creation of the defendant's source code does not infringe the copyright in the program represented by the plaintiff's source code (the reproduction right or adaptation right).”

No general tort established either.

“It cannot be recognized as an interest deserving legal protection that differs from … the interest in exclusive exploitation of a work regulated by the Copyright Act.”

Cf. the Tsubasa System case

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90590.pdf

[Unfair Competition Prevention Act] Osaka District Court, 2018 (Wa) 8708

Original Ameblo publication: 2022-10-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768131457.html

[Unfair Competition Prevention Act] Osaka District Court, 2018 (Wa) 8708

Patent enforcement—claim limitations not satisfied

"Where … enforcement of a patent right … is not permitted …, enforcement under the Unfair Competition Prevention Act based on the commonality of portions belonging to … general configurations and shapes whose configuration and satisfaction of the limitations are undisputed … cannot be allowed absent special reasons…."

Cf. the Supreme Court judgment concerning North Korea and copyright

https://www.nikkei.com/article/DGXNASDG08043_Y1A201C1CR8000/

https://www.nakapat.gr.jp/ja/

Osaka District Court, 2018 (Wa) 5037

Original Ameblo publication: 2022-10-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768342306.html

Osaka District Court, 2018 (Wa) 5037

Kaneka—patent owner

Hirano—licensee

PI—manufactured film using machinery purchased from Hirano and lost a patent-infringement lawsuit brought by Kaneka in the United States.

Unlike in the US litigation, an implied agreement that Hirano would not sell machinery to Kaneka's competitors was rejected.

PI's manufacturing was protected by exhaustion.

However…

090450_hanrei.pdf (courts.go.jp)

Tokyo District Court, 2003 (Wa) 19324 [Method for producing Branut granules] <Mimura>

Original Ameblo publication: 2022-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768798363.html

Tokyo District Court, 2003 (Wa) 19324 [Method for producing Branut granules] <Mimura>

Taking the prosecution history into account as well,

“…adjusting to 30°C–0°C”

was interpreted

to mean “actively adjusting the temperature by some means so as to bring the temperature of the kneaded material supplied to the extrusion granulator to 30–0°C.”

⇒ Claim limitation not satisfied

[Claim 1] …A method for producing pharmaceutical granules … characterized by adjusting the temperature of the kneaded material supplied to the extrusion granulator to 30°C–0°C.

(Excerpts from the judgment)

⋯In the invalidation decision …, “adjusting the temperature of the kneaded material supplied to the extrusion granulator to 30°C–0°C” within the scope of the second patented invention at issue was held not to mean merely the state in which “the temperature of the kneaded material supplied to the extrusion granulator is 30°C–0°C.” Rather, it means, for example, detecting the temperature of the kneaded material supplied to the granulator and performing the processing necessary to maintain the set temperature range; otherwise, it cannot be said to be “adjusted.” In accordance with this interpretation, the second patented invention was distinguished from prior art in which the temperature might naturally remain at 30–0°C but which disclosed nothing about active temperature adjustment, and it was held that such prior art did not negate the novelty of the second patented invention.

In light of the foregoing history, …“adjusting the temperature of the kneaded material supplied to the extrusion granulator to 30°C–0°C” means, even if it does not necessarily require “providing a means of temperature adjustment,” at least actively adjusting the temperature by some means so as to bring the temperature of the kneaded material supplied to the extrusion granulator to 30–0°C (for example, setting the temperature of the water used during kneading considerably lower). It does not encompass a case where the temperature of the kneaded material naturally remains at 30–0°C because of the working environment….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9779.pdf

Tokyo High Court, 2002 (Ne) 2457 [Method for reusing ready-mixed concrete sludge] <Yamashita>

Original Ameblo publication: 2022-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768798695.html

Tokyo High Court, 2002 (Ne) 2457 [Method for reusing ready-mixed concrete sludge] <Yamashita>

"Even if the defendant's method shares a point with the invention in that it includes cases where … the concentration happens to be 20.2 wt% or less and no adjustment is necessary, …it cannot be said that 'adjustment' is being made…."

⇒ Claim limitation not satisfied

[Claim 1] …A method for reusing ready-mixed concrete sludge, characterized by adjusting … the solids concentration of the ready-mixed concrete sludge to 20.2 wt% or less….

(Excerpts from the judgment)

…"Adjustment" generally means "putting in order, eliminating excesses and deficiencies, and making appropriate" (Kojien, 4th edition), or "① putting in order; ② putting in order to meet a certain standard, eliminating excesses and deficiencies; ③ bringing into a balanced state" (Daijirin). In light of the general meaning of "adjustment" above (particularly putting in order to meet a certain standard), absent special circumstances requiring a contrary interpretation, it is appropriate to construe "adjusting the solids concentration of ready-mixed concrete sludge to 20.2 wt% or less" in Claim Element C as bringing the concentration into conformity with the standard of 20.2 wt% or less: specifically, measuring the solids concentration and, if it exceeds 20.2 wt%, performing an operation to reduce it to 20.2 wt% or less…. Even if the defendant's method shares a point with the invention in that it includes cases where the measured solids concentration happens to be 20.2 wt% or less and no adjustment is necessary, this does not permit a finding that "adjustment" is being made in the defendant's method.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10781.pdf

IP High Court, 2021 (Gyo-Ke) 10059 [Container for microwave-heated food] <Shoji>

Original Ameblo publication: 2022-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768799756.html

IP High Court, 2021 (Gyo-Ke) 10059 [Container for microwave-heated food] <Shoji>

*Determining the size and number of holes to release water vapor appropriately is a matter of design.

“Determining the diameter and number of small holes … and the total opening area … in consideration of the amount of water vapor that may arise from the food inside the container, so as to release water vapor appropriately … is a matter of design.”

[Claim 1] …A container for microwave-heated food … wherein the diameter of the exhaust pores is 0.15–0.59 mm, the number of the exhaust pores is 8–1,000, and the total opening area of the exhaust pores in the exhaust-hole group is 0.25–100 mm²….

(Excerpts from the judgment)

The small holes of the cited invention are formed in “an appropriate number and with an appropriate size of about 0.5–1 mm in diameter, capable of reliably discharging heated air and water vapor from inside the container.” Exhibit Ko 2 contains no specific disclosure concerning this “appropriate” size and number. However, it is obvious to a person skilled in the art that, if the amount of water vapor generated by the contents of the container changes, the size (diameter) and number of the holes that release water vapor must also be changed accordingly to release it appropriately…. Thus, for a person skilled in the art encountering the cited invention, determining the diameter and number of small holes and the total opening area readily calculated from them, in consideration of the amount of water vapor that may arise from the food inside the container, so as to release water vapor appropriately, is merely a matter of design.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90730.pdf

Tokyo District Court, 2017 (Wa) 24942 [Webpage browsing method … apparatus] <Sato>

Original Ameblo publication: 2022-10-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12768973006.html

2017 (Wa) 24942 [Webpage browsing method … apparatus] <Sato>

(Plaintiff's argument)

There are also substantial numbers of cases in which users connect to a distant access point that is easier to reach.

(Judgment)

Even with a dial-up connection, users ordinarily access the access point nearest the location of their terminal.

⇒ Claim limitation satisfied

⇒ More than ¥1 billion awarded!

…However, reversed on appeal: claim limitation not satisfied.

IP High Court, 2021 (Ne) 10022 <Shoji>

Construction of “area corresponding to the access point”

(Appeal) “The location where the access point is installed and a certain surrounding area.”

(First instance) “Means ‘the area corresponding to the extent of installation of the physical network or the like used by the access point assigning the IP address.’”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90338.pdf

[Copyright] Tokyo District Court, 2021 (Wa) 4491 <Sato>

Original Ameblo publication: 2022-10-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769135299.html

[Copyright] Tokyo District Court, 2021 (Wa) 4491 <Sato>

Complaint published on the Internet before being presented at oral argument.

⇒ Damages for emotional distress awarded for infringement of the author's moral right (right to make a work public).

Article 40(1) of the Copyright Act (public statements made in … judicial proceedings … conducted publicly … may be exploited) does not apply by analogy to publication of a complaint before it has been presented.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90530.pdf

Tokyo District Court, 2019 (Wa) 23407 […Suspension … apparatus] <Shibata>

Original Ameblo publication: 2022-10-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769306624.html

2019 (Wa) 23407 […Suspension … apparatus] <Shibata>

Literal construction of “adjustment means”

⇒ Although not recited in the claims, the specification described advance adjustment after recognizing the difference as the principle for solving the problem, and contained no description of a way to solve it by other means.

⇒ Construed narrowly to the scope capable of solving the problem.

The defendant's product is an ordinarily used connecting member and does not make an adjustment.

⇒ Claim limitation not satisfied

(Excerpts from the judgment)

⋯The “adjustment means” (Claim Element C) of the invention is understood to mean a means for changing the length in advance to match the recognized difference at issue as a reference, in order to suspend and stretch the suspended body appropriately, without excess or deficiency. …Even if a suspension apparatus has some configuration for changing length, if it is not recognized as a means for changing the length of the lifting wire or the like in advance to match the difference at issue as a reference, it is not the invention's “adjustment means.” If merely a means for changing length were construed as the adjustment means of the invention, when changing the length of the lifting wire or the like during installation or maintenance of the suspended body, it would be necessary to use some other means to match that difference as a reference. However, the specification and other materials do not establish that such work could be performed entirely from the floor side, and such a configuration cannot solve the problem of the invention. The specification states here that the length of the lifting wire can also be adjusted by providing the lifting wire with an engaging member for the net body, or by providing the net body with an engaging member for the lifting wire (paragraph [0058]). In light of the foregoing, where such an engaging member can be described as a means for changing the length of the lifting wire or the like in advance to match the recognized difference as a reference, it can be described as the invention's “adjustment means,” and the above description can be understood in that sense. Conversely, an engaging member that cannot be described as such a means and has no configuration or function beyond those of an ordinary engaging member is, in light of the foregoing, an engaging member used independently of the invention; it does not produce the effects of the invention's “adjustment means” and is not found to fall within that term.… The wire clip in … the defendant's product … is found to be a connecting member ordinarily used to secure a wire….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90574.pdf

Tokyo District Court, 2019 (Wa) 23164 [Image-forming apparatus] <Tanaka>

Original Ameblo publication: 2022-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769619993.html

2019 (Wa) 23164 [Image-forming apparatus] <Tanaka>

*The child application violated the divisional-application requirements.

⇒ The grandchild application's filing date goes back only to the child application's actual filing date.

=Osaka High Court, 2002 (Ne) 2776

=Tokyo High Court, 2003 (Gyo-Ke) 65

*Additional statements in the specification were the reason for the violation of the divisional requirements.

⇒ The first such case since the Artificial Nipple case (Tokyo High Court, 2002 (Gyo-Ke) 539)!?

(Excerpts from the judgment)

⋯The patent application at issue is a divisional application of Application 3, which is itself a divisional application of Application 2, which in turn is a divisional application of Application 1. Because the defendant argues that Application 2 violates the divisional requirements, this point will be considered.

…Where a divisional application is lawful, its effect relates back to the filing date of the original application (main text of Article 44(2) of the Patent Act), but where it is unlawful, substantive examination is conducted using the date on which the divisional application was filed as the reference date. It is appropriate to interpret the requirements for a divisional application's filing date to relate back to that of the original application as follows: ① the matters described in the divisional application's specification and other documents must be within the scope of the matters described in the original application's specification and other documents as initially filed; and ② they must be within the scope of the matters described in the original application's specification and other documents immediately before division. Where an application is divided during a period when the original application's specification and other documents may be amended, satisfying requirement ① is understood also to satisfy requirement ②. However, Application 2 was not filed … during a period when the specification and other documents of Application 1 could be amended…. Thus, as divisional requirements for Application 2, requirement ② must also be satisfied separately from requirement ①.…

…Comparing the specification and other documents of Application 1 at the time Application 2 was filed as a divisional application—that is, those at the time of the decision to grant Application 1 …—with the specification and other documents of Application 2 (the specification at division of Application 2 …), the latter differs from the specification at grant of Application 1 in that it adds, for example, a description of retaining processing conditions even after power-off through a designation-retention instruction unit and displaying them on the first screen shown on subsequent occasions (paragraph [0100]); a description of reducing the number of magnification settings, a frequently used processing condition, and reducing the number of menu settings by displaying “one higher” and “one lower” to specify magnification (paragraph [0105]); a description of preventing erroneous instructions from casual menu changes by providing a means to lock registered menus against changes (paragraph [0145]); and Figures 7–15 and related descriptions (paragraph [0041] …). Because the specification at division of Application 2 contains matters absent from the specification at grant of Application 1, it cannot be said to be within the scope of the matters described in the latter…. Application 2 therefore fails to satisfy divisional requirement …② and must be said to violate the divisional requirements; Article 44(2) of the Patent Act does not apply to Application 2.

…Accordingly, even if the patent application at issue satisfies the divisional requirements in relation to Application 3, and Application 3 satisfies them in relation to Application 2, Application 2 does not satisfy them in relation to Application 1. The filing date of Application 2 therefore does not relate back to that of Application 1, but is its actual filing date …, and likewise the filing date to which the patent application at issue relates back is the filing date of Application 2….

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e5%af%a9%e6%b1%ba%e5%8f%96%e6%b6%88%e8%ab%8b%e6%b1%82%e4%ba%8b%e4%bb%b6%ef%bc%88%e8%a6%aa%e3%83%bb%e5%ad%90%e3%83%bb%e5%ad%ab%e3%81%a8/

Intellectual property that decision-makers should understand in light of the CGC (Corporate Governance Code)

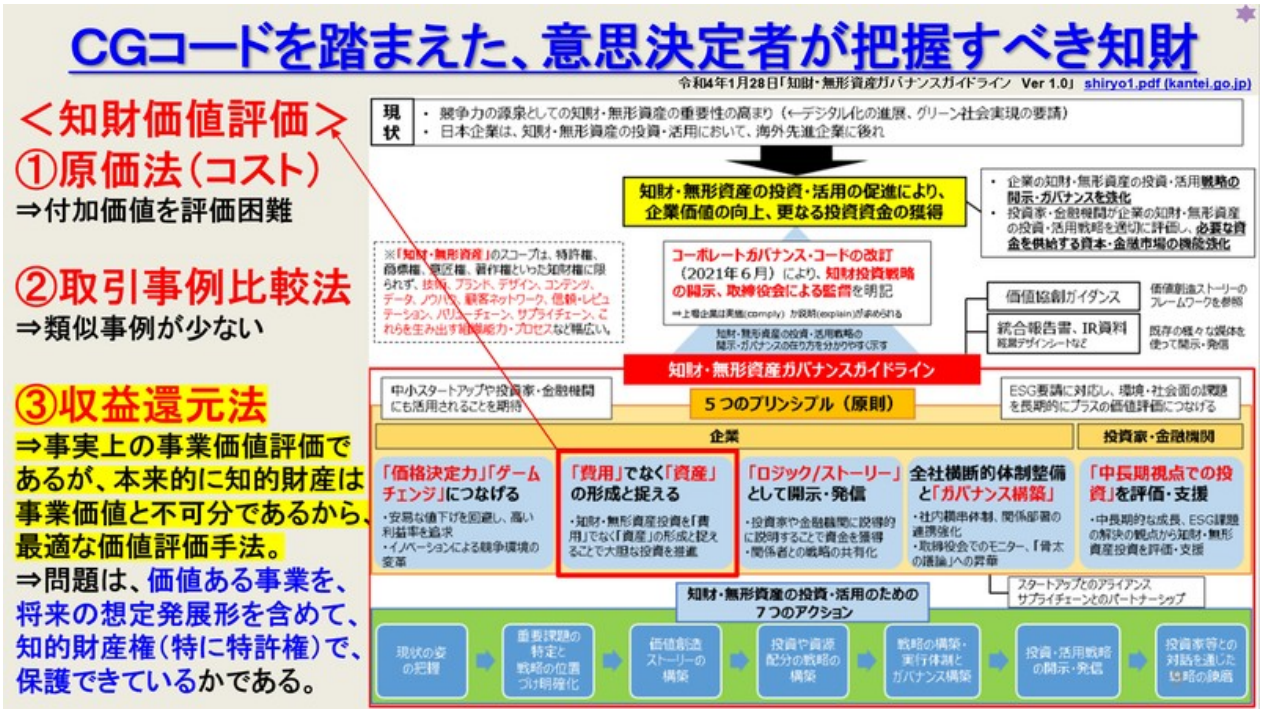
Original Ameblo publication: 2022-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769637481.html

【YouTube #short】 Intellectual property that decision-makers should understand in light of the CGC (Corporate Governance Code)

It is important for management to view investment in intellectual property and intangible assets as the creation of “assets,” not single-year “expenses,” and thereby remain conscious not to make it an easy target for cuts.

https://youtube.com/shorts/_LC19RQjb-A



English translation of the figure

Intellectual property that decision-makers should understand in light of the Corporate Governance Code.

Intellectual property valuation: (1) Cost approach — added value is difficult to evaluate. (2) Comparable-transaction approach — there are few similar cases. (3) Income approach — in substance it evaluates business value; however, because intellectual property is inherently inseparable from business value, it is the optimal valuation method. The question is whether the valuable business, including its anticipated future forms of development, is protected by intellectual property rights (particularly patents).

Current situation: The importance of intellectual property and intangible assets as sources of competitiveness is increasing, driven by progress in digitalization and calls to realize a green society. Japanese companies lag behind leading overseas companies in investment in and use of intellectual property and intangible assets.

Promoting investment in and use of intellectual property and intangible assets → increasing corporate value and obtaining further investment funds.

Strengthen disclosure and governance of companies' strategies for investing in and using intellectual property and intangible assets. Strengthen the functions of capital and financial markets so that investors and financial institutions appropriately evaluate those strategies and provide the necessary funds.

The scope of "intellectual property and intangible assets" is broad: it is not limited to intellectual property rights such as patents, trademarks, design rights and copyright, but also includes technology, brands, designs, content, data, know-how, customer networks, trust and reputation, value chains, supply chains, and the organizational capabilities and processes that create these.

Revision of the Corporate Governance Code (June 2021) expressly requires disclosure of intellectual property investment strategies and supervision by boards of directors. Listed companies are required to comply or explain.

Guidelines on Governance of Intellectual Property and Intangible Assets: clearly show how disclosure and governance should operate for investment in and use of intellectual property and intangible assets. Guidance for Collaborative Value Creation: consult the value-creation-story framework. Integrated reports, investor-relations materials, management-design sheets and other existing media: use various media for disclosure and communication.

Five principles. Companies: (1) Connect investment and use to "pricing power" and "game changing": avoid easy price reductions and pursue high profit margins; transform the competitive environment through innovation. (2) Treat them as formation of "assets," rather than "costs": promote bold investment by treating investment in intellectual property and intangible assets as asset formation. (3) Disclose and communicate as "logic/stories": obtain funds by explaining persuasively to investors and financial institutions; share strategies among stakeholders. (4) Establish cross-company structures and "governance": strengthen cooperation among internal horizontal structures and related departments; have the board monitor, raising the discussion to an "outside" perspective. Investors and financial institutions: (5) Evaluate and support "investment from a medium- to long-term perspective": evaluate and support intellectual property and intangible-asset investment from the standpoint of medium- and long-term growth and resolution of ESG issues.

The guidelines are expected to be used by small and medium-sized enterprises, startups, investors and financial institutions as well. Respond to ESG demands and connect environmental and social issues to positive value creation over the long term. Alliances with startups; partnerships with supply chains.

Seven actions for investment in and use of intellectual property and intangible assets: grasp the current situation → identify important issues and clarify the positioning of the strategy → build a value-creation story → build a strategy for allocating investment and resources → build the strategy, implementation structure and governance → disclose and communicate the investment/use strategy → refine it through dialogue with investors and others.

January 28, 2022, Guidelines on Governance of Intellectual Property and Intangible Assets, Version 1.0. shiryo1.pdf (kantei.go.jp).

[Patents: Case introduction (YouTube)] IP High Court, 2020 (Ne) 10057 <Otaka>

Original Ameblo publication: 2022-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769637718.html

[Patents: Case introduction (YouTube)] IP High Court, 2020 (Ne) 10057 <Otaka>

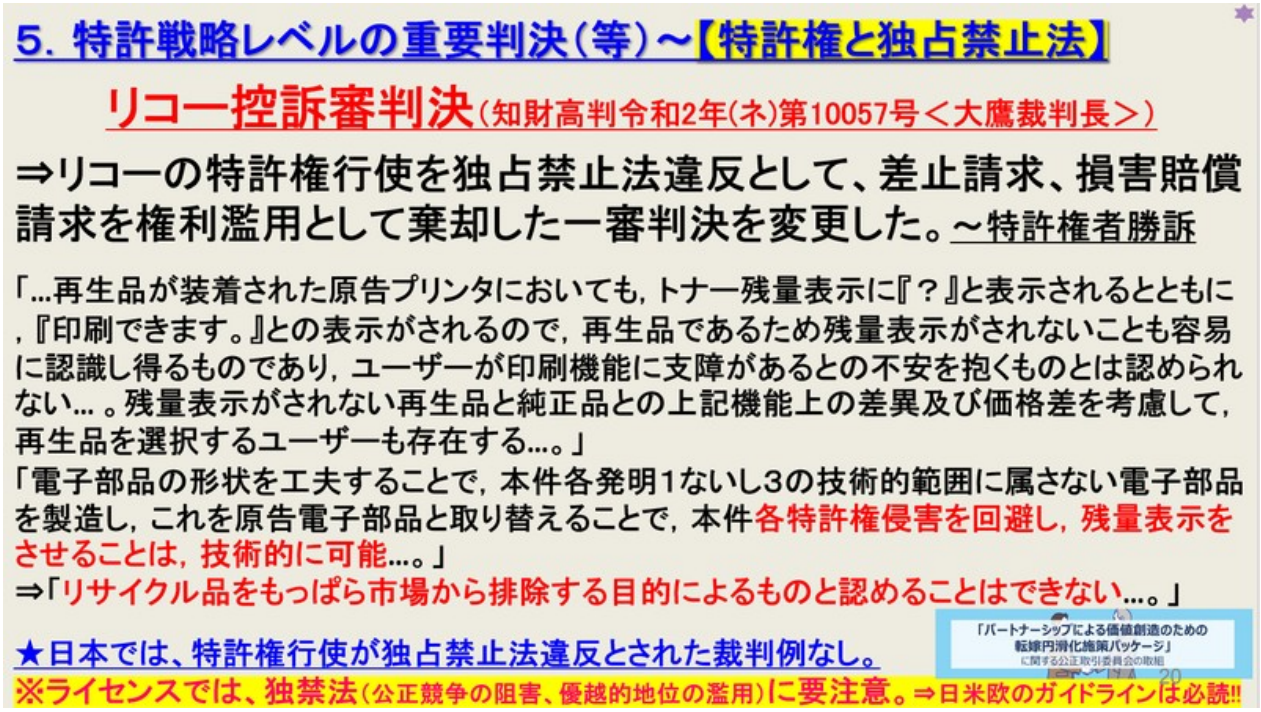
The first-instance judgment holding patent enforcement to be an abuse of rights in violation of the Antimonopoly Act was modified.

⇒ Patentee wins on reversal.

“It is technically possible to display the remaining amount while avoiding infringement of the patents at issue.”

—The purpose was not solely to exclude recycled products from the market.

https://youtube.com/watch?v=IMeI3-Rlbd8



English translation of the figure

5. Important judgments and other matters at the patent-strategy level — patent rights and the Antimonopoly Act. Ricoh appellate judgment: IP High Court, 2020 (Ne) 10057 <Presiding Judge Otaka>.

The appellate court reversed the first-instance judgment, which had treated Ricoh’s exercise of its patent rights as violating the Antimonopoly Act and dismissed the claims for an injunction and damages as an abuse of rights. The patentee prevailed.

“… Even in the plaintiff’s printer fitted with a recycled product, the remaining-toner display shows ‘?’ together with the message ‘Printing is possible.’ It is therefore easy to recognize that the remaining amount is not displayed because the product is recycled, and it cannot be found that the user would feel concern about an impediment to the printing function. … There are also users who select recycled products in consideration of the difference in function and price between recycled products without a remaining-amount display and genuine products. …”

“By devising the shape of the electronic component, manufacturing an electronic component outside the technical scope of Inventions 1 to 3 at issue, and replacing the original electronic component with it, it is technically possible to avoid infringement of the patents at issue and provide a remaining-amount display. …” ⇒ “… The purpose cannot be found to be solely to exclude recycled products from the market. …”

There is no Japanese judgment holding that exercise of a patent right violated the Antimonopoly Act. When granting licenses, attention must be paid to the Antimonopoly Act (obstruction of fair competition and abuse of a superior bargaining position). Read the Japanese, US and European guidelines!!

Guidelines for Promoting Appropriate Transactions to Create Value through Partnership, Cabinet Secretariat and Japan Fair Trade Commission (2022 edition).

[Patent YouTube #short] ① Responding to rejections; ② Utilizing dependent claims (claim differentiation)

Original Ameblo publication: 2022-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769637942.html

[Patent YouTube #short] ① Responding to rejections; ② Utilizing dependent claims (claim differentiation)

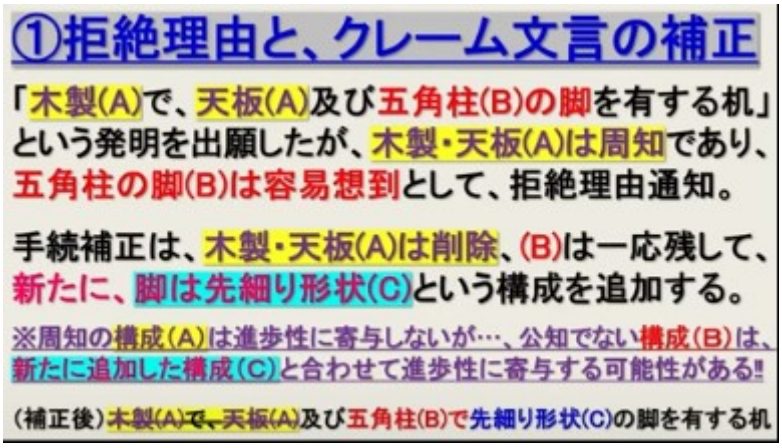
① Responding to rejections

⇒ Delete features that do not contribute to inventive step and broaden the invention while keeping it strong.

② Utilizing dependent claims (claim differentiation)

⇒ If a dependent claim includes the limiting feature, the “problem” can be characterized as the dependent claim's problem, avoiding a restrictive construction of the independent claim!

(30) [Patents] ① Responding to rejections; ② Utilizing dependent claims (claim differentiation); ⑩ Utilizing separate applications #shorts - YouTube



English translation of the figure

1. Grounds for rejection and amendment of claim wording.

An application was filed for an invention of “a desk made of wood (A), having a top board (A) and pentagonal-prism (B) legs,” but a notice of reasons for rejection was issued on the grounds that wood and a top board (A) were well known and pentagonal-prism legs (B) were easily conceivable.

In the amendment, wood and the top board (A) are deleted; (B) is maintained for the time being; and the new feature that the legs have a tapered shape (C) is added.

Although the well-known features (A) do not contribute to inventive step, the publicly known feature (B) may contribute to inventive step in combination with the newly added feature (C)!!

After amendment: a desk [“made of wood (A), having a top board (A)” deleted] having legs that are pentagonal prisms (B) and have a tapered shape (C).

IP High Court, 2021 (Gyo-Ke) 10006 [X-ray inspection apparatus] <Kanno>

Original Ameblo publication: 2022-10-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769802791.html

IP High Court, 2021 (Gyo-Ke) 10006 [X-ray inspection apparatus] <Kanno>

The problems of the primary and secondary references were understood abstractly and found to be the same.

⇒ Obvious

"Cited Invention 1 …, an X-ray detection apparatus inspecting food and the like for foreign matter, and the technical matters of Cited Document 2 …, which performs medical and baggage inspections, are related as technical fields in which X-ray inspection apparatuses are used…."

(Excerpts from the judgment)

The technical matters of Cited Document 2 enable detection of drugs concealed in baggage or the human body, or prohibited articles such as explosives and ivory, by using highly absorbed X-rays specific to a substance. It is therefore not only for the human body, but also an X-ray baggage inspection apparatus that checks for invisible objects in baggage…. Thus, the technical field of Cited Invention 1, an X-ray detection apparatus inspecting food and the like for foreign matter, and the technical field of the technical matters of Cited Document 2, which performs medical and baggage inspections, are related as technical fields in which X-ray inspection apparatuses are used…. …Cited Invention 1 and the technical matters of Cited Document 2 have close relationships and commonality in technical field, problem to be solved, and action and function … there is strong motivation to combine them….

⋯Because Cited Invention 1 is a foreign-matter inspection apparatus that checks workpieces on a conveyor path for metal and other foreign matter, it is an apparatus for a product-manufacturing site. Even if Cited Document 2 directly contemplates use of its technical matters in medical inspection apparatuses, the level of cost to be incurred is not directly linked to technical field. Disregarding the nature of the product, the scale of the manufacturing site, and the product's sales channels, it certainly cannot be said that apparatuses for product-manufacturing sites uniformly need only be low-performance products, or that persons skilled in the art pay no attention to performance improvements and are unconcerned with technologies for medical inspection apparatuses….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90649.pdf

US Patents 2016 CAFC Shaw Industries v. Automated Creel

Original Ameblo publication: 2022-10-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12769973196.html

[US Patents] 2016.03 CAFC

Shaw Industries v. Automated Creel

In its 2016 Shaw decision, the Federal Circuit held that estoppel concerning grounds that were “raised or reasonably could have been raised” did not extend to grounds on which the PTAB had not instituted IPR.

(Note) The approach taken in Shaw in 2016 was overruled by California Institute of Technology v. Broadcom on February 4, 2022. The latter decision held that estoppel also extends to grounds that reasonably could have been included in the petition.

https://t.co/IgzT6nfOus

[US Patents] 2016.06 US Supreme Court Cuozzo Speed v. Lee

Original Ameblo publication: 2022-10-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770138615.html

[US Patents] 2016.06 US Supreme Court Cuozzo Speed v. Lee

Under the rules in force at the time of the 2016 decision, claims in IPR proceedings were construed under the Broadest Reasonable Interpretation (BRI) standard.

Under the claim-construction rules then in force, IPR could be more favorable to the petitioner challenging validity than an invalidity defense in federal district court.

https://www.oliff.com/ja/ipr%E3%81%AB%E3%81%8A%E3%81%91%E3%82%8B%E6%9C%80%E3%82%82%E5%B9%85%E3%81%AE%E5%BA%83%E3%81%84%E7%90%86%E5%B1%88%E3%81%AB%E9%81%A9%E3%81%A3%E3%81%9F%E8%A7%A3%E9%87%88%E3%81%AE%E5%9F%BA%E6%BA%96/

Tokyo District Court, 2020 (Wa) 33027 [Control system for fee-charging automatic machines] <Nakashima>

Original Ameblo publication: 2022-10-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770298882.html

2020 (Wa) 33027 [Control system for fee-charging automatic machines] <Nakashima>

*An amendment generalizing a concept violated the amendment requirements because it was not “obvious” from the original specification and other documents.

⇒ The following permit amendment where the deleted matter specifying the invention is not directly related to the invention's problem:

Examination Handbook, Annex A, section 7 (Amendments Adding New Matter), Example 7;

IP High Court, 2014 (Gyo-Ke) 10087 [Rack transport apparatus] case <Shitara>;

IP High Court, 2017 (Gyo-Ke) 10089, 10090 [Medical flexible container] case <Takabe>.

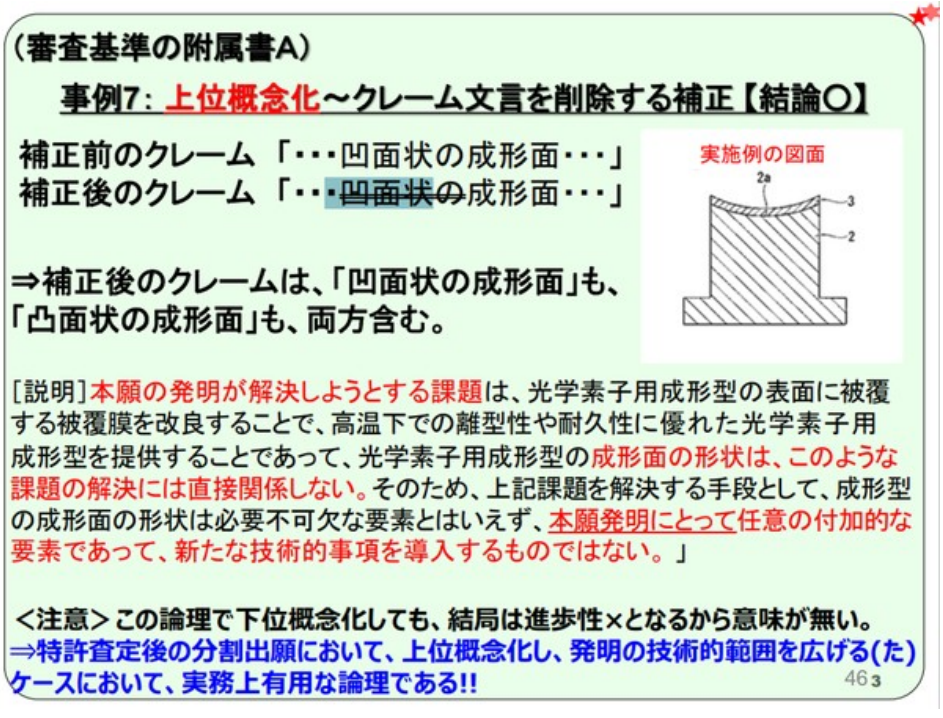
I want to examine that consistency!!

(Excerpts from the judgment)

…The amendment excluded the “sensor detecting operation of the fee-charging automatic machine” from the patented configuration, and changed it to a configuration in which “information indicating whether the connected laundry apparatus is in operation,” generated by an “apparatus having an IC card reader/writer unit and a communication unit,” is transmitted to a management server…. …The original specification and other documents disclose no method whatsoever of determining whether the fee-charging automatic machine is operating, or inferring that result, on the basis of information other than the detection signal of the sensor detecting its operation…. Moreover, it cannot be found that, for a person skilled in the art reading the original specification and other documents, the amended matters were obvious from those documents in light of common general technical knowledge at the time of filing.…

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91267.pdf





English translation of the figure

The “resolution of the invention described in the specification,” taking patentability requirements into account ⇒ divisional-application strategy.

Appendix A to the Examination Handbook. Example 7: generalization — amendment deleting claim wording [conclusion: permitted].

Claim before amendment: “… concave molding surface …”. Claim after amendment: “… [the word ‘concave’ deleted] molding surface …”. ⇒ The amended claim includes both a “concave molding surface” and a “convex molding surface.” Drawing of the embodiment: labels 2a, 1, 3 and 2.

[Explanation] “The problem to be solved by the invention of this application is to improve the coating film covering the surface of an optical-element molding die, thereby providing an optical-element molding die with excellent releasability at high temperatures and durability. The shape of the molding surface of the optical-element molding die is not directly related to solving that problem. Therefore, the shape of the molding surface of the molding die is not an indispensable element as a means of solving the above problem, but an optional additional element for the invention of this application, and it does not introduce a new technical matter.”

Caution: Even if a more specific concept is adopted using this reasoning, the conclusion will be lack of inventive step, so there is little significance. ⇒ In a divisional application after allowance, generalize and expand the technical scope of the invention! Depending on the case, this is very useful reasoning in practice!!

Image of the source booklet: [Appendix A] Case Examples for the Patent and Utility Model Examination Handbook. Slide 46.

Tokyo District Court, 2021 (Wa) 13905 […Use of eribulin] <Shibata>

Original Ameblo publication: 2022-10-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770455037.html

Tokyo District Court, 2021 (Wa) 13905 […Use of eribulin] <Shibata>

*Because the patents exist, Ministry of Health, Labour and Welfare manufacturing approval and drug-price listing are not highly probable.

⇒ A claim for a declaration of the nonexistence of a “future” right to enjoin a generic drug lacks an interest in bringing suit.

*For “current” manufacture (testing and research), there is no infringement and no intention to enforce the rights, so there is no interest in bringing suit.

⇒ Action dismissed as inadmissible

(Excerpts from the judgment)

In this case, it is not found highly probable that the Minister of Health, Labour and Welfare will approve manufacture and sale of the plaintiff's pharmaceutical product or that it will be listed in the drug-price standard in the near future; consequently, it is not found highly probable that the plaintiff will manufacture and sell its pharmaceutical product…. It is by no means certain that a legal dispute will arise in the near future between the plaintiff and the defendants over the nonexistence of defendant Eisai RD's right to seek an injunction against the plaintiff based on the patents at issue, or the defendants' rights to claim tort damages against the plaintiff for infringement of those patents. There is insufficient basis to find a present danger or uncertainty concerning the plaintiff's rights or legal status.

Accordingly, the plaintiff's action against the defendants seeking declarations that, if the plaintiff's pharmaceutical product is listed in the drug-price standard in the future, defendant Eisai RD will have no right to seek an injunction against the plaintiff under the patents at issue and the defendants will have no right to claim tort damages against the plaintiff for infringement of those patents must be said to lack an interest in seeking declaratory relief.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91454.pdf

[Individual Patent Case Introduction (YouTube)] IP High Court, 2020 (Ne) 10004 [Light irradiation] case <Otaka>

Original Ameblo publication: 2022-10-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770530756.html

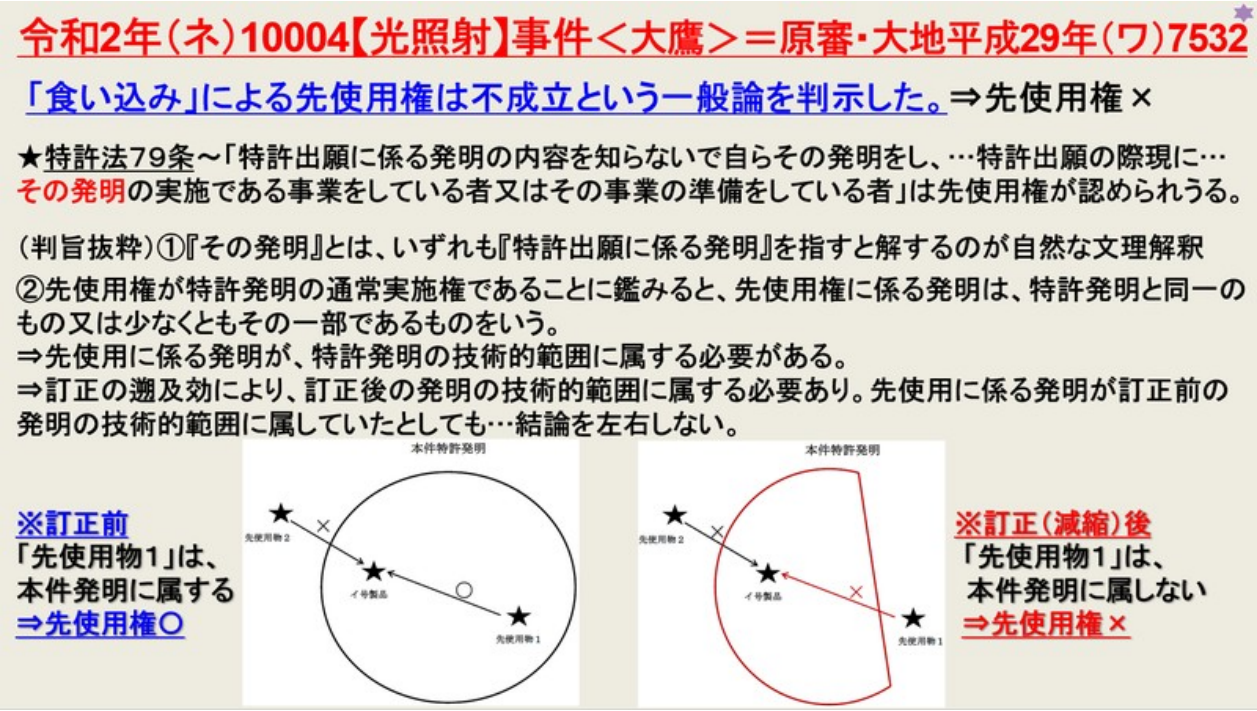
[Individual Patent Case Introduction (YouTube)] IP High Court, 2020 (Ne) 10004 [Light irradiation] case <Otaka>

The court stated the general proposition that a prior-use right is not established through so-called “encroachment.”

=First instance: Osaka District Court, 2017 (Wa) 7532

Because of the retroactive effect of correction, the invention relating to the prior use must fall within the technical scope of the corrected invention.

(14) [Patents] IP High Court, 2020 (Ne) 10004 [Light irradiation] case <Otaka>—The court stated the general proposition that a prior-use right is not established through “encroachment.” - YouTube



English translation of the figure

IP High Court, 2020 (Ne) 10004, “Light Irradiation” <Otaka>; first instance: Osaka District Court, 2017 (Wa) 7532.

A general proposition was stated that a prior-use right cannot arise by “encroachment” ⇒ prior-use right denied.

Patent Act Article 79: A person who, without knowing the content of the invention in the patent application, independently makes an invention … and, at the time of the patent application, … is conducting or preparing a business working that invention is entitled to a prior-use right.

(Excerpts from the judgment) (1) It is natural to interpret “that invention” in each instance as referring to “the invention in the patent application.” (2) In view of the fact that a prior-use right is a non-exclusive

license to the patented invention, the invention relating to prior use means one that is identical to, or at least part of, the patented invention.

⇒ The invention relating to prior use must fall within the technical scope of the patented invention. ⇒ Because correction has retroactive effect, it must fall within the technical scope of the corrected invention. Even if the invention relating to prior use fell within the technical scope before correction, that does not affect the conclusion.

Left, before correction: “Prior-used article 1” falls within the invention at issue ⇒ prior-use right permitted. Right, after correction (narrowing): “Prior-used article 1” does not fall within the invention at issue ⇒ prior-use right denied.

Diagram labels: patented invention at issue; prior-used article 2; accused product; prior-used article 1. Left diagram: × between prior-used article 2 and the accused product; ○ between the accused product and prior-used article 1. Right diagram: × on both of those connections.

2021.08 CAFC Gsk v. Teva Sale of skinny-label generics—Induced infringement found

Original Ameblo publication: 2022-10-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770936134.html

2021.08 CAFC　Glaxosmithkline v. Teva

Induced infringement was found in the sale of a generic pharmaceutical product with a skinny label (a label excluding the patented method).

The product had been marketed as effective for congestive heart failure, physicians knew this, and although congestive heart failure was removed from the label, hypertension and other indications were not.

=Japanese precedent / IP High Court, 2005 (Ne) 10125

2014.03 CAFC Endo v. Actavis Settlement of earlier litigation—Scope of presumed implied license

Original Ameblo publication: 2022-10-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12770936394.html

2014.03 CAFC　Endo Pharmaceuticals v. Actavis

Scope in which an implied license is presumed from settlement of earlier patent-infringement litigation (general proposition)

⇒ An implied license is presumed for continuation patents.

⇒ Merely sharing a provisional application does not give rise to a presumed implied license.

US Designs 2019 CAFC Curver Luxembourg v. Home Expressions

Original Ameblo publication: 2022-10-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771108167.html

[US Designs] 2019.09 CAFC Curver Luxembourg v. Home Expressions

In this case, the title, claim, and figure descriptions of the design patent were amended to refer to a pattern for a chair, limiting the scope of the patent. During prosecution, the title was amended to “Pattern for a Chair” and the claim to “ornamental design for a pattern for a chair.”

⇒ Home Expressions' basket did not infringe.

2015 CAFC INEOS USA v. Berry Plastics Inventions with numerical limitations and novelty

Original Ameblo publication: 2022-10-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771268830.html

2015.04 CAFC INEOS USA v. Berry Plastics (Inventions with numerical limitations and novelty)

① The reference discloses a specific numerical value within the claimed numerical range.

⇒ No novelty.

② Where the reference discloses a numerical range rather than a specific value, it describes the claimed numerical range with sufficient specificity for a reasonable fact finder to conclude that there is no reasonable difference in how the invention operates over the claimed range and the range disclosed in the reference.

⇒ No novelty.

=Japanese precedents: Tokyo High Court, 1994 (Gyo-Ke) 267; Tokyo High Court, 1994 (Gyo-Ke) 30

IP High Court (Grand Panel), 2020 (Ne) No. 10024 [Chair-type massage machine]

Original Ameblo publication: 2022-10-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771444835.html

IP High Court (Grand Panel), 2020 (Ne) No. 10024 [Chair-type massage machine]

With respect to the portion for which the presumption under Article 102(2) of the Patent Act is rebutted:

⇒ Paragraph (3) applies where the patent owner could have granted a license.

Paragraph (3) does not apply to the portion for which the presumption is rebutted on the ground that the patented invention is implemented only in part of the infringing product.

Paragraph (3) applies to the portion for which the presumption is rebutted on the ground that the markets are not identical.

https://www.ip.courts.go.jp/vc-files/ip/2022/2n10024.pdf

An article on “Rights of Publicity” has been uploaded to the Nakamura & Partners website.

Original Ameblo publication: 2022-10-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771513111.html

An article on “Rights of Publicity” has been uploaded to the Nakamura & Partners website.

① Using a portrait or the like itself as a product intended for independent appreciation;

② Affixing a portrait or the like to a product or the like to differentiate it;

③ Using it in advertising for a product or the like—where it can be said that the sole purpose is to exploit the customer-attracting power of the portrait or the like,

⇒ This constitutes infringement of the right of publicity.

(Supreme Court, 2009 (Ju) No. 2056, “Pink Lady” case)

https://www.nakapat.gr.jp/ja/practices-details/right-of-publicity/

2014.06 US Supreme Court Nautilus v. Biosig

Original Ameblo publication: 2022-10-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771582717.html

2014.06 US Supreme Court Nautilus v. Biosig

The standard for the definiteness requirement was changed from the previous “insolubly ambiguous” standard to the “reasonable certainty” standard (a claim is indefinite where “a person skilled in the art, even considering the specification and prosecution history, cannot understand the scope of the invention with reasonable certainty”).

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/Nautilus-v-Biosig.pdf

Section 252 of the US Patent Act—Effect of reissue (intervening rights)

Original Ameblo publication: 2022-10-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12771831428.html

(Section 252 of the US Patent Act)—Effect of reissue (intervening rights)

⇒ If the reissued patent claims are substantially identical to the original patent claims, no intervening rights arise, and damages may also be claimed for infringing acts committed before reissue.

(Yoshinari Kishimoto, “US Patent Litigation as an Intellectual Property Strategy,” p. 159)

2022.01 CAFC Evolusion v. Juggernaut

Original Ameblo publication: 2022-10-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772074984.html

2022.01 CAFC Evolusion v. Juggernaut

Where the same claim language is used in another claim, it is construed to have a consistent meaning unless that language clearly has a different meaning in the other claim.

Even if an embodiment includes a particular limiting element, the claim language is not thereby limited in that way.

<WIPO Japan Office Webinars> Past videos and materials have been uploaded.

Original Ameblo publication: 2022-11-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772245653.html

<WIPO Japan Office Webinars> Past videos and materials have been uploaded.

Videos and materials are provided on numerous topics concerning foreign patents, trademarks, designs, and more, and they are extremely useful!!

I first read all the materials.

I am now watching the videos on topics that particularly interest me.

WIPO Japan Office P26

“Anti-Counterfeiting Measures Using Japan Customs”

*Prior consultation is important when using customs!!

⇒ A lawyer who is a colleague of mine at Nakamura & Partners has personal connections with customs offices throughout Japan and is in a position to conduct prior consultations smoothly. Moreover, the lawyer makes effective use of the local police.

https://www.wipo.int/about-wipo/ja/offices/japan/webinars_in_japanese.html

https://www.wipo.int/edocs/mdocs/mdocs/ja/wipo_webinar_wjo_2021_26/wipo_webinar_wjo_2021_26_presentation.pdf

[US Designs] 2021.10 CAFC In re SurgiSil, L.L.P., Peter Raphael, Scott Harris

Original Ameblo publication: 2022-11-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772245878.html

[US Designs] 2021.10 CAFC In re SurgiSil, L.L.P., Peter Raphael, Scott Harris

In assessing anticipation of a U.S. design patent, the claimed design is limited to the lip implant identified in the claim and depicted in the drawings. A prior-art design for an art tool therefore does not anticipate the claimed lip implant merely because the shapes are similar.

*Under Japan's Design Act as well, the “article” affects novelty.

https://www.patest.co.jp/in-re-surgisil-llp-peter-raphael-scott-harris-%E4%BA%8B%E4%BB%B6/

Tokyo High Court, 1997 (Gyo-Ke) 87 [False-twist processing method] case <Ito>

Original Ameblo publication: 2022-11-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772413896.html

Tokyo High Court, 1997 (Gyo-Ke) 87 [False-twist processing method] case <Ito>

*A decision denying inventive step by reversing the primary and secondary references violates the binding effect of the judgment.

"Although it differs from the previous decision at issue in using Reference 1 as the primary reference, it is unlawful as contrary to the binding effect of the previous judgment at issue (Article 33(1) of the Administrative Case Litigation Act)."

Cf. Opposite to the IP High Court decision in 2012 (Gyo-Ke) 10328!!

(Excerpts from the judgment)

The previous judgment rescinded the previous decision at issue on the ground that a person skilled in the art could not be said to have readily conceived the claimed invention from Reference 2 and Reference 1, and that judgment became final and binding. As a result of its binding effect, the trial examiners making the present decision are not permitted to find and determine that, before the patent application, a person skilled in the art could have readily conceived the claimed invention from the same references used in the previous decision. This principle applies equally even if the reasons for the present decision, unlike the previous decision, use Reference 1 as the primary reference.…

Where there are two references, Reference A and Reference B, whether to use A or B as the primary reference is merely a question of the method of analysis when determining whether an invention involves an inventive step in relation to References A and B….

Accordingly, the finding and determination in the present decision that the claimed invention could have been readily conceived on the basis of References 1 and 2 uses the same references as the previous decision. Although it differs from the previous decision in using Reference 1 as the primary reference, it must be described as unlawful because it violates the binding effect of the previous judgment (Article 33(1) of the Administrative Case Litigation Act), and that illegality affects the conclusion of the present decision….

https://www.itohpat.co.jp/ip/385/

IP High Court, 2012 (Gyo-Ke) 10328 <Shibata> [Odor-neutralizing and liquid-absorbing waste bag]

Original Ameblo publication: 2022-11-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772743586.html

IP High Court, 2012 (Gyo-Ke) 10328 <Shibata> [Odor-neutralizing and liquid-absorbing waste bag]

* In this case, the decision denying inventive step based on an interchange of the primary and secondary references was held not to violate the binding effect of the prior judgment.

"Because the decision, by changing the primary reference, is found to address a different subject of determination from the prior judgment, it cannot be said to violate the binding effect … of the prior judgment."

Cf. Opposite to the Tokyo High Court decision in 1997 (Gyo-Ke) 87

⇒ Although it did not violate the binding effect of the prior judgment, the decision was rescinded for an error in the obviousness determination concerning the differences.

(Excerpts from the judgment)

…The decision at issue … used as its primary reference the document presented in the first decision as Well-Known Example 2 relating to Difference 1, identified the presence or absence of an odor-neutralizing composition as the difference, and determined, principally from the matters described in Reference 2 (Well-Known Example 6 in the first decision), that the configuration relating to that difference would have been obvious. Accordingly, by changing the primary reference, the present decision is found to address a different subject of determination from the prior judgment, and cannot be said to violate its binding effect (Article 33(1) of the Administrative Case Litigation Act).

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E3%80%8C%E5%B0%8E%E9%9B%BB%E6%80%A7%E6%9D%90%E6%96%99%E3%81%AE%E8%A3%BD%E9%80%A0%E6%96%B9%E6%B3%95%E3%80%8D%E4%BA%8B%E4%BB%B6%EF%BC%8D%E2%91%A0/

Osaka District Court, 2019 (Wa) 9113 [Information communication unit] <Sugiura>

Original Ameblo publication: 2022-11-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12772743768.html

Osaka District Court, 2019 (Wa) 9113 [Information communication unit] <Sugiura>

<Damages>

Consumption tax included

Foreign-exchange gains included

Concurrent application of paragraphs (2) and (3) does not apply to a deduction for competing products.

“The only … circumstance rebutting the presumption … under paragraph (2) … is competing products … not directly related to the sales performance of the defendant's products … there is no basis for applying paragraph (3).”

⇒ The appellate judgment in the IP High Court case 2021 (Ne) 10088 and other cases likewise held that paragraphs (2) and (3) do not apply concurrently to deductions for competing products.

(Excerpts from the judgment)

…Foreign-exchange gains are understood to arise in connection with settlement in foreign currency of purchases of each of the defendant's products. Accordingly, when calculating the amount of profit the defendant obtained from sales of those products, the calculated foreign-exchange gains against the exchange rate at the time of the import contract, arising from foreign-currency settlement of purchases during a certain period, should be assessed as part of cost together with the purchase price of each product, and should appropriately be included in calculating the defendant's profits.

With respect to concurrent application of Article 102(2) and (3) of the Patent Act, …the only circumstance to be considered as rebutting the presumption of the amount of damages under paragraph (2) is the existence of competing products. For the portion rebutted on the basis of such a circumstance, which is not directly related to the defendant's sales performance of each accused product, there is no basis for applying paragraph (3).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90650.pdf

2004.8.16 US CAFC Fisher-Price v. Safety 1st, Inc

Original Ameblo publication: 2022-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773008092.html

2004.8.16 US CAFC Fisher-Price v. Safety 1st, Inc.

The original claim included the limitation “secured to the rear surface of the seat,” but it was deleted during examination.

⇒ Being “secured to the rear surface of the seat” was not an essential requirement of the invention, and there was no proof that a person skilled in the art could not recognize the invention. Written description requirement satisfied.

(IP Management, Vol. 56, No. 8, 2006)

IP High Court, 2021 (Gyo-Ke) 10082 [Electrically insulating cable] <Shoji>

Original Ameblo publication: 2022-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773008246.html

IP High Court, 2021 (Gyo-Ke) 10082 [Electrically insulating cable] <Shoji>

No motivation to combine the secondary reference to solve a problem already solved by the cited invention.

=IP High Court, 2007 (Gyo-Ke) 10238 […Concrete block]

=IP High Court, 2012 (Gyo-Ke) 10328 […Waste bag]

=IP High Court, 2016 (Gyo-Ke) 10103 [Wire grip]

=IP High Court, 2017 (Gyo-Ke) 10013 [Method for manufacturing dried noodles], etc.

091207_hanrei.pdf (courts.go.jp)

[Copyright] Osaka District Court, 2020 (Wa) 9992 Copyrightability of the clock's “original artwork” was denied.

Original Ameblo publication: 2022-11-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773257780.html

[Copyright] Osaka District Court, 2020 (Wa) 9992

Copyrightability of the clock's “original artwork” was denied.

“The original artwork at issue was created for practical use and constitutes so-called applied art.”

⇒ No portion could be identified as having aesthetic qualities making it an object of aesthetic appreciation separately from the configurations necessary for the clock's practical purpose.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90473.pdf

[Patents] Support requirement: Polarizing Film Grand Panel judgment—On “parameter inventions”

Original Ameblo publication: 2022-11-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773338703.html

[Patents] Support requirement

Polarizing Film Grand Panel judgment—On “parameter inventions”: It must be possible to understand “the technical meaning of the relationship between the range indicated by the formula and the resulting effect (performance).”

⇒ Technical meaning is required of the parameter, but if that is how “parameter invention” is defined, is this a tautology!?

https://www.youtube.com/watch?v=jTjDl9d8dFI

[Designs] Tokyo District Court, 2018 (Wa) 38585 and other cases (Status as creator of the design ⇒ denied)

Original Ameblo publication: 2022-11-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773425067.html

[Designs] 2018 (Wa) 38585 and other cases (Status as creator of the design ⇒ denied)

"It is appropriate to find that the shape of the hinge designed by the plaintiff is … indispensable … to give the lid the functions described above. Accordingly, the shape of the hinge portion of the denture container designed by the plaintiff … is not protected as a design…."

https://kanz.jp/hanrei/detail/90605/

IP High Court, 2021 (Ne) 10091 […Fracture fixation system] <Honda>

Original Ameblo publication: 2022-11-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773601574.html

Tokyo District Court, 2019 (Wa) 14314 […Fracture fixation system] <Shibata>

"The plaintiff is … a corporation managing part of the group's intellectual property rights … and there is insufficient evidence to find that it sells any products or the like beyond that management, and it does not sell products competing with the defendant's products 1–3.… Article 102(2) of the Patent Act cannot be applied."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90844.pdf

⇒ The appellate judgment in the IP High Court case 2021 (Ne) 10091 <Honda> reached the opposite conclusion!

IP High Court, 2021 (Ne) 10091 […Fracture fixation system] <Honda>

*Article 102(2) applies to a corporation managing a group's intellectual property.

⇒ Opposite to the first-instance judgment

"The first-instance plaintiff … is in a position to exercise rights independently in managing and enforcing the patent at issue for the group…."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91183.pdf

IP High Court, 2016 (Gyo-Ke) 10118 [High-efficiency propeller] <Shimizu> “Publication” under Article 29(1)(iii)

Original Ameblo publication: 2022-11-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12773925979.html

IP High Court, 2016 (Gyo-Ke) 10118 [High-efficiency propeller] <Shimizu>

“Publication” under Article 29(1)(iii)

*For an “invention described in a publication” under Article 29(1)(iii) of the Patent Act, it is sufficient that the invention is described to an extent that allows a person skilled in the art to recognize and implement it without special thought.

(Excerpts from the judgment)

…The plaintiff argues that, because the Figure 1 invention is merely a conventional example, the cited invention should be identified as the invention in Figure 3 and other figures.… The expression “an invention described in a publication distributed in Japan or a foreign country before the filing of the patent application” in Article 29(1) …(iii) of the Patent Act is understood to require only a description sufficient for a person skilled in the art encountering the distributed publication to recognize and implement the invention without special thought. Thus, where the publication is a published patent application, not only the patented invention that is the subject of the publication but also prior art described in that publication as a technical idea constitutes an “invention described in a publication” under that item if it is described sufficiently to permit recognition and implementation of the technology…. …The fact that the invention is described as “background art” in the cited document does not prevent the above finding.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86418.pdf

“The Essence of Trademark Similarity in Supreme Court Precedents” (former judge Mitsuru Shishido): Introduces 11 Supreme Court trademark judgments

Original Ameblo publication: 2022-11-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774169970.html

[Article / Trademarks] “The Essence of Trademark Similarity in Supreme Court Precedents” (former judge Mitsuru Shishido)

A useful article concisely introducing 11 Supreme Court judgments concerning trademarks!!

<Similarity>

Coca-Cola

Janome

Singer

Mimasu

Lila Takarazuka

Shozan

Hodogaya Chemical

Daishinrin

<Composite trademarks>

Seiko Eye

Kozo Sushi

Tsutsumi no Ohinakkoya

https://system.jpaa.or.jp/patent/viewPdf/2911

[Patents] Addition of new matter (parent, child, and grandchild applications)

Original Ameblo publication: 2022-11-12

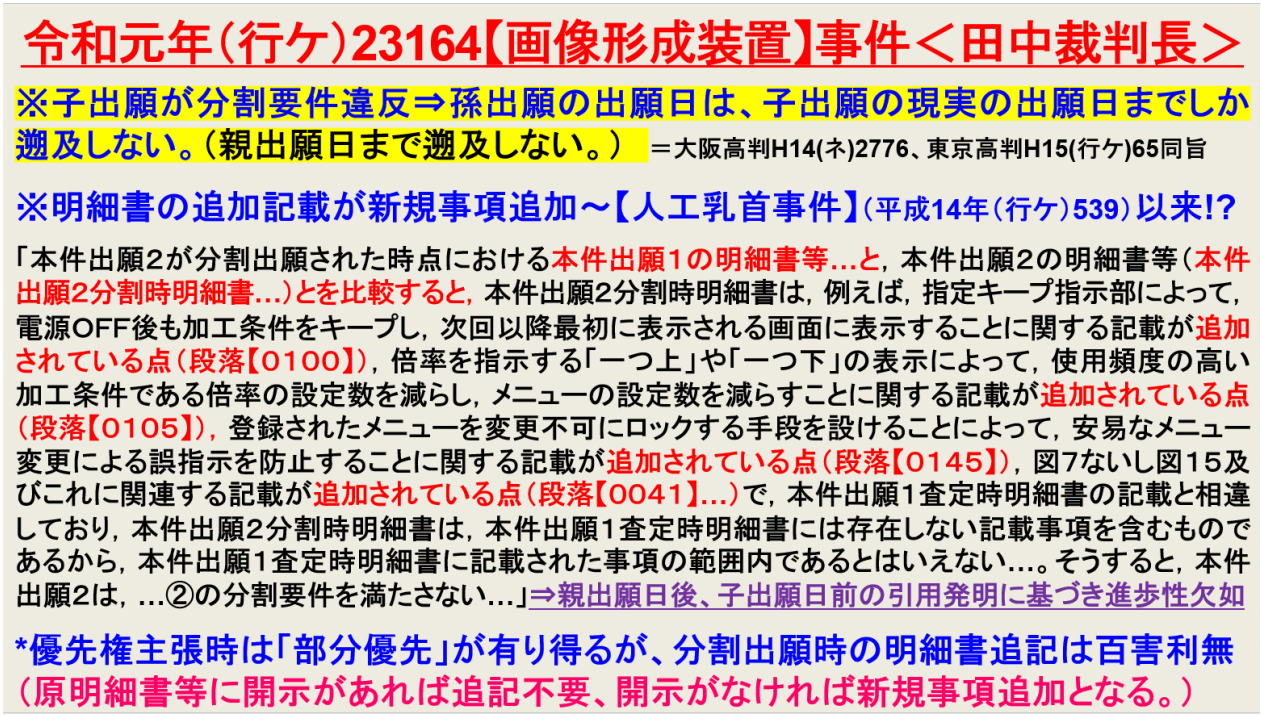
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774170283.html

[Patents] Addition of new matter (parent, child, and grandchild applications)

If an amendment adds new matter to a child application, the retroactive effect of the amendment causes the child application to violate the divisional requirements.

⇒ “Partial priority” may be available when claiming priority, but adding text to the specification when filing a divisional application does nothing but harm. (If disclosed in the original specification and other documents, the addition is unnecessary; if not disclosed, it adds new matter.)

https://www.youtube.com/watch?v=jTjDl9d8dFI



English translation of the figure

Tokyo District Court, 2019 (Wa) 23164, “Image Forming Apparatus” <Presiding Judge Tanaka>.

If the child application violates the requirements for a divisional application, the filing date of the grandchild application goes back only to the actual filing date of the child application, not to the filing date of the parent application. Osaka High Court, 2002 (Ne) 2776, and Tokyo High Court, 2003 (Gyo-Ke) 65, are to the same effect.

Addition to the specification constitutes addition of new matter — since the “Artificial Nipple” case (2002 (Gyo-Ke) 539)!?

“Comparing the specification and other documents of Application 1 at issue … at the time Application 2 at issue was filed as a divisional application with the specification and other documents of Application 2 at issue (the specification of Application 2 at the time of division …), the latter differs from the specification of Application 1 at the time of the decision in that, for example: it adds a description concerning retention of processing conditions even after the power is switched off by means of a designated-keep instruction unit and displaying them on the screen first displayed on the next and subsequent occasions (paragraph [0100]);

it adds a description concerning reduction in the number of magnification settings, which are frequently used processing conditions, and in the number of menu settings by means of ‘one above’ or ‘one below’ instructions indicating magnification (paragraph [0105]); it adds a description concerning prevention of erroneous instructions resulting from easy changes to the menu by providing means for locking registered menus so that they cannot be changed (paragraph [0145]); and it adds Figures 7 to 15 and associated descriptions (paragraph [0041] …). Because the specification of Application 2 at the time of division includes matters not present in the specification of Application 1 at the time of the decision, it cannot be said to fall within the scope of the matters described in the latter. … Accordingly, Application 2 at issue does not satisfy divisional requirement (2). …” ⇒ Lack of novelty based on a cited invention that became public after the filing date of the parent application and before the filing date of the child application.

Although “partial priority” may be possible when claiming priority, additions to the specification when filing a divisional application bring harm and no benefit. If disclosed in the original specification and other documents, addition is unnecessary; if not disclosed, it constitutes addition of new matter.

(Note) The figure gives the case number as “2019 (Gyo-Ke) 23164” and the conclusion as “lack of inventive step.” The correct case number is 2019 (Wa) 23164, and the court found lack of novelty under Article 29(1)(iii) of the Patent Act (judgment, p. 32, lines 5–7).

Osaka District Court, 2020 (Wa) 3474 [Lighting fixture] <Tani>

Original Ameblo publication: 2022-11-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774170415.html

Osaka District Court, 2020 (Wa) 3474 [Lighting fixture] <Tani>

When the plaintiff learned of the respective accused products and suspected, from their appearance, infringement of the patent at issue, it could readily have examined their structures and other details.

⇒ At that point, it knew of the damage and the person causing it to a degree enabling it to claim damages.

⇒ The limitation period began to run.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90665.pdf

[Article] “Practice of Patent Licensing Agreements” (Professor Masayasu Ishida)

Original Ameblo publication: 2022-11-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774431585.html

[Article] “Practice of Patent Licensing Agreements” (Professor Masayasu Ishida)

Examines related issues and is useful in practice!

Intellectual property issues concerning the results of joint research and development

Warranty issues in licensing agreements

Treatment of a licensee's improvements

Points for licensors to bear in mind in licensing agreements

Utilization of intellectual property and legal risk management

https://system.jpaa.or.jp/patent/viewPdf/2818

Tokyo District Court, 2014 (Wa) 17797 [Compression-bonded herbaceous material] <Okinaka> Substantial quantities outside the numerical range ⇛ Claim limitation not satisfied

Original Ameblo publication: 2022-11-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774588127.html

Tokyo District Court, 2014 (Wa) 17797 [Compression-bonded herbaceous material] <Okinaka>

*There is a numerical limitation requiring bulk specific gravity to be adjusted to the range of 0.15–0.25 or less, while the specification contains no statement permitting values outside that numerical range.

⇒ Adjustment must be made consistently within the above range.

⇒ If substantial quantities fall outside the numerical range, the limitation is not satisfied.

[Claim 1] …A loosened material obtained by … bonding pulverized lignin-rich herbaceous material whose bulk specific gravity has been adjusted to 0.15–0.25 or less to form a compression-bonded material, and then loosening the compression bond.

(Excerpts from the judgment)

⋯There is a numerical limitation requiring the bulk specific gravity of the pulverized herbaceous material to be adjusted to a range of 0.15–0.25 or less, but no statement is found indicating that the bulk specific gravity of some portion of the pulverized herbaceous material may fall outside that range. Accordingly, for the defendant's product to satisfy Claim Element B, it must at least be the case that the bulk specific gravity of the pulverized material in the defendant's product is adjusted consistently within that range. If the bulk specific gravity is unstable and substantial quantities of the pulverized material fall outside that range, it cannot be said that its bulk specific gravity has been adjusted to that range, and Claim Element B cannot be found satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85655.pdf

IP High Court, 2021 (Gyo-Ke) 10111 [Laser processing apparatus] <Kanno> Correction to a negative limitation ⇒ Inventive step satisfied

Original Ameblo publication: 2022-11-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774757781.html

IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno>

The absence of grooves was discerned from the specification's drawings, and correction to a negative limitation was allowed. Because grooves are essential to the cited invention, there is a teaching away.

⇒ Inventive step affirmed.

My impression is that amendments adding negative limitations to avoid Article 29-2 (conflict with an earlier-filed, later-published application) are often passed over as not introducing new technical matter.

On the other hand, my impression is that amendments adding negative limitations to overcome inventive-step objections receive a thorough examination of the disclosure in the specification.

⇒ Both should be issues of added new matter under the “Solder Resist IP High Court Grand Panel judgment,” but I sense a difference.

⇒ The Japanese Examination Guidelines, US MPEP, and the Guidelines for Examination in the EPO also distinguish between them. …But there appears to be no legal basis for this distinction.

(Excerpts from the judgment)

<Addition of new matter>

Correction 1 merely excludes from the invention of claim 1 before correction the conceptually encompassed “silicon wafer in which a groove along said planned cutting line is formed in the silicon single-crystal structure portion,” or a groove-essential apparatus. Thus, Correction 1, whose purpose is to narrow the scope of the claims, does not add a new technical matter to the “laser processing apparatus” of the invention of claim 1. Even in light of the description, ... Figures 1 and 3 are plan views depicting planned cutting lines on workpiece 1, while neither Figure 2, a cross-sectional view along line II–II in Figure 1, nor Figure 4, a cross-sectional view along line IV–IV in Figure 3, shows a groove being formed. ... In Figures 1 through 4, “planned cutting lines” are depicted but “grooves” are not. If the invention before correction presupposed the presence of “grooves,” it would be unnatural to depict “planned cutting lines” yet deliberately omit “grooves.”

<Inventive step>

It is inconceivable that a person skilled in the art encountering Exhibit Ko 11 would disregard, from substrate 201, groove 203, which provides the internal stress used to cut the semiconductor wafer. Not only is there no motivation to adopt, as the object to be processed, a substrate 201 without grooves along the break lines and modify it to form a processing-modified portion inside substrate 201 whose surface has no grooves, but rather there is a teaching away from such a modification….

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e6%98%8e%e7%b4%b0%e6%9b%b8%e4%b8%ad%e3%81%ae%e5%9b%b3%e9%9d%a2%e3%81%8b%e3%82%89%e6%ba%9d%e3%81%ae%e4%b8%8d%e5%ad%98%e5%9c%a8%e3%82%92%e7%9c%8b/

Tokyo District Court, 2019 (Wa) 33246 [(Sequel) case] <Kokubu> ⇛ Pursuing the earlier infringement action was not a tort.

Original Ameblo publication: 2022-11-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12774916332.html

Tokyo District Court, 2019 (Wa) 33246 [(Sequel) case] <Kokubu>

It is not unnatural that the party may not have recognized the existence of a “gap” in its own past products.

⇒ Pursuing the earlier infringement action was not a tort.

<Earlier action>

Tokyo District Court, 2017 (Wa) 17791 (=IP High Court, 2018 (Ne) 10088)

⇒ Public working through its own past products

“…After the heat-staking horn of the heat-staking machine is lowered and crushes the heat-staking protrusion from above, when the horn reverses and rises, the heat-staking protrusion springs back slightly due to stress, which is thought to create a gap in the direction of the shaft's rotational axis (Exhibit Otsu 13). In the plaintiff's water-flow experiment, although No-Gap 1 through No-Gap 5 were manufactured to have as little gap as possible, gaps as described above arose. This can be said to show that creation of a gap in the direction of the shaft's rotational axis is unavoidable during heat staking with the plaintiff's heat-staking machine.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91228.pdf

My posts were mentioned in “Sotoku Diary.”

Original Ameblo publication: 2022-11-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775073927.html

My posts were mentioned in “Sotoku Diary.”

“[Claim 1] A product having Configuration A (which may or may not produce Effect X).

[Claim 2] A product having Configuration A and producing Effect X.

Whereas Claim 1 includes both ‘products producing Effect X’ and ‘products not producing Effect X,’ Claim 2 excludes ‘products not producing Effect X.’ Since Claim 2 therefore does not require support for ‘products not producing Effect X,’ can it be said that the support requirement is easier to satisfy for Claim 2 than for Claim 1?”

My view is as follows.

The support requirement depends on the problem addressed by the invention.

⇒ If the invention's problem is to provide A (a new substance), the ease of satisfying the support requirement is considered the same for Claims 1 and 2.

However, if the invention's problem is Effect X, I consider the support requirement easier to satisfy for Claim 2 than for Claim 1, at least comparatively.

⇒ Taking into account that the invention's problem itself may become an issue in litigation, I consider Claim 2 useful in practice.

https://thinkpat.seesaa.net/article/493159174.html

IP High Court, 2020 (Ne) 10004 <Otaka> [Light irradiation apparatus] =Osaka District Court, 2017 (Wa) 7532 <Sugiura>

Original Ameblo publication: 2022-11-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775074275.html

IP High Court, 2020 (Ne) 10004 <Otaka> [Light irradiation apparatus]

The product lineup (2004– Comprehensive LED Lighting Catalog), including publicly worked products, was used as a reason to reject obviousness. A prior-use right through “encroachment” was not established.

⇒ A prior-use right is not established where the prior-use invention falls outside the scope of the post-correction invention, even if it fell within the scope of the pre-correction invention.

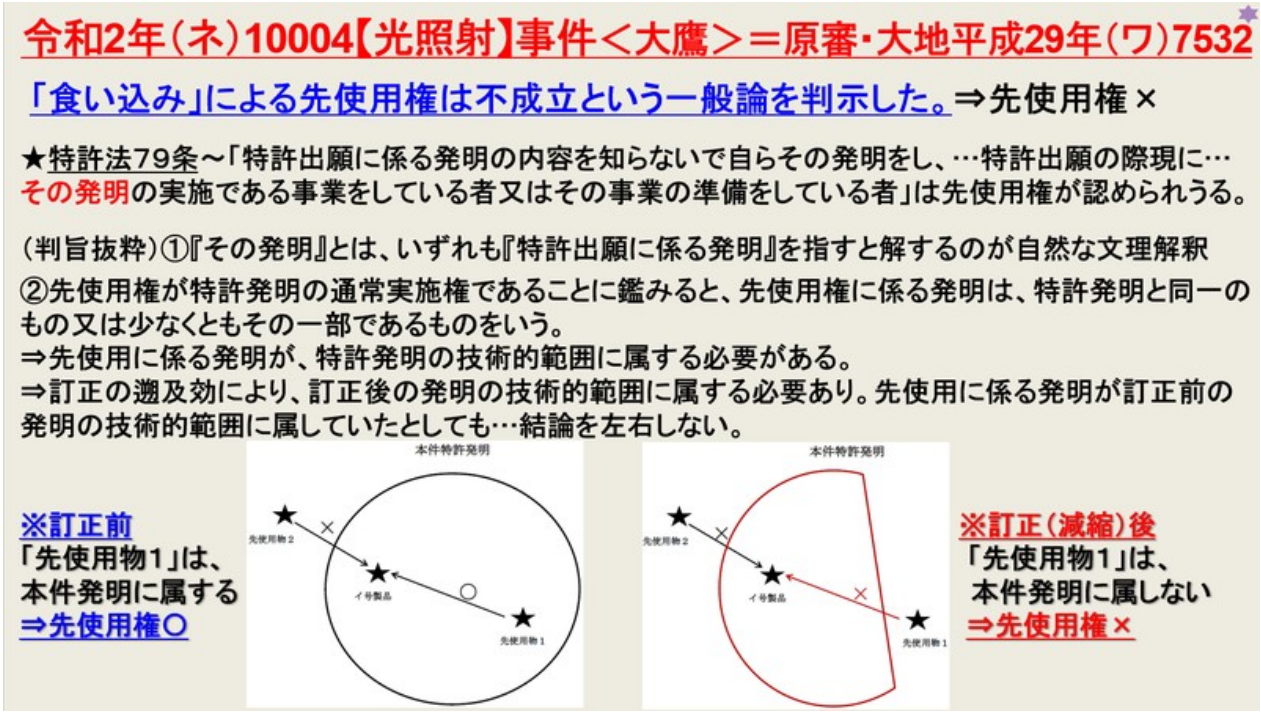
=Osaka District Court, 2017 (Wa) 7532 <Sugiura>

*Inventive step was found even using the publicly worked invention = prior-use invention as a reference.

(Excerpts from the judgment)

As an exception to the first-to-file principle (Article 39(1)), the Patent Act recognizes a statutory non-exclusive license based on prior use (prior-use right) where the requirements of Article 79 are met. The person entitled to a prior-use right is defined as “a person who, without knowing the contents of the invention pertaining to a patent application, independently made that invention … and, at the time of filing the patent application, is actually engaged in business implementing that invention in Japan or preparing for such business.” The natural textual interpretation is that “that invention” in each instance refers to “the invention pertaining to the patent application.” In addition, given that a prior-use right is, as stated above, a non-exclusive license of the patented invention, the invention covered by the prior-use right is understood to mean one identical to the patented invention or at least a part of it. Accordingly, establishment of a prior-use right requires the prior-use invention to fall within the technical scope of the patented invention.… Once the decision concerning the re-correction at issue became final and binding, the patent application, registration of the patent right, and other acts concerning the patent are deemed to have been made on the basis of the claims after that re-correction (Article 128 of the Patent Act). …Even if the invention fell within the technical scope of the corrected invention at issue …, this does not alter the conclusion. Furthermore, even with this interpretation, correction means that the patentee's rights are recognized only within the technical scope of the patented invention based on the post-correction claims. This interpretation therefore cannot be said to conflict with the purpose of the prior-use-right system, which seeks fairness between the patentee and a person who had previously worked the patented invention.

089805_hanrei.pdf (courts.go.jp)



English translation of the figure

IP High Court, 2020 (Ne) 10004, “Light Irradiation” <Otaka>; first instance: Osaka District Court, 2017 (Wa) 7532.

A general proposition was stated that a prior-use right cannot arise by “encroachment” ⇒ prior-use right denied.

Patent Act Article 79: A person who, without knowing the content of the invention in the patent application, independently makes an invention … and, at the time of the patent application, … is conducting or preparing a business working that invention is entitled to a prior-use right.

(Excerpts from the judgment) (1) It is natural to interpret “that invention” in each instance as referring to “the invention in the patent application.” (2) In view of the fact that a prior-use right is a non-exclusive license to the patented invention, the invention relating to prior use means one that is identical to, or at least part of, the patented invention.

⇒ The invention relating to prior use must fall within the technical scope of the patented invention. ⇒ Because correction has retroactive effect, it must fall within the technical scope of the corrected invention. Even if the invention relating to prior use fell within the technical scope before correction, that does not affect the conclusion.

Left, before correction: “Prior-used article 1” falls within the invention at issue ⇒ prior-use right permitted. Right, after correction (narrowing): “Prior-used article 1” does not fall within the invention at issue ⇒ prior-use right denied.

Diagram labels: patented invention at issue; prior-used article 2; accused product; prior-used article 1. Left diagram: × between prior-used article 2 and the accused product; ○ between the accused product and prior-used article 1. Right diagram: × on both of those connections.

IP High Court, 2014 (Gyo-Ke) 10059 Ishii Package containing a dry liposomal pharmaceutical composition containing an iodophor

Original Ameblo publication: 2022-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775556560.html

IP High Court, 2014 (Gyo-Ke) 10059 [Package containing a dry liposomal pharmaceutical composition containing an iodophor] <Ishii>

*The configuration was obvious.

⇒ Adopting the claimed invention's configuration relating to Difference (A) automatically achieves the claimed effect (“storage stability”) as well.

⇒ Inventive step denied.

[Claim 1] …A storage-stable package containing a dry liposomal pharmaceutical composition containing an iodophor.

(Excerpts from the judgment)

…The decision erred … in determining that Difference (B) was not a substantive difference on the ground that the iodophor-containing dry liposomal pharmaceutical composition in the Reference 1 invention satisfies “storage-stable” in the claimed invention regardless of the material of the storage container…. …

However, …a person skilled in the art could readily have conceived of adopting, in the Reference 1 invention, the claimed invention's configuration relating to Difference (A), and the configuration relating to Difference (B) is achieved simultaneously. It can therefore be said that a person skilled in the art could also readily have adopted the configuration relating to Difference (B) in the Reference 1 invention. Accordingly, the claimed invention should be considered one that a person skilled in the art could readily have conceived on the basis of the inventions described in References 1 and 2, and …the above error in the decision does not affect its conclusion.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84708.pdf

Tokyo District Court, 2020 (Wa) 8506 […Work gloves] <Sato>

Original Ameblo publication: 2022-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775556998.html

Tokyo District Court, 2020 (Wa) 8506 […Work gloves] <Sato>

"The plaintiff … argues that the 'irregularities' must have been intentionally formed, and that the irregularities in question are merely 'surface roughness' inevitably arising during manufacture. However, …on the surface of the Exhibit Otsu 1 gloves …the irregularities cannot be said to have arisen inevitably during manufacture, but were intentionally formed."

⇒ Does public working require intentional formation?

Even exclusive sales constitute "disclosure to a third party" and thus public working. (*No evidence establishing a confidentiality agreement.)

The irregularities on the surface of the publicly worked product were intentionally formed.

Other points not limited by the claim language are not differences.

Defendant Yotsugi sold the product to Tohoku Electric Power and transferred ownership, and there is insufficient evidence to find that Tohoku Electric Power … was obliged not to disclose it to third parties.

…Because the Exhibit Otsu 1 product was used by Tohoku Electric Power's on-site workers, the contents of the Exhibit Otsu 1 invention had been disclosed to third parties….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90942.pdf

YouTube [Patents] Inventive step (parameter inventions)

Original Ameblo publication: 2022-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775557918.html

YouTube [Patents] Inventive step (parameter inventions)

“Celecoxib” case

Focusing on the parameter was found not obvious; inventive step satisfied.

⇒ The key is the invention's problem plus whether the parameter could have been identified.

In the “Base fabric for airbags” case...,

Even with motivation to focus on the “numerical value” of a publicly worked product and move that value toward the invention at issue, inventive step was satisfied.

https://www.youtube.com/watch?v=jTjDl9d8dFI

[Trademarks] Osaka District Court, 2020 (Wa) 3646

Original Ameblo publication: 2022-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775558236.html

[Trademarks] Osaka District Court, 2020 (Wa) 3646

“This is not a case … in which selling under the defendants' marks indicated superiority over the plaintiff's … goods. Rather, the plaintiff argues that changing the product name from the plaintiff's mark to the defendants' marks constitutes the tort of removing the plaintiff's mark.”

⇒ No tort established

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90734.pdf

IP High Court, 2021 (Ne) 10029 [Handrail installation method] case <Shoji> ≪Multi-actor infringement≫ ⇒ Joint direct infringement established

Original Ameblo publication: 2022-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775631886.html

[YouTube Individual Cases]

IP High Court, 2021 (Ne) 10029 [Handrail installation method] case <Shoji>

≪Multi-actor infringement≫ Another person performed part of a method invention. ⇒ Joint direct infringement established

=First instance: Osaka District Court, 2017 (Wa) No. 10716 <Sugiura>

"The defendant … performed the steps of the defendant's method up to installing the glass-mounting frame on the handrail body, and another contractor performed the glass-installation work.… However, … the contractor performing the glass-installation work used the defendant's product, followed the defendant's designated method, and carried out installation following the defendant's work.… In this respect, the defendant and the contractor performing the glass-installation work can be assessed as having jointly implemented the defendant's method."

*Osaka District Court, May 4, 1961, Kaminshu 12.5.937 [Styrobeads] discussed in dicta circumstances in which joint direct infringement may arise; cases finding sole direct infringement under the instrumentality theory include Tokyo District Court, 2000 (Wa) No. 20503 [Method for forming an electrodeposited image].

*Under the control theory, Tokyo District Court, 2004 (Wa) No. 25576 [Method for supplying beveled spectacle lenses] (the [HOYA] case) found sole direct infringement of a product (system) invention involving multiple actors.

"…Who may be subjected to an injunction and damages based on patent infringement—that is, who performs the acts of working the invention—should, unlike the question of satisfaction of claim elements, be determined by deciding who controls and manages the system."

*US judicial practice likewise establishes, under the control theory, "direct infringement (Section 271(a))" rather than "induced infringement (Section 271(b))."

(The August 2015 CAFC en banc AKAMAI case following the June 2014 Supreme Court judgment) (≈ the Japanese [HOYA] case cited above)

⇒ Specific examples of direct infringement given were ① “directing or controlling” another, and ② forming a “joint enterprise” with another. ⇒ Further, as categories of “direction or control,” taking account of general principles of vicarious liability, the court listed ❶ an agency relationship (agent), ❷ a contractual relationship (contract), and ❸ the alleged infringer conditioning participation in a particular activity or receipt of a benefit on another person’s performance of one or more steps of a patented method (first prong), where the alleged infringer establishes the manner or timing of performance (second prong) (two-prong test).

[Patents / Individual Case Introduction] IP High Court, 2021 (Ne) 10029 [Handrail installation method] case <Shoji> ≪Multi-actor infringement≫ Another person performed part of a method invention. ⇒ Joint direct infringement established[Patents / Individual Case Introduction] IP High Court, 2021 (Ne) 10029 [Handrail installation method] case <Shoji> ≪Multi-actor infringement≫ Another person performed part of a method invention. ⇒ Joint direct infringement established (Hideki Takaishi, attorney-at-law, patent attorney, and attorney admitted in California, USA) ★ Download the presentation materials here!! https://www.takaishihideki.co...www.youtube.com

Tokyo District Court, 2018 (Wa) 1130 [Printed retroreflective sheeting] <Tanaka> Damages

Original Ameblo publication: 2022-11-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12775717187.html

Tokyo District Court, 2018 (Wa) 1130 [Printed retroreflective sheeting] <Tanaka>

Before filing this action, the plaintiff proposed 5% to the 3M group, including the defendants.

…

Defendant 3M Japan and the other parties asserted 10% in the patent-infringement action they brought against the plaintiff.

…

The royalty rate to be determined after the fact is 10%.

⇒ ¥1.5 billion awarded

(Excerpts from the judgment)

It is found that, before filing this action, the plaintiff proposed a 5% royalty rate for the patent at issue to the 3M group, including the defendants …; meanwhile, US 3M had asserted in a previous patent-infringement action against a third party that the royalty rate for a patent concerning retroreflective sheeting was 9% …; US 3M and the other parties had agreed to a royalty rate of 20% in a previous action against a third party …; and …defendant 3M Japan and the other parties asserted a 10% royalty rate in a patent-infringement action they brought against the plaintiff.…

The royalty rate receivable for the working at issue, to be determined after the fact for the defendants who infringed the patent at issue, is not less than 10%….

https://t.co/pG9Fh55ZgN

IP High Court, 2021 (Ne) 10088 and other cases [Information communication unit]—No concurrent application of paragraphs (2) and (3) to deductions for competing products

Original Ameblo publication: 2022-11-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776051541.html

On appeal, the IP High Court likewise held in 2021 (Ne) 10088 and other cases [Information communication unit] <Kanno> that paragraphs (2) and (3) do not apply concurrently to deductions for competing products (the same as the first-instance judgment).

First instance: Osaka District Court, 2019 (Wa) 9113

“Foreign-exchange gains … should be assessed as cost together with the purchase price and included in calculating the defendant's profits.”

(Excerpt from the judgment / First instance: Osaka District Court, 2019 (Wa) 9113)

…Foreign-exchange gains are understood to arise in connection with settlement in foreign currency of purchases of each of the defendant's products. Accordingly, when calculating the amount of profit the defendant obtained from sales of those products, the calculated foreign-exchange gains against the exchange rate at the time of the import contract, arising from foreign-currency settlement of purchases during a certain period, should be assessed as part of cost together with the purchase price of each product, and should appropriately be included in calculating the defendant's profits.

With respect to concurrent application of Article 102(2) and (3) of the Patent Act, …the only circumstance to be considered as rebutting the presumption of the amount of damages under paragraph (2) is the existence of competing products. For the portion rebutted on the basis of such a circumstance, which is not directly related to the defendant's sales performance of each accused product, there is no basis for applying paragraph (3).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91319.pdf

[Copyright] Osaka District Court, 2021 (Wa) 3208 Sale of pirated copies ⇒ Damages under Article 114(3) of the Copyright Act

Original Ameblo publication: 2022-11-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776051678.html

[Copyright] 2021 (Wa) 3208

Sale of pirated copies ⇒ Damages under Article 114(3) of the Copyright Act

"The list price of the perpetual-license version of the plaintiff's product … is the amount receivable for the exercise of the copyright"; "an amount equivalent to the list price of the perpetual-license version that would have been received was not received."

Cf. Tokyo District Court, May 16, 2001, "LEC case"

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90685.pdf

IP High Court, 2017 (Ne) 10090 [Pharmaceutical] case <Takabe>

Original Ameblo publication: 2022-11-24

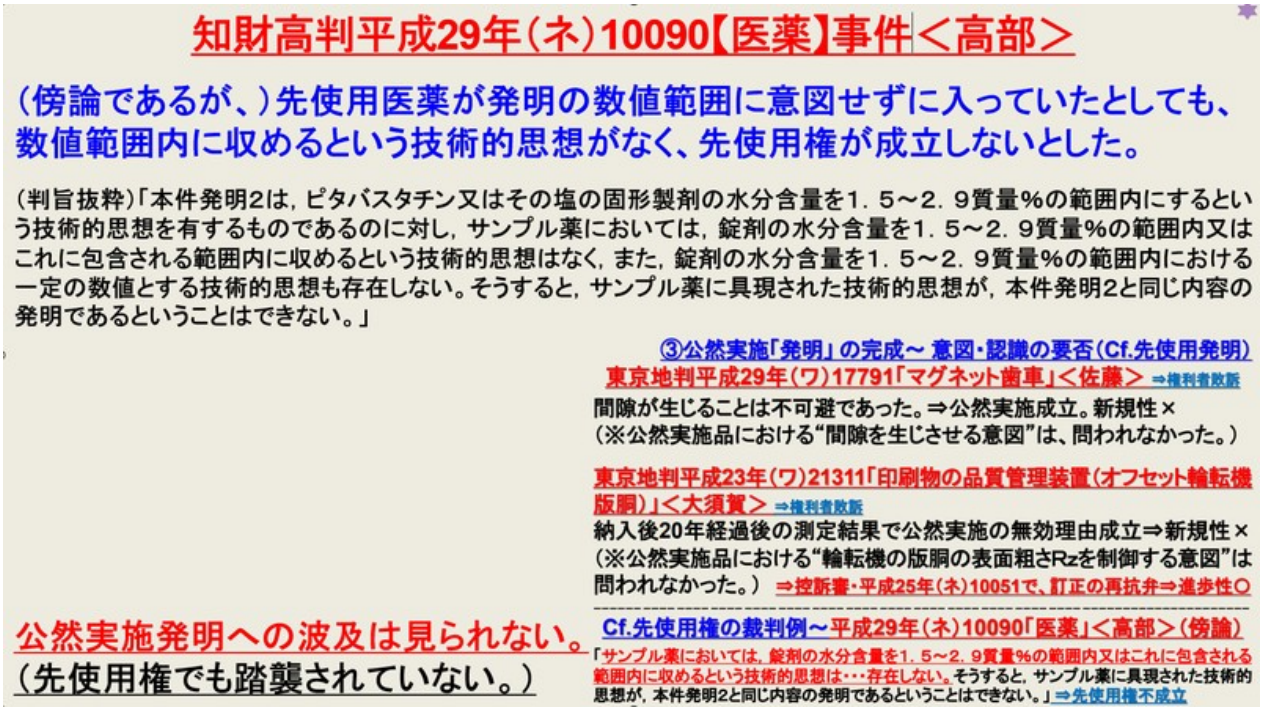
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776051865.html

IP High Court, 2017 (Ne) 10090 [Pharmaceutical] case <Takabe>

(Although obiter dictum,) the court held that, even if the prior-use pharmaceutical unintentionally fell within the invention's numerical range, there was no technical idea of bringing it within that range, and no prior-use right was established.

⇒ In the second action (claim for damages), the support requirement failed at first instance and inventive step failed on appeal.

https://www.youtube.com/watch?v=pyijXtGm9so



English translation of the figure

IP High Court, 2017 (Ne) 10090, "Pharmaceutical" <Takabe>.

(Although obiter dictum,) the court held that, even if the prior-used pharmaceutical unintentionally fell within the numerical range of the invention, there was no technical concept of keeping it within that numerical range, and a prior-use right was not established.

(Excerpt from the judgment) "Invention 2 at issue has the technical concept of setting the water content of a solid preparation of pitavastatin or a salt thereof within the range of 1.5–2.9% by mass. In contrast, the sample drugs have neither the technical concept of keeping the water content of the tablets within the range of 1.5–2.9% by mass or a range included therein, nor the technical concept of setting their water content at a particular value within the range of 1.5–2.9% by mass. Accordingly, the technical concept embodied in the sample drugs cannot be said to be an invention having the same content as Invention 2 at issue."

No extension to publicly worked inventions is seen. (It was not protected even as prior use.)

3. Completion of a publicly worked "invention" — whether intention or recognition is necessary (cf. prior-used inventions). Tokyo District Court, 2017 (Wa) 17791, "Magnetic Gear" <Sato> ⇒ patentee lost.

Formation of a gap was inevitable ⇒ public working established; no novelty. (An “intention to create a gap” in the publicly worked product was not required.)

Tokyo District Court, 2011 (Wa) 21311, “Printed-Matter Quality Management Apparatus (Offset Rotary Press Plate Cylinder)” <Osuga> ⇒ patentee lost. An invalidity ground based on public working was established through measurements taken 20 years after delivery ⇒ no novelty. (An “intention to control the surface roughness Rz of the rotary press plate cylinder” in the publicly worked product was not required.) ⇒ On appeal, 2013 (Ne) 10051, rebuttal based on correction ⇒ inventive step recognized.

Cf. prior-use-right judgment: 2017 (Ne) 10090, “Pharmaceutical” <Takabe> (obiter dictum). “In the sample drugs, the technical concept of keeping the water content of the tablets within the range of 1.5–2.9% by mass or a range included therein … does not exist. Accordingly, the technical concept embodied in the sample drugs cannot be said to be an invention having the same content as Invention 2 at issue.” ⇒ Prior-use right not established.

Tokyo District Court, 2020 (Wa) 13326, 13331 [Forearm-fracture inhibitor containing eldecalcitol] <Shibata>

Original Ameblo publication: 2022-11-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776211867.html

2020 (Wa) 13326, 13331 [Forearm-fracture inhibitor containing eldecalcitol] <Shibata>

Lack of novelty of a use invention

“The configuration for use in preventing fractures of the radius should be regarded as identical to the invention described in Exhibit Otsu 1 and lacks novelty.”

⇒ A meaningful precedent for situations under Article 29-2

(Excerpts from the judgment)

Regarding the limitation of the subjects of administration to patients with Type I osteoporosis, at the priority date at issue, it had been proposed to classify as Type I osteoporosis the osteoporosis occurring in women during the first 15–20 years after menopause, characterized by an excessive and disproportionate phenomenon in cancellous bone compared with cortical bone…. It is clear that Type I osteoporosis as thus proposed is a type of osteoporosis. On the other hand, the specification contains no description whatsoever of effects or the like arising from distinguishing patients with Type I osteoporosis from the osteoporosis patients targeted by the Exhibit Otsu 1 invention as subjects of administration. Accordingly, limiting the subjects of administration to Type I osteoporosis patients should be assessed as a use contemplated by the Exhibit Otsu 1 invention, and cannot be said to constitute a difference from that invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91266.pdf

IP High Court, 2020 (Ne) 10048 <Tsuruoka> ⇛ A case denying a claim for employee-invention remuneration for know-how

Original Ameblo publication: 2022-11-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776425364.html

IP High Court, 2020 (Ne) 10048 <Tsuruoka>

First instance: Tokyo District Court, 2018 (Wa) 36424

⇒ A case denying a claim for employee-invention remuneration for know-how

*Patentability of the know-how was denied.

⇒ Conversely, if know-how is patentable, a claim for employee-invention remuneration may be allowed!!

(Excerpts from the judgment)

…The appellant also argues that the know-how at issue is groundbreaking in combining a main game with a payout rate of 90% and a subgame with a payout rate of 100%, thereby balancing the interests of the game arcade and its customers. However, the question of what payout rate to set is not, in itself, a technical question but merely a matter of arrangement. Thus, the point advanced by the appellant does not constitute a circumstance supporting the patentability of the know-how at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90409.pdf

https://www.youtube.com/watch?v=SPbJ4sPVgAQ

[Patents] Offer for assignment: Tokyo District Court, 2016 (Wa) 25436 [Method for producing L-glutamic acid] <Yamada>

Original Ameblo publication: 2022-11-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776425643.html

(YouTube) [Patents] Offer for assignment

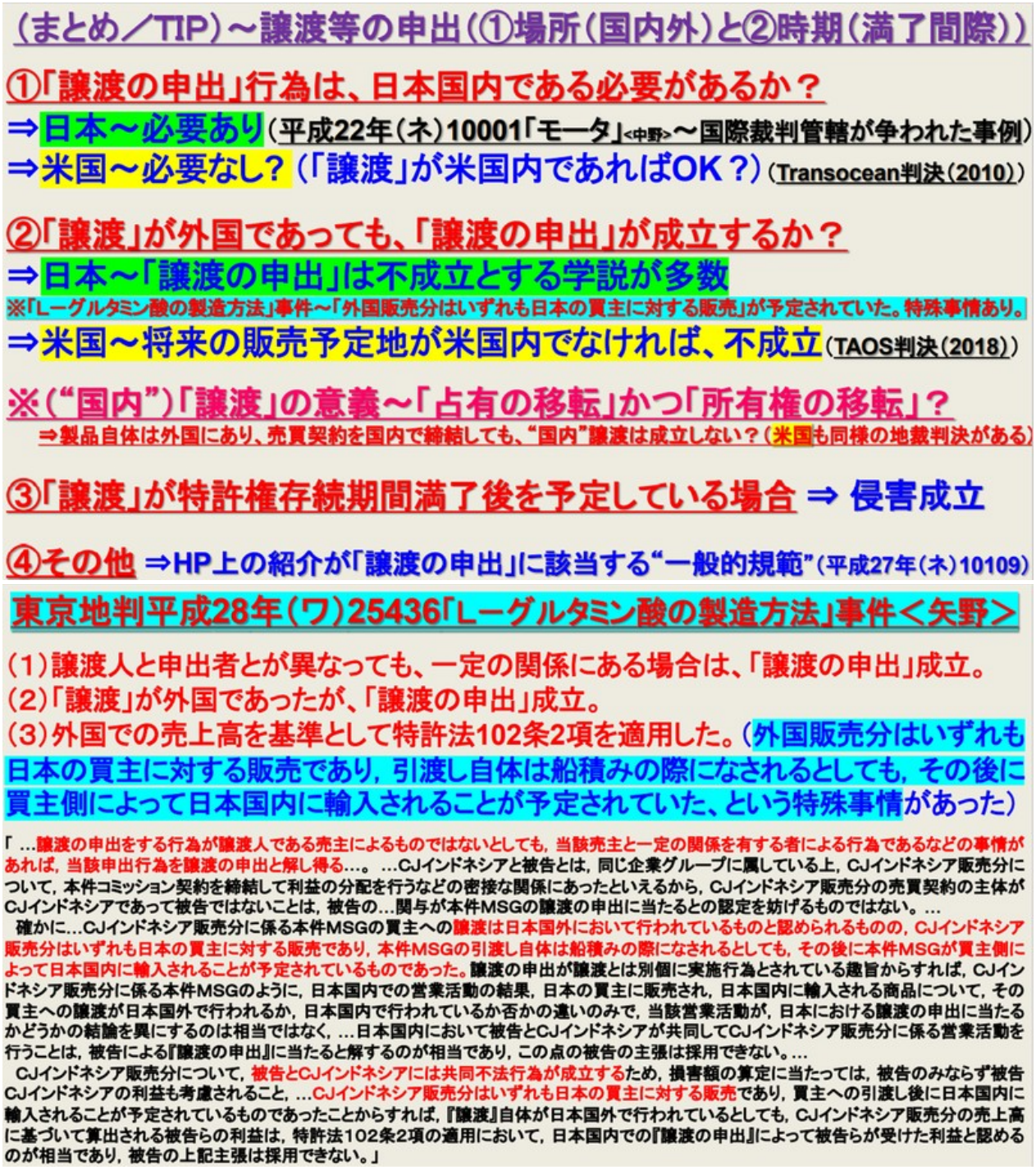
Tokyo District Court, 2016 (Wa) 25436 [Method for producing L-glutamic acid] <Yamada>

1. Even where the transferor and the offeror differ, an “offer for assignment” is established if they have a certain relationship.

2. An “offer for assignment” was established even though the “assignment” took place abroad.

3. Article 102(2) of the Patent Act was applied on the basis of overseas sales.

https://www.youtube.com/watch?v=2U8_ddBQLNI&feature=youtu.be



English translation of the first figure

(Summary/TIP) Offers for assignment and similar acts: (1) location (domestic or overseas) and (2) timing (immediately before expiration).

1. Must the act of “offering for assignment” take place within Japan? Japan — yes: 2010 (Ne) 10001, “Motor” <Nakano>, a case in which international jurisdiction was disputed. United States — not necessary? (Is it sufficient if the “sale” is within the United States?) (Transocean, 2010.)

2. Can an “offer for assignment” be established even if the “assignment” is overseas? Japan — many academic views take the position that an “offer for assignment” is not established. The “Method for Producing L-Glutamic Acid” case involved special circumstances: all overseas sales were intended to be sales to Japanese purchasers. United States — not established unless the anticipated location of the future sale is within the United States (TAOS, 2018).

Meaning of “assignment” (“domestically”): “transfer of possession” and “transfer of ownership”? ⇒ If the product itself is overseas, is a “domestic” assignment not established even if the sales contract is concluded domestically? (There is a US district court judgment to the same effect.)

3. Where “assignment” is scheduled to occur after expiration of the patent term ⇒ infringement established.

4. Other: a “general standard” under which introduction on a website constitutes an “offer for assignment” (2015 (Ne) 10109).

English translation of the second figure

Tokyo District Court, 2016 (Wa) 25436, “Method for Producing L-Glutamic Acid” <Yamada>.

(1) Even if the assignor and the person making the offer differ, an “offer for assignment” is established where they have a certain relationship. (2) An “offer for assignment” was established although the “assignment” was overseas. (3) Article 102(2) of the Patent Act was applied using overseas sales as the basis. (There were special circumstances: all overseas sales were to Japanese purchasers, and even if delivery itself occurred at shipment, subsequent importation into Japan by the purchaser was planned.)

“… Even if the act of making an offer for assignment is not performed by the seller who is the assignor, if there are circumstances such as performance by a person having a certain relationship with that seller, that act may be interpreted as an offer for assignment. … CJ Indonesia and the defendant belonged to the same corporate group and had a close relationship, including entering into the commission agreement at issue and distributing profits in relation to the CJ Indonesia sales. Therefore, the fact that the party to the sales contracts for the CJ Indonesia sales was CJ Indonesia rather than the defendant does not preclude a finding that the defendant’s … involvement constitutes an offer for assignment of the MSG at issue. …

Certainly, … although the assignment to the purchasers of the MSG at issue relating to the CJ Indonesia sales is found to have occurred outside Japan, all the CJ Indonesia sales were to Japanese purchasers, and even if delivery of the MSG at issue itself occurred at shipment, the MSG at issue was intended subsequently to be imported into Japan by the purchasers. In light of the purpose of treating an offer for assignment as an act of working separate from assignment itself, for products such as the MSG at issue relating to the CJ Indonesia sales, which are sold to Japanese purchasers and imported into Japan as a result of business activities in Japan, it would not be appropriate to reach different conclusions as to whether those business activities constitute an offer for assignment in Japan solely because assignment to the purchasers occurs outside rather than within Japan. … It is appropriate to interpret the defendant’s and CJ Indonesia’s joint conduct in Japan of business activities relating to the CJ Indonesia sales as an “offer for assignment” by the defendant; the defendant’s argument on this point cannot be accepted. …

Since the defendant and CJ Indonesia are joint tortfeasors with respect to the CJ Indonesia sales, the profits not only of the defendant but also of CJ Indonesia should be taken into account in calculating damages. … All the CJ Indonesia sales were to Japanese purchasers, and importation into Japan after delivery to the purchasers was planned. Therefore, even if the “assignment” itself occurred outside Japan, it is appropriate, in applying Article 102(2) of the Patent Act, to regard the profits of the defendant and CJ Indonesia calculated from sales of the CJ Indonesia sales as profits received by them through the domestic “offer for assignment.” The defendant’s above argument cannot be accepted.”

(Note) The figure gives the presiding judge as <Yano>. The presiding judge in this case was Judge Mami Yamada (judgment, p. 243, lines 5–6).

IP High Court, 2010 (Ne) 10001 [Motor] <Nakano> *International jurisdiction

Original Ameblo publication: 2022-11-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776704886.html

IP High Court, 2010 (Ne) 10001 [Motor] <Nakano>

*International jurisdiction

With respect to an “act of offering for assignment,” whether Japan has international jurisdiction is determined by whether, as an objective matter of fact, the act of transmitting the offer or the result of its receipt occurred within Japan.

⇒ The defendant was found to have conducted sales activities in Japan.

(Excerpts from the judgment)

…In applying Article 5(ix) of the Code of Civil Procedure, which is considered when determining the existence of international jurisdiction, the place having jurisdiction over an action relating to a tort is the “place where the tort occurred.” This “place where the tort occurred” is understood to include both the place where the harmful act was committed (“place of the harmful act”) and the place where the result occurred (“place of the result”). Because the right the appellant (plaintiff at first instance) alleges was infringed in this action is Japanese Patent No. 3688015, it is appropriate to understand that, with respect to the appellee's (defendant at first instance) “act of offering for assignment,” which the appellant alleges constitutes a tort, whether Japan has international jurisdiction is determined by whether, as an objective matter of fact, the act of transmitting the offer or the result of its receipt occurred within Japan.…

The appellee operates an English-language website that lists one of the accused products and lists “Japan” under “Sales Inquiry,” with the address, telephone number, and fax number of its Japanese base (Minato-ku, Tokyo) under “Sales Headquarter”; its Japanese-language website also contains a webpage introducing the “Slim ODD Motor,” and selecting the “Inquiries concerning purchase” item on that page allows a user to prepare an inquiry form concerning sales of the “Slim ODD Motor”; the appellant's sales manager states in a written statement that the appellee's sales representatives conduct sales activities in Japan concerning ODD motors and that the accused products are being evaluated at … for incorporation into products (ODDs); A, a management adviser to the appellee, prepares and uses business cards bearing that title, the appellee's company name, and an address in Minato-ku, Tokyo, in Japanese; and there is a strong possibility that a DVD multi-drive incorporating one of the accused products is manufactured and sold by a domestic manufacturer and distributed domestically. Assessing these circumstances comprehensively, it is appropriate to find that, with respect to the act of offering the accused products for assignment that the appellant alleges constitutes a tort, the appellee's act of transmitting the offer or the result of its receipt occurred in Japan.…

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80702.pdf

“Dispatch of Lecturers—Strong Support for Developing In-House Intellectual Property Personnel—” has been uploaded to the Nakamura & Partners website

Original Ameblo publication: 2022-11-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776705043.html

“Dispatch of Lecturers—Strong Support for Developing In-House Intellectual Property Personnel—” has been uploaded to the Nakamura & Partners website.

For companies, including their management, it is essential to continue striving daily to build appropriate organizations and systems and to develop and secure suitable personnel for each of the above departments and stages.

https://www.nakapat.gr.jp/ja/practices-details/dispatch-lecturer/

[US Patents] 2022.06 CAFC Novartis v. Accord Healthcare

Original Ameblo publication: 2022-11-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776705315.html

[US Patents] 2022.06 CAFC Novartis v. Accord Healthcare

For a negative limitation to satisfy the written description requirement of Section 112(a), the specification, considered as a whole, must contain a description from which it can be understood that the inventor intended to exclude that feature.

⇒ Written description requirement not satisfied (district court judgment reversed).

https://kilpatricktownsend.jp/%E3%82%AF%E3%83%AC%E3%83%BC%E3%83%A0%E4%B8%AD%E3%81%AE%E5%90%A6%E5%AE%9A%E7%9A%84%E9%99%90%E5%AE%9A/

<Trademarks> IP High Court, 2021 (Gyo-Ke) 10013 “Lingua Franca” Cancellation for non-use

Original Ameblo publication: 2022-11-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12776863375.html

<Trademarks> IP High Court, 2021 (Gyo-Ke) 10013 “Lingua Franca” Cancellation for non-use

An advertising video concerning a service that ended before the period for which use must be proved and that the trademark owner did not take over is not used for services provided in the course of trade. Therefore, even if the trademark at issue appears in it, this is not trademark use.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90491.pdf

Tokyo High Court, 2001 (Gyo-Ke) 489 [Spring structure] <Tsukahara> *No patentability even if a previously known product happens to fall within the numerical range.

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Tokyo High Court, 2001 (Gyo-Ke) 489 [Spring structure] <Tsukahara>

*No patentability even if a previously known product happens to fall within the numerical range.

Even if the concept D/h had not attracted attention in previously known spring structures … it is entirely possible to discover that they happen to fall within that numerical range ... this would amount to granting a patent on the previously known spring structure itself … improper …

(Excerpts from the judgment)

…Even if nobody had focused on D/h before the application, and the concept D/h had not attracted attention in previously known spring structures, its constituent elements D (diameter of the rubber plates) and h (total thickness of the rubber plates) themselves naturally existed in a state in which they could be known. Thus, if it is discovered that spring structures whose ratio D/h lies within a particular numerical range have superior performance, it is entirely possible that calculating the D/h of a previously known spring structure will reveal that it happens to lie within that range. In such a case, granting a patent on spring structures whose D/h lies within a particular numerical range would amount to granting a patent on the previously known spring structure itself, and it is clear that this would be improper.

https://www.youtube.com/watch?v=DlVnhbFibS0

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10813.pdf

[Article] (United States) ITC Features Worth Knowing for Litigation Strategy (IP Management, Vol. 69, No. 1, 2019)

Original Ameblo publication: 2022-12-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777183094.html

[Article] (United States) ITC Features Worth Knowing for Litigation Strategy (IP Management, Vol. 69, No. 1, 2019)

The four requirements for an injunction under eBay do not apply to issuance of exclusion orders in ITC Section 337 proceedings.

⇒ Injunctive relief is easier to obtain at the ITC than in US courts.

Bringing a case before the ITC requires standing (the domestic-industry requirement)!!

https://www.youtube.com/watch?v=spPaitOtvR8

[Article] A case dismissing an action against a corporate representative because the arbitration agreement extended to the representative (JCA Journal, Vol. 69, No. 8)

Original Ameblo publication: 2022-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777349214.html

[Article] A case dismissing an action against a corporate representative because the arbitration agreement extended to the representative (JCA Journal, Vol. 69, No. 8)

International: [Ring Ring Circus case], Supreme Court, September 4, 1997

Domestic: Nagoya District Court, October 27, 1995

Bringing an action against a representative over what is substantively a claim against the corporation and joining the corporation as a party substantively violates the arbitration agreement.

https://www.google.co.jp/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwjdxbikudn7AhVTQPUHHQ8pD8MQFnoECBgQAQ&url=https%3A%2F%2Fkokushikan.repo.nii.ac.jp%2F%3Faction%3Drepository_action_common_download%26item_id%3D11332%26item_no%3D1%26attribute_id%3D189%26file_no%3D1&usg=AOvVaw1rDXFV6lal5ar9kupt_2lS

[Copyright] Tokyo District Court, 2020 (Wa) 19840 <Nakashima> Copyrightability denied for a company name (trade name) rendered as a logotype

Original Ameblo publication: 2022-12-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777668717.html

[Copyright] Tokyo District Court, 2020 (Wa) 19840 <Nakashima>

Copyrightability denied for a company name (trade name) rendered as a logotype.

The defendant had neither the intention nor the need to exploit the plaintiff's name recognition or reputation.

⇒ The defendant's trade name was independently devised.

⇒ “Improper purpose” under Article 8(1) of the Companies Act and “purpose of obtaining an illicit gain” under Article 2(1)(xix) of the Unfair Competition Prevention Act were denied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90848.pdf

Osaka District Court, 2020 (Wa) 4023 […Attachment-assisting plate] <Tani>

Original Ameblo publication: 2022-12-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777669036.html

Osaka District Court, 2020 (Wa) 4023 […Attachment-assisting plate] <Tani>

Unless the plate can retain its shape even under the weight of the cover body, it is difficult to keep the cover body in an elevated position.

⇒ Something that bends under its own weight and has neither rigidity nor elasticity does not constitute a “plate” (some products did not satisfy the limitation).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90666.pdf

Osaka District Court, 2018 (Wa) 866 <Claim for employee-invention remuneration> Exclusivity benefit denied ⇒ Claim dismissed

Original Ameblo publication: 2022-12-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777820542.html

Osaka District Court, 2018 (Wa) 866 <Claim for employee-invention remuneration>

Exclusivity benefit denied

⇒ Claim dismissed

“There are no circumstances such as an increase in the defendant's market share … it cannot be said that the existence of the patent rights caused competitors to refrain from working the inventions at issue.… This is also consistent with … allowing the respective patents to lapse … through nonpayment of patent fees.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91579.pdf

Tokyo High Court, 2001 (Ne) 2630 […Reinforcing rod] <Shinohara> Equivalent substantially identical to an earlier-filed, later-published application

Original Ameblo publication: 2022-12-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12777995151.html

Tokyo High Court, 2001 (Ne) 2630 […Reinforcing rod] <Shinohara>

Equivalent substantially identical to an earlier-filed, later-published application

⇒ Fourth requirement not satisfied

"Requirement ④′ … is based on the view that something for which nobody should have been able to obtain utility model registration cannot be regarded as falling within the technical scope of the registered utility model."

⇒ Utility model right holder loses on reversal

⇒ What about other patentability requirements?

(Even if the equivalent is a support-requirement issue, is it acceptable to find equivalence? …I cannot even find discussion of this point.)

(Excerpts from the judgment)

⋯Regarding requirement ④′ (not being publicly known technology), the appellant argues that the thinking underlying the above Supreme Court judgment is that expansion of the technical scope of a registered utility model through the doctrine of equivalents is impermissible if it results in including a ground for invalidity of that utility model registration; that, if a configuration in which the upper end of the reinforcing rod is attached to the side rod of the platform frame is equivalent to one in which it is attached to the rear rod, the device at issue, with its technical scope thus expanded, would be identical to the device described in the earlier application's specification and would include a ground for invalidity under the main text of Article 3-2 of the Utility Model Act; and that the appellee's assertion of equivalence therefore cannot stand.

Considering the appellant's argument, as stated above, requirement ④′ is based on the view that something for which nobody should have been able to obtain utility model registration in the first place cannot be regarded as falling within the technical scope of a registered utility model. Where a registered utility model is identical to a device described in the specification or drawings originally attached to another utility model application filed before its filing date and published after its filing, the main text of Article 3-2 of the Utility Model Act likewise means that nobody should have been able to obtain utility model registration for that device. In such a case, as with the circumstances specified in requirement ④′, it is inappropriate to treat the device as falling within the technical scope of the registered utility model.

Accordingly, where the accused product is identical to a device described in the specification or drawings of an earlier application for the registered utility model as provided in the main text of Article 3-2 of the Utility Model Act, it should be treated analogously to publicly known technology at the time of filing. It cannot be construed as falling within the technical scope of the registered utility model as an equivalent of the configuration recited in its claims.

https://www.uslf.jp/wp-content/uploads/2018/08/P41.%E6%9D%B1%E4%BA%AC%E9%AB%98%E8%A3%81%E5%B9%B3%E6%88%9013%E5%B9%B411%E6%9C%8828%E6%97%A5%E5%88%A4%E6%B1%BA%EF%BC%88%E4%B8%89%E8%84%9A%E8%84%9A%E7%AB%8B%E4%BA%8B%E4%BB%B6%EF%BC%89.pdf

Osaka District Court, 1999 (Wa) 12699 [Infringement of an inventor's right of honor] <Komatsu> True inventor may demand amendment of the inventor field

Original Ameblo publication: 2022-12-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778141075.html

Osaka District Court, 1999 (Wa) 12699 [Infringement of an inventor's right of honor] <Komatsu>

The true inventor may demand amendment of the statement in the application's inventor field.

“[The plaintiff] has an inventor's right of honor (right to be named as inventor), a personality right … the statement in the application that Defendant B is the inventor infringes the plaintiff's inventor's right of honor.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11858.pdf

IP High Court, 2019 (Gyo-Ke) 10132 <Tsuruoka> [Brunnian link-making device and kit]

Original Ameblo publication: 2022-12-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778317333.html

IP High Court, 2019 (Gyo-Ke) 10132 <Tsuruoka>

[Brunnian link-making device and kit]

① Partial priority

(Note) Where a new configuration added in the later application is not included in the priority application, priority is denied for that component. However, that fact alone does not render the patent invalid; the component must be found to lack novelty or inventive step in light of the cited invention.

② Deleting a feature not essential to solving the problem does not add new matter.

⇒ Amendment requirements satisfied

=IP High Court, 2014 (Gyo-Ke) 10087; IP High Court, 2019 (Gyo-Ke) 10046

③ Whether the amended invention includes an integrally molded configuration is unrelated to new matter.

(Excerpts from the judgment)

It is clear that the invention at issue … includes a configuration without points ①–④ that the plaintiff contends are new configurations—that is, the configuration exactly as in the embodiment described in the specification of the US provisional application at issue…. This configuration constitutes one complete invention; it does not become complete as an invention only upon supplementation with configurations ①–④. In such a case, under Article 4F of the Paris Convention, priority may not be refused, nor may a patent application filed with a claim to Paris Convention priority be rejected, on the ground that it contains elements not included in the priority application. Rather, Paris Convention priority is denied only for the elements not included in the underlying application. Thus, to invalidate a patent arising from such an application, it is not enough merely to find that the patent contains elements absent from the application underlying Paris Convention priority; those elements must be found to lack novelty or inventive step in light of the cited invention…. …Otherwise, for example, suppose a patentee files a foreign application for an invention with Configuration A; after Invention B, which includes that configuration, becomes publicly known, the patentee files in Japan, claiming Paris Convention priority, an invention with Configuration A+C, combining Configuration A with Configuration C, which was not included in the foreign application but has novelty and inventive step over Invention B. Although the foreign application precedes Invention B for the Configuration A portion, priority is claimed, and Configuration C has novelty and inventive step over Invention B, the mere inclusion of Configuration C, absent from the foreign application, would necessarily result in denial even of priority for Configuration A and rejection of the application. Such a result is considered wholly unacceptable under Article 4F of the Paris Convention. Furthermore, because ①–④ can each constitute elements of independent inventions, novelty and inventive step over the cited invention must be considered separately for each configuration.… The tool in the Exhibit Ko 1 video has Configuration ③…. Because the claims of the invention at issue … include Configuration ③ …, the invention at issue … lacks novelty in relation to that video…. Accordingly, to determine whether Paris Convention priority is recognized, it is further necessary to determine whether Configuration ③ is absent from the US provisional application at issue. In contrast, the tool in the Exhibit Ko 1 video is not found to include Configurations ①, ②, or ④, leaving no room for a novelty issue, and there is insufficient argument or evidence to establish that these configurations lack inventive step over the invention in that video. Thus, without needing to determine whether these configurations are absent from the US provisional application,

the plaintiff's argument must be deemed unfounded.… Configuration ③ cannot be said to be absent from the US provisional application, so the plaintiff's argument on this point is also unfounded.… The invention at issue is not found to have a ground for invalidity based on lack of novelty or inventive step in relation to the Exhibit Ko 1 video.

The plaintiff argues that the amendment resulted in inclusion of a configuration in which each of the multiple pins is directly fixed to the base. However, …in the embodiments, the “pin bar” is a configuration for achieving various arrangements of multiple pins, not one essential to solving the invention's problem. Thus, it cannot be said that the original specification and other documents excluded a configuration without a pin bar—that is, the technical idea of supporting pins on the base without a “pin bar”…. The plaintiff also argues that “given that the decision considers the pins supported on the base in Invention 6 to include an integrally molded configuration of pins and base, it is clear that such a configuration is not disclosed.” However, the amendment did not recite the specific configuration of integral molding in the claims, and whether such a configuration is included in Invention 6 does not affect whether new matter has been added (it is merely a question of construing Invention 6). Accordingly, none of the plaintiff's above arguments can be accepted.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E5%AF%A9%E6%B1%BA%E5%8F%96%E6%B6%88%E8%AB%8B%E6%B1%82%E4%BA%8B%E4%BB%B6%EF%BC%88%E3%83%91%E3%83%AA%E6%9D%A1%E7%B4%84%E3%81%AB%E5%9F%BA%E3%81%A5/

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89824.pdf

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-cooled screw compressor] <Tsuruoka> Motivation found from a general problem

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778473480.html

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

Although not mentioned in the cited document, a general problem recognizable to a person skilled in the art at the filing date was held also to apply to the cited invention, establishing motivation.⇒ No inventive step

The judgment does not examine “the problem of the invention at issue.” Is this because the well-known problem is also the invention's problem?

(Excerpts from the judgment)

⋯A person skilled in the art is found able to recognize that the problem of reverse thrust force (a reverse thrust-load state) … arises in screw compressors generally, and can recognize that it also arises in the Exhibit Ko 1 invention…. Thus, for the Exhibit Ko 1 invention as well, …motivation arises to provide an unpressurized path to eliminate the reverse thrust load in order to solve that problem…. Accordingly, even if Exhibit Ko 1 does not directly mention the technical problem of reverse thrust force (a reverse thrust-load state) arising or the resolution of that problem, motivation arises to provide an unpressurized path in the Exhibit Ko 1 invention to solve it….

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e5%af%a9%e6%b1%ba%e5%8f%96%e6%b6%88%e8%ab%8b%e6%b1%82%e4%ba%8b%e4%bb%b6%ef%bc%88%e5%bc%95%e7%94%a8%e6%96%87%e7%8c%ae%e3%81%ab%e8%a8%80%e5%8f%8a%e7%84%a1/

Tokyo District Court, 2020 (Wa) 13326, 13331 <Shibata> [Forearm-fracture inhibitor containing eldecalcitol]

Original Ameblo publication: 2022-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778700212.html

Tokyo District Court, 2020 (Wa) 13326, 13331 <Shibata>

[Forearm-fracture inhibitor containing eldecalcitol]

*Novelty of the “use” was denied.

“Limiting the subjects of administration to Type I osteoporosis patients should be assessed as a use contemplated by the Exhibit Otsu 1 invention, and cannot be said to constitute a difference from that invention.”

⇒ Found to lack novelty, rather than inventive step.

⇒ A useful holding, since it can also be used in cases involving an earlier-filed, later-published application (Article 29-2)!!

(Excerpts from the judgment)

Regarding the limitation of the subjects of administration to patients with Type I osteoporosis, at the priority date at issue, it had been proposed to classify as Type I osteoporosis the osteoporosis occurring in women during the first 15–20 years after menopause, characterized by an excessive and disproportionate phenomenon in cancellous bone compared with cortical bone…. It is clear that Type I osteoporosis as thus proposed is a type of osteoporosis. On the other hand, the specification contains no description whatsoever of effects or the like arising from distinguishing patients with Type I osteoporosis from the osteoporosis patients targeted by the Exhibit Otsu 1 invention as subjects of administration. Accordingly, limiting the subjects of administration to Type I osteoporosis patients should be assessed as a use contemplated by the Exhibit Otsu 1 invention, and cannot be said to constitute a difference from that invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91266.pdf

IP High Court, 2021 (Ne) 10031 <Shoji> [Semiconductor integrated circuit device] =Tokyo District Court, 2020 (Wa) 6675

Original Ameblo publication: 2022-12-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778940481.html

IP High Court, 2021 (Ne) 10031 <Shoji>

[Semiconductor integrated circuit device] =Tokyo District Court, 2020 (Wa) 6675

Although “semiconductor integrated circuit device” in the claims may include DRAM in its general meaning, the detailed description uses it to mean a system LSI.

⇒ Product A, which is DRAM, does not satisfy the limitation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90865.pdf

Tokyo District Court, 1997 (Wa) 938 [Fragrant liquid bleach composition] (Kabi Killer)

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12778943331.html

Tokyo District Court, 1997 (Wa) 938

[Fragrant liquid bleach composition] (Kabi Killer)

*The claim term “containing” = in its ordinary sense, it is enough that the substance is contained.

*Direct infringement found for a product that changes over time.

Cf. Tokyo High Court, 2002 (Ne) 4193 “Doctor Blade case” (a referenced decision not separately discussed in this collection)

Cf. 2007 (Wa) 10364

Cf. IP High Court, 2011 (Ne) 10074

(Excerpts from the judgment)

Patented Invention 1 at issue is a product invention concerning a fragrant liquid bleach composition, with no limitation on its manufacturing method. Therefore, its technical scope should include not only cases where a fragrance recited in the claims is added from the outset, but also cases where, during manufacture, another fragrance capable of producing the claimed fragrance is added so that the claimed fragrance comes to be contained between manufacture and use.

⋯Even the defendant's experimental results establish that, 28 days after the experiment began, approximately one-third of the “dimethylbenzylcarbinyl isobutyrate” had changed into “dimethylbenzylcarbinol.” The defendant's product is a household mold remover, and the period of 28–30 days is by no means excessively long compared with the normal period from manufacture through distribution until the product reaches ordinary consumers. Moreover, the contents of a bottle of household mold remover are rarely used up at once; it is ordinarily kept in the home and used for cleaning and the like over a certain period. Accordingly, it is appropriate to find that a considerable portion of the “dimethylbenzylcarbinyl isobutyrate” in the defendant's product has changed into “dimethylbenzylcarbinol” by the time it is used by consumers.

Thus, although at the time of manufacture (the configuration described in item 1 of the attached “List of Defendant's Products”) the defendant's product does not contain any fragrance recited in Claim Element (1) of Patented Invention 1, subsequent changes over time inevitably cause it to contain the “dimethylbenzylcarbinol” recited in Claim Element (1). The defendant's act of manufacturing that product should therefore be regarded as an act of working Patented Invention 1.…

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13508.pdf

IP High Court, 2019 (Gyo-Ke) 10041 [Wound dressing] <Kanno> Support requirement satisfied; inventive step satisfied

Original Ameblo publication: 2022-12-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779095646.html

IP High Court, 2019 (Gyo-Ke) 10041 [Wound dressing] <Kanno>

<Support requirement>

*The support requirement was satisfied by a calculation based on the respective minimum values of two numerical ranges described in the specification.

“Calculating on the basis of the minimum diameter of 280 μm and the minimum density of 50 holes/cm² … gives an open-area ratio of 3.07%.… This is a matter equivalent to one described....”

<Inventive step>

*No motivation to extract only part of the secondary cited invention and apply it to the primary cited invention.

(Excerpts from the judgment)

<Support requirement>

⋯As to the open-area ratio of through-holes for retaining an appropriate amount of exudate on the wound site, the specification states that “the opening area at the first surface (11) preferably corresponds to a circle with a diameter of 280–1,400 μm” … and that “the through-holes (13) are preferably present at a density of 50–400 holes/cm², and more preferably at a density of 60–325 holes/cm²”…. Calculating from the minimum diameter of 280 μm and minimum density of 50 holes/cm² within the preferred ranges for through-hole diameter and density … gives an open-area ratio of 3.07%.… Although the invention-defining matter “an open-area ratio of 3.07% or more” is not directly stated in the detailed description, it can be said to be equivalent to a matter described there. Accordingly, it can be recognized that setting the through-holes to that open-area ratio solves the invention's problem.

<Inventive step>

⋯The invention described in Exhibit Ko 4 has an integrated structure comprising a first layer with numerous holes that form an appropriate storage space between the wound surface and the second layer, retain an appropriate amount of exudate on the wound surface, and prevent exudate from spreading in the in-plane direction; a second layer that is an initial water-pressure-resistant sheet material; and a sheet material capable of absorbing and retaining water (third layer). Because its technical significance lies in maintaining a moist wound surface through that structure, there is no motivation to extract only the first layer of the Exhibit Ko 4 invention and apply it to the Exhibit Ko 1 invention.… The three functions of Common General Technical Knowledge 1 asserted by the plaintiff are merely described in the above three patent documents concerning wound dressings having such functions. Disregarding the specific configurations of those wound dressings, those descriptions are insufficient to establish that, for wound dressings generally, providing the functions of Common General Technical Knowledge 1 is common general technical knowledge for effective moist wound therapy.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90012.pdf

Damages (concurrent application of paragraphs (2) and (3)): IP High Court (Grand Panel), 2020 (Ne) 10024; IP High Court, 2021 (Ne) 10088

Original Ameblo publication: 2022-12-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779252643.html

IP High Court Grand Panel judgment, 2020 (Ne) 10024 [Chair-type massage machine]

Among the grounds for rebutting the presumption under Article 102(2), the court denied application of paragraph (3) to the portion … rebutted on the ground that the patented invention was implemented only in part of the infringing product, but allowed application of paragraph (3) to the portion … rebutted on the ground that the markets were not identical.

https://www.ip.courts.go.jp/vc-files/ip/2022/Re2ne10024-zen.pdf

IP High Court, 2021 (Ne) 10088 [Information communication unit] <Kanno> Damages ⇒ Concurrent application of paragraphs (2) and (3)

"For the portion of the presumption rebutted because of the probability that competing products would have been sold, the patent owner … is not, in the first place, in a relationship of granting a license to the appellant, and there is no room to receive an amount equivalent to a royalty under paragraph (3)…."

⇒ Concurrent application of paragraphs (2) and (3) denied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91319.pdf

[US Patents] 2009 CAFC Section 271(f) of the US Patent Act does not apply to method claims.

Original Ameblo publication: 2022-12-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779552281.html

[US Patents] 2009.08 CAFC en banc

Cardiac Pacemakers v. St. Jude Medical

Section 271(f) of the US Patent Act does not apply to method claims.

*The CAFC, sitting en banc, overruled Union Carbide v. Shell Oil Co., 425 F.3d 1366 (Fed. Cir. 2005).

https://www.jpaa.or.jp/old/about_us/organization/affiliation/chuuou/pdf/no22/no22-3.pdf

https://www.youtube.com/watch?v=H9q946WD_Z0

[US Patents] 2016.03 CAFC Could have been raised ⇒ IPR not instituted ⇒ No estoppel for invalidity grounds

Original Ameblo publication: 2022-12-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779781682.html

[US Patents] 2016.03 CAFC Shaw Industries v. Automated Creel

In its 2016 Shaw decision, the Federal Circuit held that estoppel concerning grounds that were “raised or reasonably could have been raised” did not extend to grounds on which the PTAB had not instituted IPR.

(Note) The approach taken in Shaw in 2016 was overruled by California Institute of Technology v. Broadcom on February 4, 2022. The latter decision held that estoppel also extends to grounds that reasonably could have been included in the petition.

https://www.youtube.com/watch?v=4C9YW0eD9dE

[Individual Case Introduction] Tokyo District Court, 2019 (Wa) 30991 […Composition] <Tanaka>

Original Ameblo publication: 2022-12-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779781843.html

[Individual Case Introduction] Tokyo District Court, 2019 (Wa) 30991 […Composition] <Tanaka>

"Although … each is described individually in the original specification, they are not described as a combination of three particular compounds, nor is any basis stated for that combination of three particular compounds being inevitable."

https://www.youtube.com/watch?v=qWW83hjTF9Q

[US Patents] 2016 Supreme Court Claim construction in IPR proceedings also followed the BRI standard under the rules then in force

Original Ameblo publication: 2022-12-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12779782093.html

[US Patents] 2016.06 US Supreme Court Cuozzo Speed v. Lee

Under the rules in force at the time of the 2016 decision, claims in IPR proceedings were construed under the Broadest Reasonable Interpretation (BRI) standard.

Under the claim-construction rules then in force, IPR could be more favorable to the petitioner challenging validity than an invalidity defense in federal district court.

[US Patents] Non-obviousness (Section 103 of the US Patent Act) (corresponding to Japan's “inventive step”) - YouTube

2019.05 US Supreme Court Mission Product v. Tempnology

Original Ameblo publication: 2022-12-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12780010844.html

2019.05 US Supreme Court Mission Product v. Tempnology

Even where a trademark licensor went bankrupt and rejected performance of an executory contract under Section 365(a) of the Bankruptcy Code, the licensee was permitted to continue using the trademark (the license).

The issue arose because trademarks are excluded from the definition of “intellectual property” in 11 U.S.C. § 101(35A), and thus fall outside the special rule in § 365(n).

https://www.supremecourt.gov/opinions/18pdf/17-1657_4f15.pdf

[United States] Section 337 of the US Tariff Act—Also covers products that do not satisfy the claim limitations at importation but do when customers use them after importation

Original Ameblo publication: 2022-12-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12780167792.html

[US Patents] 2020.03 CAFC

Comcast v. ITC

Section 337 of the US Tariff Act also applies to products that do not satisfy the claim limitations at importation but do when customers use them after importation.

(Note) In this case, products that were non-infringing at importation were subject to Section 337 of the US Tariff Act on the basis of direct infringement by customers through post-importation use and induced infringement by Comcast.

https://openlegalcommunity.com/itc-infringement-after-importation-method-claim/

[United States] Statements made during prosecution of a parent application affect claim construction in a continuation if relevant to the continuation's patent claims

Original Ameblo publication: 2022-12-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12780168052.html

[US Patents] 2019.08 CAFC

Iridescent Networks v. AT&T

Statements made during prosecution of the parent application affect claim construction in the continuation application if they relate to the continuation's patent claims.

Enablement arguments result in a narrower claim scope - Open Legal Community

[US Patents] Scope in which an implied license is presumed from settlement of earlier litigation (general proposition)

Original Ameblo publication: 2022-12-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12780319955.html

[US Patents] 2014.03 CAFC Endo Pharmaceuticals v. Actavis

Scope in which an implied license is presumed from settlement of earlier patent-infringement litigation (general proposition)

An implied license is presumed for continuation patents of the licensed patent.

Merely sharing a provisional application with the licensed patent does not give rise to a presumed implied license.

https://www.oliff.com/wp-content/uploads/2019/06/2018-1054-OBJP.pdf

[US Patents] Induced infringement found for a skinny-label generic pharmaceutical product.

Original Ameblo publication: 2022-12-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12780473549.html

[US Patents] 2021.08 CAFC Glaxosmithkline v. Teva

Induced infringement was found for a generic pharmaceutical product with a skinny label (a label excluding the patented method).

Teva had marketed the product as effective for congestive heart failure, physicians knew this, and it did not remove matters concerning hypertension and other indications from the label.

=Japan's IP High Court, 2005 (Ne) 10125

https://www.elementiplaw.com/%E3%82%B8%E3%82%A7%E3%83%8D%E3%83%AA%E3%83%83%E3%82%AF%E5%8C%BB%E8%96%AC%E5%93%81%E3%81%AB%E3%81%8A%E3%81%91%E3%82%8B%E8%AA%98%E5%BC%95%E4%BE%B5%E5%AE%B3%E3%81%AE%E5%88%A4%E6%96%AD%E3%81%AB%E3%81%A4/

[US Patents] 2014.06 US Supreme Court Nautilus v. Biosig Standard for the definiteness requirement

Original Ameblo publication: 2022-12-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781115200.html

[US Patents] 2014.06 US Supreme Court Nautilus v. Biosig

The standard for the definiteness requirement was changed from the previous “insolubly ambiguous” standard to the “reasonable certainty” standard (indefinite where a person skilled in the art, even considering the specification and prosecution history, cannot understand the scope of the invention with reasonable certainty).

⇒ It is easier to find a violation of the definiteness requirement.

U.S. Case Report: Nautilus, Inc. v. Biosig Instruments, Inc. (jpaa.or.jp)

[Article] “US Patent Litigation as an Intellectual Property Strategy” Section 252 of the US Patent Act—Effect of reissue (intervening rights)

Original Ameblo publication: 2022-12-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781115371.html

[Article] “US Patent Litigation as an Intellectual Property Strategy” (Yoshinari Kishimoto, Nikkei Publishing, p. 159)

Section 252 of the US Patent Act—Effect of reissue (intervening rights)

⇒ If the reissued patent claims are substantially identical to the original patent claims, no intervening rights arise, and damages may also be claimed for infringing acts committed before reissue.

https://www.amazon.co.jp/%E7%9F%A5%E8%B2%A1%E6%88%A6%E7%95%A5%E3%81%A8%E3%81%97%E3%81%A6%E3%81%AE%E7%B1%B3%E5%9B%BD%E7%89%B9%E8%A8%B1%E8%A8%B4%E8%A8%9F-%E5%B2%B8%E6%9C%AC%E8%8A%B3%E4%B9%9F-ebook/dp/B079Y4WPH9/ref=sr_1_1?adgrpid=54049165420&gclid=CjwKCAiAhqCdBhB0EiwAH8M_GnQFg-YG6Qu9xojHfLEACjiqtefzIg1P2Pf6FbwiRswd8Px0EmzYQRoCdu8QAvD_BwE&hvadid=618622781956&hvdev=c&hvlocphy=1009280&hvnetw=g&hvqmt=e&hvrand=6909192450780647391&hvtargid=kwd-334805789956&hydadcr=27707_14598618&jp-ad-ap=0&keywords=%E7%9F%A5%E8%B2%A1%E6%88%A6%E7%95%A5%E3%81%A8%E3%81%97%E3%81%A6%E3%81%AE%E7%B1%B3%E5%9B%BD%E7%89%B9%E8%A8%B1%E8%A8%B4%E8%A8%9F&qid=1672015578&sr=8-1

[US Patents] HZNP v. Actavis “consisting essentially of”

Original Ameblo publication: 2022-12-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781256241.html

[US Patents] 2019.10 CAFC HZNP v. Actavis

The phrase “consisting essentially of” is not inherently indefinite. It can encompass compositions containing unlisted ingredients that do not materially affect the basic and novel properties. Those properties and the resulting claim boundaries must nevertheless be understood by a person of ordinary skill with reasonable certainty.

⇒ The standard in the Supreme Court's Nautilus judgment requires that the characteristics be known and definite.

⇒ Indefinite.

https://www.oliff.com/wp-content/uploads/2019/11/2017-2149-OBJP.pdf

IP High Court, 2017 (Gyo-Ke) 10089, 10090 [Medical flexible container] case <Takabe>

Original Ameblo publication: 2022-12-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781256642.html

(YouTube Individual Patent Cases)

IP High Court, 2017 (Gyo-Ke) 10089, 10090 [Medical flexible container] case <Takabe>

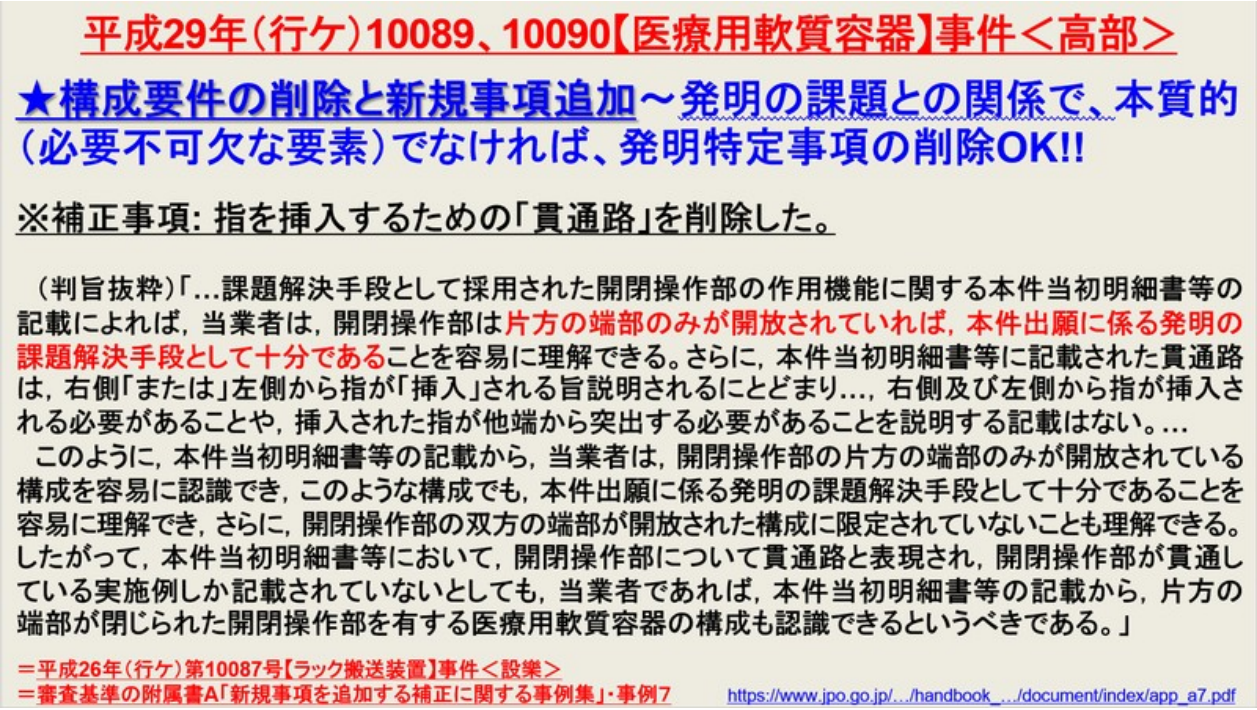
<Deletion of claim elements and addition of new matter>

Deleting a matter specifying the invention is permissible if it is not essential (an indispensable element) in relation to the invention's problem!!

=IP High Court, 2014 (Gyo-Ke) 10087

=Examination Handbook, Annex A, section 7 (Amendments Adding New Matter), Example 7

https://www.youtube.com/watch?v=Y8NpVGolOeg



English translation of the figure

IP High Court, 2017 (Gyo-Ke) 10089 and 10090, “Medical Flexible Container” <Takabe>.

Deletion of a constituent feature and addition of new matter: in relation to the problem of the invention, deletion of a matter specifying the invention is permitted if it is not essential (indispensable)!! Amendment: the “through passage” for inserting a finger was deleted.

(Excerpt from the judgment) “… According to the description of the function of the opening operation portion adopted as a means for solving the problem in the original specification and other documents at issue, a person skilled in the art can easily understand that it is sufficient as a means for solving the problem of the invention in the application at issue if only one end of the opening operation portion is open. In addition, the through passage described in the original specification and other documents merely describes insertion of a finger from the right ‘or’ the left; it does not describe the necessity of insertion from both the right and the left, or of the inserted finger protruding from the other end. …

In this way, from the description in the original specification and other documents, a person skilled in the art can easily recognize a structure in which only one end of the opening operation portion is open, can easily understand that such a structure is sufficient as a means for solving the problem of the invention in the application at issue, and can further understand that it is not limited to a structure in which both ends of the opening operation portion are open. Therefore, even if the original specification and other documents describe the opening operation portion as a through passage and describe only embodiments in which the opening operation portion passes through, a person skilled in the art should be able to recognize, from that description, the configuration of a medical flexible container having an opening operation portion closed at one end."

2014 (Gyo-Ke) 10087, "Buckle Locking Device" <Shitara>, to the same effect. Appendix A to the Examination Handbook, "Case Examples concerning Amendments that Add New Matter," Examples 4 and 7. Displayed link: https://www.jpo.go.jp/…/handbook_…/document/app_a7.pdf.

[US Patents] Eli Lilly v. Teva The purpose of a method of use is construed restrictively by the preamble

Original Ameblo publication: 2022-12-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781407031.html

[US Patents] 2021.08 CAFC Eli Lilly v. Teva

A method of using an apparatus or composition … ordinarily depends entirely on “what the method does.”

Because what the method does is ordinarily stated in the preamble, the purpose of a method of use tends to be construed restrictively by the preamble.

*In the United States as well, a method claim’s preamble may be construed as limiting in light of the specification and other relevant context; it was held limiting in this case.

https://www.cafc.uscourts.gov/opinions-orders/20-1876.opinion.8-16-2021_1819528.pdf

“Valuation of Intellectual Property Rights” has been uploaded to the Nakamura & Partners website.

Original Ameblo publication: 2022-12-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781456203.html

“Valuation of Intellectual Property Rights—Ensuring an Objective Valuation When Transferring … Within a Group—” has been uploaded to the Nakamura & Partners website.

“You can fulfill the company's accountability obligations or an individual director's duty of care of a prudent manager.”

(Recently, directors have been held personally liable in a succession of patent-infringement cases in which the patentees prevailed.)

https://www.nakapat.gr.jp/ja/practices-details/ip-valuation/

[United States] CAFC Evolusion v. Juggernaut Construction of claim language

Original Ameblo publication: 2022-12-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781984188.html

[US Patents] 2022.01 CAFC Evolusion v. Juggernaut

Where the same claim language is used in another claim, it is construed to have a consistent meaning unless it clearly has a different meaning.

Even if an embodiment includes a particular limiting element, the claim is not thereby limited in that way.

⇒ There is no Japanese precedent to the same effect!!

https://www.oliff.com/wp-content/uploads/2022/02/2021-1987-OBJP.pdf

“Valuation of Intellectual Property Rights—Ensuring an Objective Valuation When Transferring … Within a Group—”

Original Ameblo publication: 2022-12-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12781985011.html

“Valuation of Intellectual Property Rights—Ensuring an Objective Valuation When Transferring … Within a Group—” has been posted on the Nakamura & Partners website.

“You can fulfill the company's accountability obligations or an individual director's duty of care of a prudent manager.”

(Recently, directors have been held personally liable in a succession of cases.)

https://www.youtube.com/watch?v=P43hYOZIhAA

https://www.nakapat.gr.jp/ja/practices-details/ip-valuation/

Hideki Takaishi Article Collection

January–June 2023

English Edition

177 articles

Complete English translations of the revised Ameblo articles

In chronological order of the original Ameblo publication date

Confirmed errors in wording, legal descriptions, and translations have been corrected. Unless otherwise stated, descriptions of legal rules, outlooks, and statistics reflect the time when each original article was published.

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03 2023-01-04 [Patents] Divisional applications — Where the child application violates the divisional requirements/adds new matter, the grandchild's filing date does not relate back to the parent's!

04 2023-01-04 [United States] Georgetown Rail v. Holland — Preambles and limitations on claim scope

05 2023-01-06 IP High Court, 2005 (Gyo-Ke) 10608 <Shinohara> — Correction requirements for a 'disclaimer claim'

06 2023-01-07 IP High Court, 2005 (Gyo-Ke) 10143 [Filter Substrate] <Nakano> — *Clarity requirement concerning the measurement method: not satisfied

07 2023-01-07 Tokyo High Court, 2001 (Gyo-Ke) 209 [Cleaning Blade for an Electrophotographic Copying Machine] — Enablement requirement concerning the measurement method: not satisfied

08 2023-01-09 Tokyo District Court, 2018 (Wa) 17586 et al. [Pharmaceutical] (Kowa v. Towa Pharmaceutical) — Second judgment (the patentee loses in the later damages action)

09 2023-01-10 IP High Court, 2022 (Ne) 10052 <Honda> [Pharmaceutical] (Kowa v. Towa Pharmaceutical) — *Patentee prevailed in the preceding injunction action

10 2023-01-11 Tokyo District Court, 2008 (Wa) 38602 [Wireless Access Communication System] <Shoji> — Support and enablement requirements: not satisfied

11 2023-01-12 [Copyright] Tokyo District Court, 2021 (Wa) 1333 <Tanaka> — Conduct found to aid infringement of the right of public transmission

12 2023-01-13 Osaka District Court, 2020 (Wa) 3247, 8842 — Filing the lawsuit held to constitute a tort!!

13 2023-01-14 Nakamura & Partners website — 'IP Mix: Multifaceted Protection and Enforcement through Multiple Intellectual Property Rights'

14 2023-01-14 IP High Court, 2021 (Gyo-Ke) 10137 [Working Machine] <Shoji> — *Not recognizable from the external appearance of the publicly worked product ⇒ Novelty upheld

15 2023-01-16 August 2019, CAFC, Iridescent Networks v. AT&T — Prosecution history of the parent application

16 2023-01-16 [Trademarks] IP High Court, 2019 (Gyo-Ke) 10078 'AROMA ZONE' — Domestic use/display even where the transfer occurs abroad

17 2023-01-17 [U.S. Patents] March 2020, CAFC, Comcast v. ITC — Section 337 of the U.S. Tariff Act

18 2023-01-18 May 2019, U.S. Supreme Court, Mission Product v. Tempnology

19 2023-01-20 [Chinese Case Law] Supreme People's Court (2020) Zui Gao Fa Zhi Min Zhong No. 621 (judgment dated December 18, 2021)

20 2023-01-21 August 2022, CAFC, In re McDonald <Recapture rule>

21 2023-01-23 [Unfair Competition Prevention Act] Tokyo District Court, 2020 (Wa) 19889

22 2023-01-24 IP High Court, 2021 (Gyo-Ke) 10157, 10155 [Agent for Treating Movement Disorders] <Honda> — *Limiting the patient population supported inventive step

23 2023-01-25 IP High Court, 2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe> — Unclear how far numerical values should be changed ⇒ Inventive step upheld

24 2023-01-26 Osaka District Court, 2017 (Wa) 7391, 2019 (Wa) 3587 — Claim for remuneration for an employee invention (Mitsubishi Electric)

25 2023-01-26 [YouTube Video] Every Issue in Inventive Step (57 minutes) — Premiere, Sunday, January 29, at 8 p.m.

26 2023-01-27 Osaka District Court, 2006 (Wa) 6264 — ≈ Tokyo District Court, 2002 (Wa) 1943 [Fine Coral Fossil Powder]

27 2023-01-28 [Unfair Competition Prevention Act, Article 2(1)(i)] IP High Court, 2021 (Ne) 10025 — Disclaimer recognized; no confusion found

28 2023-01-28 [Unfair Competition Prevention Act] IP High Court, 2021 (Ne) 10018 — Advertised as 100% oligosaccharide

29 2023-01-30 [Article] ‘Reading Leading Cases of the European Patent Office Boards of Appeal’ (Kenji Miyazaki and Masashi Jinno)

30 2023-01-31 [U.S. Patents] April 2015, CAFC, INEOS USA v. Berry Plastics

31 2023-02-01 IP High Court, 2021 (Gyo-Ke) 10066 <Shoji> [Agent Containing Eldecalcitol for Suppressing Forearm Fractures]

32 2023-02-07 Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheet] <Tanaka> — Trends in damages after the Grand Panel judgment

33 2023-02-08 Tokyo District Court, 1998 (Wa) 16963 [Moon Projector] <Mimura> — Entering into a contract for work also constitutes ‘transfer’

34 2023-02-08 I have posted an article on ‘Strategic Use of Standardization’ on the Nakamura & Partners website

35 2023-02-08 [Article] ‘Can the Parameters of a Trained Program Be Understood as a Product Invention?’ (Patent Attorney Tadashi Matsushita)

36 2023-02-08 [U.S. Patents] October 2022, CAFC, Nature Simulation Systems v. Autodesk

37 2023-02-08 [Article] ‘Inherent Properties and Novelty: Taking Inventions in Immunology-Related Fields as Examples’ (Patent Attorney Yoshinori Hosoda)

38 2023-02-08 IP High Court, 2019 (Ne) 10007 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Kanno> — Indirect infringement under Article 101(ii)

39 2023-02-08 [Article] Protection of Data (Structures) under Patent Law (Tsutomu Shimohagiwara)

40 2023-02-08 IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno> — Disclaimer claims and inventive step

41 2023-02-09 [United States] Prior-art effect based on a provisional application — MPEP 706.02(f), 2136.03, revised January 2018

42 2023-02-09 I have published ‘Sports Law’ on the Nakamura & Partners website

43 2023-02-09 [New YouTube Video] Divisional Application Strategies (complete 23-minute version)

44 2023-02-10 IP High Court, 2021 (Gyo-Ke) 10093 [Second PCSK9 Litigation (Regeneron)] — Unlike the first litigation, support requirement not satisfied

45 2023-02-11 IP High Court, 2021 (Gyo-Ke) 10140 [Electroformed Tube] <Kanno> — *Violation of the clarity requirement for a PBP claim

46 2023-02-12 [U.S. Patents] Novelty, MPEP — April 2015, CAFC, INEOS v. BERRY PLASTICS

47 2023-02-13 [U.S. Patents] 1995 (CAFC), Exxon Chem. Patents v. Lubrizol

48 2023-02-14 [U.S. Patents] August 2016, CAFC, Multilayer Stretch Cling Film

49 2023-02-15 [U.S. Patents] July 2019, CAFC, Enzo v. Roche

50 2023-02-16 [U.S. Patents] July 2018, CAFC, Boston University v. Everlight

51 2023-02-17 [Trademarks] IP High Court, 2019 (Gyo-Ke) 10078 ‘AROMA ZONE’ — ★Foreign server; directed to Japanese customers ⇒ Domestic use upheld

52 2023-02-17 [Trademarks] IP High Court, 2017 (Gyo-Ke) 10071 ‘COVERDERM’ — ★Foreign server; Japanese language ⇒ Domestic use upheld

53 2023-02-17 [U.S. Trademarks] Playboy v. Chuckleberry — ⇒ Acceptance of new subscriptions from U.S. residents prohibited

54 2023-02-17 [Trademarks] IP High Court, 2005 (Gyo-Ke) 10095 ‘PAPA JOHN’S’ — ★Foreign server; English-language site not found to target Japanese consumers ⇒ Domestic use denied

55 2023-02-17 [YouTube] Foreign-server issues (Are ‘providing’ a program and ‘transferring’ tangible goods parallel?)

56 2023-02-20 [Trademarks] IP High Court, 2013 (Gyo-Ke) 10031, ‘Gram’ case — A material's trademark also used for clothing

57 2023-02-22 [China (Article)] Reducing warranty liability risks in technology licensing to Chinese companies: Considering optimal structures for the business environment (2015, Intellectual Property Management)

58 2023-02-24 IP High Court, 2018 (Gyo-Ke) 10023 [Cushioning Material for Polishing] <Otaka>

59 2023-02-24 Tokyo District Court, 2017 (Wa) 35663 [Equol-Containing Fermented Soybean Hypocotyl Product] <Okinaka>

60 2023-02-25 Tokyo District Court, 2007 (Wa) 27187 [User Interface for Television Program Listings]

61 2023-03-01 [U.S. Patents] August 2020, CAFC, IP Bridge v. TCL

62 2023-03-02 [Korean Patents] Patent Court judgment of February 17, 2022, 2020 Heo 5832

63 2023-03-03 [U.S. Patents] March 2016, CAFC, DSS v. Taiwan Semiconductor

64 2023-03-05 [U.S. Patents] 2021, U.S. Supreme Court, Minerva v. Hologic

65 2023-03-05 [U.S. Patents] April 2020, CAFC, Nike v. Adidas

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68 2023-03-08 [U.S. Patents] Shifting attorney fees to the losing party

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70 2023-03-10 [U.S. Patents] Paper Examples <USPTO notice of July 1, 2021>

71 2023-03-13 [Copyright] Osaka District Court, 2021 (Wa) 5086

72 2023-03-14 [U.S. Patents / Statutory Provision] Section 271(g) — Importing into the United States a product made abroad using a patented process constitutes infringement

73 2023-03-15 [U.S. Patents / Statutory Provision] Section 295

74 2023-03-16 Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor] <Sugiura>

75 2023-03-17 Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a … Ladder Circuit] — Admitting facts does not establish a judicial admission of satisfaction of a claim limitation

76 2023-03-18 IP High Court (Grand Panel), 2016 (Ne) 10046 [Elplat Case] ⇒ Petition for acceptance of final appeal not accepted

77 2023-03-20 [Germany] Düsseldorf Higher Regional Court (2009), ‘Prepaid Card’ case

78 2023-03-20 [United Kingdom] EWHC [2002], Menashe v. William Hill

79 2023-03-20 [China] Supreme People's Court judgment of May 25, 2021 <(2020) Zui Gao Fa Zhi Min Zhong No. 746>

80 2023-03-20 [Korea] Seoul Central District Court, September 7, 2007 <2006 Gahap 73442>

81 2023-03-21 IP High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

82 2023-03-22 [Contracts / Contractual Penalty] Osaka District Court, 2021 (Wa) 4467 — In this case, the penalty was valid only up to an amount equal to the damages

83 2023-03-23 Osaka District Court, 2019 (Wa) 9842 — Although ultimately rejected, the ‘defense of failure to achieve the functions and effects’ was considered!!

84 2023-03-24 ‘Trial and Appeal Practitioner Study Group Report 2022’

85 2023-03-25 [Copyright] Osaka District Court, 2022 (Wa) 2064

86 2023-03-25 Osaka District Court, 2022 (Wa) 3374 [Method of Controlling Microbial Growth] <Matsuami>

87 2023-03-27 IP High Court, 2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy…] <Honda>

88 2023-03-27 [Japan / Criminal Law] Supreme Court decisions, November 25, 2014 — 2013 (A) 574 <Shukei, No. 315, p. 187>; 2013 (A) 510 <Keishu, Vol. 68, No. 9, p. 1053>

89 2023-03-28 [Trademarks] IP High Court, 2021 (Gyo-Ke) 10079 <Kanno>

90 2023-03-29 IP High Court, 2020 (Ne) 10042 [Vehicle Guidance System] <Honda>

91 2023-03-30 [Copyright] Osaka District Court, 2020 (Wa) 9992 — ‘Original artwork claimed to be a copyrightable artistic work,’ but copyrightability denied

92 2023-03-30 [YouTube: Introducing One Case] IP High Court, 2019 (Gyo-Ke) 10159 [X-Ray Fluoroscopic Imaging Apparatus] <Kanno>

93 2023-03-31 [U.S. Patents] November 2022, AMP Plus, Inc. (d/b/a ELCO Lighting) v. DMF, Inc. <CAFC>

94 2023-04-02 [Violation of Exclusive Jurisdiction] Osaka High Court, 2022 (Ne) 1273

95 2023-04-03 Tokyo District Court, 2019 (Wa) 20074 [Heater Assembly for an Aerosol-Generating System] <Kokubu>

96 2023-04-04 [U.S. Patents] Nonstatutory Double Patenting — MPEP 804, subsection I.B.1.b)(iv)

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98 2023-04-07 [Article] 'Case Study of Technical Features of Software Inventions in European Patents' (Intellectual Property Management, January 2023 issue, First Subcommittee of the Software Committee)

99 2023-04-08 [Article] [United States] Evolving Written-Description Requirements for Functional Genus Claims and Countermeasures (Intellectual Property Management, January 2023 issue, Nao Takada)

100 2023-04-10 [Copyright] Tokyo District Court, 2019 (Wa) 8969

101 2023-04-11 [U.S. Patents] December 2022, CAFC, Google v. Hammond <Collateral estoppel>

102 2023-04-12 [Article] A Case Invalidating a Use-Invention Patent as Indistinguishable from a Known Use (Professor Hiroshi Yoshida)

103 2023-04-13 [Article] Cross-Border Patent Infringement: Two Recent Cases (Professor Yasuyuki Echi, September 2022)

104 2023-04-14 IP High Court, 2020 (Ne) 10042 [Vehicle Guidance System] <Honda> — *Reversed on appeal: claim limitations held satisfied

105 2023-04-15 [Trademarks] Tokyo District Court, 2020 (Wa) 1160 <Kokubu> — 'KENT' 'BROS.'

106 2023-04-15 Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs]

107 2023-04-17 IP High Court, 2021 (Gyo-Ke) 10085 [Printed Retroreflective Sheet] <Kanno>

108 2023-04-19 [U.S. Patents] USPTO memorandum of August 18, 2020 — Treatment of AAPA in IPR

109 2023-04-20 IP High Court, 2017 (Gyo-Ke) 10201 [Beauty Device] <Takabe>

110 2023-04-24 IP High Court, 2021 (Gyo-Ke) 10140 [Electroformed Tube Case] — *I have posted a commentary on the Nakamura & Partners website

111 2023-04-24 [U.S. Patents] June 2022, CAFC, Novartis v. Accord Healthcare

112 2023-04-24 IP High Court, 2022 (Gyo-Ke) 10019 [Die for Wire Having a Polygonal Cross Section] <Honda>

113 2023-04-24 IP High Court, 2022 (Gyo-Ke) 10027 [Tilling Claw] <Shoji> — *'Substantially constant' and 'substantially the same' ⇒ Clarity requirement satisfied

114 2023-04-25 [U.S. Patents] July 2005, CAFC en banc, Phillips v. AWH Corp.

115 2023-04-26 [Copyright] Fukuoka District Court, 2019 (Criminal Wa) 1181 <Mangamura / Criminal Case> — *The reverse-proxy configuration in this case infringed the right to make a work transmittable

116 2023-04-27 [Article] Handling License Agreements in Business Transfers, Acquisitions, and Insolvency (Intellectual Property Management, Vol. 64, No. 9, 2014)

117 2023-04-28 [Copyright / Right of Publication] Tokyo District Court, 2021 (Wa) 13720 <Kokubu>

118 2023-04-29 IP High Court, 2021 (Gyo-Ke) 10135 [Vector Containing a Stuffer/Filler Polynucleotide Sequence] <Kanno>

119 2023-04-29 ★JPO Decision 2020-015732 Recognizing Criticality [Acoustic Wave Device]

120 2023-05-01 [U.S. Patents] 2015, U.S. Supreme Court, Commil v. Cisco — Claims to non-manufacturing methods are extremely useful in the United States!

121 2023-05-02 [U.S. Patents] February 2016, CAFC, PPC Broadband v. Corning

122 2023-05-03 [U.S. Patents] March 2018, CAFC, In re Power Integrations

123 2023-05-04 [U.S. Patents] August 2022, CAFC, In re McDonald

124 2023-05-05 [Copyright] A Case Finding Inclusion of Tweets in a Book to Be Lawful Quotation under Copyright Act Article 32(1): the KuToo Case

125 2023-05-08 [Copyright] Cases Rebutting the Presumption under Article 61(2), (1): Osaka High Court decision, March 31, 2011, 'Hikonyan'

126 2023-05-08 Tokyo District Court, 1994 (Wa) 22487 [Sintered Body for High-Hardness Tools] <Mimura>

127 2023-05-08 IP High Court, 2020 (Gyo-Ke) 10146 [TDI Line Image Sensor] <Kanno>

128 2023-05-10 [Portrait Rights] Tokyo District Court, 2020 (Wa) 33192 <Nakashima>

129 2023-05-11 IP High Court, 2021 (Gyo-Ke) 10056 [Information Processing Apparatus] <Shoji> — Invention-defining features in subcombination claims

130 2023-05-12 [U.S. Trademarks / Patents and Designs] In re Reelex Packaging Solutions (CAFC, November 5, 2020)

131 2023-05-13 [U.S. Patents] Almirall v. Amneal (CAFC), March 14, 2022

132 2023-05-13 Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Takamatsu>

133 2023-05-15 Tokyo District Court, 2008 (Wa) 19874 [Medical Instrument] <Otaka>

134 2023-05-16 IP High Court, 2005 (Ne) 10125 [Cilostazol] <Sato>

135 2023-05-17 [U.S. Patents] March 2010, CAFC en banc, Ariad v. Eli Lilly

136 2023-05-17 [New YouTube Video] Overview of the Issues to Know Now Ahead of the May 26 Dwango Grand Panel Judgment

137 2023-05-19 [Article] Antitrust Assessment of Product Hopping by Pharmaceutical Companies (Naoko Mariyama, September 2017)

138 2023-05-22 [Personality Rights] Tokyo District Court, 2021 (Wa) 30051 — 'It cannot be said that peaceful daily life was disrupted'

139 2023-05-22 Tokyo District Court, 2020 (Wa) 28889 [Method for Treating an Asbestos-Containing Wall]

140 2023-05-23 Trial and Appeal Practitioner Study Group Report 2022 <Topic 1> — Takaishi's group

141 2023-05-24 Trial and Appeal Practitioner Study Group Report 2022 <Topic 2> — Clarity requirement

142 2023-05-25 Trial and Appeal Practitioner Study Group Report 2022 <Topic 3> — Inherent properties in novelty assessment

143 2023-05-26 Trial and Appeal Practitioner Study Group Report 2022 <Topic 4> — Inventive step where the difference concerns …game rules…

144 2023-05-26 IP High Court, 2022 (Ne) 10046, 'Dwango Grand Panel Judgment' — Patentee (Dwango) wins on reversal!!

145 2023-05-27 [Trademarks] Trial and Appeal Practitioner Study Group Report 2022 <Topic 5> — Assessment of similarity of composite trademarks

146 2023-06-02 IP High Court, 2022 (Ne) 10093 [Use of Eribulin in Treating Breast Cancer] <Otaka>

147 2023-06-02 'Suspension of Examination of Divisional Applications'

148 2023-06-02 'Relaxation of Restoration Requirements under Relief Provisions after Expiration of a Time Limit'

149 2023-06-05 IP High Court, 2021 (Gyo-Ke) 10136 [Soldering Apparatus] <Honda>

150 2023-06-05 [U.S. Patents] May 2023, U.S. Supreme Court, Amgen v. Sanofi ⇒ Enablement requirement not satisfied

151 2023-06-05 IP High Court, 2019 (Ne) 10007 [Apparatus Displaying a … Ladder Circuit] <Kanno>

152 2023-06-07 [Trademarks] IP High Court, 2022 (Gyo-Ke) 10023 [Vegas Vegas Case]

153 2023-06-07 Tokyo District Court, 2020 (Wa) 29897 <Kokubu> — 'Claim for Remuneration for an Employee Invention'

154 2023-06-08 IP High Court, 2022 (Gyo-Ke) 10030 [Laminate of a Polyester Resin Composition] <Kanno>

155 2023-06-09 IP High Court, 2022 (Gyo-Ke) 10037 [Air-Outlet Adjustment Mechanism for Air-Conditioned Clothing] <Honda>

156 2023-06-10 IP High Court, 2016 (Gyo-Ke) 10152 [Charge Control Agent] <Mori>

157 2023-06-10 [Trademarks] IP High Court, 2021 (Gyo-Ke) 10087 (Cancellation for Nonuse) — 'I R O PARIS'

158 2023-06-12 Tokyo High Court, 1999 (Gyo-Ke) 230 [Guide for Magnetic Tape] <Yamashita>

159 2023-06-13 IP High Court, 2021 (Gyo-Ke) 10093, 'Antigen-Binding Proteins against PCSK9,' Second Judgment (Regeneron) <Kanno>

160 2023-06-14 IP High Court, 2021 (Gyo-Ke) No. 10140 [Electroformed Tube Case] <Kanno> — PBP claim fails the clarity requirement

161 2023-06-15 IP High Court, 2021 (Gyo-Ke) 10096 [Light Source] <Honda>

162 2023-06-16 [Trademarks] IP High Court, 2022 (Gyo-Ke) 10002 <Shoji>

163 2023-06-17 Osaka District Court, 2005 (Wa) 10821 [Cart Securing Device]

164 2023-06-17 IP High Court, 2021 (Gyo-Ke) 10144 [Dot Pattern] <Kanno>

165 2023-06-19 [Copyright / Provider Liability] IP High Court, 2022 (Ne) 10019 — Claim for disclosure of sender information

166 2023-06-20 [Unfair Competition Prevention Act, Article 2(1)(iii)] Tokyo District Court, 2021 (Wa) 3418 <Kokubu> — 'Date first sold'

167 2023-06-22 [Article / Designs] 'Considerations on Assessing Creative Difficulty' (Patent Attorney Masato Sasaki) (Patent, 2021, Vol. 74, No. 3)

168 2023-06-22 [Article] 'Novelty and Effects of Use Inventions' (Patent, March 2021) (Former Judge Shigeru Osuga)

169 2023-06-23 [Article] Examples of Strategic Use of Divisional Applications (Patent Attorney Mamoru Suzuki and Attorney Tomoaki Yasui) (Patent, 2020, Vol. 73, No. 1)

170 2023-06-24 [Trademarks / Article] Current State of Actions to Revoke JPO Decisions on Color-Only Trademarks (Masahiko Otsuka) (Patent, 2021, Vol. 74, No. 4)

171 2023-06-25 [Article / General] 'My Bookshelf (Books Useful for Patent Practice and Japanese-Language Information Sources)' — Corporate Legal Affairs A to Z, June 2023

172 2023-06-26 IP High Court, 2022 (Gyo-Ke) 10092 [Program] <Shoji> — Intermediate generalization held not to add new matter

173 2023-06-27 IP High Court, 2022 (Gyo-Ke) 10009 [Gas Fire-Extinguishing Equipment] <Otaka>

174 2023-06-28 [Article] Settlement of Pharmaceutical Patent Disputes and Antitrust Law (Naoko Mariyama, September 2021)

175 2023-06-29 IP High Court, 2021 (Gyo-Ke) 10027 [Information Providing Apparatus] <Otaka>

176 2023-06-30 IP High Court, 2016 (Ne) 10093 [Cosmetic for … Skin Care] <Shimizu>

177 2023-06-30 [Trademarks] IP High Court, 2022 (Gyo-Ke) 10122 <Honda> — 'Sakuhoku Curry' case

IP High Court, 2020 (Gyo-Ke) 10089 [… Child … Seat] <Shoji>

Original Ameblo publication: 2023-01-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12782248249.html

2020 (Gyo-Ke) 10089 […Child … Seat] <Shoji>

*Claim language is interpreted according to its ordinary meaning unless the specification/drawings define or explain it in a meaning different from the ordinary one.

⇒ The JPO decision's claim construction, treating it as a ‘distinct structural element added further to those elements,’ was erroneous.

⇒ Inventive step: not satisfied

(Excerpt from the court's reasoning)

The gist of an invention should be identified on the basis of the claims, and it is appropriate to interpret the language of the claims according to its ordinary meaning, taking into account the common general technical knowledge in the relevant technical field before the priority date. Admittedly, if the specification or drawings define or explain the meaning of the claim language as differing from its ordinary meaning, there may be room to interpret it differently from its ordinary meaning. In the absence of such a definition or explanation, however, the interpretation set out above is appropriate.

…The invention at issue does not specify that the support member is located only inside the seat shell or does not cover the sides or back of the seat shell, nor does it specify that the support member has a skeletal structure separate from the seat shell; paragraph [0031] of the specification likewise contains no such statement. …No basis can be found for adopting the JPO decision's interpretation that it is … a structural element distinct from, and additionally provided beyond, the ‘seat shell’ and ‘flexible material supporting the child’ in the prior art (common general technical knowledge)….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90833.pdf

IP High Court, 2018 (Ne) 10034 [Solenoid] <Kanno> — Reversed on appeal: claim limitations held satisfied

Original Ameblo publication: 2023-01-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12782413373.html

2018 (Ne) 10034 [Solenoid] <Kanno>

The claim construction concerning whether ‘sealing’ must be achieved by the end member itself was changed, and the patentee won a reversal!!

⇒ The limitation is satisfied because the effect is achieved in combination with the O-ring.

Over 70% of appellate reversals involve a change in claim construction.

The outcome depended on which paragraphs of the detailed description of the invention were emphasized.

⇒ The patentee prevailed on reversal in the appellate court (first-instance case: 2017 (Wa) 3569).

*The interpretation of ‘sealing fit’ was at issue both at first instance and on appeal.

⇒ The outcomes were opposite.

[Claim 1] A solenoid characterized by the provision of … an end member made of a corrosion-resistant material that is fitted sealingly into a mounting hole to close the opening of that mounting hole….

(Excerpt from the court's reasoning) …The language of the claims does not necessarily unambiguously specify how tightly mechanical parts must be ‘fitted’ so as to ‘seal tightly’ in order to constitute the ‘sealing fit’ in the invention at issue. Looking therefore to the specification to interpret the term, the specification states: ‘characterized by comprising an end member made of a corrosion-resistant material that is fitted sealingly into the mounting hole to close its opening’ (paragraph [0015]); and ‘As a result, the members of the solenoid housed inside the mounting hole that are farther inward than the end member are not exposed to the outside, and the entry of the external atmosphere (fluids such as moisture or water) is inhibited by the end member, making it possible to improve corrosion resistance in the state assembled to the mating housing member’ (paragraph [0016]). In light of these statements in the specification, …‘sealing’ in ‘sealing fit’ refers to a degree sufficient to ‘inhibit’ the entry of the external atmosphere (fluids such as moisture or water)…. …The invention also includes the defining feature ‘a sealing member arranged between the mounting hole and the end member to inhibit the entry of the external atmosphere’ (…). The specification states: ‘It is also preferable to provide a sealing member between the mounting hole and the end member. This further inhibits the entry of the external atmosphere’ ([0019]). Thus, the ‘sealing member arranged between the mounting hole and the end member’ in the invention can likewise be described as a member provided to further inhibit the entry of the external atmosphere. Accordingly, the effect of the invention—improved corrosion resistance of the solenoid—is understood to result … from the two components that inhibit the entry of the external atmosphere: (i) … the end member and (ii) … the sealing member. There is therefore no reason to adopt a restrictive interpretation requiring the ‘end member’ alone to completely prevent the entry of the external atmosphere.

It is undisputed between the parties that the defendant's product … has a sealing member at the outer end of the plate and has … a configuration that, when housed in the mounting hole, seals the space between the body and the mounting hole to inhibit the entry of outside air, moisture, and the like….

According to the results of the experiments in Exhibits Otsu 1, Otsu 14, Ko 49, Ko 58, Otsu 19, and Otsu 20, the defendant's product, which has an end member and a sealing member (O-ring), completely prevents the inflow of the external atmosphere (moisture, water, and the like). The defendant's product therefore inhibits the inflow of the external atmosphere by fitting the end member (H) into the opening on the upper

side of the body; by additionally having the sealing member, it seals the space between the body and the mounting hole and further inhibits that inflow. Consequently, the defendant's product also satisfies … the wording ‘“sealing” fit’….

https://t.co/LnO9Icmsiv

[Patents] Divisional applications — Where the child application violates the divisional requirements/adds new matter, the grandchild's filing date does not relate back to the parent's!

Original Ameblo publication: 2023-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12782564506.html

[Patents] When divisional applications are filed in a parent–child–grandchild… chain, if the child application unlawfully violates the divisional requirements/adds new matter, the grandchild's filing date does not relate back to the parent's filing date!

An amendment to the child application has retroactive effect, and its content can change whether the division is proper. If a defect arising from added matter remains uncorrected, the grandchild application cannot benefit from the parent application’s filing date.

Comparison of the requirements for division and amendment regarding added matter ⇒ The cases apply the same standard.

Final rejection of the child application, final invalidation of the resulting patent, or withdrawal of the child application does not, by itself, render an otherwise proper grandchild divisional application improper.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e5%af%a9%e6%b1%ba%e5%8f%96%e6%b6%88%e8%ab%8b%e6%b1%82%e4%ba%8b%e4%bb%b6%ef%bc%88%e8%a6%aa%e3%83%bb%e5%ad%90%e3%83%bb%e5%ad%ab%e3%81%a8/

[United States] Georgetown Rail v. Holland — Preambles and limitations on claim scope

Original Ameblo publication: 2023-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12782571634.html

[U.S. Patents] August 2017, CAFC, Georgetown Rail v. Holland

For the product invention at issue, the court held that the preamble did not limit the scope of rights, while identifying five circumstances in which a preamble may be limiting. (‘Mounted on a vehicle for movement along the railroad track’ describes a principal use of the invention and is not a structural limitation.)

(1) Where the preamble recites essential structure (essential components) or steps.

(2) Where the claim relies on the disputed preamble wording as an antecedent basis.

(3) Where the preamble is necessary (essential) to understand limitations or terms in the body of the claim.

(4) Where the preamble recites additional structure or steps emphasized in the specification as important.

(5) Where the preamble was expressly relied upon during prosecution to distinguish the claimed invention from the prior art.

<Reference> August 2021, CAFC, Eli Lilly v. Teva

In contrast to claims to apparatuses or compositions, methods of using apparatuses or compositions are not directed to what the method ‘is,’ but ordinarily depend entirely on what the method ‘does.’ What a method does is ordinarily stated in its preamble, and the purpose of a method of use therefore tends to be construed as limited by the preamble.

(*In the United States too, method inventions may be construed as limited by the preamble.)

https://www.itohpat.co.jp/ip/38/

IP High Court, 2005 (Gyo-Ke) 10608 <Shinohara> — Correction requirements for a ‘disclaimer claim’

Original Ameblo publication: 2023-01-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12782879391.html

2005 (Gyo-Ke) 10608 <Shinohara> — Correction requirements for a ‘disclaimer claim’

⇒ The correction did not exclude an overlap, and there was no allegation or proof that the technical concept differed markedly from the prior art.

⇒ Correction requirements: not satisfied

‘Leaving aside whether it is appropriate to treat a correction excluding overlap with prior art … as being within the scope of the matters described in the specification…’

(Excerpt from the court's reasoning)

…Leaving aside whether it is appropriate to treat a correction excluding overlap with prior art as a so-called ‘disclaimer claim’ falling within the matters described in the specification, …the correction at issue states, concerning aluminum in an iron-based material, that it ‘does not contain aluminum in an amount exceeding the amount contained as an unavoidable impurity.’ However, …even taking into account not only the description in the patent specification but also the common general technical knowledge of a person skilled in the art at the filing date…, it cannot be found clear what quantity is meant by ‘an amount exceeding the amount contained as an unavoidable impurity.’ It therefore cannot readily be found that the correction excludes the overlap with the cited invention, which contains ‘0.03–0.1% (preferably 0.03–0.07%) aluminum.’ Furthermore, according to …the common general technical knowledge of a person skilled in the art that aluminum added as a deoxidizer is sometimes also called an unavoidable impurity, published unexamined patent applications and other prior-art documents contain statements to the effect that, where aluminum is added as a deoxidizer, its proportion is limited to 0.1 percent or less because of its effect on the properties of the final product…. Thus, a case in which an iron-based material contains 0.03–0.1 percent aluminum, as in the cited reference, can also be described as a case that ‘does not contain aluminum in an amount exceeding the amount contained as an unavoidable impurity.’ In this respect too, the correction does not remove the overlap between the cited invention and Invention 1 at issue. Accordingly, since the correction cannot be found to remove the overlap between the cited invention and Invention 1 concerning aluminum content in an iron-based material, the plaintiff's argument, which presupposes that the overlap is removed, lacks its very premise…. …

…The foregoing treatment of so-called ‘disclaimer claims,’ as stated in …the Examination Guidelines…, is said to be permissible where an invention differs markedly in technical concept from the prior art and inherently involves an inventive step, but happens to overlap with that prior art. It is understood to be permissible for inventions whose technical concept differs markedly from the prior art irrespective of whether an amendment is made. In this case, limiting the aluminum content of the iron-based material as in the correction is a matter not described in the patent specification, nor can such a limitation be said to be self-evident from that specification…. Therefore, to argue that the correction is lawful under the foregoing treatment, the plaintiff must allege and prove, concerning Invention 1—which is understood to have no limitation on the aluminum content of the iron-based material—that its technical concept differs markedly from the cited prior-art invention and that it inherently involves an inventive step. The plaintiff, however, merely argues that the technical concept of an invention whose iron-based material ‘does not contain aluminum in an amount exceeding the amount contained as an unavoidable impurity’ differs from that of the cited invention. The plaintiff's argument is therefore without merit in this respect as well.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33236.pdf

IP High Court, 2005 (Gyo-Ke) 10143 [Filter Substrate] <Nakano> — *Clarity requirement concerning the measurement method: not satisfied

Original Ameblo publication: 2023-01-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783037318.html

2005 (Gyo-Ke) 10143 [Filter Substrate] <Nakano>

*Clarity requirement concerning the measurement method: not satisfied

⇒ Conditions and the like enabling measurement to the number of significant digits treated as meaningful in the specification must be stated.

—Values to the third decimal place are meaningful, but the value at that third decimal place cannot be identified accurately.

=2001 (Gyo-Ke) 209 (enablement requirement: not satisfied)

(Excerpt from the court's reasoning)

…The value of ‘Y/X^2’ defined in the claims … is meaningful to the third decimal place. If, when determining the ‘Y/X^2’ value of a sample, measurement error appears at the third decimal place, a situation arises in which it is impossible to determine whether that sample falls within the claims…. Therefore, the value of ‘Y/X^2’ must be accurately identifiable to the third decimal place…. As explained above, despite the significance of the value of ‘Y/X^2’ to the third decimal place, the value at that decimal place cannot be accurately identified. The feature ‘$Y/X^2 \geq 0.03$’ therefore cannot clearly express the technical scope of the invention at issue. In this respect, the claims in the specification must be regarded as unclear, and cannot be said to recite only matters indispensable to the configuration of the invention. Accordingly, the specification does not satisfy the requirements prescribed in Article 36(5)(ii) of the Act….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9353.pdf

Tokyo High Court, 2001 (Gyo-Ke) 209 [Cleaning Blade for an Electrophotographic Copying Machine] — Enablement requirement concerning the measurement method: not satisfied

Original Ameblo publication: 2023-01-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783037437.html

2001 (Gyo-Ke) 209 [Cleaning Blade for an Electrophotographic Copying Machine]

Enablement requirement concerning the measurement method: not satisfied

⇒ Conditions and the like enabling measurement to the number of significant digits treated as meaningful in the specification must be stated.

It was understood that the ratio would vary with the type and number of columns used.

=2005 (Gyo-Ke) 10143 (clarity requirement: not satisfied)

(Claim after correction) A cleaning blade for an electrophotographic copying machine, characterized by being made of urethane rubber obtained by reacting polyisocyanate with a polyol having a molecular-weight distribution whose ratio of weight-average molecular weight (Mw) to number-average molecular weight (Mn), Mw/Mn, is 2 or less as measured by the GPC method.

(Excerpt from the court's reasoning)

…Focusing on the numerical value of the ratio (Mw/Mn), the first decimal place is treated as significant. Moreover, FT5, with a value of 2.0, is presented as a working example of the invention before correction, while FT11, with a value of 2.1, is presented as a comparative example; the comparison between these two values, differing by ‘1’ in the first decimal place, is intended to substantiate the effect described above. The original specification therefore treats values of the ratio (Mw/Mn) to the first decimal place as meaningful.

According to the … statements in Exhibit Ko 4, when that publication was issued in 1968, …it was generally understood that even when using the same GPC method, the ratio (Mw/Mn) would differ if the type or number of columns used differed. …At the time of publication of Exhibit Ko 4, namely before the application at issue, it was generally known that, when calculating the ratio (Mw/Mn) indicating molecular-weight distribution, a value significant to the first decimal place could not be obtained unless the method of determining it was specified. Further, …it can be inferred that this situation continued to exist at the filing date.

…Ultimately, the original specification does not describe how to obtain a polyol with a ratio (Mw/Mn) of 2 or less (treating the first decimal place as significant), and a person skilled in the art cannot understand what polyol to use as a raw material for the invention. Accordingly, the original specification cannot be found to describe the configuration of the invention sufficiently for a person skilled in the art to readily work the invention before correction.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11245.pdf

Tokyo District Court, 2018 (Wa) 17586 et al. [Pharmaceutical] (Kowa v. Towa Pharmaceutical) — Second judgment (the patentee loses in the later damages action)

Original Ameblo publication: 2023-01-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783380657.html

Tokyo District Court, 2018 (Wa) 17586, 2019 (Wa) 7191, 2020 (Wa) 7989, 2021 (Wa) 8097 <Shibata>

[Pharmaceutical] (Kowa v. Towa Pharmaceutical)

The patentee prevailed in the preceding injunction action (2017 (Ne) 10090 <Takabe>) (prior-use right not established).

⇒ The damages action (this case): violation of the support requirement

*The problem addressed by the invention was redefined using specific numerical values.

⇒ Without crystalline cellulose, achievement of the problem's solution cannot be recognized.

(On appeal, inventive step was denied.)

(Excerpt from the court's reasoning)

…The problem addressed by the inventions at issue is to provide a pharmaceutical product in which the rate of formation of the lactone form is suppressed. Solving that problem means, on the premise that these are inventions providing a pharmaceutical product, that lowering the moisture content to the fixed threshold of '2.9 mass% or less' suppresses the rate of formation of the lactone form (after two months at 40°C and 75% RH) to no more than some value between 0.23% and 0.35%….

…For the orally disintegrating tablets manufactured according to Formulation Example 1, it can be said that the specification describes how reducing the moisture content of the solid formulation to 2.9 mass% or less sufficiently suppresses the formation of the lactone form, thereby solving the problem addressed by the inventions.

On the other hand, the specification contains only the above working example as a working example of the inventions. It contains no working example showing the rate of formation of the lactone form when the moisture content of the solid formulation is reduced to 2.9 mass% or less for a pharmaceutical product of the inventions having a formulation other than the orally disintegrating tablets manufactured according to Formulation Example 1 in Table 2.

…The crystalline cellulose contained in the orally disintegrating tablets manufactured according to Formulation Example 1 may have contributed to the stability of pitavastatin calcium…. In addition, the specification does not describe the specific mechanism by which reducing the moisture content of the solid formulation to 2.9 mass% or less suppresses the formation of the lactone form…. Nor does it contain a working example showing the rate of formation of the lactone form when the moisture content is reduced to 2.9 mass% or less in a formulation other than the orally disintegrating tablets manufactured according to Formulation Example 1 in Table 2. There is also no common general technical knowledge that a pharmaceutical product with a suppressed rate of lactone formation can be provided using a formulation obtained by removing crystalline cellulose from the orally disintegrating tablets manufactured according to Formulation Example 1.

Taken together, these matters mean that, from the specification, a person skilled in the art cannot recognize that reducing the moisture content of the solid formulation to 2.9 mass% or less can provide, in a formulation excluding crystalline cellulose, a pharmaceutical product in which the rate of formation of the lactone form (after two months at 40°C and 75% RH) is suppressed to no more than some value between 0.23% and 0.35%. It must therefore be said that a person skilled in the art cannot recognize that the problem addressed by the inventions can be solved.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91417.pdf

IP High Court, 2022 (Ne) 10052 <Honda> [Pharmaceutical] (Kowa v. Towa Pharmaceutical) — *Patentee prevailed in the preceding injunction action

Original Ameblo publication: 2023-01-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783549296.html

2022 (Ne) 10052 <Honda> [Pharmaceutical] (Kowa v. Towa Pharmaceutical)

*The patentee prevailed in the preceding injunction action.

2017 (Ne) 10090 <Takabe>: prior-use right not established

⇒ This case: inventive step not satisfied

*The judgment below found the support requirement not satisfied.

‘…cannot be found to be an essential feature of the Exhibit Otsu 12 invention. …There is no …factor teaching away from changing it.’

(Excerpt from the court's reasoning)

…The appellant argues that the Exhibit Otsu 12 invention necessarily has ‘a configuration coated with a layer of a material containing polyvinyl alcohol or a cellulose derivative as a film-forming agent,’ and that replacing this with …another coating is not contemplated; consequently, there is a factor teaching away from replacing that essential feature with the configuration of Corrected Invention 6 corresponding to Difference 2.

However, …an appropriate ‘film-forming agent’ for the Exhibit Otsu 12 invention is first understood to mean any agent applied as a coating to a core of a pharmaceutical dosage form containing particles or active substances (sensitive to environmental effects), which protects the active substances against environmental effects (such as oxidation and/or ambient humidity). The most preferable ‘film-forming agent’ is any agent protecting the active substances against oxidation. It is then natural to understand that, among those possible ‘film-forming agents,’ suitable ones are selected from the group consisting of polyvinyl alcohol (PVA) and cellulose derivatives. Accordingly, ‘a configuration coated with a layer of a material containing polyvinyl alcohol or a cellulose derivative as a film-forming agent’ cannot be found to be an essential feature of the Exhibit Otsu 12 invention. It therefore cannot be said that any factor teaches away from replacing that configuration with the configuration of Corrected Invention 6 corresponding to Difference 2.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91429.pdf

Tokyo District Court, 2008 (Wa) 38602 [Wireless Access Communication System] <Shoji> — Support and enablement requirements: not satisfied

Original Ameblo publication: 2023-01-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783714900.html

2008 (Wa) 38602 [Wireless Access Communication System] <Shoji>

Not described in the detailed description of the invention

⇒ Support requirement: not satisfied

‘The portion of the invention … construed as … concerns matters not stated in the detailed description of the invention in the specification, etc., and …does not fall within a range in which the problem addressed by the invention can be recognized as solvable….’

⇒ Enablement requirement: not satisfied

The invention must be capable of being worked so as to achieve its functions and effects.

(Excerpt from the court's reasoning)

…The time control described in the original specification, etc. means controlling the time of transmission from a processor to a vocoder within the internal configuration of a switching system. There is no statement or suggestion whatsoever concerning control of the ‘time’ of ‘transmission’ from the ‘exit’ of the ‘switching system’…. …The part of the invention … construed as ‘means for controlling the time at which the exit of the switching system transmits incoming traffic, such that a packet carrying the incoming traffic is received at the entrance of the switching system within a predetermined window time before the time at which it is transmitted from the exit of the switching system’ …concerns matters not stated in the detailed description of the invention in the specification, etc. Nor does it fall within a range in which a person skilled in the art can recognize, on the basis of that detailed description, that the problem addressed by the invention can be solved. Nor, even in the absence of such a statement or suggestion, can it be said to fall within a range in which a person skilled in the art can recognize that the problem can be solved in light of the common general technical knowledge at the filing date….

…To satisfy the enablement requirement, the description must be sufficient for a person skilled in the art, in light of the common general technical knowledge at the filing date, to understand the invention accurately and reproduce it without excessive trial and error. It is appropriate to construe the requirement as also requiring that the intended functions and effects can thereby be achieved….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83253.pdf

[Copyright] Tokyo District Court, 2021 (Wa) 1333 <Tanaka> — Conduct found to aid infringement of the right of public transmission

Original Ameblo publication: 2023-01-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12783875638.html

[Copyright] 2021 (Wa) 1333 <Tanaka>

Soliciting advertisers for the online pirate site Mangamura, arranging the placement of advertisements, and paying advertising fees to the site's operators were held to constitute aiding the infringement of the right of public transmission. (It was not the advertisers themselves who were held to have aided the infringement.)

⇒ One reason given was that advertising fees were virtually the only source of funding.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90901.pdf

Osaka District Court, 2020 (Wa) 3247, 8842 — Filing the lawsuit held to constitute a tort!!

Original Ameblo publication: 2023-01-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784046662.html

Osaka District Court, 2020 (Wa) 3247, 8842

‘The filing of a lawsuit can be considered …an unlawful act only where …it lacks a factual and legal basis and …the lawsuit was nevertheless deliberately filed even though an ordinary person could readily have known that fact, or similar circumstances make filing the lawsuit manifestly inappropriate in light of the purpose and objectives of the judicial system.’

⇒ Tort established!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90580.pdf

Nakamura & Partners website — ‘IP Mix: Multifaceted Protection and Enforcement through Multiple Intellectual Property Rights’

Original Ameblo publication: 2023-01-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784240020.html

An article entitled ‘IP Mix: Multifaceted Protection and Enforcement through Multiple Intellectual Property Rights’ has been published on the Nakamura & Partners website.

In particular, where the functional features of a creation can be depicted as structure, that function is readily recognized as an essential part of the design. Dual protection by patents and design rights is therefore possible and highly effective.

https://www.nakapat.gr.jp/ja/practices-details/ip-mix/

IP High Court, 2021 (Gyo-Ke) 10137 [Working Machine] <Shoji> — *Not recognizable from the external appearance of the publicly worked product ⇛ Novelty upheld

Original Ameblo publication: 2023-01-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784240688.html

2021 (Gyo-Ke) 10137 [Working Machine] <Shoji>

‘Exhibition’ (attendees were allowed to touch the machine)

⇒ Claim elements not recognizable from the external appearance of the publicly worked product were not disclosed. Novelty upheld.

*Reproduction experiment: not reliable

*Blog by an exhibition attendee: insufficient recognition

Is the framework that novelty would be denied if a person skilled in the art could recognize the feature by touching the machine?

(Excerpt from the court's reasoning)

The plaintiff argues that a person skilled in the art who saw Inspection Exhibit Ko 1—which has the same structure as the working machine of the invention (except that the gas spring is oriented in the opposite direction)—at the exhibition could recognize the theoretical explanation of Claim Element G from common general knowledge of mechanics. The plaintiff further argues that Inspection Exhibit Ko 1 possesses Claim Element G because that element can be recognized by looking at Inspection Exhibit Ko 1…. However, …in light of the …relationship between the force (Fs) required to flip up the apron and the angle of the apron, … whether the machine has the configuration recited in Claim Element G, namely that ‘the force required to flip up the apron gradually decreases within a predetermined angular range as the apron angle increases,’ depends on the characteristics of the ‘gas spring’ used in the assist mechanism (the relationship between stroke length and gas reaction force, etc.). It is not something that can be recognized from external appearance alone…. …

Exhibit Ko 103 shows results measured …after this action was brought, and cannot be found to show the condition of Inspection Exhibit Ko 1 at the exhibition held …approximately six and a half years earlier…. …The measurement results in Exhibit Ko 103 are inconsistent with the behavior of the working machine filmed in Exhibit Ko 106-2, and those results cannot be regarded as reliable….

…A …blog …approximately two months after the exhibition states: ‘It seems …to make it easy to lift the leveling plate that cannot be lifted because the spring is too stiff.’ …However, while these statements suggest that the assist mechanism was configured to reduce the force required to lift the leveling plate, they cannot be regarded as describing an experience that ‘the force required to flip up the apron gradually decreases within a predetermined angular range as the apron angle increases.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91384.pdf

August 2019, CAFC, Iridescent Networks v. AT&T — Prosecution history of the parent application

Original Ameblo publication: 2023-01-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784523168.html

August 2019, CAFC, Iridescent Networks v. AT&T

Opinions expressed in the prosecution history of a parent application affect claim construction in a continuation application where they relate to the patent claims of the continuation application.

An argument concerning the enablement requirement resulted in narrowing the claim scope.

https://openlegalcommunity.com/enablement-argument-narrowed-claim-scope/

[Trademarks] IP High Court, 2019 (Gyo-Ke) 10078 ‘AROMA ZONE’ — Domestic use/display even where the transfer occurs abroad

Original Ameblo publication: 2023-01-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784525326.html

[Trademarks] 2019 (Gyo-Ke) 10078 ‘AROMA ZONE’ <Tsuruoka>

Although the trademark owner transferred the goods to a French retailer abroad, use in Japan was recognized on the basis of the owner’s knowledge that the goods would be sold to Japanese consumers and the retailer’s sales and displays directed to Japan!!

<Keywords>

‘An online shop operated by A, a Japanese national residing in France

Japanese language

Sales of goods directed to Japan

Japanese yen

Awareness that the goods would be sold to consumers in Japan’

(Excerpt from the court's reasoning)

‘L'Ange Bio is an online shop operated by A, a Japanese national residing in France. It operates in Japanese and sells goods to Japan. …During the period for which proof of use is required …L'Ange Bio's webpage listed the plaintiff's bottles and glass containers as goods for sale, with prices stated in Japanese yen.

…It can be inferred that the plaintiff transferred the goods for which use must be proved to L'Ange Bio bearing the trademark at issue, knowing that they would be sold to consumers in Japan, and that L'Ange Bio transferred the goods on which use is at issue to Japanese consumers, bearing the trademark, during the relevant period. At the very least, it is clear that L'Ange Bio displayed them for transfer.

On these facts, the trademark can be assessed as having been used within Japan during the relevant period, by the plaintiff as trademark owner, on the goods for which use must be proved.’

⇒ The foreign transfer, the owner’s knowledge of intended sales to Japanese consumers, and the sales and displays directed to Japan together supported the finding of “use in Japan.”

⇒ A useful judgment when considering whether the reasoning on ‘providing a program’ in the IP High Court's judgment in the earlier Dwango case also extends to tangible goods.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89219.pdf

[U.S. Patents] March 2020, CAFC, Comcast v. ITC — Section 337 of the U.S. Tariff Act

Original Ameblo publication: 2023-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784689407.html

[U.S. Patents] March 2020, CAFC, Comcast v. ITC

Section 337 of the U.S. Tariff Act also reaches products that do not satisfy the claim limitations when imported but do so when customers use them after importation, where, as in this case, the customers' post-importation infringement was induced.

(Direct infringement occurs when Comcast's customers use the X1 system.)

https://t.co/2KsoB6daWf

May 2019, U.S. Supreme Court, Mission Product v. Tempnology

Original Ameblo publication: 2023-01-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12784888492.html

May 2019, U.S. Supreme Court, Mission Product v. Tempnology

Even where a trademark licensor goes bankrupt and rejects performance of an executory contract under Section 365(a) of the U.S. Bankruptcy Code, the licensee was permitted to continue using the trademark (under the license).

The issue arose because trademarks are not included in the definition of “intellectual property” in Section 101(35A) of the U.S. Bankruptcy Code, which applies to Section 365(n).

https://system.jpaa.or.jp/patent/viewPdf/3468

[Chinese Case Law] Supreme People's Court (2020) Zui Gao Fa Zhi Min Zhong No. 621 (judgment dated December 18, 2021)

Original Ameblo publication: 2023-01-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12785161970.html

[Chinese Case Law] Supreme People's Court (2020) Zui Gao Fa Zhi Min Zhong No. 621 (judgment dated December 18, 2021)

In this case, after the confidentiality period ends, the licensee may itself use the know-how at issue but may not allow third parties to use it. The licensee continues to owe a general duty to refrain from infringement under tort law and a confidentiality obligation incidental to the contract based on good faith.

⇒ Also instructive under Japanese law.

https://kyk-ip.com/2022/03/01/%E3%80%90%E4%B8%AD%E5%9B%BD%E3%80%91%E3%80%8C%E6%9C%80%E9%AB%98%E4%BA%BA%E6%B0%91%E6%B3%95%E9%99%A2%E7%9F%A5%E7%9A%84%E8%B2%A1%E7%94%A3%E6%A8%A9%E8%A3%81%E5%88%A4%E6%89%80%E8%A3%81%E5%88%A4%E8%A6%81/

August 2022, CAFC, In re McDonald <Recapture rule>

Original Ameblo publication: 2023-01-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12785373094.html

August 2022, CAFC, In re McDonald

<Recapture rule> When broadening claim scope through reissue, a patentee cannot recapture subject matter intentionally surrendered during prosecution to obtain the original patent claims.

⇒ The recapture rule applies to amendments made to overcome Section 101 as well as Sections 102 and 103.

https://patent-law.hatenablog.com/entry/2022/08/12/020827

[Unfair Competition Prevention Act] Tokyo District Court, 2020 (Wa) 19889

Original Ameblo publication: 2023-01-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12785636153.html

[Unfair Competition Prevention Act] 2020 (Wa) 19889

‘The plaintiff …dispatched engineers engaged in system development, and the defendant company paid the fees for that outsourced work, so the two companies can be said to have been on good terms at the time. … It cannot be found that the statement “group company (softusing Co., Ltd.)” in the email at issue was false, and there is no other evidence sufficient to establish that it was false.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90987.pdf

IP High Court, 2021 (Gyo-Ke) 10157, 10155 [Agent for Treating Movement Disorders] <Honda> — *Limiting the patient population supported inventive step

Original Ameblo publication: 2023-01-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12785805522.html

2021 (Gyo-Ke) 10157, 10155 [Agent for Treating Movement Disorders] <Honda>

*Although the active ingredient and disease were the same, novelty and inventive step were recognized by limiting the patient population!!

<Common features>

Active ingredient

Directed to animals with Parkinson's disease

Used in combination with L-dopa

<Difference 1>

The invention at issue

Targets '…patients who have reached a stage of exhibiting wearing-off phenomena and/or on-off fluctuations';

Is '…administered to those patients to reduce the off time of wearing-off phenomena and/or on-off fluctuations'; and

Is administered in '…L-dopa therapy.'

Cf. This requires consideration alongside 2021 (Gyo-Ke) 10066 and 2022 (Ne) 10065 <Shoji>, which denied novelty despite limiting the target anatomical site (for fracture suppression) (to the forearm).

⇒ The key is whether, at the priority date, a person skilled in the art could have recognized that the conventional pharmaceutical product was effective for that 'patient population' or 'anatomical site'!!

(Excerpt from the court's reasoning)

A person skilled in the art at the priority date cannot be found to have readily conceived, on the basis of Exhibit Ko A1, …of using KW-6002 for the use (method of use) of the invention corresponding to Difference 1. …None of Exhibits Ko A2 through Ko A5 discloses or suggests the configuration of the invention corresponding to Difference 1 (the configuration in which 'the agent' is administered 'in the L-dopa therapy' 'to reduce the off time of wearing-off phenomena and/or on-off fluctuations in the L-dopa therapy')…. …

Plaintiff Towa argues that a person skilled in the art encountering Exhibit Ko A1 could readily have conceived of the configuration of the invention corresponding to Difference 1, on the following grounds: (i) at the priority date, wearing-off was recognized as a phenomenon in which the duration of L-dopa's efficacy shortened, caused by an abnormality in the dopaminergic system; and (ii) at the priority date, it was widely known that KW-6002's mechanism of action was not dopaminergic like that of L-dopa and the like, but was based on a different mechanism. However, as to (i), …a person skilled in the art at the priority date recognized that, in addition to reduced dopamine-retention capacity of dopamine neurons and reduced dopamine-receptor sensitivity, presynaptic and postsynaptic events caused by continuous administration of L-dopa could also be important causes of wearing-off phenomena and on-off fluctuations. It therefore cannot be said …that such a person recognized wearing-off as caused exclusively by abnormalities of the

dopaminergic system. As to (ii), …the results show that, although there was no clear recovery from movement disorders 24 hours after administering KW-6002 alone, …when L-dopa was administered 24 hours after KW-6002, the action of L-dopa was enhanced six hours later. It is therefore difficult to imagine …that a person skilled in the art would understand KW-6002 to exert an independent action unrelated to the neural circuitry involved in L-dopa's action. Accordingly, it cannot be said that a person skilled in the art recognized the mechanism of KW-6002 in Exhibit Ko A1 as non-dopaminergic, unlike L-dopa and the like, and based on a different mechanism.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91684.pdf

IP High Court, 2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe> — Unclear how far numerical values should be changed ⇛ Inventive step upheld

Original Ameblo publication: 2023-01-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12785954714.html

2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe>

<JPO decision>

Because it is an existing product already optimized for its function, a commensurate motivation is needed to change it.

⇒ Inventive step upheld

<This judgment>

There is motivation to move the numerical values of the publicly worked product toward those of the invention, but it is unclear how far they should be moved.

⇒ Inventive step upheld

Difference 1B: Dynamic air permeability. Invention 1 specifies ‘1,300 mm/s or less,’ whereas the cited invention has ‘1,498 mm/s.’

Difference 1C: Resistance to yarn withdrawal. Invention 3 specifies ‘146–200 N/cm/cm,’ whereas Cited Invention 1 has ‘53 N/cm/cm.’

<JPO decision (Conclusion: inventive step upheld; maintained)>

Even if the problem is well known, the Exhibit Ko 1 invention is an ‘existing product’ optimized for its function; a commensurate motivation is therefore considered necessary to change it. It cannot be said that there is motivation to alter, within the ranges specified in Invention 1, the boiling-water shrinkage, single-filament fineness of the constituent yarns, yarn-withdrawal resistance, and cover factor affecting dynamic air permeability in the Exhibit Ko 1 invention, to the extent of bringing that permeability within the specific range ‘1,300 mm/s or less.’ Nor is there evidence demonstrating that this is possible.

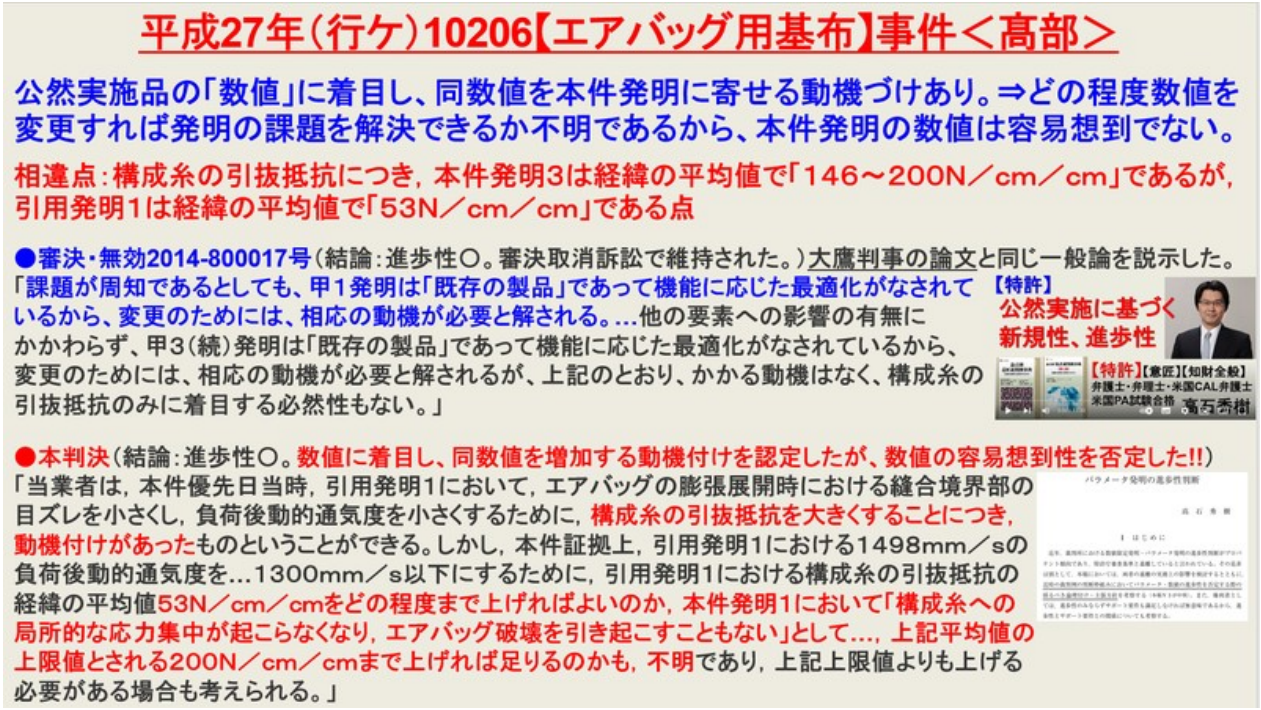
<This judgment>

(b) Increasing the cover factor

…It can be said that a person skilled in the art at the priority date would try increasing the cover factor of Cited Invention 1 above 2,131 to reduce seam slippage at the stitched boundaries when the airbag inflates and deploys, thereby reducing dynamic air permeability after loading. However, the evidence does not establish the relationship between the extent of increase in cover factor and the extent of decrease in dynamic air permeability after loading; nor is there any indication that common general technical knowledge on this point existed at the priority date. It is therefore unclear how far the cover factor of 2,131 in Cited Invention 1 must be raised to reduce its dynamic air permeability after loading from 1,498 mm/s … to 1,300 mm/s or less. It is conceivable that it would need to be raised beyond the upper limit of the 2,100–2,500 range specified for the cover factor in Invention 1 as more preferable …‘from the perspective of achieving both deployment performance and productivity.’ Moreover, since the cover factor is calculated from the average total yarn fineness in the warp and weft directions and the average weaving density in those directions…, changing the cover factor also affects the total fineness of the constituent yarns….

(c) Increasing resistance to yarn withdrawal

…It can be said that, at the priority date, a person skilled in the art had motivation to increase the yarn-withdrawal resistance of Cited Invention 1 to reduce seam slippage at the stitched boundaries during airbag inflation and deployment, thereby reducing dynamic air permeability after loading. However, the evidence does not establish how far the average warp/weft yarn-withdrawal resistance of 53 N/cm/cm in Cited Invention 1 must be raised to reduce its dynamic air permeability after loading from 1,498 mm/s …to 1,300 mm/s or less. Nor is it clear whether raising it to 200 N/cm/cm, the upper limit for that average value in Invention 1—at which …'localized stress concentration in the constituent yarns no longer occurs, and airbag rupture is not caused'—would suffice. It is conceivable that an increase beyond that upper limit would be necessary.



https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86260.pdf

English translation of the image

2015 (Gyo-Ke) 10206 [Base Fabric for Airbags] <Takabe>

Attention was directed to the numerical value of the publicly worked product, and there was motivation to bring that value closer to the claimed invention. However, because it was unclear to what extent the value should be changed to solve the invention's problem, the claimed numerical value was not readily conceivable.

Difference: As to the pull-out resistance of the constituent yarns, Invention 3 has a warp-and-weft average of 146–200 N/cm/cm, whereas Cited Invention 1 has a warp-and-weft average of 53 N/cm/cm.

JPO trial decision: Invalidation No. 2014-800017. Conclusion: inventive step affirmed; maintained in the action seeking revocation of the trial decision. General reasoning similar to that in the Grand Panel decision was stated. 'Even if the problem is well known, Exhibit Ko 1 Invention is an existing product that has been optimized according to its function, and therefore a corresponding motivation is considered necessary to change it. … Irrespective of whether other factors have an effect, Exhibit Ko 3 (New) Invention is an existing product that has been optimized according to its function, and therefore, as stated above, a corresponding motivation is considered necessary to change it. There is no such motivation, and there is also no necessity to focus only on the pull-out resistance of the constituent yarns.'

Court judgment: Inventive step affirmed. Although the court focused on the numerical value and found motivation to increase it, the numerical value was held not readily conceivable.

‘It can be said that, as of the priority date, a person skilled in the art had motivation in Cited Invention 1 to increase the pull-out resistance of the constituent yarns in order to reduce seam slippage at the stitched boundaries during airbag inflation and deployment and to reduce dynamic air permeability after loading. However, on the evidence in this case, it is unclear to what extent the warp-and-weft average pull-out resistance of 53 N/cm/cm in Cited Invention 1 should be increased to reduce its dynamic air permeability after loading from 1498 mm/s … to 1300 mm/s or less. It is also unclear whether it would suffice to raise that average to 200 N/cm/cm, the upper limit stated in Invention 1 … at which “localized stress concentration in the constituent yarns does not occur, and airbag rupture is not caused.” It is conceivable that an increase beyond that upper limit would be necessary.’

Inset heading: [Patents] Novelty and inventive step based on publicly worked products. Video heading: [Patents] [Designs] [Unfair competition] Attorney-at-law, patent attorney, and California attorney Hideki Takaishi — Patent and Design Channels. Inset document heading: Summary of an inventive-step trial decision.

Osaka District Court, 2017 (Wa) 7391, 2019 (Wa) 3587 — Claim for remuneration for an employee invention (Mitsubishi Electric)

Original Ameblo publication: 2023-01-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786124785.html

2017 (Wa) 7391, 2019 (Wa) 3587 — Claim for remuneration for an employee invention (Mitsubishi Electric)

“No unreasonable aspect is found in the disclosure of the criteria under the defendant’s rules. …It must be said that there is nothing in the defendant’s series of responses that should be assessed as unreasonable or insincere.”

“The plaintiff also argues …that the substance of the criteria for calculating performance-based compensation under the defendant’s rules and their application are unreasonable. However, no specific circumstances can be found that would warrant finding them unreasonable….”

https://chizaihanrei.com/h29wa7391/

[YouTube Video] Every Issue in Inventive Step (57 minutes) — Premiere, Sunday, January 29, at 8 p.m.

Original Ameblo publication: 2023-01-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786141584.html

[YouTube Video] Every Issue in Inventive Step (57 minutes)

Sunday, January 29, at 8 p.m.

As a first attempt, I have set this up as a video premiere.

⇒ Chat is available during the premiere, so I will answer any questions!!

Please drop by for a little while if you would like.

<Presentation materials>

https://takaishihideki.com/_files/ugd/324a18_285d3f33fcac4cf79916272da8df9eaa.pdf

<Video>

https://www.youtube.com/watch?v=HEU-zc-jOXI

Osaka District Court, 2006 (Wa) 6264 — ≈ Tokyo District Court, 2002 (Wa) 1943 [Fine Coral Fossil Powder]

Original Ameblo publication: 2023-01-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786278736.html

Osaka District Court, 2006 (Wa) 6264

In this case, Japanese company X sent warning letters to Japanese company Y's customers alleging that Y's distribution of products abroad infringed X's foreign patent. The court recognized Y's interest in seeking a declaration in a Japanese court that X had no right to an injunction against Y.

≈ Tokyo District Court, 2002 (Wa) 1943 [Fine Coral Fossil Powder]

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-34491.pdf

[Unfair Competition Prevention Act, Article 2(1)(i)] IP High Court, 2021 (Ne) 10025 — Disclaimer recognized; no confusion found

Original Ameblo publication: 2023-01-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786530921.html

[Unfair Competition Prevention Act, Article 2(1)(i)] 2021 (Ne) 10025

Three lines reading, in the displayed order: “Made by Takagi” / “replacement cartridges for water-purifying faucets” / “for those looking for them.”

⇒ The sentence ‘Although the flow rate of purified water is lower than with genuine cartridges, our products…’ was recognized as a disclaimer, and confusion was not found.

(The defendant's website has been changed!)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90875.pdf

[Unfair Competition Prevention Act] IP High Court, 2021 (Ne) 10018 — Advertised as 100% oligosaccharide

Original Ameblo publication: 2023-01-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786531104.html

[Unfair Competition Prevention Act] 2021 (Ne) 10018

Misleading indication of quality established — Presumption of damages rebutted by 91%.

Act damaging business reputation established — Presumption of damages rebutted by 99%.

The defendant advertised its product as 100% oligosaccharide although its oligosaccharide content was approximately 53%.

At an event for affiliate marketers, it stated that the plaintiff's product was not 100% oligosaccharide but that the defendant's product was.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90899.pdf

[Article] ‘Reading Leading Cases of the European Patent Office Boards of Appeal’ (Kenji Miyazaki and Masashi Jinno)

Original Ameblo publication: 2023-01-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786759084.html

[Article] ‘Reading Leading Cases of the European Patent Office Boards of Appeal’ (Kenji Miyazaki and Masashi Jinno)

The EPO's problem–solution approach, including identification of the problem, has parallels with Japanese practice.

The same factor may sometimes contribute to patentability and at other times count against it.

⇒ Reciting an effect in a claim is useful in Japan but can backfire in Europe!!

(Note) In Japan too, adding an effect does not always narrow the claims (see Article 81).

http://www.tokugikon.jp/gikonshi/305/305kiko2.pdf

[U.S. Patents] April 2015, CAFC, INEOS USA v. Berry Plastics

Original Ameblo publication: 2023-01-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12786916384.html

[U.S. Patents] April 2015, CAFC, INEOS USA v. Berry Plastics

Where a reference discloses a numerical range rather than a specific value, that disclosure can anticipate the claimed range only if it describes that range with sufficient specificity for a reasonable fact finder to conclude that there is no reasonable difference in how the invention operates over the ranges.

Cf. Japan: 1994 (Gyo-Ke) 267 and 1994 (Gyo-Ke) 30

https://www.cafc.uscourts.gov/opinions-orders/14-1540.opinion.4-14-2015.1.pdf

IP High Court, 2021 (Gyo-Ke) 10066 <Shoji> [Agent Containing Eldecalcitol for Suppressing Forearm Fractures]

Original Ameblo publication: 2023-02-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12787073033.html

2021 (Gyo-Ke) 10066 <Shoji> [Agent Containing Eldecalcitol for Suppressing Forearm Fractures]

=2022 (Ne) No. 10065

*Novelty of the use denied

‘A person skilled in the art would not recognize the pathological condition of the forearm bones and the resulting fracture risk as differing from the pathological condition and fracture risk of bones at other sites.’

≈ Tokyo District Court, 2020 (Wa) 13326, 13331 <Shibata>

(Excerpt from the court's reasoning)

…According to the common general technical knowledge, a person skilled in the art would recognize the ‘osteoporosis therapeutic agent’ of the Exhibit Ko 1 invention as an agent administered to patients whose bones throughout the body, including the vertebrae, forearms, femurs, and upper arms, have reduced strength caused by loss of bone mass and deterioration of bone microarchitecture, in order to reduce fracture risk at each site. Further, …according to the common general technical knowledge, a person skilled in the art would expect eldecalcitol to affect both cancellous and cortical bone, and would recognize that its effects extend to the forearm bones, which comprise cancellous and cortical bone. Furthermore, under the common general technical knowledge referred to in (3)(b) and (c) above, a person skilled in the art would recognize that osteoporosis can cause fractures from external force at any bodily site, and that forearm fracture risk has in common with fracture risk at other sites susceptible to osteoporotic fractures the fact that it increases as bone strength declines. Taking these circumstances into account, it must be said that a person skilled in the art would not recognize the pathological condition of the forearm bones and the resulting fracture risk in osteoporosis patients as differing from those of bones at other sites, nor recognize the purpose and effects of administering eldecalcitol as the ‘osteoporosis therapeutic agent’ of the Exhibit Ko 1 invention as differing between the forearm and other sites….

It must be said that specifying the use of eldecalcitol as ‘for suppressing non-traumatic forearm fractures’ would not lead a person skilled in the art to recognize that an unknown function or effect of eldecalcitol would arise, or that it could treat a pathological condition different from that treated by eldecalcitol administered as an osteoporosis therapeutic agent. Accordingly, the corrected inventions cannot be regarded as use inventions that discover an unknown property of the known substance eldecalcitol and, through that property, discover its suitability for a new use. The use corresponding to Difference 1 is therefore not distinguishable from the use as an ‘osteoporosis therapeutic agent’ in the Exhibit Ko 1 invention. …Thus, Difference 1 is not a substantive difference.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91620.pdf

Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheet] <Tanaka> — Trends in damages after the Grand Panel judgment

Original Ameblo publication: 2023-02-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788073766.html

Tokyo District Court, August 31, 2021, 2018 (Wa) 1130 [Printed Retroreflective Sheet] <Tanaka>

The royalty rate (5%) proposed by the patentee during pre-litigation negotiations was considered as one factor, and the royalty rate determined retrospectively was held to be 10%, twice that rate.

Observations — Trends in damages after the Grand Panel judgment in the Carbon Dioxide-Containing Viscous Composition case

(Excerpt from the court's reasoning)

It is established that, before bringing this action, the plaintiff proposed a 5% license royalty for the patent to the 3M group, including the defendants…; that, on the other hand, U.S. 3M had argued in a patent-infringement action previously brought against a third party that the royalty rate for a retroreflective-sheet patent was 9%…; that U.S. 3M and others had agreed on a royalty rate of 20% in a prior action against a third party…; and that …defendant 3M Japan and others argue for a royalty rate of 10% in a patent-infringement action they brought against the plaintiff…. …

The royalty rate receivable for the working at issue, to be determined retrospectively for the defendants who infringed the patent, is not less than 10%….

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e7%89%b9%e8%a8%b1%e6%a8%a9%e4%be%b5%e5%ae%b3%e5%b7%ae%e6%ad%a2%e7%ad%89%e8%ab%8b%e6%b1%82%e4%ba%8b%e4%bb%b6%ef%bc%88%e7%89%b9%e8%a8%b1%e6%a8%a9%e8%80%85/

Tokyo District Court, 1998 (Wa) 16963 [Moon Projector] <Mimura> — Entering into a contract for work also constitutes ‘transfer’

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788235310.html

Tokyo District Court, 1998 (Wa) 16963 [Moon Projector] <Mimura>

*Entering into a contract for work also constitutes ‘transfer.’

‘Entering into a contract for work to manufacture and deliver Defendant's Apparatus 2 for consideration is also construed to constitute “transfer” as prescribed in Article 2 of the Patent Act, and therefore constitutes an act infringing Patent Right 2 at issue.’

*The court held that the prior-use product did not embody the technical concept of the patented invention.

‘Defendant's Apparatus 3 does not embody the technical concept of attaching to the light-beam outlet an eyepiece tube of such a length that the tip of the eyepiece reaches an observer on the floor. Accordingly, the difference between Invention 2 and Defendant's Apparatus 3 concerning the length of the eyepiece tube cannot be regarded as a mere difference in mode of implementation, and the technical concepts embodied in Invention 2 and Defendant's Apparatus 3 cannot be said to be identical.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12747.pdf

I have posted an article on ‘Strategic Use of Standardization’ on the Nakamura & Partners website

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788235522.html

I have posted an article on ‘Strategic Use of Standardization’ on the Nakamura & Partners website.

Our firm handles worldwide litigation concerning standard-essential patents, conducts essentiality assessments, and provides advice during standardization work; through these activities, we have accumulated know-how.

Please contact us when you need legal advice on standardization.

https://www.nakapat.gr.jp/ja/practices-details/standardization/

[Article] ‘Can the Parameters of a Trained Program Be Understood as a Product Invention?’ (Patent Attorney Tadashi Matsushita)

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788235601.html

[Article] ‘Can the Parameters of a Trained Program Be Understood as a Product Invention?’ (Patent Attorney Tadashi Matsushita)

An examination going beyond the framework of defining a trained model by its manufacturing method

Limiting the claim to optimal parameter values alone yields an excessively narrow scope.

⇒ Specify parameter ranges.

⇒ Specify some of the parameters.

Are data-structure claims difficult to define?

https://www.jstage.jst.go.jp/article/patentsp/75/27/75_1/_article/-char/ja/

[U.S. Patents] October 2022, CAFC, Nature Simulation Systems v. Autodesk

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788235699.html

[U.S. Patents] October 2022, CAFC, Nature Simulation Systems v. Autodesk

The definiteness requirement requires claims, considered in light of the specification and prosecution history, to inform a person skilled in the art of the scope of the invention with reasonable certainty; it does not require absolute precision.

This need not be achieved by the claims alone.

https://www.patest.co.jp/nature-simulation-systems-inc-%E5%AF%BE-autodesk-inc-%E4%BA%8B%E4%BB%B6/

[Article] ‘Inherent Properties and Novelty: Taking Inventions in Immunology-Related Fields as Examples’ (Patent Attorney Yoshinori Hosoda)

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788235769.html

[Article] ‘Inherent Properties and Novelty: Taking Inventions in Immunology-Related Fields as Examples’ (Patent Attorney Yoshinori Hosoda)

An examination focused particularly on use inventions

Inhibition of IL-17 production

IL-2 variants

Vaccine compositions

Recently, functional claims and the recitation of effects in claims have been used, and many cases involve the inherent properties of known products.

https://www.jstage.jst.go.jp/article/patentsp/75/27/75_199/_pdf/-char/ja

IP High Court, 2019 (Ne) 10007 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Kanno> — Indirect infringement under Article 101(ii)

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788236074.html

2019 (Ne) 10007 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Kanno>

For an invention combining existing components, each of the existing components (the programmable display unit itself and its OS) was found to be indispensable.

⇒ Indirect infringement under Article 101(ii) established

The court below, Osaka District Court, 2015 (Wa) 8974, also found Article 101(ii) satisfied.

(Excerpt from the court's reasoning)

(d) Defendant's Product 3

Defendant's Product 3 stores the circuit-monitoring-function portion and the like of the extension/optional-function OS. Installing it on Defendant's Display A enables the circuit-monitoring function and the like to be used on Display A. The circuit-monitoring-function portion and the like of Product 3 and its other portions are found to form an integrated whole both physically and functionally.

Accordingly, Defendant's Product 3 as a whole is a characteristic component that directly provides the characteristic technical means of Invention 1.

Defendant's Product 3 therefore constitutes an article indispensable to solving the problem addressed by Invention 1.

(e) Defendant's Display A

The configuration that searches for a contact by touch when an abnormality occurs—the characteristic technical means newly disclosed by Invention 1—can be realized only when both Defendant's Display A and Defendant's Product 3 are present. As the first-instance defendant itself acknowledges, the only OS that can be installed on Display A to realize the circuit-monitoring function and the like is Product 3, and the only display on which Product 3 can be installed to realize those functions is Display A…. Thus, Display A can function so as to realize that configuration when, and only when, the OS of Product 3 is installed. Moreover, both Display A and Product 3 are produced and sold by the first-instance defendant, which is thoroughly familiar with the configuration described above, deliberately selected it, and provides both products to customers.

In view of these matters, although the fact that Display A and Product 3 happen to be physically separate products distributes a single function among multiple components, Display A is intrinsically functionally integrated and inseparable from Product 3. Even if treated as an independent product, it must be regarded as constituting a characteristic component or the like that directly provides the characteristic technical means of Invention 1. Accordingly, Defendant's Display A is an article indispensable to solving the problem addressed by Invention 1.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91445.pdf

[Article] Protection of Data (Structures) under Patent Law (Tsutomu Shimohagiwara)

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788236209.html

[Article] Protection of Data (Structures) under Patent Law (Tsutomu Shimohagiwara)

Data-related inventions may be eligible for patent protection where they qualify as “information equivalent to a computer program.”

It is necessary to clarify what ‘structure’ of the data specifies what ‘processing’ by the computer; both ‘structure’ and ‘processing’ are necessary.

https://www.jstage.jst.go.jp/article/patentsp/74/26/74_121/_pdf/-char/ja

IP High Court, 2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno> — Disclaimer claims and inventive step

Original Ameblo publication: 2023-02-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788236476.html

2021 (Gyo-Ke) 10111 [Laser Processing Apparatus] <Kanno>

The absence of grooves was discerned from the drawings in the specification, and a correction introducing a disclaimer was permitted. Because grooves are essential to the cited invention, there is a factor teaching away from the modification. ⇒ Inventive step upheld

<Observations>

(1) Amendments, corrections, divisional applications, etc. based on drawings (addition of new matter)

(2) Disclaimer claims and inventive step

(Excerpt from the court's reasoning)

<Addition of new matter>

Correction 1 merely excludes from the invention of Claim 1 before correction a ‘silicon wafer in which a groove along the predetermined cutting line is formed in the silicon single-crystal structure portion,’ or an apparatus necessarily requiring a groove, which had been conceptually encompassed. Accordingly, Correction 1, intended to narrow the claims, adds no new technical matter to the ‘laser processing apparatus’ of Claim 1. Even in light of the specification, …Figures 1 and 3 of the specification, etc. are plan views showing predetermined cutting lines on workpiece 1, while both Figure 2, a cross section along line II–II in Figure 1, and Figure 4, a cross section along line IV–IV in Figure 3, show that no grooves are formed. …Figures 1–4 depict ‘predetermined cutting lines’ but not ‘grooves.’ If the invention before correction presupposed the presence of ‘grooves,’ it would be unnatural to depict the ‘predetermined cutting lines’ while deliberately omitting the ‘grooves.’

<Inventive step>

It is inconceivable that a person skilled in the art encountering Exhibit Ko 11 would disregard groove portions 203, which generate internal stress used to cut the semiconductor wafer, in substrate 201. There is not only no motivation to adopt, as the workpiece, a substrate 201 without grooves along the break lines and to modify it so as to form a processing-modified region inside substrate 201 whose surface has no grooves; rather, there is a factor teaching away from such a modification….

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e6%98%8e%e7%b4%b0%e6%9b%b8%e4%b8%ad%e3%81%ae%e5%9b%b3%e9%9d%a2%e3%81%8b%e3%82%89%e6%ba%9d%e3%81%ae%e4%b8%8d%e5%ad%98%e5%9c%a8%e3%82%92%e7%9c%8b/

[United States] Prior-art effect based on a provisional application — MPEP 706.02(f), 2136.03, revised January 2018

Original Ameblo publication: 2023-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788415871.html

[U.S. Patents] Prior-art effect based on a provisional application — MPEP 706.02(f), 2136.03, revised January 2018

<Requirements>

• The provisional application includes a specification and any necessary drawings.

• A nonprovisional application based on the provisional application (or conversion to one).

⇒ Not only a published U.S. patent application but also a PCT international application filed on or after November 29, 2000, designating the United States and published internationally in English satisfies one of the requirements for prior-art effect under pre-AIA Section 102(e) based on the provisional application's filing date.

(Note) A proper claim to the benefit of the provisional application and support in that application for the subject matter used to make the rejection are also required. Where the provisional filing date is relied upon, at least one claim of the application serving as the reference must also be supported by the provisional application's disclosure.

http://www.ip.uec.ac.jp/ipo/announcement/pdf/provisional.pdf

Reference (current MPEP 2136): https://www.uspto.gov/web/offices/pac/mpep/s2136.html

I have published ‘Sports Law’ on the Nakamura & Partners website

Original Ameblo publication: 2023-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788425116.html

I have published ‘Sports Law’ on the Nakamura & Partners website.

Sports law encompasses diverse areas, from accidents and disputes to governance of sports organizations, anti-doping regulation, and the sports-business world, including professional baseball and the Olympics, and has distinctive features not found in other fields of law.

https://www.nakapat.gr.jp/ja/practices-details/sports-law/

[New YouTube Video] Divisional Application Strategies (complete 23-minute version)

Original Ameblo publication: 2023-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788458218.html

[New YouTube Video] Divisional Application Strategies (complete 23-minute version)

<Contents>

1. Application statistics (divisional applications and entry into foreign jurisdictions)
2. Points to note for parent–child–grandchild (three-generation) divisional applications
3. Adding disclosure to the specification and ‘addition of new matter’
4. Criteria for determining addition of new matter (general principles)
5. Examples of successful divisional-application strategies

https://www.youtube.com/watch?v=nB0lo8UagWI&feature=youtu.be

IP High Court, 2021 (Gyo-Ke) 10093 [Second PCSK9 Litigation (Regeneron)] — Unlike the first litigation, support requirement not satisfied

Original Ameblo publication: 2023-02-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788553594.html

2021 (Gyo-Ke) 10093 <Kanno> [Second PCSK9 Litigation (Regeneron)]
⇒ Support requirement not satisfied—the exact opposite of the first litigation (Sanofi).
*Not the presiding judge in the series of earlier litigation
*Arguments based on a mechanism not considered in the earlier action
*In this case, the court rejected the view that reciting the effect in the claim was sufficient to satisfy the support requirement.
*Emphasis on expert opinions
[Claim 1] An isolated monoclonal antibody capable of neutralizing the binding of PCSK9 to LDLR protein and competing, for binding to PCSK9, with an antibody comprising a heavy chain including a heavy-chain variable region consisting of the amino-acid sequence of SEQ ID NO: 49 and a light chain including a light-chain variable region consisting of the amino-acid sequence of SEQ ID NO: 23.
(Excerpt from the court's reasoning)
…The problem addressed by the invention is, in the first place, …to provide an antibody that neutralizes the binding between LDLR protein and PCSK9—which, by binding to LDLR protein, decreases the amount of LDLR protein and increases the amount of LDL in a subject—or a pharmaceutical composition containing that antibody. In relation to solving that problem, no independent significance can be found in competition with the reference antibody itself. From this perspective too, …the technical significance of the invention must be said to lie in identifying that an antibody competing with the 21B12 antibody possesses the functional characteristics of a binding-neutralizing antibody through the same mechanism as the 21B12 antibody….
The defendant argues …that even if antibodies existed that compete with the 21B12 antibody (the reference antibody) but cannot neutralize binding between PCSK9 and LDLR protein, such antibodies are excluded by the claim wording from the technical scope of Invention 1, and therefore do not provide a reason for finding a violation of the support requirement. However, as already explained, the technical significance of the invention must be said to lie in identifying that an antibody competing with the 21B12 antibody has the functional characteristics of an antibody neutralizing binding between PCSK9 and LDLR protein through the same mechanism as the 21B12 antibody. If antibodies competing with 21B12 include antibodies without binding-neutralizing ability, the premise of that technical significance plainly collapses. (In a case such as this, if it were sufficient merely to exclude antibodies lacking binding-neutralizing ability by claim wording, extremely broad definitions of the antibody's binding site on PCSK9—for example, most of PCSK9—would also be permitted. That would allow claims to be broadened without legitimate grounds and is therefore inappropriate.) …
In the separate action to revoke the JPO decision concerning the invention, …Sanofi's arguments regarding violation of the support requirement were rejected. However, this can also be understood as resulting from the assumption, taken for granted in light of the allegations and evidence then presented, that antibodies competing with the 21B12 antibody bind to substantially the same location on PCSK9 and have the same function as that antibody. In contrast, in this action, new arguments based on new evidence—including structural analyses in the respective statements of Dr. [A] and Dr. [B] and the expert report of Professor [F] …, and relevant documentary evidence concerning ‘EGFa-mimic antibodies’…—have cast doubt on that premise, yet no material supporting it can be found. There is therefore a commensurate reason for the conclusion of the separate judgment and the determination in this case to differ.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91744.pdf

IP High Court, 2021 (Gyo-Ke) 10140 [Electroformed Tube] <Kanno> — *Violation of the clarity requirement for a PBP claim

Original Ameblo publication: 2023-02-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788789259.html

2021 (Gyo-Ke) 10140 [Electroformed Tube] <Kanno>

*Violation of the clarity requirement for a product-by-process (PBP) claim

⇒ If, at the filing date, the structure or properties of the resulting product are unambiguously clear from the claims, specification, drawings, and common general technical knowledge, the clarity requirement is not violated even without impossible or impractical circumstances.

⇒ This invention is not unambiguously clear.

⇒ The defendant acknowledged that no impossible or impractical circumstances existed.

*How is this consistent with cases finding that claims were not PBP claims within the meaning of the Supreme Court judgment?

(Excerpt from the court's reasoning)

…Even where claims for a patent on a product invention recite the manufacturing process for that product, if, unlike the general situation described above, it is unambiguously clear at the filing date from the claims, specification, drawings, and common general technical knowledge what structure or properties the product manufactured by that process represents, third parties' interests are not unjustly harmed. It is therefore understood that there is no violation of the clarity requirement even in the absence of impossible or impractical circumstances….

…The specification neither states nor suggests anything concerning the inner-surface accuracy of electroformed tubes manufactured by the processes of Invention 6 and Corrected Invention 9. The specification describes the following methods of removing the fine wire: (i) forming a gap between the electrodeposit, etc. and the fine wire by heating and thermally expanding the electrodeposit, etc. or cooling and shrinking the wire; (ii) making the contact area between the fine wire and the electrodeposit, etc. slippery by immersing it in liquid or pouring liquid over it; (iii) pulling from one or both ends to deform it so as to reduce its cross-sectional area and thereby form a gap between the fine wire and the electrodeposit, etc., then gripping and pulling it, suctioning it, physically pushing it, or forcing it out by ejecting gas or liquid; and (iv) melting or dissolving it with heat or a solvent ([0041], [0116]). However, there is no description whatsoever of the technical relationship between these methods and the inner-surface accuracy of the electroformed tube produced, much less any statement or suggestion that the manufacturing processes of Invention 6 and Corrected Invention 9 (included in method (iii) above) signify a particular inner-surface accuracy different from that of tubes produced by other methods. Nor can it be found that there was common general technical knowledge as to whether these methods produce differences in inner-surface accuracy. Accordingly, the structure or properties of electroformed tubes produced by the manufacturing processes of Invention 6 and Corrected Invention 9 cannot be said to be unambiguously clear….

In view of the foregoing, Invention 6 and Corrected Invention 9 can be regarded as clear only if, at the filing date, circumstances existed that made it impossible or impractical to identify the electroformed tubes of those inventions directly by their structure or properties. The defendant acknowledges that no such circumstances existed.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91552.pdf

[U.S. Patents] Novelty, MPEP — April 2015, CAFC, INEOS v. BERRY PLASTICS

Original Ameblo publication: 2023-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12788878935.html

[U.S. Patents] Novelty, MPEP

1. If a specific prior-art example falls within the claimed range, that range lacks novelty.

2. 2012 (CAFC), Clear Value v. Pearl River

3. Prior art teaching a numerical value or range extremely close to, but not overlapping or touching, the claimed range does not deprive the claim of novelty.

Cf. 2014 (CAFC), In re Patel (an obviousness decision holding that proximity of the numerical ranges alone was insufficient to establish a prima facie case of obviousness).

April 2015, CAFC, INEOS v. BERRY PLASTICS

Even if the claimed numerical range overlaps the cited invention, novelty may be recognized if criticality over the prior art is demonstrated.

⇒ In this case, the ultimate conclusion was negative.

=2012 (CAFC), Clear Value v. Pearl River

Japan: Inventive step upheld in 1994 (Gyo-Ke) 30 and 1990 (Gyo-Ke) 269

https://www.jpo.go.jp/system/laws/gaikoku/document/mokuji/usa-shinsa_binran2100.pdf

[U.S. Patents] 1995 (CAFC), Exxon Chem. Patents v. Lubrizol

Original Ameblo publication: 2023-02-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789041201.html

[U.S. Patents] 1995 (CAFC), Exxon Chem. Patents v. Lubrizol

The defendant used the starting ingredients listed in the claims, but chemical reactions after mixing were at issue, and Exxon did not prove that the defendant's products contained the claimed amount of ashless dispersant.

⇒ ‘Comprising’ means that a composition has a given constituent, not that it is a composition produced from that constituent.

⇒ Claim limitation not satisfied

https://www.ryuka.com/jp/news/topics/patent/26995/

[U.S. Patents] August 2016, CAFC, Multilayer Stretch Cling Film

Original Ameblo publication: 2023-02-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789199877.html

[U.S. Patents] August 2016, CAFC, Multilayer Stretch Cling Film v. Berry Plastics

A dependent claim cannot add a different element to a Markush group defined using ‘consisting of.’

⇒ Dependent Claim 10, which added a different element expanding the claim scope (the technical scope of the invention), was invalid.

https://www.oliff.com/wp-content/uploads/2012/03/2015-1420-OB.pdf

[U.S. Patents] July 2019, CAFC, Enzo v. Roche

Original Ameblo publication: 2023-02-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789363954.html

[U.S. Patents] July 2019, CAFC, Enzo v. Roche

Because the claims recite a labeled probe capable of both hybridization and detection, the specification must disclose more than merely how to make a labeled probe.

⇒ The specification does not teach a person skilled in the art whether many embodiments within the broad claims perform the required functions.

⇒ Enablement requirement: not satisfied

https://www.oliff.com/wp-content/uploads/2019/08/2017-2498-OBJP.pdf

[U.S. Patents] July 2018, CAFC, Boston University v. Everlight

Original Ameblo publication: 2023-02-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789524546.html

[U.S. Patents] July 2018, CAFC, Boston University v. Everlight

This patent encompasses six combinations: indirect or direct × polycrystalline, amorphous, or mixed. However, the disclosure is insufficient to enable the direct × amorphous embodiment. ⇒ Enablement not satisfied

=2008 (CAFC), Sitrick v. Dreamworks

=2003 (CAFC), AK Steel v. Sollac and Ugine

https://www.itohpat.co.jp/ip/1315/

[Trademarks] IP High Court, 2019 (Gyo-Ke) 10078 ‘AROMA ZONE’ — ★Foreign server; directed to Japanese customers ⇛ Domestic use upheld

Original Ameblo publication: 2023-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789681608.html

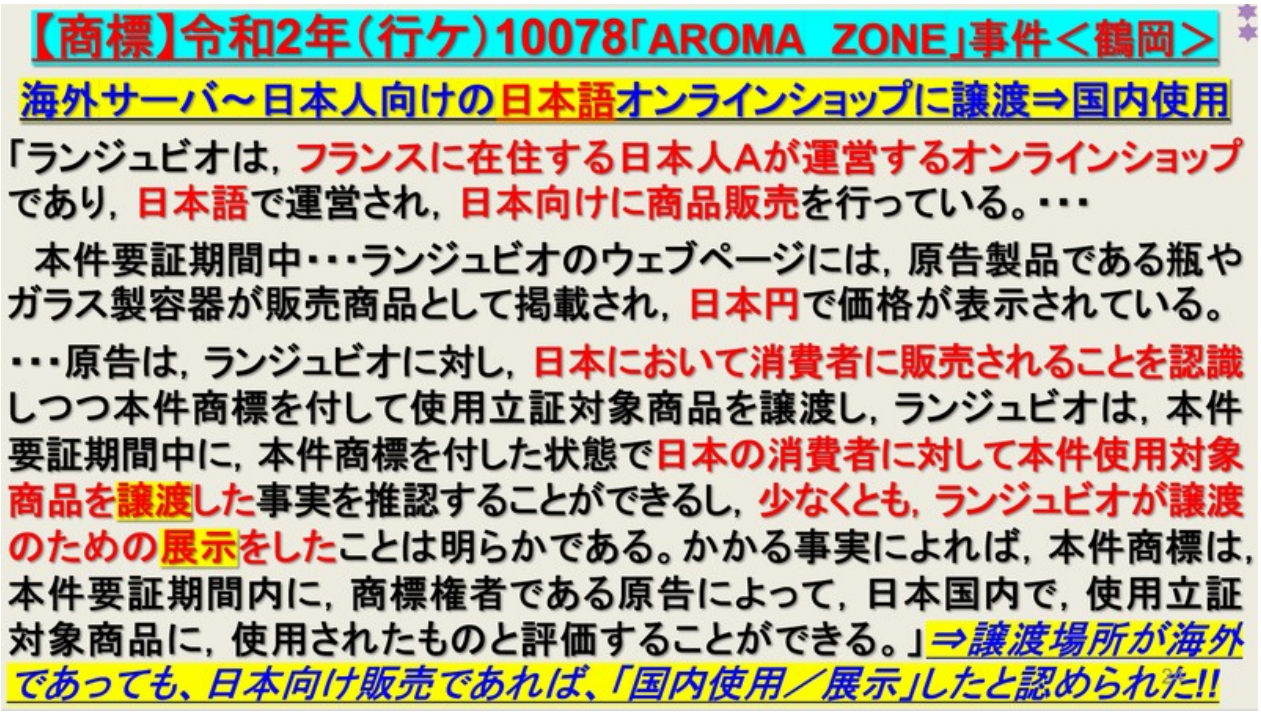
[Trademarks] 2019 (Gyo-Ke) 10078, ‘AROMA ZONE’ case <Tsuruoka>

Foreign server — Goods transferred to a Japanese-language online shop directed to Japanese customers, with knowledge of sales in Japan ⇒ Domestic use upheld

‘An online shop operated by A, a Japanese national residing in France, operating in Japanese and selling goods to Japan. …Prices are displayed in Japanese yen. …It can be inferred that the goods at issue were transferred to Japanese consumers; at the very least, it is clear that L’Ange Bio displayed them for transfer.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89219.pdf

Correction to the image heading: the case number is 2019 (Gyo-Ke) 10078; the judgment date is January 28, 2020.



English translation of the image

[Trademarks] 2019 (Gyo-Ke) 10078 [AROMA ZONE] <Tsuruoka>

Foreign server — transfer to a Japanese-language online shop selling to Japan ⇒ Domestic use.

‘L’Ange Bio is an online shop operated by A, a Japanese national residing in France; it is operated in Japanese and sells goods to Japan. … During the relevant period … L’Ange Bio's webpage listed the plaintiff's bottles and glass containers as products for sale, and prices were displayed in Japanese yen. … The plaintiff transferred the goods offered as evidence of use, bearing the trademark at issue, to L’Ange Bio with knowledge that they would be sold to consumers in Japan. It can be inferred that, during the relevant period, L’Ange Bio transferred the goods at issue bearing the trademark to Japanese consumers; at the very least, it is clear that L’Ange Bio displayed them for transfer. In light of these facts, the trademark can be

assessed as having been used by the plaintiff, its owner, in Japan, for the goods offered as evidence of use during the relevant period.’

⇒ Even if the place of transfer is abroad, sales directed to Japan were recognized as domestic use or display!!

[Trademarks] IP High Court, 2017 (Gyo-Ke) 10071 ‘COVERDERM’ — ★Foreign server; Japanese language ⇛ Domestic use upheld

Original Ameblo publication: 2023-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789682044.html

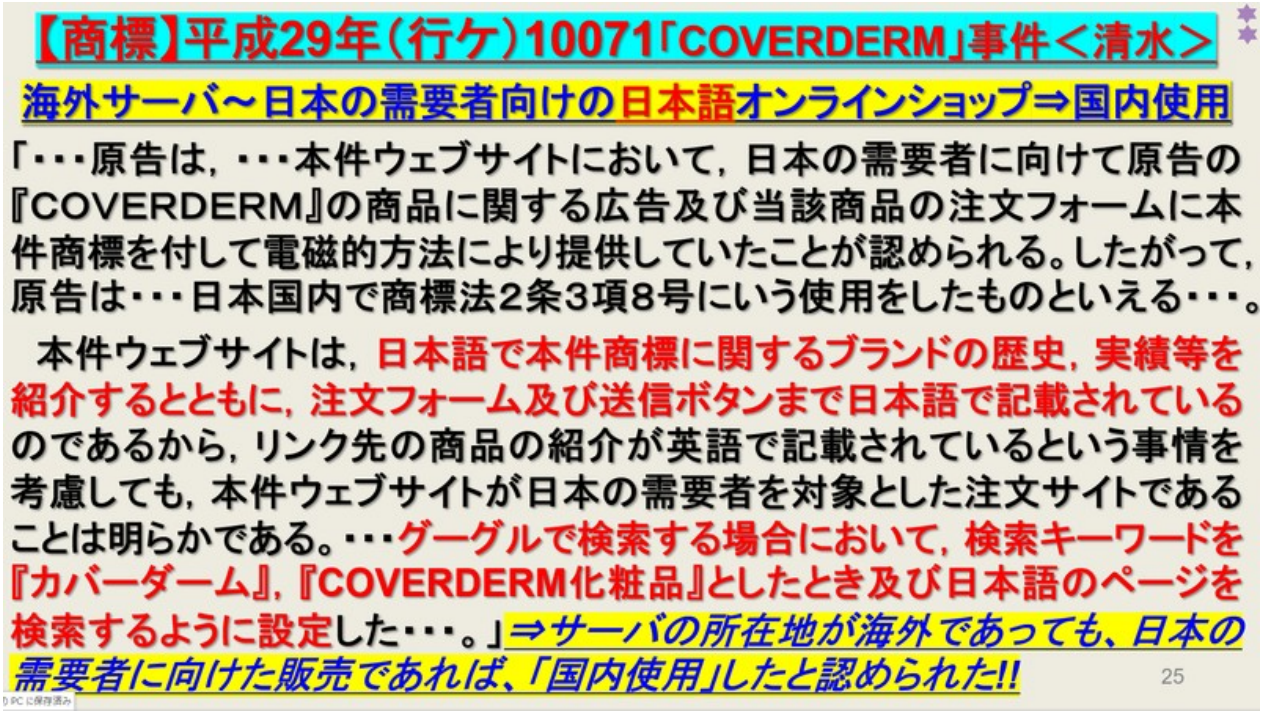
[Trademarks] 2017 (Gyo-Ke) 10071, ‘COVERDERM’ case <Shimizu>

Foreign server — Japanese-language online shop directed to Japanese consumers ⇒ Domestic use upheld

‘In Japanese …introducing the brand's history, achievements, and the like, with even the order form and submit button in Japanese.’

‘When searching on Google …the settings were configured to search Japanese-language pages.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87298.pdf



English translation of the image

[Trademarks] 2017 (Gyo-Ke) 10071 [COVERDERM] <Shimizu>

Foreign server — Japanese-language online shop directed to Japanese consumers ⇒ Domestic use.

‘… The plaintiff … is found to have provided, by electronic means, advertising relating to its COVERDERM products and order forms for those products bearing the trademark on the website at issue to consumers in Japan. Accordingly, the plaintiff … can be said to have made use in Japan within the meaning of Article 2(3)(viii) of the Trademark Act. … The website at issue introduces, in Japanese, the history and achievements of the brand relating to the trademark, and even its order form and submit button are written in Japanese. Thus, even taking account of the fact that the products on the linked site are introduced in English, it is clear that the website at issue is an ordering site directed to Japanese consumers.

… When searching on Google, the search terms were set to “カバーダーム” [Coverderm] and “COVERDERM 化粧品” [COVERDERM cosmetics], and the settings were made to search Japanese-language pages.’

⇒ Even if the server is located abroad, sales directed to Japanese consumers were recognized as domestic use!!

[U.S. Trademarks] Playboy v. Chuckleberry — ⇛ Acceptance of new subscriptions from U.S. residents prohibited

Original Ameblo publication: 2023-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789682291.html

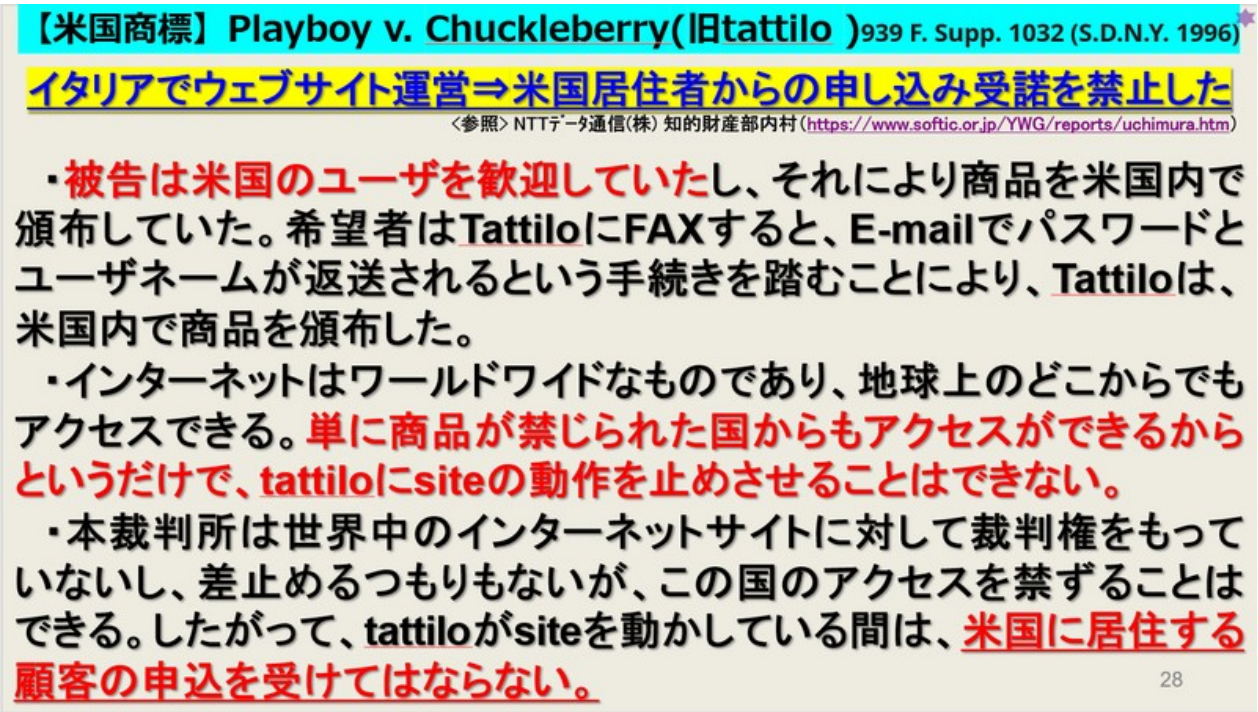
[U.S. Trademarks] Playboy v. Chuckleberry (the order concerned defendant Tattilo Editrice), 939 F. Supp. 1032 (S.D.N.Y. 1996)

The defendant operated a website in Italy.

⇛ It was prohibited from accepting new subscriptions from U.S. residents.

‘Tattilo cannot be required to stop operating its site merely because the site is also accessible from a country in which its products are prohibited.’

https://www.softic.or.jp/YWG/reports/uchimura.htm



English translation of the image

[U.S. Trademarks] Playboy v. Chuckleberry (formerly Tattilo), 939 F. Supp. 1032 (S.D.N.Y. 1996)

Operation of a website in Italy ⇛ Acceptance of applications from U.S. residents prohibited.

The defendant welcomed U.S. users and thereby distributed products within the United States. Through a procedure under which an interested person sent a fax to Tattilo and received a password and username by email, Tattilo distributed products in the United States.

The Internet is worldwide and can be accessed from anywhere on Earth. Tattilo cannot be required to stop operating its site merely because it is accessible from a country in which its products are prohibited.

This court does not have jurisdiction over Internet sites throughout the world and does not intend to enjoin them, but it can prohibit access from this country. Therefore, while Tattilo operates the site, it must not accept applications from customers residing in the United States.

[Trademarks] IP High Court, 2005 (Gyo-Ke) 10095 ‘PAPA JOHN’S’ — ★Foreign server; English-language site not found to target Japanese consumers ⇒ Domestic use denied

Original Ameblo publication: 2023-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789682616.html

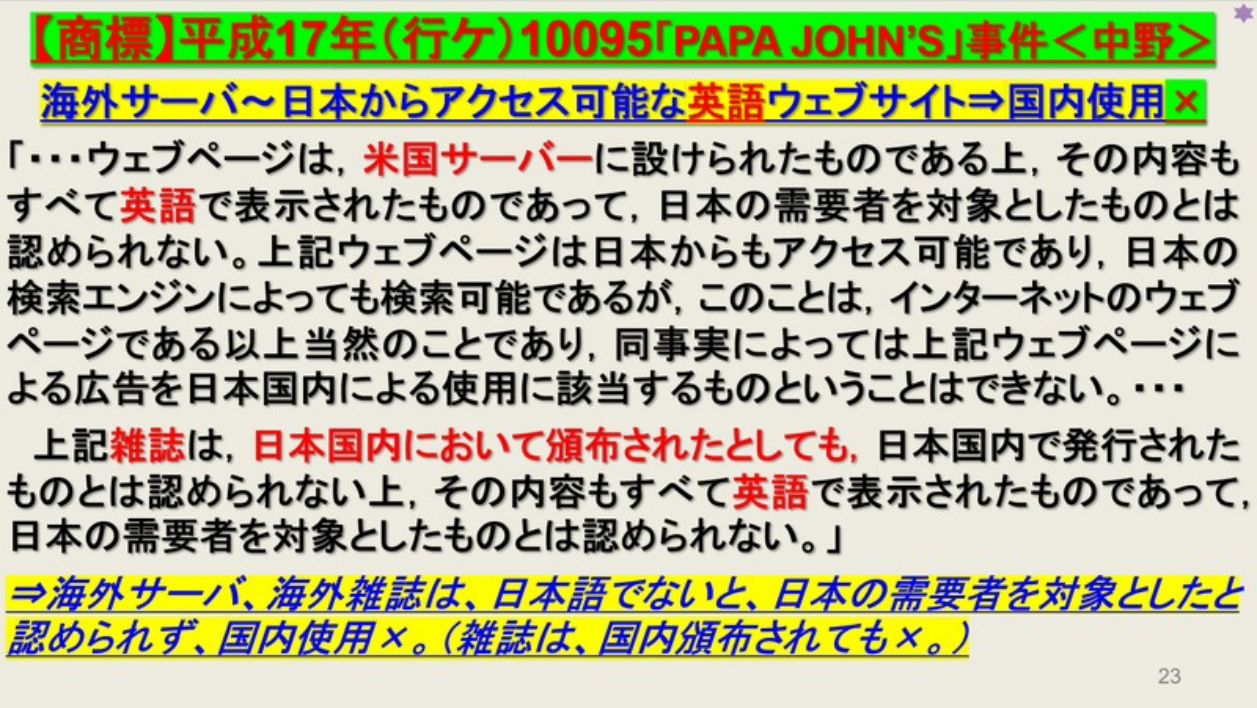
[Trademarks] 2005 (Gyo-Ke) 10095, ‘PAPA JOHN’S’ case <Nakano>

★Foreign server — An ‘English-language’ website accessible from Japan — ‘Cannot be found to target Japanese consumers’ ⇒ Domestic use denied

★An ‘English-language’ magazine published abroad, even if distributed in Japan, ‘cannot be found to target Japanese consumers’ ⇒ Domestic use denied

(Note) The issue in this case was whether the website or magazine could be found to target Japanese consumers, rather than its language alone.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9225.pdf



English translation of the image

[Trademarks] 2005 (Gyo-Ke) 10095 [PAPA JOHN’S] <Nakano>

Foreign server — English-language website accessible from Japan ⇒ Domestic use denied.

‘… The webpage was placed on a server in the United States, and all of its content was displayed in English; it cannot be found to have targeted Japanese consumers. The webpage was accessible from Japan and could also be found using Japanese search engines, but that is natural for an Internet webpage. Those circumstances do not make the advertising on the webpage use in Japan. … Even if the magazine was distributed in Japan, it cannot be found to have been published in Japan, and its content was all displayed in English; it cannot be found to have targeted Japanese consumers.’

⇒ In this case, the foreign-server webpage and foreign magazine were not found to target Japanese consumers, taking account of their language and the other circumstances; domestic use was denied. Domestic distribution of the magazine did not alter that conclusion.

[YouTube] Foreign-server issues (Are ‘providing’ a program and ‘transferring’ tangible goods parallel?)

Original Ameblo publication: 2023-02-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12789728314.html

[New YouTube Video] Foreign-server issues (Are ‘providing’ a program and ‘transferring’ tangible goods parallel?)

<Contents>

1. Relationship between the two patents

2. First litigation (patent for a program + display apparatus)

(1) Reversed on appeal: claim limitations held satisfied — Is satisfaction in a particular situation enough?

(2) Territoriality — Distribution of a program to domestic users

⇒ Are ‘providing’ a program and ‘transferring’ tangible goods parallel?

(3) Normative attribution of infringement (the copyright ‘karaoke doctrine’)

3. Second litigation (system patent) — Multiple actors

4. Divisional-application strategies (general)

(★The presentation materials downloadable from the link below have been expanded to include the following group of cases!!)

[Trademarks] 2019 (Gyo-Ke) 10078, ‘AROMA ZONE’ case <Presiding Judge Tsuruoka>

Foreign server — Goods transferred to a Japanese-language online shop directed to Japanese customers, with knowledge of sales in Japan ⇒ Domestic use upheld

‘An online shop operated by A, a Japanese national residing in France, operating in Japanese and selling goods to Japan. …Prices are displayed in Japanese yen. …It can be inferred that the goods at issue were transferred to Japanese consumers; at the very least, it is clear that L’Ange Bio displayed them for transfer.’

[Trademarks] 2017 (Gyo-Ke) 10071, ‘COVERDERM’ case <Presiding Judge Shimizu>

Foreign server — Japanese-language online shop directed to Japanese consumers ⇒ Domestic use upheld

‘In Japanese …introducing the brand's history, achievements, and the like, with even the order form and submit button in Japanese.’

‘When searching on Google …the settings were configured to search Japanese-language pages.’

[U.S. Trademarks] Playboy v. Chuckleberry (the order concerned defendant Tattilo Editrice), 939 F. Supp. 1032 (S.D.N.Y. 1996)

Website operated in Italy ⇒ Acceptance of new subscriptions from U.S. residents prohibited.

‘Tattilo cannot be required to stop operating its site merely because the site is also accessible from a country in which its products are prohibited….’

[Trademarks] 2005 (Gyo-Ke) 10095, ‘PAPA JOHN’S’ case <Presiding Judge Nakano>

★Foreign server — An ‘English-language’ website accessible from Japan — ‘Cannot be found to target Japanese consumers’ ⇒ Domestic use denied

★An ‘English-language’ magazine published abroad, even if distributed in Japan, ‘cannot be found to target Japanese consumers’ ⇒ Domestic use denied

*U.S. patents — California Institute v. Broadcom and Apple (2022) has been cited as a CAFC judgment recognizing extraterritorial application, but I have not examined it sufficiently and have not included it in the presentation materials. https://www.aoyamapat.gr.jp/news/3207

<Materials>

https://takaishihideki.com/_files/ugd/324a18_ce6878142a254ef98dfebb22646e9301.pdf

<Video>

https://youtube.com/watch?v=tS4Xl9oRXfs

[Trademarks] IP High Court, 2013 (Gyo-Ke) 10031, ‘Gram’ case — A material's trademark also used for clothing

Original Ameblo publication: 2023-02-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12790157682.html

[Trademarks] 2013 (Gyo-Ke) 10031, ‘Gram’ case

The court held that use of a material's trademark was not merely use to indicate the material, but also use for the finished product (clothing).

‘Because the material is extremely light, …it can also be understood as indicating that the product offers excellent functionality and comfort, with a lightweight, soft feel, …’

Cf. the ‘ZAX’ case

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83614.pdf

[Trademarks] 2004 (Gyo-Ke) 404, ‘ZAX’ case: A material's trademark was not used for the finished product. ‘Even if it can be understood to guarantee the quality or function of the “material”… it does not guarantee …the slacks…. …It was agreed that [the party] would bear no responsibility and would not be involved in complaints or the like.’ Cf. the Gram case

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9698.pdf

[China (Article)] Reducing warranty liability risks in technology licensing to Chinese companies: Considering optimal structures for the business environment (2015, Intellectual Property Management)

Original Ameblo publication: 2023-02-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12790469198.html

[China (Article)] Reducing warranty liability risks in technology licensing to Chinese companies: Considering optimal structures for the business environment (FY2014 Licensing Committee 1, Subcommittee 2)

Under China's Regulations on Administration of Technology Import and Export as addressed in the article at the time, the licensor bore warranty obligations concerning the technology and the rights licensed.

⇒ Except in cases such as licensing to a Sino-Japanese joint venture, indirect licensing (through a Chinese-affiliated company located outside China) is useful!!

(Note) The 2019 amendment deleted the provision imposing liability on the transferor for infringement of third-party rights resulting from working the imported technology. The foregoing concerns the rules applicable at the time addressed by the article. Warranties concerning technical performance and liability for infringement of rights require separate consideration.

IP High Court, 2018 (Gyo-Ke) 10023 [Cushioning Material for Polishing] <Otaka>

Original Ameblo publication: 2023-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12790878168.html

2018 (Gyo-Ke) 10023 [Cushioning Material for Polishing] <Otaka>

Prosecution history estoppel ⇒ Correction not permitted

A deliberately excluded claim cannot be restored by correction.

⇒ Substantive change

‘The correction …contradicts the deletion of former Claims 5 and 6 during prosecution…. Permitting it … would risk unforeseen harm to third parties who consulted the prosecution history.’

(Excerpt from the court's reasoning)

The plaintiff, …after receiving a notice of reasons for refusal, …voluntarily deleted former Claims 5 and 6 by amendment, …and the patent was then allowed. It is therefore found to have expressed an intention to deliberately exclude the inventions of former Claims 5 and 6 from the scope of the patent….

Claims 3 and 4 after correction (Correction 2) effectively restore inventions including …the configurations of former Claims 5 and 6 deleted by the amendment. The correction corresponding to Correction 2 is therefore inconsistent with the deletion of former Claims 5 and 6 in the patent's prosecution history. Permitting it would risk unforeseen harm to third parties who consulted that history. …It substantively changes the scope of the claims….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88518.pdf

Tokyo District Court, 2017 (Wa) 35663 [Equol-Containing Fermented Soybean Hypocotyl Product] <Okinaka>

Original Ameblo publication: 2023-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12790878599.html

Tokyo District Court, 2017 (Wa) 35663 [Equol-Containing Fermented Soybean Hypocotyl Product] <Okinaka>

*Appeal: 2019 (Ne) 10015 <Otaka>

*In the divisional application in this case, claim language is construed consistently with arguments made during prosecution of the parent application.

Cf. Opposite to 2007 (Wa) 27187

‘Because this patent arises from a divisional of the parent application, “soybean hypocotyl” in the invention must likewise be understood in the same way as in the parent application.’

(Excerpt from the court's reasoning)

…The foregoing arguments by the plaintiff (applicant) during prosecution of the parent application are understood to assert that …‘soybean hypocotyl’ means ‘the soybean hypocotyl itself, containing components that inhibit fermentation,’ as distinct from ‘an extract of soybean hypocotyl (isoflavones, etc.).’ Because this patent arises from a divisional of the parent application, ‘soybean hypocotyl’ in the invention should likewise be understood in the same way as in the parent application. The plaintiff's foregoing arguments during prosecution of the parent application are consistent with, and substantiate, the explanation in (2) above….

The defendant's product is found to be …obtained by further fermenting high-purity isoflavone raw material—an extract taken from soybean hypocotyl—of which at least 90% consists of soybean isoflavones such as daidzin. Accordingly, ‘EQ-5’ contained in the defendant's product is a fermented soybean-hypocotyl extract, not a fermented product of the soybean hypocotyl itself, and therefore …does not fall within the technical scope of the invention….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88389.pdf

Tokyo District Court, 2007 (Wa) 27187 [User Interface for Television Program Listings]

Original Ameblo publication: 2023-02-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12790996305.html

Tokyo District Court, 2007 (Wa) 27187 [User Interface for Television Program Listings]

*In a divisional application, it is permissible to argue for a claim construction different from that in prosecution of the original application.

Cf. Opposite to 2017 (Wa) 35663

‘A divisional application …inherently concerns different subject matter…. Interpretation of the wording need not necessarily coincide with its interpretation in the proceedings for the original application.’

(Excerpt from the court's reasoning)

The divisional-application system allows an applicant who has sought patents for two or more different inventions in one application to divide the application and obtain patents for each invention, with each deemed filed retroactively at the original filing date. The inventions for which patents are sought in the original and divisional applications therefore inherently differ in subject matter. It must thus be said that interpretation of language in the ‘claims’ of the divisional invention need not necessarily coincide with interpretation of that language in the original application's proceedings.

Accordingly, even if the wording ‘television program listings’ in this patent is interpreted differently from the meaning of ‘television program listings’ used in the appeal against refusal of the original application and the action to revoke the JPO decision on the original application, that interpretation cannot be said to be impermissible under the doctrine of estoppel, and the defendant's contention cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-37845.pdf

[U.S. Patents] August 2020, CAFC, IP Bridge v. TCL

Original Ameblo publication: 2023-03-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12791587077.html

[U.S. Patents] August 2020, CAFC, IP Bridge v. TCL

Whether the asserted claims are essential to a standard is a question of fact for the factfinder in the infringement proceedings, rather than a question of law resolved by the judge as part of claim construction. In this case, it was for the jury.

⇒ This affects the evidentiary strategy for proving whether a self-described SEP is truly standard-essential.

Cf.

Infringement — Question of fact

Novelty — Question of fact

Obviousness — Question of law based on questions of fact

https://iplegal.livedoor.blog/archives/1077761044.html

[Korean Patents] Patent Court judgment of February 17, 2022, 2020 Heo 5832

Original Ameblo publication: 2023-03-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12791744293.html

[Korean Patents] Patent Court judgment of February 17, 2022, 2020 Heo 5832

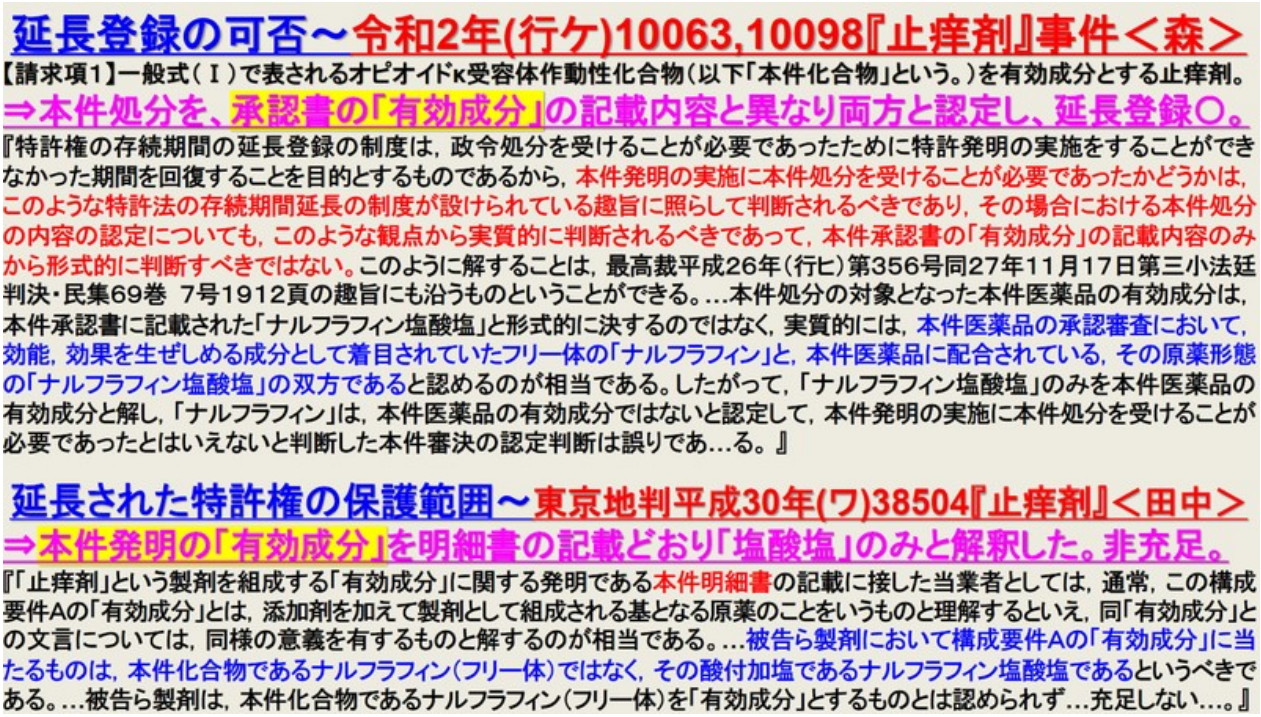
A compound patent extended under the doctrine of equivalents to a prodrug (a substance that undergoes a chemical change in the body to become a substance producing the pharmacological effect).

Although the claims were narrowed during prosecution, the prodrug was not deliberately excluded.

⇒ In contrast, Tokyo District Court, 2018 (Wa) 38504, the Antipruritic Agent case, rejected equivalence because the hydrochloride had been deleted during prosecution (deliberate exclusion).

http://www.central.kr/jp/sub04/index.php#

Japanese comparative cases: extension registration and the scope of protection of an extended patent right concerning an antipruritic agent



English translation of the image

Japanese comparative cases — Antipruritic Agent

Eligibility for registration of a patent-term extension — 2020 (Gyo-Ke) 10063 and 10098 [Antipruritic Agent] <Mori>

[Claim 1] An antipruritic agent having, as an active ingredient, an opioid receptor agonist compound represented by general formula (I) (hereinafter referred to as ‘the compound of the invention’).

⇒ The administrative disposition relating to the invention was assessed differently from the wording in the approval document's ‘active ingredient’ field, and extension registration was affirmed.

‘The system for registering extensions of the duration of patent rights is intended to restore the period during which the patented invention could not be worked because it was necessary to obtain an administrative disposition. Whether a disposition was necessary to work the invention must therefore be

determined in light of the purpose for which this special extension system was established. The content of the disposition must likewise be determined substantively from that perspective, and cannot be determined formally solely from the wording in the “active ingredient” field of the approval document. This interpretation also accords with the purpose of the Supreme Court First Petty Bench judgment of November 17, 2015, 2014 (Gyo-Hi) 356, Minshu Vol. 69, No. 7, p. 1912. … The active ingredients of the drug subject to the disposition should be understood substantively as both the free-form nalfurafine that was regarded in the approval review as the ingredient producing efficacy and effects, and nalfurafine hydrochloride, its raw material contained in the drug, rather than formally as only “nalfurafine hydrochloride” as written in the approval document. Accordingly, the JPO's determination was erroneous insofar as it identified only nalfurafine hydrochloride as the active ingredient, treated nalfurafine as not being an active ingredient, and determined that it was not necessary to obtain the disposition in order to work the invention.’

Scope of protection of the extended patent right — Tokyo District Court, 2018 (Wa) 38504 [Antipruritic Agent] <Tanaka>

⇒ The invention's ‘active ingredient’ was construed as the hydrochloride only, as stated in the specification. The claim limitation was not satisfied.

‘A person skilled in the art reading the specification's explanation of the “active ingredient” constituting the preparation called an “antipruritic agent” would ordinarily understand the “active ingredient” in limitation A as the raw material that forms the basis of the preparation, rather than the preparation to which additives have been added. It is appropriate to understand the same phrase in the same manner. … The substance in the defendant's preparation corresponding to the “active ingredient” in limitation A should be understood as nalfurafine hydrochloride, an acid-addition salt, rather than the free-form nalfurafine that is the compound of the invention. … The defendant's preparation cannot be found to have the free-form nalfurafine that is the compound of the invention as its active ingredient … [the claim limitation is not satisfied].’

[U.S. Patents] March 2016, CAFC, DSS v. Taiwan Semiconductor

Original Ameblo publication: 2023-03-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12791906925.html

[U.S. Patents] March 2016, CAFC, DSS v. Taiwan Semiconductor

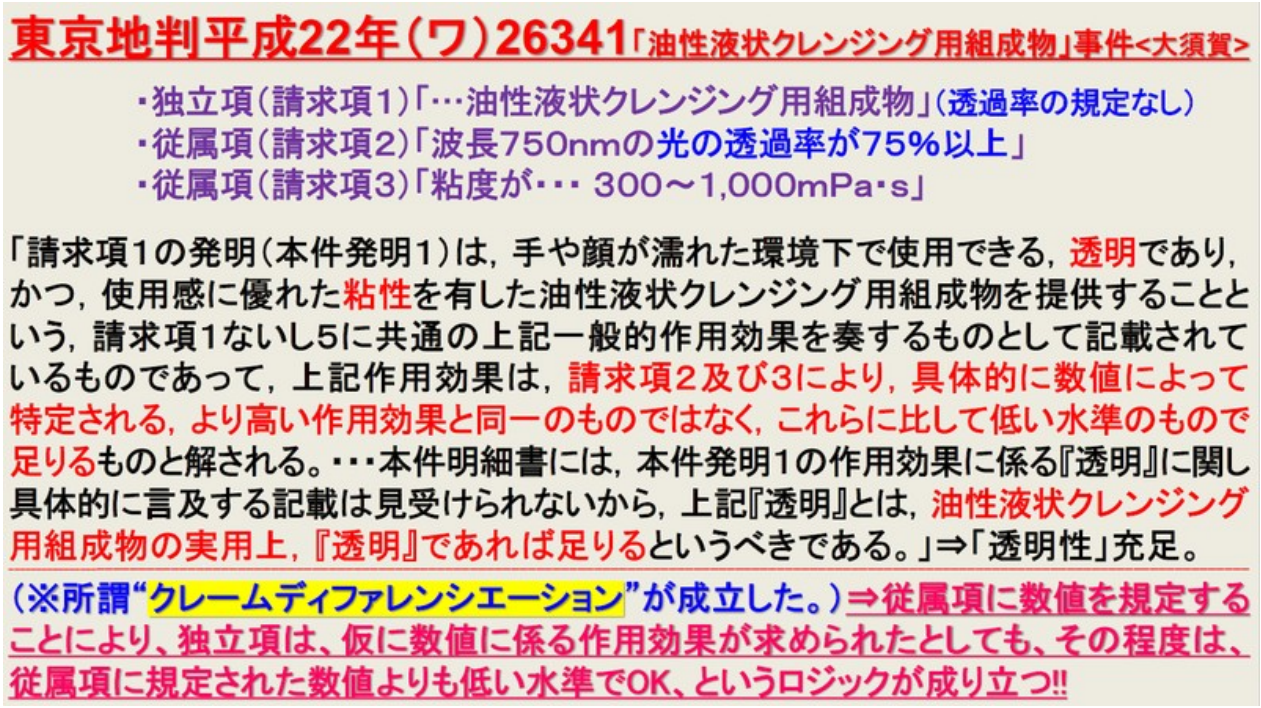
Even if the independent claim is construed narrowly, the dependent claim remains narrower still; thus claim differentiation (related provision: 35 U.S.C. §112(d)) is not violated.

⇒ Place features and the like that you do not want read into the independent claim as limitations into dependent claims!!

=In Japan too: Tokyo District Court, 2010 (Wa) 26341 <Osuga>

DSSvTSM.pdf (jpaa.or.jp)

Japanese comparative case: independent and dependent claims for an oil-based liquid cleansing composition



English translation of the image

Japanese comparative case — Tokyo District Court, 2010 (Wa) 26341 [Oil-Based Liquid Cleansing Composition] <Osuga>

Independent claim, Claim 1: '… an oil-based liquid cleansing composition' (no transmittance value specified). Dependent Claim 2: 'transmittance of light at a wavelength of 750 nm of 75% or more.' Dependent Claim 3: 'viscosity … 300–1,000 mPa·s.'

'The invention of Claim 1 (Invention 1) is described as achieving the above general effects common to Claims 1 to 5: providing an oil-based liquid cleansing composition that can be used when the hands or face are wet, is transparent, and has viscosity giving an excellent feeling in use. The above effects are not identical to the higher effects specified by concrete numerical values in Claims 2 and 3, but are understood to be satisfied by a lower level. … The specification contains no concrete statement concerning the

“transparency” involved in the effects of Invention 1, and therefore the transparency referred to above should be understood as satisfied if the oil-based liquid cleansing composition is “transparent” in practical use.’ ⇒ The transparency limitation was satisfied.

*So-called claim differentiation was established. By specifying numerical values in dependent claims, the reasoning can be sustained that even if effects relating to those values are required in the independent claim, those effects may be of a lower level than the values specified in the dependent claims!!

[U.S. Patents] 2021, U.S. Supreme Court, Minerva v. Hologic

Original Ameblo publication: 2023-03-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792217296.html

[U.S. Patents] 2021, U.S. Supreme Court, Minerva v. Hologic

‘Assignor estoppel’ is limited, for example, in the following circumstances.

(1) The assignment took place before the inventor could possibly warrant validity (e.g., an assignment under an employment agreement).

(2) A subsequent change in law rendered the warranty at assignment meaningless.

(3) After assignment, the patent claims were changed so that they became materially broader than the claims at the time of assignment.

https://www.jetro.go.jp/ext_images/_Ipnews/us/2021/20210701.pdf

[U.S. Patents] April 2020, CAFC, Nike v. Adidas

Original Ameblo publication: 2023-03-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792217407.html

[U.S. Patents] April 2020, CAFC, Nike v. Adidas

In an IPR, the PTAB may, based on prior art in the record, present new grounds for denying the patentability of amended claims, but must notify the patentee and provide an opportunity to respond before its final decision.

⇒ Even where prior art was already in the record during the IPR, an opportunity to respond is required when it is used as the basis for a new theory of unpatentability.

https://www.cafc.uscourts.gov/opinions-orders/19-1262.opinion.4-9-2020_1566865.pdf

[U.S. Patents] November 2020, CAFC, In re Google Technology

Original Ameblo publication: 2023-03-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792392596.html

[U.S. Patents] November 2020, CAFC, In re Google Technology

In this case, a claim construction not presented to the PTAB could not be raised for the first time on appeal.

Even if the PTAB construed the claims on its own initiative, Google should have presented its preferred claim construction to the PTAB.

https://www.knobbe.com/blog/claim-construction-arguments-not-made-ptab-are-forfeited-appeal/

[U.S. Patents] SIMO v. Hong Kong / SuperGuide v. DirecTV

Original Ameblo publication: 2023-03-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792546801.html

[U.S. Patents] January 2021, CAFC, SIMO v. Hong Kong uCloudlink

Where the claim language is expressed schematically as ‘a plurality of A, B, C, D and E,’ the court required a plurality of each of A, B, C, D, and E.

⇒ Claim limitation not satisfied

If ‘a plurality of’ did not modify ‘E,’ the indefinite article ‘a’ would have preceded ‘E.’

https://www.fukamipat.gr.jp/region_ip/5976/

[U.S. Patents] February 2004, CAFC, SuperGuide v. DirecTV Enters.

Where the claim language is expressed schematically as ‘at least one of A, B, C, D and E,’ the court required at least one item from each listed category.

⇒ Claim limitation not satisfied

The specification provides no support for selecting just one.

Enforcement based on an unsupported claim construction was rejected.

⇒ ‘Comprises at least one of A, B and C’ is construed as ‘Comprises at least one of A, at least one of B and at least one of C.’

‘And’ should be changed to ‘or.’

Comprises at least one selected from the group consisting of A, B and C

would be acceptable.

(Note) These are drafting proposals, and the construction is not determined uniformly by them. The listed items, grammar, and the specification must be considered.

https://jpaa-patent.info/patents_files_old/201609/jpaapatent201609_111-119.pdf

[U.S. Patents] Shifting attorney fees to the losing party

Original Ameblo publication: 2023-03-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792703638.html

[U.S. Patents] Shifting attorney fees to the losing party

Octane Fitness v. Icon Health & Fitness

Highmark v. Allcare Health Management System

U.S. Supreme Court judgments of April 29, 2014

(1) Unreasonable litigation conduct may be sufficiently exceptional to justify an award of attorney fees.

(2) Either subjective bad faith or objective baselessness may, on its own, support a finding that a case is exceptional.

(Note) Items (1) and (2) above explain the exceptional-case determination in Octane Fitness. Highmark held that an appellate court should apply an abuse-of-discretion standard in reviewing all aspects of a district court’s determination under 35 U.S.C. §285.

https://t.co/6JS7X3calg

[U.S. Patents] February 2020, CAFC, Samsung v. Prisua

Original Ameblo publication: 2023-03-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12792857487.html

[U.S. Patents] February 2020, CAFC, Samsung v. Prisua

(1) A patent cannot be invalidated for indefiniteness in an IPR.

⇒ Indefiniteness can be challenged in post-grant review (PGR).

(2) Even if the challenged claims are indefinite, this does not necessarily prevent consideration of novelty and obviousness.

⇒ In this case, the Board was directed on remand to determine anticipation and obviousness on the instituted grounds.

https://www.cafc.uscourts.gov/opinions-orders/19-1169.opinion.2-4-2020_1526242.pdf

[U.S. Patents] Paper Examples <USPTO notice of July 1, 2021>

Original Ameblo publication: 2023-03-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12793021244.html

[U.S. Patents] Paper Examples <USPTO notice of July 1, 2021>

In the United States, prophetic examples (unperformed experiments and predicted results) must be distinguished from working examples (experiments actually performed and actual results). (MPEP 608.01(p))

⇒ Prophetic examples (= paper examples) should be written in the future/present tense.

https://www.aoyamapat.gr.jp/news/3066

[Copyright] Osaka District Court, 2021 (Wa) 5086

Original Ameblo publication: 2023-03-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12793492437.html

[Copyright] Osaka District Court, 2021 (Wa) 5086

Copyrightability upheld

‘These are very common forms of expression seen in cherry-blossom illustrations and are commonplace … and do not constitute essential features. …The works share identity only …in portions that are not expression itself, such as ideas, or portions lacking creativity in expression …so the defendant's illustration does not constitute a reproduction or adaptation.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91665.pdf

[U.S. Patents / Statutory Provision] Section 271(g) — Importing into the United States a product made abroad using a patented process constitutes infringement

Original Ameblo publication: 2023-03-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12793672795.html

[U.S. Patents / Statutory Provision] Section 271(g) — Importing into the United States a product made abroad using a patented process constitutes infringement.

The following are exceptions.

1) Materially changed by subsequent processing

E.g., intermediate and final product (CAFC 1996, Eli Lilly v. American Cyanamid)

2) Made a trivial and nonessential component of another product

Japan: Indirect products of a patented manufacturing process — No case law

[Patents] Distinguishing a Simple Method from a Manufacturing Process + Scope of Rights under a Manufacturing-Process Patent — YouTube

[U.S. Patents / Statutory Provision] Section 295

Original Ameblo publication: 2023-03-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12793774655.html

[U.S. Patents / Statutory Provision] Section 295

A presumption that the patented process was used arises if the court finds (1) a substantial likelihood that the product was made using that process and (2) that the plaintiff made a reasonable effort (including discovery) to determine the process actually used but was unable to determine it.

⇒ Unlike Article 104 of the Japanese Patent Act, the product need not be new.

⇒ A U.S. process patent allows the use of discovery and, if the above requirements are met, the presumption, together with Section 271(g)!!

*Needs to be examined together with 28 U.S.C. §1782

https://t.co/c9eQhbwYUP

Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor] <Sugiura>

Original Ameblo publication: 2023-03-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12793931425.html

Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor] <Sugiura>

Interpretation of claim language is not subject to a judicial admission!!

=Osaka District Court, 2011 (Wa) 10590

(Excerpt from the court's reasoning)

‘The defendant points out that, as to the meaning of “partition wall,” the plaintiff initially advanced the interpretation now asserted by the defendant, but later withdrew it and argued for a different interpretation, which the defendant characterizes as withdrawal of an admission. However, interpretation of claim language is not an allegation of fact and is therefore not, in the first place, subject to a judicial admission. The defendant's argument on this point cannot be accepted.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89306.pdf

Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a … Ladder Circuit] — Admitting facts does not establish a judicial admission of satisfaction of a claim limitation

Original Ameblo publication: 2023-03-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794094128.html

Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs]

*Admitting facts does not establish a judicial admission of satisfaction of a claim limitation.

‘The defendant merely admitted …that a search target can be specified by touching an input/output element…. It cannot be found that a judicial admission extending to satisfaction of the claim limitation had been established.’

(Excerpt from the court's reasoning)

The defendant merely admitted that, including for Defendant's Display 2A, a search target can be specified by touching an input/output element; …whether this satisfies Claim Element 1F is a question of interpretation. Moreover, because the defendant disputed satisfaction of Claim Element 1F itself (…), it cannot be found that a judicial admission had been established extending beyond the fact that Defendant's Display A is configured so that an input/output element is touched when searching for an input/output element in a ladder circuit, to satisfaction of that claim element itself.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88263.pdf

IP High Court (Grand Panel), 2016 (Ne) 10046 [Elplat Case] ⇒ Petition for acceptance of final appeal not accepted

Original Ameblo publication: 2023-03-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794320391.html

IP High Court (Grand Panel), 2016 (Ne) 10046 [Elplat Case] ⇒ Petition for acceptance of final appeal not accepted

After holding that the Japanese claim wording ‘kara naru’ (translated here as ‘consisting of’) could, from the claims themselves, be read either as including or as excluding other components such as additives, the court construed it as ‘consisting only of.’

⇒ Claim limitation not satisfied

=Cases restricting ‘consisting of’ to ‘only’: 1999 (Wa) 3012, 2002 (Wa) 25697, 2008 (Wa) 10196

Cf. A case not restricting ‘consisting of’ to ‘only’: 2012 (Wa) 15621

(Excerpt from the court's reasoning)

…Claim Element C, ‘consisting of an aqueous solution of oxaliplatinum,’ can, from the claim wording itself, be construed either as an aqueous solution consisting only of oxaliplatinum and water or as merely requiring an aqueous solution of oxaliplatinum and water while also encompassing other components such as additives. Claim Element C must therefore be determined by reference to the specification and prosecution history…. The problem addressed by the invention is to obtain a ready-to-use oxaliplatinum injection solution of the known active ingredient ‘oxaliplatinum’ that remains pharmaceutically stable for an acceptable period under approved standards and exhibits chemical purity and therapeutic activity equivalent to those of a solution obtained from a lyophilized product; the invention presents …the means of solving that problem…. It means that the invention is an aqueous solution consisting only of oxaliplatinum and water, without other components such as additives….

https://www.courts.go.jp/ip/vc-files/ip/file/zen_28ne10046.pdf

[Germany] Düsseldorf Higher Regional Court (2009), ‘Prepaid Card’ case

Original Ameblo publication: 2023-03-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794546504.html

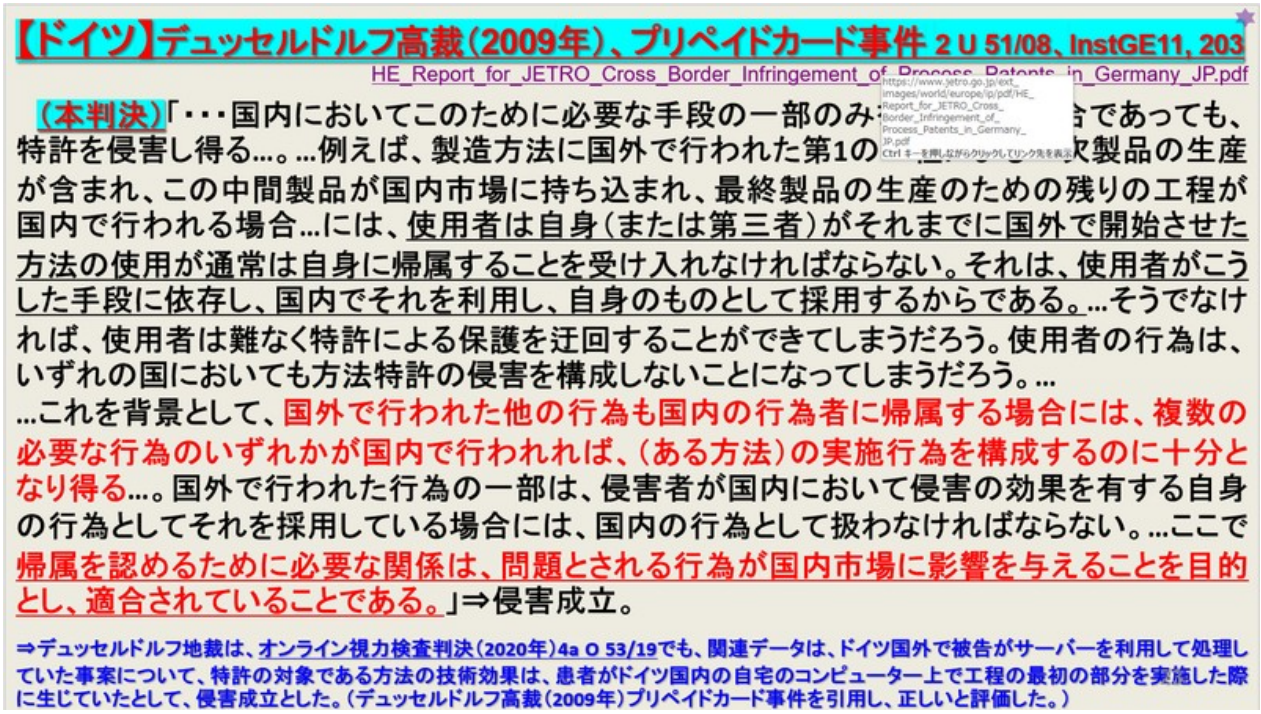
[Germany] Düsseldorf Higher Regional Court (2009), ‘Prepaid Card’ case, 2 U 51/08, InstGE 11, 203

(This judgment) ‘…A patent may be infringed even where only some of the measures necessary for this purpose are carried out domestically…. …For example, where a manufacturing process includes production of a primary product through a first step carried out abroad, that intermediate product is brought into the domestic market, and the remaining steps for producing the final product are performed domestically…, the user must normally accept attribution to itself of the use of the process previously initiated abroad by itself (or a third party). This is because the user relies on those measures, utilizes them domestically, and adopts them as its own. …Otherwise, the user could readily circumvent patent protection. The user's conduct would not constitute infringement of the process patent in any country….

…Against this background, where other acts performed abroad are also attributable to the domestic actor, performance of any one of several necessary acts domestically may suffice to constitute working (of a process)…. Some acts performed abroad must be treated as domestic acts where the infringer adopts them as its own acts having an infringing effect domestically. …The connection necessary for attribution here is that the acts in question are intended and adapted to affect the domestic market.’ ⇒ Infringement established.

⇒ In the Online Eye Test judgment (2020), 4a O 53/19, the Düsseldorf Regional Court likewise found infringement in a case where the defendant processed the relevant data using a server outside Germany. The court held that the technical effect of the patented method arose when patients performed the first part of the steps on their home computers in Germany. (It cited and endorsed the Düsseldorf Higher Regional Court's 2009 Prepaid Card judgment.)

https://www.jetro.go.jp/ext_images/world/europe/ip/pdf/HE_Report_for_JETRO_Cross_Border_Infringement_of_Process_Patents_in_Germany_JP.pdf



English translation of the image

[Germany] Düsseldorf Higher Regional Court (2009), Prepaid Card case, 2 U 51/08, InstGE 11, 203

[Judgment] '… A patent is infringed even if only some of the steps necessary for that purpose are performed in the country. … For example, where a manufacturing process includes production of an intermediate product performed abroad, the intermediate product is brought onto the domestic market, and the remaining steps for production of the final product are performed in the country, … the user must normally accept attribution to itself of the use of the process that it (or a third party) had begun abroad. That is because the user uses the obtained means, takes advantage of them in the country, and adopts them as its own. … Otherwise, the user could evade patent protection without difficulty. The user's conduct would not constitute infringement of the method patent in any country. … Against that background, where other acts performed abroad are also attributable to a domestic actor, performance of any one of the several necessary acts within the country may be sufficient to constitute working of a method. … Some acts performed abroad must be treated as domestic acts where the infringer adopts them as its own acts having an infringing effect within the country. … The causal relationship necessary to recognize attribution here is that the conduct at issue is directed and suited to affecting the domestic market.' ⇒ Infringement established.

⇒ In its Online Eyesight Test judgment (2020), 4a O 53/19, the Düsseldorf Regional Court also held that the technical effect of the patented method arose when the patient performed the first part of the process on a computer at home in Germany, in a case in which relevant data were processed in the Netherlands using a server managed by the defendant in Germany, and found infringement. It cited and correctly evaluated the Düsseldorf Higher Regional Court's 2009 Prepaid Card case.

[United Kingdom] EWHC [2002], Menashe v. William Hill

Original Ameblo publication: 2023-03-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794546846.html

[United Kingdom] Menashe v. William Hill, [2002] EWHC 397, [2002] EWCA Civ 1702

William Hill provided customers with computer programs recorded on CDs that converted their computers into terminal computers communicating with a host computer over the internet. William Hill's host computer was located outside the United Kingdom (in the Netherlands Antilles).

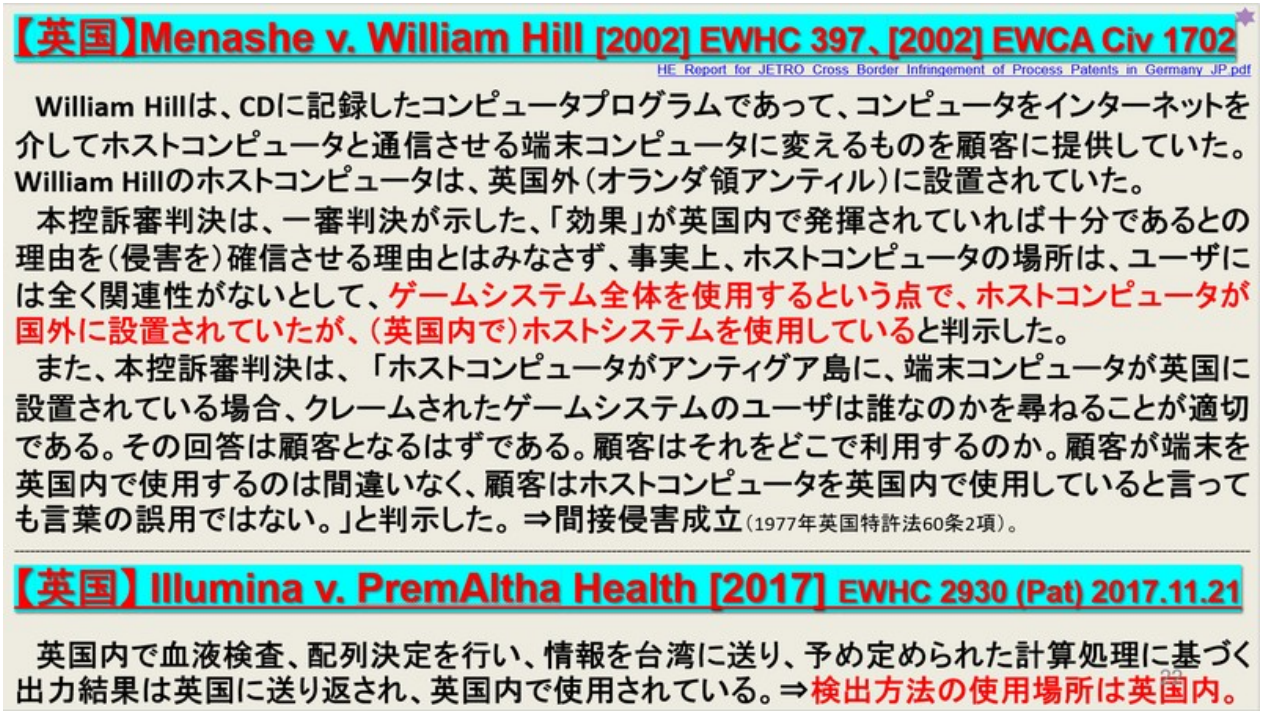
The appellate judgment did not regard the first-instance reasoning—that it was sufficient for the ‘effect’ to occur in the United Kingdom—as a convincing reason for finding infringement. Rather, it held that the host computer's location was, in practical terms, entirely irrelevant to the user: in using the gaming system as a whole, the user used the host system (in the United Kingdom) even though the host computer was located abroad.

The appellate judgment also held: ‘Where the host computer is located in Antigua and the terminal computer in the United Kingdom, it is appropriate to ask who uses the claimed gaming system. The answer must be the customer. Where does the customer use it? There is no doubt that the customer uses the terminal in the United Kingdom, and it is not a misuse of language to say that the customer uses the host computer in the United Kingdom.’ ⇒ The foreign-host defense was rejected; liability for indirect infringement could arise under Section 60(2) of the UK Patents Act 1977.

[United Kingdom] Illumina v. Premaitha Health, [2017] EWHC 2930 (Pat), November 21, 2017

Under the proposed alternative process, blood testing and sequencing would be performed in the United Kingdom, information would be sent to Taiwan, and the output from predetermined computational processing would be sent back to and used in the United Kingdom. ⇒ The court held that, in substance, this process would be used in the United Kingdom.

https://www.jetro.go.jp/ext_images/world/europe/ip/pdf/HE_Report_for_JETRO_Cross_Border_Infringement_of_Process_Patents_in_Germany_JP.pdf



English translation of the image

[United Kingdom] Menashe v. William Hill [2002] EWHC 397; [2002] EWCA Civ 1702

William Hill supplied customers with a computer program recorded on a CD that turned their computers into terminal computers communicating with a host computer over the Internet. William Hill's host computer was located outside the United Kingdom, in the Netherlands Antilles.

The appellate judgment did not accept the first-instance court's reasoning that it was sufficient for the ‘effect’ to arise in the United Kingdom as a basis for finding infringement. Rather, the location of the host computer was entirely irrelevant to the user; from the perspective of using the gaming system as a whole, the host computer was being used in the United Kingdom even though it was installed abroad.

The appellate judgment also stated: ‘If the host computer is installed in Antigua and the terminal computer in the United Kingdom, it is appropriate to ask who the user of the claimed gaming system is. The answer can only be the customer. What does the customer use it for? There is no doubt that the customer uses the terminal in the United Kingdom, and saying that the customer uses the host computer in the United Kingdom is not an abuse of language.’ ⇒ Indirect infringement established (Patents Act 1977, section 60(2)).

[United Kingdom] Illumina v. Premaitha Health [2017] EWHC 2930 (Pat), November 21, 2017

Blood testing and sequencing were performed in the United Kingdom; information was sent to Taiwan, and output based on predetermined computational processing was sent back to the United Kingdom and used there. ⇒ The detection method was used within the United Kingdom.

[China] Supreme People's Court judgment of May 25, 2021 <(2020) Zui Gao Fa Zhi Min Zhong No. 746>

Original Ameblo publication: 2023-03-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794547611.html

[China] Supreme People's Court judgment of May 25, 2021 <(2020) Zui Gao Fa Zhi Min Zhong No. 746>

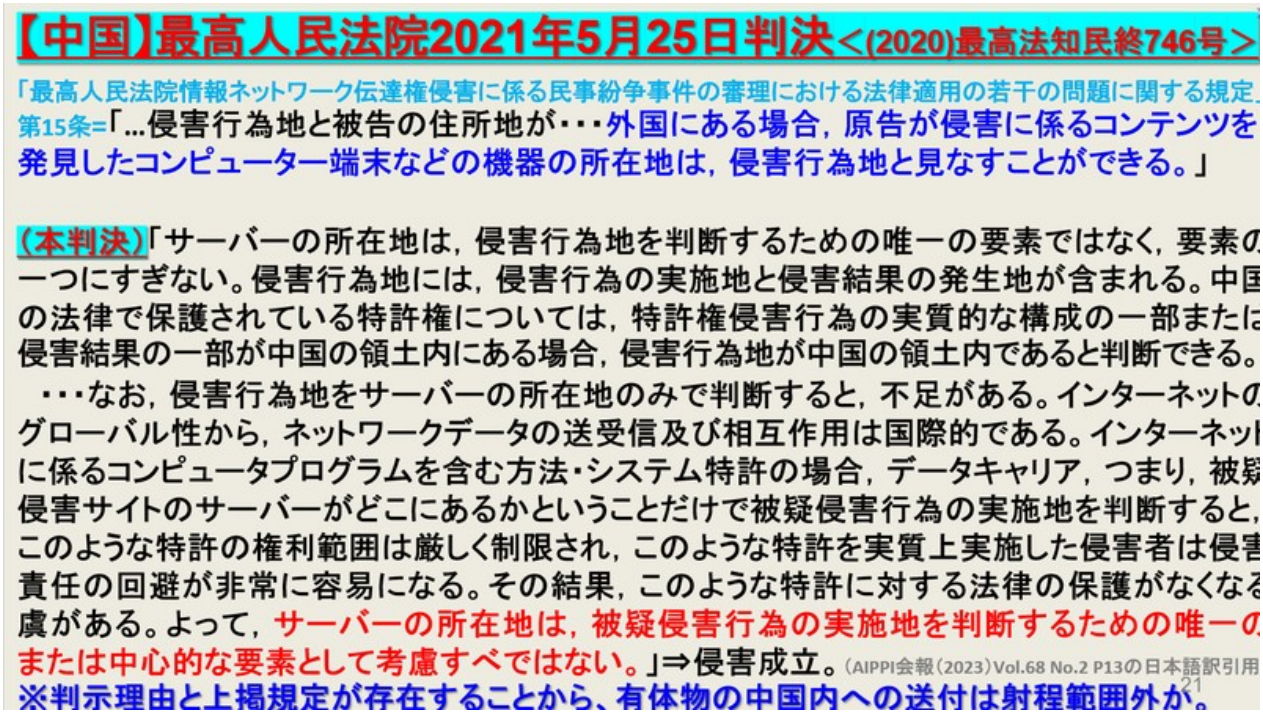
Article 15 of the ‘Supreme People's Court Provisions on Several Issues Concerning the Application of Law in the Trial of Civil Disputes Involving Infringement of the Right of Communication through Information Networks’

=‘…Where the place of infringement and the defendant's domicile are …abroad, the location of equipment such as the computer terminal on which the plaintiff discovered the infringing content may be deemed the place of infringement.’

(This judgment) ‘The location of the server is not the sole factor for determining the place of infringement, but only one factor. The place of infringement includes both the place where the infringing acts are carried out and the place where the consequences of infringement occur. For patent rights protected by Chinese law, where part of the substantive elements of the patent-infringing acts or part of their consequences lies within Chinese territory, the place of infringement may be determined to be within Chinese territory.

…Moreover, determining the place of infringement solely by the location of the server is inadequate. Given the global nature of the internet, transmission, reception, and interaction of network data are international. For method and system patents involving computer programs related to the internet, determining the place of the alleged infringing acts solely by the data carrier—that is, the location of the server of the allegedly infringing website—would severely restrict the scope of such patents and make it extremely easy for infringers who substantially work them to evade liability. As a result, such patents could effectively lose legal protection. Accordingly, the server's location should not be considered the sole or central factor in determining the place where the alleged infringing acts are carried out.’ ⇒ Infringement established. (English translation of the Japanese quotation in AIPPI Journal (2023), Vol. 68, No. 2, pp. 20–23 (issue pagination).)

*In view of the reasoning and the existence of the provision quoted above, might shipment of tangible goods into China fall outside its reach?



English translation of the image

[China] Supreme People's Court judgment of May 25, 2021, (2020) Zui Gao Fa Zhi Min Zhong No. 746

Article 15 of the Provisions of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Civil Dispute Cases Involving Infringement of the Right of Communication through Information Networks: '… If the place of infringement and the defendant's domicile are … abroad, the location of equipment such as a computer terminal on which the plaintiff discovered the infringing content may be regarded as the place of infringement.'

[Judgment] 'The location of the server is not the sole factor for determining the place of infringement, but only one factor. The place of infringement includes the place where the infringing act is performed and the place where its result occurs. For patent rights protected under Chinese law, where part of the substantive composition of the patent-infringing act or part of its result is within Chinese territory, the place of infringement may be determined to be within Chinese territory. … Determining the place of infringement solely by the location of the server is insufficient. Because the Internet is global, the transmission, reception, and interaction of network data are international. For method and system patents including computer programs relating to the Internet, determining where the accused infringing act is performed solely by the location of the data carrier, namely the accused infringing website's server, would severely restrict the scope of such patent rights and make it extremely easy for an infringer who substantially works such a patent to evade liability. As a result, legal protection of such patents might be lost. The location of the server should not be considered the sole or central factor for determining where the accused infringing act is performed.' ⇒ Infringement established. (Quoted from the Japanese translation in AIPPI Journal (2023), Vol. 68, No. 2, p. 13.)

*In view of the reasoning and the existence of the above provision, is sending tangible goods into China outside the scope of the decision?

[Korea] Seoul Central District Court, September 7, 2007 <2006 Gahap 73442>

Original Ameblo publication: 2023-03-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794547936.html

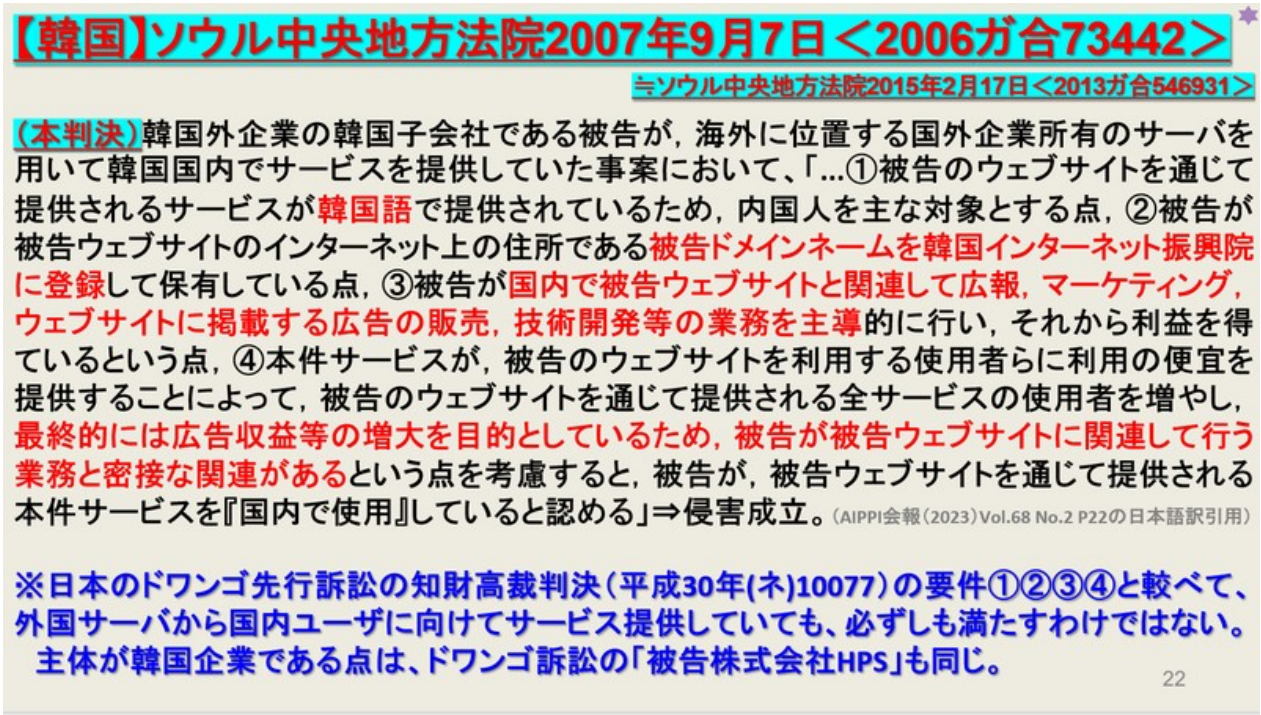
[Korea] Seoul Central District Court, September 7, 2007 <2006 Gahap 73442>

≈ Seoul Central District Court, February 17, 2015 <2013 Gahap 546931>

(This judgment) In a case where the defendant, the Korean subsidiary of a foreign company, provided services in Korea using a server located abroad and owned by the foreign company: '…Considering (i) that the services offered through the defendant's website are in Korean and thus principally target domestic nationals; (ii) that the defendant registers with the National Internet Development Agency of Korea and holds the defendant's domain name, the internet address of its website; (iii) that the defendant takes the leading role domestically in publicity, marketing, sales of advertising to be placed on the website, technological development, and other work related to its website, and profits from those activities; and (iv) that the services at issue, by providing convenience to users of the defendant's website, aim to increase users of all services offered through the website and ultimately to increase advertising revenue and the like, and are thus closely related to the defendant's activities concerning its website, it is appropriate to find that the defendant "uses domestically" the services at issue offered through its website, …' ⇒ Domestic use was found. However, the infringement injunction claim in that case was dismissed as an abuse of rights because the invention lacked novelty. (English translation of the Japanese quotation in AIPPI Journal (2023), Vol. 68, No. 2, p. 14 (cumulative p. 128).)

*Compared with requirements (i)–(iv) in the IP High Court judgment in Japan's earlier Dwango litigation (2018 (Ne) 10077), these requirements are not necessarily met merely because services are provided from a foreign server to domestic users.

Both cases involved a domestic company: the defendant in the Korean case was a Korean company, and defendant HPS Co., Ltd. in the Dwango litigation was a Japanese company.



English translation of the image

[Korea] Seoul Central District Court, September 7, 2007, 2006 Gahap 73442; also Seoul Central District Court, February 17, 2015, 2013 Gahap 546931

[Judgment] In a case in which the defendant, the Korean subsidiary of a foreign company, provided services in Korea using a server owned by the foreign company and located abroad: '… Taking account of (1) the fact that the service supplied through the defendant's website is provided in Korean and thus primarily targets domestic users; (2) the fact that the defendant has registered and holds the defendant's domain name, the address of its website on the Internet, with the Korea Internet & Security Agency; (3) the fact that the defendant takes the lead in domestic public relations, marketing, sales of advertising placed on the website, and technology development relating to its website and derives profits from them; and (4) the fact that the service at issue provides convenience to users of the defendant's website, thereby increasing the users of all services supplied through the website and ultimately aiming at increased advertising revenue and the like, and thus is closely related to the defendant's business concerning its website, the defendant is found to use domestically the service at issue supplied through its website.' ⇒ Infringement established. (Quoted from the Japanese translation in AIPPI Journal (2023), Vol. 68, No. 2, p. 22.)

*Compared with requirements (1)–(4) in the IP High Court judgment in Japan's first Dwango action, 2018 (Ne) 10077, provision of a service from a foreign server to domestic users does not necessarily satisfy these circumstances. The fact that the actor is a Korean company is also common to defendant HPS Inc. in the Dwango action.

IP High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

Original Ameblo publication: 2023-03-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794793273.html

2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

Merely reciting the functions and effects achieved by a configuration does not narrow the claim. ⇒ Correction requirements not satisfied

‘Because it merely recites the functions and effects achieved by the configuration, …it cannot be found to narrow the claims.’

(Excerpt from the court's reasoning)

Correction 1 …changes ‘spray product’ to ‘spray product with reduced irritation to mucous membranes,’ and Correction 2 …changes ‘spraying method’ to ‘spraying method that reduces irritation to mucous membranes.’ They therefore …add, respectively, the functional descriptions ‘with reduced irritation to mucous membranes’ and ‘that reduces irritation to mucous membranes’ to the descriptions of the ‘spray product’ and …‘spraying method’….

The specification neither states nor suggests that there may be cases in which the foregoing configurations of Claims 1 and 3 before correction do not achieve the function and effect of ‘reducing irritation to mucous membranes.’ Accordingly, the functional descriptions ‘with reduced irritation to mucous membranes’ and ‘that reduces irritation to mucous membranes’ added by Corrections 1 and 2 merely recite the functions and effects achieved by the foregoing configurations of Claims 1 and 3 before correction. Corrections 1 and 2 therefore cannot be found to narrow the claims for the respective inventions of Claims 1 and 3 before correction. …Consequently, Corrections 1 and 2 cannot be found to have the purpose of ‘narrowing the claims’….

https://t.co/qu38crRN4y

[Contracts / Contractual Penalty] Osaka District Court, 2021 (Wa) 4467 — In this case, the penalty was valid only up to an amount equal to the damages

Original Ameblo publication: 2023-03-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794861773.html

[Contracts / Contractual Penalty] Osaka District Court, 2021 (Wa) 4467

Imitation of configuration ⇒ Notice ⇒ Copying from the original found

Knowledge of the ‘imitation’ at importation was found.

A contractual penalty of ¥20 million had been stipulated at the previous infringement/settlement.

⇒ Stipulating ¥20 million did not, by itself, make the penalty invalid.

⇒ An excessive amount grossly disproportionate to the damage violates public policy.

⇒ In this case, valid only to the extent of a contractual penalty equal to the damages excluding attorney fees.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91578.pdf

Osaka District Court, 2019 (Wa) 9842 — Although ultimately rejected, the ‘defense of failure to achieve the functions and effects’ was considered!!

Original Ameblo publication: 2023-03-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12794978297.html

Osaka District Court, 2019 (Wa) 9842 — Patent infringement established

Although ultimately rejected, the ‘defense of failure to achieve the functions and effects’ was considered under a separate heading!!

‘4. Whether the defense of failure to achieve the functions and effects is established (Issue 1-3)…

The defendant's product can be said to produce an effect addressing the problem that the respective corrected inventions seek to solve.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91241.pdf

‘Trial and Appeal Practitioner Study Group Report 2022’

Original Ameblo publication: 2023-03-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795219675.html

‘Trial and Appeal Practitioner Study Group Report 2022’

Personally, after being forced to retire from the Japan Patent Attorneys Association's Patent Committee under the 6–8 rule, I had been disappointed that my consecutive attendance might end at nine years. But the JPO selected me directly, allowing me to participate as the only observer other than judges, and I achieved perfect attendance for ten consecutive years!!

I have no regrets left now!!

2022_houkokusyo_honpen.pdf (jpo.go.jp)



English translation of the image

Trial and Appeal Practitioners Study Group Report 2022

March 2023 — Trial and Appeal Department, Japan Patent Office.

Japan Patent Office.

[Copyright] Osaka District Court, 2022 (Wa) 2064

Original Ameblo publication: 2023-03-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795365727.html

[Copyright] Osaka District Court, 2022 (Wa) 2064

The defendant did not appear in the proceedings.

Even so, damages were not calculated under the Japan Photographers Union's rules.

⇒ While industry-association rules are given weight in Agency for Cultural Affairs determinations…

A total of ¥10 million was claimed for lost profits, infringement of moral rights, and intangible harm from false statements. The court awarded ¥800,000 for intangible harm from false statements, including the harm from infringement of moral rights.

The claim to publish an apology as a measure to restore reputation was granted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91293.pdf

Osaka District Court, 2022 (Wa) 3374 [Method of Controlling Microbial Growth] <Matsuami>

Original Ameblo publication: 2023-03-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795366136.html

Osaka District Court, 2022 (Wa) 3374 [Method of Controlling Microbial Growth] <Matsuami>

The court required a ‘direct relationship’ between blue-light ‘irradiation’ and ‘suppression of microbial growth.’

⇒ Claim limitation not satisfied (insufficient proof; the growth suppression could have resulted from low temperature rather than blue light).

‘[Claim element] …A method …of culturing under irradiation with light in a wavelength region from approximately 400 nm to 490 nm to suppress the growth of the microorganism…’

(Excerpt from the court's reasoning)

…In light of the literal meaning of ‘under irradiation with light,’ the claims of the patent and the specification, and the plaintiff's argument that ‘under irradiation with light’ means that microorganisms such as Bacillus subtilis and Staphylococcus aureus are irradiated with blue light that suppresses their growth, it is appropriate to construe ‘under irradiation with light’ in Claim Element B as requiring that microbial growth be suppressed by the effects of blue-light irradiation (that there be a direct relationship between blue-light irradiation and suppression of microbial growth)…. …

LED (5), the principal blue-light source, emits blue light when the partial-freezing compartment is in the slightly frozen partial-freezing state (rather than chilled) and automatic rapid cooling is underway. In that case, the compartment is maintained at approximately −3°C to −1°C. This is consistent with the results of the respective experiments in Exhibits Otsu 12–15 showing that some of the culture medium and the pork were frozen. The absence of Staphylococcus aureus and Bacillus subtilis colonies in the experiments in Exhibits Otsu 12 and 13 is also consistent with the general growth-temperature range of Staphylococcus aureus being 5–47.8°C (optimal growth temperature: 30–37°C), and that of Bacillus subtilis being 5–55°C (optimal growth-temperature range: 20–45°C) (reference materials attached to Exhibits Otsu 12 and 13)….

There is insufficient evidence to find that the product at issue …suppresses microbial growth through the effects of blue-light irradiation (that there is a direct relationship between irradiation and suppression of microbial growth). Accordingly, the method of using the product does not satisfy ‘under irradiation with light’ (Claim Element B) and does not fall within the technical scope of the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91269.pdf

IP High Court, 2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy…] <Honda>

Original Ameblo publication: 2023-03-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795584639.html

2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy…] <Honda>

*A new reference in the appeal decision ⇒ Procedural violation

‘…The reference was not identified at the examination stage, nor identified in advance during the appeal proceedings, but was first identified in the appeal decision…. …This is impermissible from the perspective of the plaintiff's procedural safeguards….’

(Excerpt from the court's reasoning)

Exhibit Ko 16 (Cited Reference 5) was not identified at the examination stage, nor identified in advance during the appeal proceedings, but was first identified in the appeal decision…. …Had Exhibit Ko 16 (Cited Reference 5) been identified in a notice of reasons for refusal, …it would have had a significant impact on the plaintiff's course of action…. …Assessing the inventive step of the amended invention using Cited Invention 5 as the primary reference must be regarded as impermissible from the perspective of the plaintiff's procedural safeguards.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91524.pdf

[Japan / Criminal Law] Supreme Court decisions, November 25, 2014 — 2013 (A) 574 <Shukei, No. 315, p. 187>; 2013 (A) 510 <Keishu, Vol. 68, No. 9, p. 1053>

Original Ameblo publication: 2023-03-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795632854.html

[Japan / Criminal Law] Supreme Court decisions, November 25, 2014 — 2013 (A) 574 <Shukei, No. 315, p. 187>; 2013 (A) 510 <Keishu, Vol. 68, No. 9, p. 1053>

Defendants residing in Japan

Transmitted obscene images created in Japan to an overseas server

Distributed them to an unspecified and large number of customers, mainly Japanese

Operated a Japanese-language website

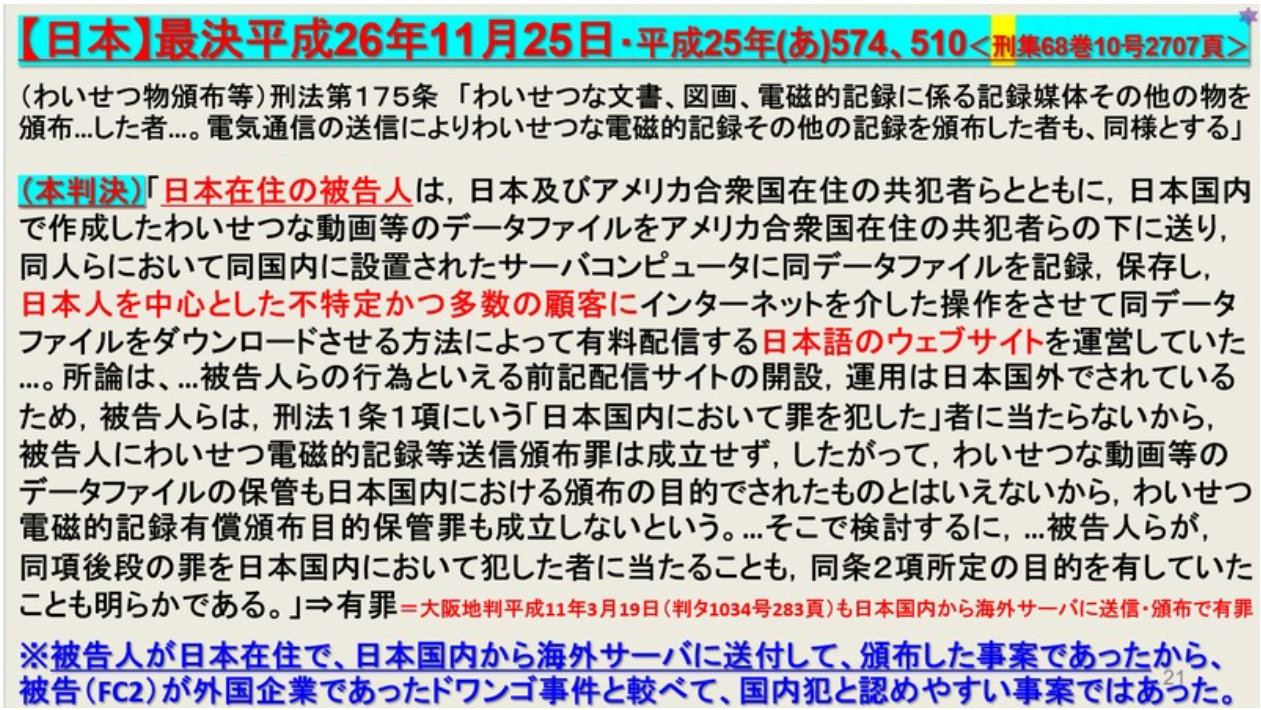
⇒ Persons who ‘committed an offense within Japan’

⇒ Guilty

*Because the defendants resided in Japan and transmitted the images from Japan to an overseas server for distribution, this was a case in which a domestic offense was more readily recognized than in the Dwango case, where the defendant (FC2) was a foreign company.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84650.pdf

Correction to the image heading: 2013 (A) 574 is reported in Shukei No. 315, p. 187; 2013 (A) 510 is reported in Keishu Vol. 68, No. 9, p. 1053. Both are decisions of the Supreme Court, Third Petty Bench, dated November 25, 2014.



English translation of the image

[Japan] Supreme Court decisions of November 25, 2014 — 2013 (A) 574, Shukei No. 315, p. 187; 2013 (A) 510, Keishu Vol. 68, No. 9, p. 1053

Penal Code, Article 175 (Distribution of Obscene Objects, etc.): ‘A person who distributes … obscene documents, drawings, recording media containing electronic or magnetic records, or other objects … The same applies to a person who distributes obscene electronic or magnetic records or other records by transmission through telecommunications.’

[Decision] ‘The defendant residing in Japan, together with accomplices residing in Japan and the United States, sent data files of obscene videos and the like created in Japan to accomplices in the United States, who recorded and stored those files on server computers installed there. They operated a Japanese-language website that distributed the files for a fee by having an unspecified and large number of customers, mainly Japanese, perform operations over the Internet to download them. … The argument is … that because the establishment and operation of the distribution website that can be attributed to the defendants were performed outside Japan, the defendants were not persons who “committed an offense within Japan” under Article 1(1) of the Penal Code; the offense of distribution of obscene electronic or magnetic records by transmission therefore was not established, and consequently storage of the data files of obscene videos and the like was not for the purpose of distribution within Japan, so the offense of possession of obscene electronic or magnetic records for the purpose of distribution for a fee also was not established. … Upon examination … it is clear both that the defendants were persons who committed the offense under the latter sentence of that paragraph within Japan and that they had the purpose specified in paragraph (2) of that article.’ ⇒ Guilty.

The Osaka District Court judgment of March 19, 2015 (Hanji No. 2348, p. 28) also found guilt where transmission and distribution were performed from Japan to an overseas server.

*Because the defendants resided in Japan and sent the files from Japan to an overseas server for distribution, this was a case in which a domestic offense was more readily recognized than in the Dwango case, where the defendant (FC2) was a foreign company.

[Trademarks] IP High Court, 2021 (Gyo-Ke) 10079 <Kanno>

Original Ameblo publication: 2023-03-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795754080.html

[Trademarks] 2021 (Gyo-Ke) 10079 <Kanno>

Inclusion in dictionaries and use in article headlines do not, by themselves, establish that a term is widely known to the general public.

The registered trademark consisting of the Roman letters ‘VEGAS’ written horizontally did not violate Article 3(1)(iii) with respect to ‘providing amusement facilities’ in Class 41.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e5%95%86%e6%a8%99%e6%b3%95%e2%98%85%e3%80%91%e3%80%8cvegas%e3%80%8d%e3%81%ae%e6%ac%a7%e6%96%87%e5%ad%97%e3%82%92%e6%a8%aa%e6%9b%b8%e3%81%8d%e3%81%97%e3%81%a6%e3%81%aa%e3%82%8b%e7%99%bb/

IP High Court, 2020 (Ne) 10042 [Vehicle Guidance System] <Honda>

Original Ameblo publication: 2023-03-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12795877464.html

2020 (Ne) 10042 [Vehicle Guidance System] <Honda>

*Claim limitations held satisfied on appeal, reversing the first-instance finding!!

*The ‘Problem’ and ‘Effects’ sections of the specification contain statements overstated relative to Claim 1 of the parent application.

⇒ Both the judgment below and the appellate judgment construed the claims restrictively in light of the problem/effects, but the appellate court adopted a broader interpretation.

‘Guidance means’ does not exclude manual intervention by an attendant.

(Excerpt from the court's reasoning)

The inventions produce Function and Effect 1 (providing a vehicle guidance system that safely guides vehicles even where an ordinary vehicle enters an entrance/exit for ETC-equipped vehicles, or the ETC system fails to operate normally for an ETC-equipped vehicle). Function and Effect 1 is achieved if data received by the ‘communication means’ from the vehicle's ETC unit are used to determine whether ETC toll collection is possible and the barriers operate at appropriate times so that the vehicle can be guided safely. That function and effect can be achieved whether the ‘communication means’ receive the data from the ETC unit before or after the vehicle passes the first barrier. Turning to Function and Effect 2 (providing a safe vehicle guidance system using an ETC system that prevents wrong-way driving or avoids collisions between preceding and following vehicles), the ‘wrong-way vehicles’ in the inventions include vehicles entering an ETC lane against the permitted direction of traffic through the exit of that lane or the exit of a departure lane, for purposes such as avoiding toll payment. It is clear that preventing such wrong-way driving has no relationship to the relative positions of the ‘communication means’ and ‘first barrier.’ Moreover, regardless of the position of the communication means, lowering the first barrier after the vehicle has passed it prevents wrong-way travel by reversing. …Accordingly, the problem and functions and effects of the inventions do not specify the relative positions of the ‘communication means’ and ‘first barrier’ as the appellee argues….

The claims do not state that the ‘guidance means for guiding to the second lane’ provide automatic guidance, and the specification does not exclude an attendant's involvement in the ‘guidance means.’ In the appellee's systems, although departure-control devices [barriers] (1) and (5) are opened by human operation, there is no need to summon an attendant to the site by intercom. Furthermore, opening those devices allows the vehicle to advance toward the second lane, eliminating the risk that it will try to leave the lane by reversing. The systems can therefore solve the problems addressed by the inventions—‘the need to summon an attendant by intercom exacerbates congestion’ and ‘attempting to leave by reversing creates a danger of collision with following vehicles’—and can achieve the functions and effects of ‘providing a vehicle guidance system that safely guides vehicles’ and ‘providing a safe vehicle guidance system capable of avoiding collisions between preceding and following vehicles.’ The inventions themselves also contemplate that a vehicle may stop before the first barrier…. Accordingly, there is no reason to construe the ‘guidance means for guiding to the second lane’ restrictively as the appellee argues, and that argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91286.pdf

[Copyright] Osaka District Court, 2020 (Wa) 9992 — ‘Original artwork claimed to be a copyrightable artistic work,’ but copyrightability denied

Original Ameblo publication: 2023-03-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796033617.html

[Copyright] Osaka District Court, 2020 (Wa) 9992

The clock’s original artwork is applied art ⇒ Copyrightability denied because no aesthetic features separable from its practical function were found

The plaintiff argued that the clock’s original artwork could be protected as an artistic work even if it was applied art, provided that it also had the nature of fine art. In light of factors including the mass production and sale of clocks commercialized from the artwork, the court held that ‘the original artwork at issue was created for practical use and constitutes so-called applied art.’ It then denied copyrightability because it found no aesthetic features that could be appreciated as art separately from the practical function.

Copyrightability denied

hanrei-pdf-90473.pdf (courts.go.jp)

[YouTube: Introducing One Case] IP High Court, 2019 (Gyo-Ke) 10159 [X-Ray Fluoroscopic Imaging Apparatus] <Kanno>

Original Ameblo publication: 2023-03-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796107779.html

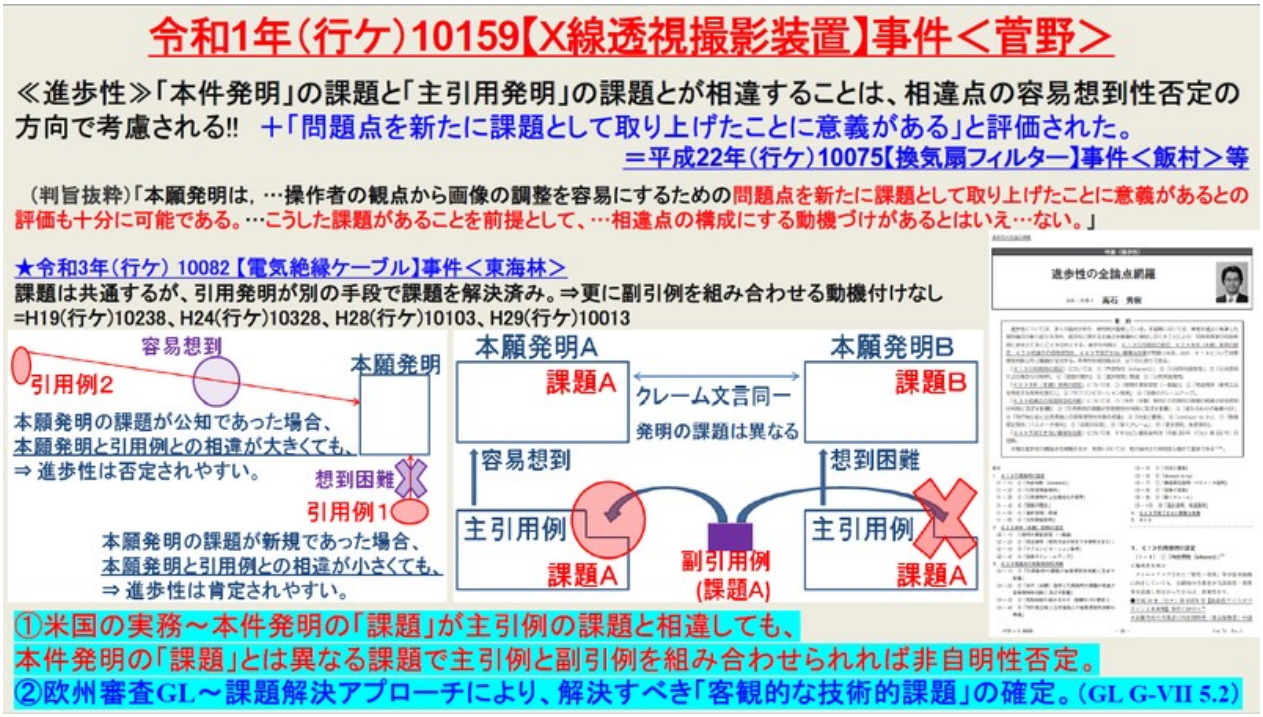
[YouTube: Introducing One Case] 2019 (Gyo-Ke) 10159 [X-Ray Fluoroscopic Imaging Apparatus] <Kanno>

<Inventive step> A difference between the problem addressed by ‘the invention at issue’ and that addressed by ‘the primary cited invention’ weighs against a finding that the distinguishing feature would have been obvious!!

+The court recognized significance in ‘newly identifying the difficulty as a problem to be addressed.’

=2010 (Gyo-Ke) 10075 [Ventilation Fan Filter] <Iimura>, etc.

(15) [Patents] X-Ray Fluoroscopic Imaging Apparatus — YouTube



English translation of the image

2019 (Gyo-Ke) 10159 [X-ray Fluoroscopic Imaging Apparatus] <Kanno>

Inventive step: A difference between the problem of the claimed invention and that of the primary cited invention weighs against finding the differences readily conceivable. The court also evaluated the significance of newly taking up the issue as a problem. See also 2010 (Gyo-Ke) 10075 [Ventilation Fan Filter] <Iimura>, etc.

[Excerpt from the judgment] ‘The invention … can also sufficiently be evaluated as significant in newly taking up the issue of making image adjustments easier from the operator's perspective as a problem. … On the premise of such a problem … it cannot be said that there is motivation to adopt the configuration constituting the difference ….’

★ 2019 (Gyo-Ke) 10082 [Electric Insulated Cable] <Shoji>: The problem is common, but the cited invention solves it by a different means. ⇒ There is no motivation additionally to combine a secondary

reference. Also 2007 (Gyo-Ke) 10238, 2012 (Gyo-Ke) 10328, 2016 (Gyo-Ke) 10103, and 2017 (Gyo-Ke) 10013.

Left diagram: Claimed invention; Cited Reference 2 — readily conceivable; Cited Reference 1 — difficult to conceive. Where the claimed invention's problem is known, inventive step is likely to be denied even if the difference between the claimed invention and the cited reference is large. Where the claimed invention's problem is novel, inventive step is likely to be affirmed even if the difference is small.

Center diagram: Claimed Invention A — Problem A; Claimed Invention B — Problem B. The claim language is the same, but the inventions' problems differ. Primary reference — Problem A; secondary reference — Problem A. Combination for Invention A: readily conceivable. Combination for Invention B: difficult to conceive.

(1) U.S. practice: Even if the claimed invention's problem differs from that of the primary reference, non-obviousness is denied if the primary and secondary references can be combined to solve a problem different from that of the claimed invention. (2) EPO Examination Guidelines: Under the problem–solution approach, determine the objective technical problem to be solved (Guidelines G-VII, 5.2).

Inset heading: Starting point of inventive step.

[U.S. Patents] November 2022, AMP Plus, Inc. (d/b/a ELCO Lighting) v. DMF, Inc. <CAFC>

Original Ameblo publication: 2023-03-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796188006.html

[U.S. Patents] November 2022, AMP Plus, Inc. (d/b/a ELCO Lighting) v. DMF, Inc. <CAFC>

In assessing novelty, the court held that there was no reason to limit a catalog's general disclosure concerning LEDs to the several specific products listed in it.

A claim-construction argument made during prosecution does not establish prosecution disclaimer unless it clearly and unambiguously surrenders claim scope.

https://t.co/YYX3Kz92Kt

[Violation of Exclusive Jurisdiction] Osaka High Court, 2022 (Ne) 1273

Original Ameblo publication: 2023-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796501098.html

[Violation of Exclusive Jurisdiction] Osaka High Court, 2022 (Ne) 1273

First instance: Kobe District Court, 2019 (Wa) 488

Claim for damages for breach of a commissioned-research agreement

⇒ An ‘action relating to a patent right…’ under Article 6(1) of the Code of Civil Procedure also includes an action concerning the right to obtain a patent.

⇒ The defendant disputes that the invention was covered by the commissioned research.

⇒ Transferred to the Osaka District Court

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91436.pdf

Tokyo District Court, 2019 (Wa) 20074 [Heater Assembly for an Aerosol-Generating System] <Kokubu>

Original Ameblo publication: 2023-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796660319.html

Tokyo District Court, 2019 (Wa) 20074 [Heater Assembly for an Aerosol-Generating System] <Kokubu>

<Satisfaction of claim limitations>

Even an inseparably integrated structure falls within ‘coupled to the heater.’

⇒ Whether ‘coupled’ includes integral molding may be outside the decision's reach.

<Damages>

Advertising expenses directly related to sales may be deducted from profits under Article 102(2).

The contribution of design to sales was unclear.

Market shares and the like of competing products must be proved.

(Excerpt from the court's reasoning)

Claim Element C provides that the heater assembly of the invention comprises ‘a heater mount coupled to the heater.’ In ordinary usage, ‘coupling’ means ‘two or more things becoming connected as one; also, connecting them into one’ (Exhibit Otsu 1). It is therefore natural from the wording to understand that a heater mount connected to the heater to form one unit or assembly satisfies this element, whether or not they can be described as inseparably integrated. Such a heater mount would also be expected to achieve the …function and effect of structurally supporting the heater and securely fixing it within the aerosol-generating device. Furthermore, the specification contains no explanation or the like requiring a restrictive interpretation of ‘coupled to the heater.’ Accordingly, a heater mount connected to the heater to form one unit or assembly falls within ‘coupled to the heater,’ irrespective of whether they are inseparably integrated….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91282.pdf

[U.S. Patents] Nonstatutory Double Patenting — MPEP 804, subsection I.B.1.b)(iv)

Original Ameblo publication: 2023-04-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12796806862.html

[U.S. Patents] Nonstatutory Double Patenting — MPEP 804, subsection I.B.1.b)(iv)

Revised to provide guidance on examiners' responses.

Obviousness-type double patenting

⇒ Nonstatutory double patenting

When considering a terminal disclaimer, take PTA (Patent Term Adjustment) into account!

https://www.uspto.gov/web/offices/pac/mpep/s804.html

[United States] 2015 (CAFC), Dow v. Nova / (2015), Teva v. Sandoz

Original Ameblo publication: 2023-04-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12797163922.html

[United States] August 2015, CAFC, Dow v. Nova

Indefinite because different methods of measuring the ‘slope of strain hardening,’ which is needed to calculate the ‘slope of strain hardening coefficient’ (SHC), can produce different results, while the patents and prosecution history do not identify which method should be used.

=CAFC (2003), Honeywell v. ITC

CAFC (2015), Teva v. Sandoz, likewise held it indefinite which ‘molecular weight’ was intended: peak-average, number-average, or weight-average molecular weight.

https://www.cafc.uscourts.gov/opinions-orders/14-1431.opinion.8-25-2015.1.pdf

[Article] ‘Case Study of Technical Features of Software Inventions in European Patents’ (Intellectual Property Management, January 2023 issue, First Subcommittee of the Software Committee)

Original Ameblo publication: 2023-04-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12797318088.html

[Article] ‘Case Study of Technical Features of Software Inventions in European Patents’ (Intellectual Property Management, January 2023 issue, First Subcommittee of the Software Committee)

Identification of ‘nontechnical matters’ in rejections under EPC Article 56 (inventive step) can be classified into the following three patterns.

(i) Merely the operations of a general-purpose computer

(ii) Does not achieve a technical effect

(iii) Makes no technical contribution

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2301

[Article] [United States] Evolving Written-Description Requirements for Functional Genus Claims and Countermeasures (Intellectual Property Management, January 2023 issue, Nao Takada)

Original Ameblo publication: 2023-04-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12797554023.html

[Article] [United States] Evolving Written-Description Requirements for Functional Genus Claims and Countermeasures (Intellectual Property Management, January 2023 issue, Nao Takada)

Ariad v. Eli Lilly (Fed. Cir. 2010)

Required disclosure

(i) A representative number of species within the genus

OR

(ii) Common structural features enabling a person skilled in the art to ‘visualize or recognize’ members of the genus

Four subsequent cases applied the same standard.

https://www.cafc.uscourts.gov/opinions-orders/08-1248.pdf

[Copyright] Tokyo District Court, 2019 (Wa) 8969

Original Ameblo publication: 2023-04-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12797810114.html

[Copyright] Tokyo District Court, 2019 (Wa) 8969

In this case, creating inline links was held neither to infringe the reproduction right nor to aid infringement of the reproduction right or the right of public transmission.

(i) It does not reproduce the work in tangible form.

(ii) It is difficult to say that creating the link facilitated reproduction or public transmission by the person who uploaded the video.

<My view> The situation would presumably be different for a link to a page with limited public access.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91123.pdf

[U.S. Patents] December 2022, CAFC, Google v. Hammond <Collateral estoppel>

Original Ameblo publication: 2023-04-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12797973156.html

[U.S. Patents] December 2022, CAFC, Google v. Hammond

Claim 18 of the second patent (the ’816 patent) was materially identical to claim 18 of the first patent (the ’483 patent), which had been finally held unpatentable; the specifications were also the same. The patentability issue was therefore identical, and collateral estoppel barred relitigation, rendering claim 18 unpatentable. Claim 14 was also held unpatentable because the parties agreed that it should receive the same disposition. For claims 15–17 and 19, however, the court affirmed the Board’s determination that unpatentability had not been established.

⇒ Identity of the patentability issue is crucial!!

https://openlegalcommunity.com/old-related-ipr-may-be-used-to-invalidate-claims-in-anoter-ipr-collateral-estoppel/

[Article] A Case Invalidating a Use-Invention Patent as Indistinguishable from a Known Use (Professor Hiroshi Yoshida)

Original Ameblo publication: 2023-04-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798138341.html

[Article] ‘A Case Invalidating a Use-Invention Patent as Indistinguishable from a Known Use’ (Professor Hiroshi Yoshida, March 2023)

<Distinguishing known products, methods, uses, and effects>

From the perspective of distinguishing inventions from the public domain, the article examines use claims, reciting effects in claims, inherent properties, and parameter inventions in an integrated manner.

https://www.inpit.go.jp/content/100877332.pdf

[Article] Cross-Border Patent Infringement: Two Recent Cases (Professor Yasuyuki Echi, September 2022)

Original Ameblo publication: 2023-04-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798293705.html

[Article] Cross-Border Patent Infringement: Two Recent Cases (Professor Yasuyuki Echi, September 2022)

Network-connected servers …If activity directed at the Japanese market diverts demand for a patented invention in Japan, claims for an injunction and damages should be considered potentially available … regardless of where the act of working itself takes place.

https://www.inpit.go.jp/content/100875847.pdf

IP High Court, 2020 (Ne) 10042 [Vehicle Guidance System] <Honda> — *Reversed on appeal: claim limitations held satisfied

Original Ameblo publication: 2023-04-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798460321.html

2020 (Ne) 10042 [Vehicle Guidance System] <Honda>

Overstated descriptions in the ‘Problem’ and ‘Effects’ sections of the specification

⇒ Both the first-instance court and the appellate court construed the claims in light of the problem/effects, but the appellate court adopted a broader interpretation.

⇒ Finding of non-satisfaction reversed on appeal

‘In relation to the problem addressed by the inventions and their functions and effects, …the relative positions cannot be restricted as the appellee argues.’

‘The claims do not state that the “guidance means for guiding to the second lane” provide automatic guidance, and the specification does not exclude an attendant's involvement in the “guidance means.” … The functions and effects can be achieved.’

(Excerpt from the court's reasoning)

The inventions produce Function and Effect 1 (providing a vehicle guidance system that safely guides vehicles even where an ordinary vehicle enters an entrance/exit for ETC-equipped vehicles, or the ETC system fails to operate normally for an ETC-equipped vehicle). Function and Effect 1 is achieved if data received by the ‘communication means’ from the vehicle's ETC unit are used to determine whether ETC toll collection is possible and the barriers operate at appropriate times so that the vehicle can be guided safely. That function and effect can be achieved whether the ‘communication means’ receive the data from the ETC unit before or after the vehicle passes the first barrier. Turning to Function and Effect 2 (providing a safe vehicle guidance system using an ETC system that prevents wrong-way driving or avoids collisions between preceding and following vehicles), the ‘wrong-way vehicles’ in the inventions include vehicles entering an ETC lane against the permitted direction of traffic through the exit of that lane or the exit of a departure lane, for purposes such as avoiding toll payment. It is clear that preventing such wrong-way driving has no relationship to the relative positions of the ‘communication means’ and ‘first barrier.’ Moreover, regardless of the position of the communication means, lowering the first barrier after the vehicle has passed it prevents wrong-way travel by reversing. …Accordingly, the problem and functions and effects of the inventions do not specify the relative positions of the ‘communication means’ and ‘first barrier’ as the appellee argues….

The claims do not state that the ‘guidance means for guiding to the second lane’ provide automatic guidance, and the specification does not exclude an attendant's involvement in the ‘guidance means.’ In the appellee's systems, although departure-control devices [barriers] (1) and (5) are opened by human operation, there is no need to summon an attendant to the site by intercom. Furthermore, opening those devices allows the vehicle to advance toward the second lane, eliminating the risk that it will try to leave the lane by reversing. The systems can therefore solve the problems addressed by the inventions—‘the need to summon an attendant by intercom exacerbates congestion’ and ‘attempting to leave by reversing creates a danger of collision with following vehicles’—and can achieve the functions and effects of ‘providing a vehicle guidance system that safely guides vehicles’ and ‘providing a safe vehicle guidance system capable of avoiding collisions between preceding and following vehicles.’ The inventions themselves also contemplate that a vehicle may stop before the first barrier…. Accordingly, there is no reason to construe the ‘guidance means for guiding to the second lane’ restrictively as the appellee argues, and that argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91286.pdf

[Trademarks] Tokyo District Court, 2020 (Wa) 1160 <Kokubu> — ‘KENT’ ‘BROS.’

Original Ameblo publication: 2023-04-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798702721.html

[Trademarks] Tokyo District Court, 2020 (Wa) 1160 <Kokubu>

Registered trademark: ‘Kent’

Defendant's sign: ‘KENT’ and ‘BROS.’ on two lines

⇒ The elements may be assessed separately

⇒ Similar

The defendant held a registered trademark with ‘KENT BROS.’ and ‘Kento Burosu’ on two lines, but….

‘Even if …a defense of use of a registered trademark could apply…, the use is not within the scope of the exclusive right.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90919.pdf

Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs]

Original Ameblo publication: 2023-04-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798703159.html

Osaka District Court, 2015 (Wa) 8974

=Appeal: 2019 (Ne) 10007

[Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] case

Indirect infringement involving an indispensable article established

Knowledge of the patented invention covered by the claims before correction also satisfies subjective requirement (i) (‘that the invention is patented’) in relation to the patented invention after correction of the claims.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88263.pdf

IP High Court, 2021 (Gyo-Ke) 10085 [Printed Retroreflective Sheet] <Kanno>

Original Ameblo publication: 2023-04-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12798957874.html

2021 (Gyo-Ke) 10085 [Printed Retroreflective Sheet] <Kanno>

Multiple differences concerning features indispensable to solving the problem should be assessed together as an integrated configuration when determining whether they were readily conceivable.

'…The problem could not be recognized, and there is no motivation to apply the technology described in Exhibit Ko 3 on the premise of such a problem.'

⇒ Inventive step upheld

'…In the invention, …adhesion between the "surface protective layer" and the "support layer" is taken for granted. The defendant's argument therefore rests on an erroneous premise and cannot be accepted.'

⇒ Support requirement satisfied

(Excerpt from the court's reasoning)

<Inventive step>

The invention …has technical significance in (i) …(ii) …(iii) …(iv) …to solve the problems of the prior art, and …(ii) and (iii) can be said to be indispensable features for solving the problem. Accordingly, rather than separately assessing whether Differences 1-1 and 1-4 concerning (ii) and (iii) were readily conceivable, they should be assessed as an integrated configuration. (Even if they were considered separately, the conclusion would not change….)

…The Exhibit Ko 1 invention has a gap between microspheres 16 and cover layer 18, together with a printing layer uniformly patterned in multiple white-colored dots on one or both sides of that cover layer. Cover layer 18 is not attached to the assembly except at portions adjacent to the edges of the sheet. The gap is provided to form an optical path for retroreflection. Accordingly, a person skilled in the art encountering the Exhibit Ko 1 invention cannot recognize the problem of water or the like entering the gap between the printed portion and second layer 14, causing swelling or the like in the printing layer and thereby reducing retroreflectivity; there is no motivation to apply the technology described in Exhibit Ko 3 on the premise of such a problem.

<Support requirement>

…The defendant argues …that the JPO decision questioned not only the failure to specify adhesion between the 'support layer' and 'surface protective layer,' but also the failure to establish that those layers in portions of Invention 1 without an 'independent printing region' are bonded over a width maintaining close adhesion. Because the claimed 'retroreflective sheet' lacking that configuration includes embodiments that would not receive an 'abnormality-free' evaluation in the weather-resistance test described in the specification…, the defendant argues that the support requirement is violated. However, in the invention, … adhesion between the 'surface protective layer' and 'support layer' is taken for granted. The defendant's argument therefore rests on an erroneous premise and cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91498.pdf

[U.S. Patents] USPTO memorandum of August 18, 2020 — Treatment of AAPA in IPR

Original Ameblo publication: 2023-04-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799264032.html

[U.S. Patents] USPTO memorandum of August 18, 2020

In an IPR, applicant-admitted prior art (AAPA) cannot itself serve as the prior art forming the basis of a ground under 35 U.S.C. §311(b). Under the 2022 updated guidance, however, it may be used as evidence of a skilled artisan’s general knowledge in an obviousness analysis based on prior-art patents or printed publications.

⇒ Take care with admissions of prior art in the specification; they can needlessly give things away, particularly in the United States!!

https://www.patent-topics-explorer.com/entry/2022/02/15/211448

IP High Court, 2017 (Gyo-Ke) 10201 [Beauty Device] <Takabe>

Original Ameblo publication: 2023-04-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799436317.html

2017 (Gyo-Ke) 10201 [Beauty Device] <Takabe>

*Even though closely interrelated Differences 1 and 2 (the respective numerical ranges) are disclosed in different references, inventive step was upheld.

Cf. ‘Obvious-upon-obvious’

⇒ Describe the relationship between the respective numerical ranges in the specification!!

Cf. 2018 (Gyo-Ke) 10013, decided on the same day by the same division between the same parties, to the same effect

‘The features corresponding to Differences 1 and 2 are not wholly independent but closely interrelated…. The fact that the respective numerical-range features are disclosed in separate references does not establish …that a person skilled in the art could readily have conceived of those features.’

(Excerpt from the court's reasoning)

…At the very least, the features corresponding to Differences 1 and 2 are not wholly independent but closely interrelated. Accordingly, the fact that the respective numerical-range features corresponding to those differences are disclosed in separate references does not establish that a person skilled in the art could readily have conceived of them….

When the beauty device of the corrected invention is in use, the configuration corresponding to Difference 3 can be described as preventing the ball-support shafts from directly contacting the skin. In terms of relating to which part of the balls contacts the skin, the same is true not only of the common feature ‘inclining the axes of the balls forward relative to the handle centerline so that the axes maintain a constant angle relative to the skin during reciprocating movement,’ but also of the feature corresponding to Difference 1, ‘setting the opening angle between the pair of ball-support shafts to 65–80 degrees,’ and the feature corresponding to Difference 2, ‘setting the spacing between the outer peripheral surfaces of the pair of balls to 10–13 mm.’ Accordingly, the feature corresponding to Difference 3 should not be regarded as independent of those other features of the corrected invention, including the features corresponding to Differences 1 and 2; rather, it is appropriate to understand and identify them as mutually related.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87967.pdf

IP High Court, 2021 (Gyo-Ke) 10140 [Electroformed Tube Case] — *I have posted a commentary on the Nakamura & Partners website

Original Ameblo publication: 2023-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799998131.html

2021 (Gyo-Ke) 10140 [Electroformed Tube Case] <Presiding Judge Kanno>

[Patents ★] Within the cases known to the author when the original article was published, the first and only lower-court decision to require ‘impossible or impractical circumstances’ for the clarity of a product invention defined by its manufacturing process, and to find a violation of the clarity requirement

*I have posted a commentary on the Nakamura & Partners website.

(Excerpt from the court's reasoning)

…Even where claims for a patent on a product invention recite the manufacturing process for that product, if, unlike the general situation described above, it is unambiguously clear at the filing date from the claims, specification, drawings, and common general technical knowledge what structure or properties the product manufactured by that process represents, third parties' interests are not unjustly harmed. It is therefore understood that there is no violation of the clarity requirement even in the absence of impossible or impractical circumstances….

…The specification neither states nor suggests anything concerning the inner-surface accuracy of electroformed tubes manufactured by the processes of Invention 6 and Corrected Invention 9. The specification describes the following methods of removing the fine wire: (i) forming a gap between the electrodeposit, etc. and the fine wire by heating and thermally expanding the electrodeposit, etc. or cooling and shrinking the wire; (ii) making the contact area between the fine wire and the electrodeposit, etc. slippery by immersing it in liquid or pouring liquid over it; (iii) pulling from one or both ends to deform it so as to reduce its cross-sectional area and thereby form a gap between the fine wire and the electrodeposit, etc., then gripping and pulling it, suctioning it, physically pushing it, or forcing it out by ejecting gas or liquid; and (iv) melting or dissolving it with heat or a solvent ([0041], [0116]). However, there is no description whatsoever of the technical relationship between these methods and the inner-surface accuracy of the electroformed tube produced, much less any statement or suggestion that the manufacturing processes of Invention 6 and Corrected Invention 9 (included in method (iii) above) signify a particular inner-surface accuracy different from that of tubes produced by other methods. Nor can it be found that there was common general technical knowledge as to whether these methods produce differences in inner-surface accuracy. Accordingly, the structure or properties of electroformed tubes produced by the manufacturing processes of Invention 6 and Corrected Invention 9 cannot be said to be unambiguously clear….

For the foregoing reasons, Invention 6 and Corrected Invention 9 can be regarded as clear only if, at the filing date of this application, there were impossible or impractical circumstances preventing the electroformed tubes of those inventions from being defined directly by their structure or properties. The defendant acknowledges that no such circumstances existed.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e8%a3%bd%e9%80%a0%e6%96%b9%e6%b3%95%e3%81%ab%e3%82%88%e3%82%8a%e7%89%b9%e5%ae%9a%e3%81%95%e3%82%8c%e3%81%9f%e7%89%a9%e3%81%ae%e7%99%ba%e6%98%8e%e3%81%ae/

[U.S. Patents] June 2022, CAFC, Novartis v. Accord Healthcare

Original Ameblo publication: 2023-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799999104.html

[U.S. Patents] June 2022, CAFC, Novartis v. Accord Healthcare

A negative limitation added during prosecution to avoid prior art does not satisfy the written-description requirement merely because the specification lacks an affirmative disclosure. (The requirement is satisfied if a person skilled in the art can understand the specification as effectively disclosing the negative limitation.)

⇒ In this case, the written-description requirement was not satisfied.

https://www.itohpat.co.jp/ip/1900/

IP High Court, 2022 (Gyo-Ke) 10019 [Die for Wire Having a Polygonal Cross Section] <Honda>

Original Ameblo publication: 2023-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799999248.html

2022 (Gyo-Ke) 10019 [Die for Wire Having a Polygonal Cross Section] <Honda>

The claim wording ‘substantially polygonal’

⇒ Directly related to the problem/effect (making lubricant less likely to accumulate at the corners of the opening).

⇒ Unclear how much rounding of the corners falls within the term.

⇒ Violation of the clarity requirement (JPO decision revoked)

(Excerpt from the court's reasoning)

…(…The tendency of lubricant to accumulate at a corner of the opening is understood to depend not only on the radius of curvature of the rounded corner, but on various factors, including the type of wire, type of lubricant, and degree of heat generated by processing. It cannot be found that a radius of approximately 0.3 mm or less invariably prevents the inventions' effect from being obtained. The defendant's argument therefore cannot be accepted.) …

According to the claims and specification, ‘substantially polygonal’ in the inventions can provisionally be understood as a figure obtained by actively rounding all or some corners of an opening that had not undergone such treatment, in order to achieve the inventions' effect (making lubricant less likely to accumulate at the corners). However, the objective shape does not distinguish ‘substantially polygonal’ from the ‘underlying polygonal cross section.’ Nor is it clear how large a rounding of the corners of the ‘underlying polygonal cross section’ qualifies as ‘substantially polygonal.’ The technical scope of the inventions must therefore be regarded as unclear, and ‘substantially polygonal’ is unclear to the extent of unjustly harming third parties' interests….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91532.pdf

IP High Court, 2022 (Gyo-Ke) 10027 [Tilling Claw] <Shoji> — *‘Substantially constant’ and ‘substantially the same’ ⇛ Clarity requirement satisfied

Original Ameblo publication: 2023-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12799999446.html

2022 (Gyo-Ke) 10027 [Tilling Claw] <Shoji>

‘Substantially constant distance’ = ‘predetermined distance’ in the detailed description

⇒ Clarity requirement satisfied

‘Substantially the same position’ — The position need only be sufficient to achieve the invention's effect (suppressing uneven wear), and a person skilled in the art can understand that degree.

⇒ Clarity requirement satisfied

(Excerpt from the court's reasoning)

[Claim 1] …A tilling claw …in which the end of the hard-alloy portion on the mounting-base side is positioned at substantially the same position as the sharpened end of the longitudinal blade portion, …and the ridge-side end of the hard-alloy portion …extends along the ridges of the longitudinal and transverse blade portions, at a substantially constant distance toward the cutting-edge side from those ridges….

…Both ‘substantially constant distance’ in Feature 1E of Invention 1 and ‘predetermined distance’ in paragraphs [0032] and [0042] of the specification, etc. refer to the distance between the ridge-side end of the hard-alloy portion and the ridges of the longitudinal and transverse blade portions. It is therefore natural to construe the latter ‘predetermined distance’ as having the same meaning as the former ‘substantially constant distance.’ Such an interpretation allows Invention 1 and its embodiments to be understood as achieving the functions and effects stated in the specification, etc.

…The [Effects of the Invention] section of the specification, etc. states: ‘According to the invention, … uneven wear in which the longitudinal blade portion wears significantly more than the transverse blade portion can be suppressed’ (paragraph [0009]). Whether the respective ends are in ‘substantially the same position’ therefore depends on whether their positions allow the hard-alloy portion to cover the sharpened part of the longitudinal blade sufficiently to ‘suppress uneven wear in which the longitudinal blade portion wears significantly more than the transverse blade portion,’ including portions without hard alloy. A person skilled in the art can understand that degree in light of the specification, etc.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91667.pdf

[U.S. Patents] July 2005, CAFC en banc, Phillips v. AWH Corp.

Original Ameblo publication: 2023-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800143008.html

[U.S. Patents] July 2005, CAFC en banc, Phillips v. AWH Corp.

‘Claim differentiation’ recognized

(Related provision: 35 U.S.C. §112(d), then §112, fourth paragraph)

‘If the baffles in Claim 1 were inherently angled, that would duplicate other claims limiting this feature.’

+Intrinsic evidence is more reliable than extrinsic evidence in claim construction.

https://www.oliff.com/wp-content/uploads/2022/03/07-25-05-Phillips-v-AWH-_Japanese_.pdf

[Copyright] Fukuoka District Court, 2019 (Criminal Wa) 1181 <Mangamura / Criminal Case> — *The reverse-proxy configuration in this case infringed the right to make a work transmittable

Original Ameblo publication: 2023-04-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800289280.html

[Copyright] Fukuoka District Court, 2019 (Criminal Wa) 1181 <Mangamura / Criminal Case>

⇒ Configuring the reverse proxy in this case (which, upon receiving a request, obtained image data from a third-party server and transmitted it to the viewer) was held to infringe the right to make a work transmittable.

Tokyo District Court, 2019 (Wa) 8969 <Kokubu>

⇒ The inline links in this case did not infringe the right of public transmission. Aiding infringement was also not established.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91123.pdf

[Article] Handling License Agreements in Business Transfers, Acquisitions, and Insolvency (Intellectual Property Management, Vol. 64, No. 9, 2014)

Original Ameblo publication: 2023-04-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800422410.html

[Article] Handling License Agreements in Business Transfers, Acquisitions, and Insolvency (Intellectual Property Management, Vol. 64, No. 9, 2014)

Even if a licensor becomes insolvent, there are measures protecting licensees through the restriction of the trustee’s termination rights under Article 53 by Article 56(1) of Japan’s Bankruptcy Act, and through provisions including Section 365(n) of the U.S. Bankruptcy Code.

However, the comparison discussed in the 2014 article is presented as identifying no comparable special statutory protection for licensees in Germany, France, or China.

https://jglobal.jst.go.jp/detail?JGLOBAL_ID=201402299317631313

[Copyright / Right of Publication] Tokyo District Court, 2021 (Wa) 13720 <Kokubu>

Original Ameblo publication: 2023-04-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800574883.html

[Copyright / Right of Publication] Tokyo District Court, 2021 (Wa) 13720 <Kokubu>

Right of publication = the right to ‘reproduce …in its original form’ (Copyright Act, Article 80(1)(i)).

⇒ Does not extend to doujinshi or derivative fan works that do not reproduce the original work in its original form.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91733.pdf

Osaka District Court, 2005 (Wa) 153

Reproduction ‘in its original form’ includes unchanged reproduction as well as reproduction with changes limited to correcting typographical errors, omissions, kana usage, and the like.

IP High Court, 2021 (Gyo-Ke) 10135 [Vector Containing a Stuffer/Filler Polynucleotide Sequence] <Kanno>

Original Ameblo publication: 2023-04-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800692051.html

2021 (Gyo-Ke) 10135 [Vector Containing a Stuffer/Filler Polynucleotide Sequence] <Kanno>

Numerical limitation with insufficient working-example data

⇒ Identical technical significance

⇒ The numerical limitation was held not to be a substantive difference!!

⇒ Novelty denied !!!!!!!!!!!!!

[Claim 1] …The polynucleotide sequence has a length of 7.0 to 10.0 Kb…

'There is no technical significance in the length falling within the specific range "7.0 to 10.0 Kb," …and it cannot be regarded as a substantive difference.'

(Excerpt from the court's reasoning)

[Claim 1] …A recombinant vector plasmid in which the first inactive filler or stuffer polynucleotide sequence has a length of 7.0 to 10.0 Kb.

There is no technical significance in the filler or stuffer polynucleotide sequence of the vector plasmid having a length within the specific range '7.0 to 10.0 Kb.' …In the cited invention too, the stuffer sequence is modified so that the backbone exceeds AAV's packaging capacity. The combined length of the transgene (4,297 nt (approximately 4.297 Kb)) and the stuffer sequence contained in this backbone (6,980 bp (approximately 6.980 Kb)) can be understood to exceed the packaging capacity of 4.7 Kb. The claimed invention …and the cited invention are therefore identical in technical significance, and specifying the filler or stuffer polynucleotide sequence of the vector plasmid in the claimed invention …to have a length within the specific range '7.0 to 10.0 Kb' is not a substantive difference. …It cannot readily be found that the amount of residual DNA in the AAV particles of the claimed invention …is even lower than 2.69 ± 0.69 pg/10^9 vg; nor, even if the residual DNA amount decreases, can it readily be found that the decrease results from lengthening the oversized backbone….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91565.pdf

★JPO Decision 2020-015732 Recognizing Criticality [Acoustic Wave Device]

Original Ameblo publication: 2023-04-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800770445.html

★JPO Decision 2020-015732 Recognizing Criticality

[Acoustic Wave Device] case

'…As shown in the graph in Figure 7 of the application, the numerical limitation setting the gap length to 0.22λ or less has so-called criticality: at 0.22λ, the propagation loss (return loss) is substantially smaller than at 0.24λ or more….'

https://www.j-platpat.inpit.go.jp/a0202

[U.S. Patents] 2015, U.S. Supreme Court, Commil v. Cisco — Claims to non-manufacturing methods are extremely useful in the United States!

Original Ameblo publication: 2023-05-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12800995999.html

May 2015, U.S. Supreme Court, Commil v. Cisco

<Damages awarded in jury verdicts during the litigation> Direct infringement: $3.7 million; induced infringement: $63.7 million

The United States has no ‘in the course of business’ requirement.

⇒ The user infringes.

⇒ Induced infringement may also arise for a non-manufacturing method if the requirements, including direct infringement and the required knowledge, are satisfied.

⇒ Claims to non-manufacturing methods are extremely useful in the United States!

*There is a parallel in Japan too, because indirect infringement does not require the direct actor to act ‘in the course of business.’

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/8_CommilUSA_LLCv_CiscoSystems_Inc.pdf

[U.S. Patents] February 2016, CAFC, PPC Broadband v. Corning

Original Ameblo publication: 2023-05-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12801142292.html

[U.S. Patents] February 2016, CAFC, PPC Broadband v. Corning

‘Reside around’ was construed narrowly under the BRI standard by reference to the specification.

‘Around’ appears seven times in the specification.

⇒ In each instance, it means ‘encircling or surrounding.’

‘Near’ and ‘nearest’ appear twelve times in the specification.

⇒ In each instance, they mean ‘in the vicinity of.’

The two are not used interchangeably.

http://beikokupat.com/us-patent/number15/

[U.S. Patents] March 2018, CAFC, In re Power Integrations

Original Ameblo publication: 2023-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12801307033.html

[U.S. Patents] March 2018, CAFC, In re Power Integrations

*The claim term ‘coupled’ was construed narrowly under the BRI standard by reference to the specification.

The BRI standard interprets claims broadly, but does not confer unlimited authority to construe claim language while disregarding the claim as a whole or the specification.

https://t.co/Y9iARgtUHO

[U.S. Patents] August 2022, CAFC, In re McDonald

Original Ameblo publication: 2023-05-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12801478959.html

[U.S. Patents] August 2022, CAFC, In re McDonald

An invention intentionally surrendered by the patentee during prosecution cannot be recovered through reissue under the rule prohibiting recapture.

⇒ After adding ‘processor’ in response to a Section 101 rejection, the patentee could not delete it in reissue.

https://openlegalcommunity.com/reissue-cannot-get-back-what-is-gave-away/

[Copyright] A Case Finding Inclusion of Tweets in a Book to Be Lawful Quotation under Copyright Act Article 32(1): the KuToo Case

Original Ameblo publication: 2023-05-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12801580604.html

[Article] A Case Finding Inclusion of Tweets in a Book to Be Lawful Quotation under Copyright Act Article 32(1): the KuToo Case (Takuto Hirasawa)

Among the judgments surveyed in this article that rejected lawful quotation, the grounds were as follows:

Many reject the ‘within a justified scope’ requirement!

Only ‘fair practice’ rejected: two decisions (the first-instance judgment and appeal in the same case)

‘Principal–subordinate relationship’ rejected: two cases

Only ‘made public’ rejected: three cases

‘Purpose of the quotation’ rejected: one case

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/87756/1/66_05_Hirasawa.pdf

[Copyright] Cases Rebutting the Presumption under Article 61(2), (1): Osaka High Court decision, March 31, 2011, ‘Hikonyan’

Original Ameblo publication: 2023-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802019807.html

[Copyright] Cases Rebutting the Presumption under Article 61(2), (1): Osaka High Court decision, March 31, 2011, ‘Hikonyan’

The character was adopted with the expectation of broad use as the mascot for the 400th anniversary festival of Hikone Castle's construction.

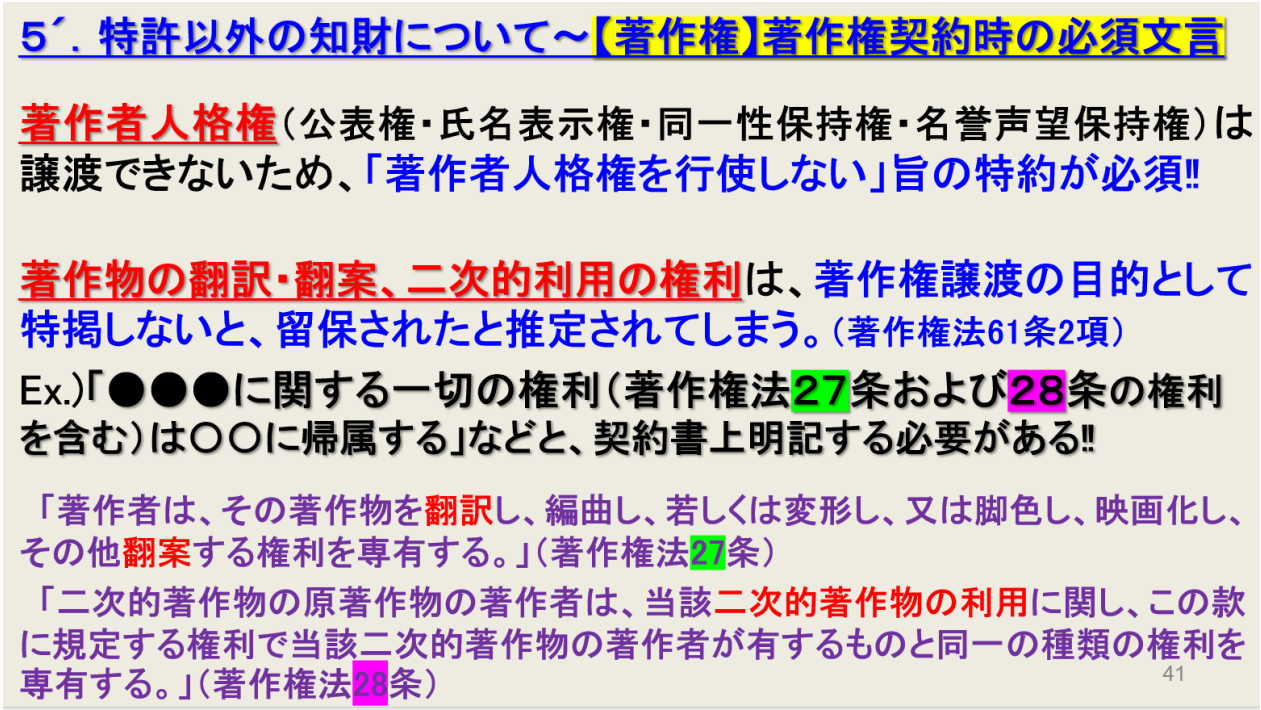
The contract states that three-dimensional objects may be freely created and used.

⇒ Three-dimensional objects may be created from the respective illustrations.

[Copyright] Cases Rebutting the Presumption under Article 61(2), (2): IP High Court judgment, August 31, 2006, ‘System K2’

The master agreement provided that the effect of copyright assignments under individual agreements would survive termination of those agreements, vested copyright in the program in the defendant, and allowed the defendant to use it. The development fee was substantial. The plaintiff received a share of the defendant's sales profits.

https://iplaw-net.com/column/1577



English translation of the image

5. Intellectual property other than patents — [Copyright] Essential wording in copyright contracts

The author's moral rights (the right to make a work public, the right of attribution, the right to integrity, and protection of honor and reputation) cannot be transferred; therefore, a special agreement that the author will not exercise moral rights is essential!!

The rights to translate or adapt a work and to exploit derivative works are presumed to be reserved unless specifically identified as the subject of the copyright transfer (Copyright Act, Article 61(2)).

For example, the contract needs to expressly state: ‘All rights relating to ●●● (including the rights under Articles 27 and 28 of the Copyright Act) belong to ○○’!!

‘The author has the exclusive right to translate, arrange musically or transform, or dramatize, cinematize, or otherwise adapt the work.’ (Copyright Act, Article 27.)

‘The author of the original work of a derivative work has, with respect to exploitation of that derivative work, rights of the same kinds as those held by the author of the derivative work under this Subsection.’ (Copyright Act, Article 28.)

Tokyo District Court, 1994 (Wa) 22487 [Sintered Body for High-Hardness Tools] <Mimura>

Original Ameblo publication: 2023-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802020051.html

Tokyo District Court, 1994 (Wa) 22487 [Sintered Body for High-Hardness Tools] <Mimura>

‘This does not exclude the presence in the sintered body of components that may unavoidably be contained, but …they are limited to small amounts negligible in relation to the whole (amounts that do not substantially change the foregoing composition)….’

⇒ Claim limitation not satisfied

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2020/10/e6017159ea8578b7609aa6c8d8bc9aa0.pdf

IP High Court, 2020 (Gyo-Ke) 10146 [TDI Line Image Sensor] <Kanno>

Original Ameblo publication: 2023-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802020308.html

2020 (Gyo-Ke) 10146 [TDI Line Image Sensor] <Kanno>

(Inventive step) Although a difference was overlooked, it was readily conceivable and therefore did not affect the outcome.

⇒ Revocation decision in the opposition maintained

'…In light of the common general technical knowledge, a person skilled in the art would readily conceive that the Exhibit Ko 2 invention likewise has a configuration in which the number of amplifiers equals the number of AD converters….'

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91058.pdf

[Portrait Rights] Tokyo District Court, 2020 (Wa) 33192 <Nakashima>

Original Ameblo publication: 2023-05-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802296907.html

[Portrait Rights] 2020 (Wa) 33192 <Nakashima>

Infringement of personal interests through the photographing or publication of a person's image may arise where the person suffers mental distress beyond the limits tolerable under prevailing social norms, such as when (i) information from the private sphere is photographed or published and is not a matter of public interest; or (ii) even in the public sphere, information that is insulting beyond those limits is photographed or published, or its publication risks disrupting peaceful daily life beyond those limits.

The fact that the photograph 'supplements the article stating that the plaintiff committed an act attracting strong public condemnation, and therefore concerns a matter of public interest' was also given as a reason for finding no infringement of portrait rights!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91350.pdf

IP High Court, 2021 (Gyo-Ke) 10056 [Information Processing Apparatus] <Shoji> — Invention-defining features in subcombination claims

Original Ameblo publication: 2023-05-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802443112.html

2021 (Gyo-Ke) 10056 [Information Processing Apparatus] <Shoji>

In this case, the recitations concerning the counterpart of the subcombination were held not to limit the configuration or function of the claimed information-processing apparatus.

⇒ Not an invention-defining feature. (The court upheld the dismissal of the amendment for lack of inventive step in the amended invention and the JPO decision based on lack of novelty in the unamended invention.)

<Question> If the counterpart of a subcombination is ABCD and therefore requires D′ as an interface, are ABC also invention-defining features?

⇒ If so…, while inventive-step analysis considers whether ‘the counterpart of the subcombination is ABCD’ was readily conceivable, is the mere presence of ‘D′ as an interface’ enough for satisfaction of the claim?

Or should satisfaction of the claim be considered as with a use invention?

Or should novelty and inventive step be considered as with a PBP claim?

Cf. ‘Roll Paper for Packaging Medicine in Separate Doses’ judgment (IP High Court, 2019 (Ne) No. 10009, June 27, 2019 (Presiding Judge Otaka))

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e3%80%8c%e8%96%ac%e5%89%a4%e5%88%86%e5%8c%85%e7%94%a8%e3%83%ad%e3%83%bc%e3%83%ab%e3%83%9a%e3%83%bc%e3%83%91%e3%80%8d%e4%ba%8b%e4%bb%b6%ef%bc%88%e6%8e%a7/

[U.S. Trademarks / Patents and Designs] In re Reelex Packaging Solutions (CAFC, November 5, 2020)

Original Ameblo publication: 2023-05-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802584733.html

[U.S. Trademarks / Patents and Designs] In re Reelex Packaging Solutions (CAFC, November 5, 2020)

(i) The disclosures and drawings of utility patents demonstrated the design’s functionality.

(ii) The applicant's advertising promoted the design's utility.

(iii) Where other evidence establishes functionality, the mere availability of alternative designs does not justify registration. The evidence offered of alternative designs was also found insufficient.

⇒ Trade-dress application refused

*In Japan, the Tokyo District Court in the ‘Rack Cover’ case, 1999 (Wa) 13242, excluded shapes dictated by the product’s function and similar features from the essential design features, found the remaining essential features dissimilar, and dismissed the claims. It did not invalidate the design registrations on the ground of functionality.

https://openlegalcommunity.com/trade-dress-and-patents/

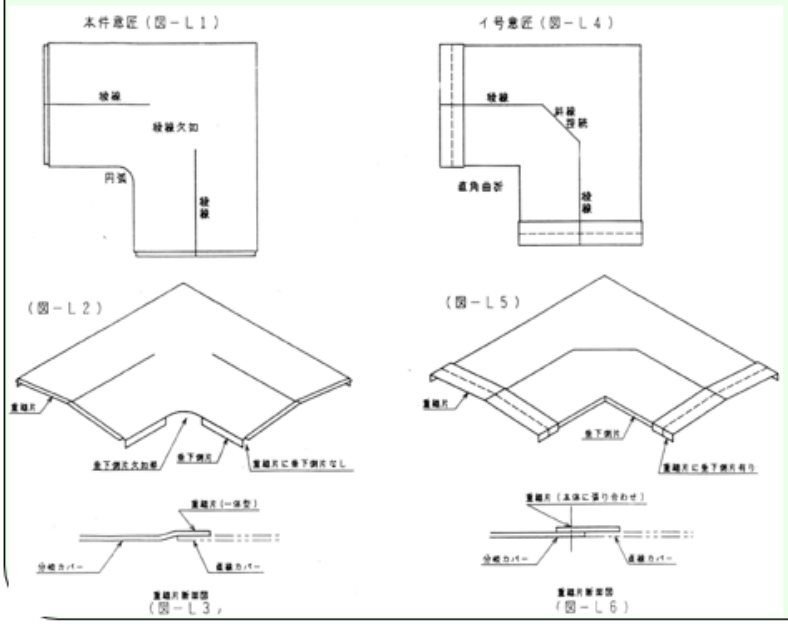
2－2．意匠の類似（侵害論）

機能的に必然な構造は、「要部」でない⇒非類似

東京地判平成11年（ワ）13242「ラック用カバー」事件

「L字状及びT字状の形状は，冷媒管等のラックカバーという物品の機能を果たすためには必然的なものであるから，この形状が本件登録意匠の特徴的部分ということはできず，これを要部ということはできない。・・・90度に交わる2つの突出部がそれぞれ山型屋根状をしているが，この頂部稜線が接することなく途切れている。そして，この稜線が途切れた部分は平らになっている。この部分は・・・ほとんどが機能必然的な構成からなる本件登録意匠1において，看者の注意を引きやすい部分である」

⇒非類似(非侵害)



81

English translation of the image

2-2. Similarity of designs — infringement

A functionally inevitable structure is not an essential part ⇒ No similarity.

Tokyo District Court, 1999 (Wa) 13242 [Duct Cover]

‘The L-shaped and T-shaped forms are inevitable for fulfilling the function of an article that is a duct cover for refrigerant pipes and the like. Accordingly, those forms cannot be regarded as characteristic portions of the registered design, and cannot be called essential parts. … The two projections intersecting at 90 degrees each have the shape of a gabled roof, but their top ridge lines are interrupted without meeting. The portion where these ridge lines are interrupted is flat. That portion … is likely to attract the viewer's attention in

Registered Design 1, which consists mostly of functionally inevitable structures.’ ⇒ No similarity (no infringement).

Diagram labels include: registered design at issue (Figure L1); Defendant’s Design No. 1 (Figure L4); ridge line; absence of a ridge line; circular arc; right-angle bend; overlapping tab; downward flap; portion without a downward flap. Figures L2 and L5 are perspective views, and Figures L3 and L6 are cross-sectional views of the overlapping tabs.

[U.S. Patents] Almirall v. Amneal (CAFC), March 14, 2022

Original Ameblo publication: 2023-05-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802794331.html

[U.S. Patents] Almirall v. Amneal (CAFC), March 14, 2022

Claim: '…does not contain adapalene'

The composition disclosed in the primary reference did not contain adapalene, although the reference did not affirmatively state that adapalene was absent.

Patentee's argument — The primary reference does not state 'does not contain adapalene.'

This judgment — Disclosure of a negative limitation does not require a statement that a feature is absent.

⇒ This limitation was held to be disclosed in the prior art; together with the other findings, this supported the conclusion that the claims were obvious.

https://openlegalcommunity.com/overlapping-ranges-and-negative-limitation-obviousness/

Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Takamatsu>

Original Ameblo publication: 2023-05-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12802794501.html

Osaka District Court, 2015 (Wa) 8974 [Apparatus Displaying a Ladder Circuit When … an Abnormality Occurs] <Takamatsu>

‘It is sufficient …to recognize and accept …the likelihood that a nonexceptional range of persons will use the product to infringe the patent.’

⇒ The defendant asserted that only ‘approximately one quarter’ of users purchased the optional function board. That proportion was not substantiated; even if assumed, it was not considered ‘exceptional.’

⇒ Indirect infringement established!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88263.pdf

Tokyo District Court, 2008 (Wa) 19874 [Medical Instrument] <Otaka>

Original Ameblo publication: 2023-05-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12803003392.html

Tokyo District Court, 2008 (Wa) 19874 [Medical Instrument] <Otaka>

‘In view of the results showing that it was employed …in approximately 27% …of cases, integrated simultaneous puncture as a way of using the defendant's product is not unusual …but is one mode of use that physicians may ordinarily adopt.’

⇒ Indirect infringement established

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81477.pdf

IP High Court, 2005 (Ne) 10125 [Cilostazol] <Sato>

Original Ameblo publication: 2023-05-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12803202092.html

2005 (Ne) 10125 [Cilostazol] <Sato>

‘Sales activities actively presented the preparation's prevention of restenosis and other effects as its characteristics.’ ‘To the extent of that certain quantity of sales, …the invention relating to the use invention must be regarded as having been worked.’

⇒ In calculating reasonable remuneration for an employee invention, the court found that the use invention relating to off-label use had been worked. It inferred that 25% of the 20% of prescriptions attributable to the cardiovascular division, equivalent to 5% of total sales, represented sales from working that use invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33823.pdf

[U.S. Patents] March 2010, CAFC en banc, Ariad v. Eli Lilly

Original Ameblo publication: 2023-05-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12803337062.html

[U.S. Patents] March 2010, CAFC en banc, Ariad v. Eli Lilly

35 U.S.C. § 112, first paragraph, as applicable to this case, contains a written-description requirement separate from the enablement requirement.

⇒ It plays the important role of excluding claims that, although satisfying enablement because making and using them requires no undue experimentation, cannot be described because they have not been invented.

https://www.jetro.go.jp/ext_images/world/n_america/us/ip/news/pdf/100401_2.pdf

100401_2.pdf (jetro.go.jp)

[New YouTube Video] Overview of the Issues to Know Now Ahead of the May 26 Dwango Grand Panel Judgment

Original Ameblo publication: 2023-05-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12803337200.html

[New YouTube Video] Overview of the Issues to Know Now Ahead of the May 26 Dwango Grand Panel Judgment

(Partly) foreign working and infringement of patents and other rights (overseas ⇒ domestic)

Cases involving tangible goods (+ trademarks)

Foreign judgments involving working partly abroad

<Contents>

1. Relationship between the two patents

2. First litigation (patent for a program + display apparatus)

(1) Reversed on appeal: claim limitations held satisfied — Is satisfaction in a particular situation enough?

(2) Territoriality — Distribution of a program to domestic users

(3) Normative attribution of infringement (the copyright ‘karaoke doctrine’)

3. Second litigation (system patent) — Multiple actors

4. Divisional-application strategies (general)

https://www.youtube.com/watch?v=nxFYw1cqaQI

[Article] Antitrust Assessment of Product Hopping by Pharmaceutical Companies (Naoko Mariyama, September 2017)

Original Ameblo publication: 2023-05-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12803617069.html

[Article] Antitrust Assessment of Product Hopping by Pharmaceutical Companies (Naoko Mariyama, September 2017)

In the United States, there is an argument that a hard switch of an originator pharmaceutical product (for example, discontinuing the old product when changing dosage form) impedes competition because generic manufacturers must submit an ANDA each time.

⇒ ‘Rule of reason’

https://www.inpit.go.jp/content/100862918.pdf

[Personality Rights] Tokyo District Court, 2021 (Wa) 30051 — ‘It cannot be said that peaceful daily life was disrupted’

Original Ameblo publication: 2023-05-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804040440.html

[Personality Rights] 2021 (Wa) 30051

It was inappropriate for the defendant (NHK) to create narration and the like by relying on text on the plaintiff's (an individual's) website, but it published an apology four days after the broadcast.

⇒ No infringement, because the plaintiff's peaceful everyday life cannot be said to have been disturbed to an extent warranting a damages claim.

⇒ Claim dismissed

★The fact that an apology was published four days after the broadcast was taken into account as a factor weighing against a finding of infringement of personality rights.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91458.pdf

Tokyo District Court, 2020 (Wa) 28889 [Method for Treating an Asbestos-Containing Wall]

Original Ameblo publication: 2023-05-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804040843.html

Tokyo District Court, 2020 (Wa) 28889 [Method for Treating an Asbestos-Containing Wall]

In light of the detailed description, the claim term ‘close proximity’ generally means that the housing and asbestos-containing wall are closely adjacent to an extent placing them in a positional relationship or condition that prevents scattering of the contents and permits their reliable collection.

⇒ Claim limitation not satisfied

Trial and Appeal Practitioner Study Group Report 2022 <Topic 1> — Takaishi's group

Original Ameblo publication: 2023-05-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804199275.html

Trial and Appeal Practitioner Study Group Report 2022 <Topic 1> — Takaishi's group

Support requirement for numerically limited inventions

Polarizing Film Grand Panel judgment

‘Describing in the specification the trends and mechanisms of parameters discerned from the working examples, and, where multiple parameters exist, whether they are correlated or independent, would be effective for understanding parameter trends.’

Trial and Appeal Practitioner Study Group Report 2022 <Case 1> Mechanical — 2019 (Gyo-Ke) 10046

‘More detailed consideration of specific technical matters falling within the …generalized scope is desirable.’

‘Expansion is possible if the feature is not directly related to solving the problem.’

‘Participants agreed that product sizes fall within certain bounds in each technical field, and that motivation might be absent where the size difference is so great that the technical fields differ or where the difference affects the problem; however, a difference in size alone does not establish an absence of motivation.’

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2022_houkokusyo_honpen.pdf

Trial and Appeal Practitioner Study Group Report 2022

<1> Support requirement for numerically limited inventions (mechanical) *The group to which Takaishi belonged

<2> Clarity requirement (chemistry (1))

<3> Inherent properties in novelty assessment (chemistry (2))

<4> Inventive-step assessment where the difference concerns business methods, game rules, or arrangements (electrical)

<5> Assessment of similarity of composite trademarks

Trial and Appeal Practitioner Study Group Report 2022 <Topic 2> — Clarity requirement

Original Ameblo publication: 2023-05-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804346158.html

Trial and Appeal Practitioner Study Group Report 2022 <Topic 2> — Clarity requirement

‘In the working examples, describe the experimental methods, experimental conditions, and equipment actually used in sufficient detail to enable reproduction.

At a minimum, stating these matters in the working examples enables invention-defining features to be interpreted on the basis of those statements, reducing the likelihood of a finding of indefiniteness.’

Trial and Appeal Practitioner Study Group Report 2022 <Case 2> Chemistry (1) — 2017 (Gyo-Ke) 10063

‘Opinions were divided on whether the defendant’s experiments substantiated the critical significance of the molecular weight of the antioxidant. This may have been influenced by differences in understanding as to whether the actual experimental results fell within the matters described in the specification and whether the experimental details (conditions and evaluation methods) conformed to the specification and were appropriate.’

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2022_houkokusyo_honpen.pdf

Trial and Appeal Practitioner Study Group Report 2022

<1> Support requirement for numerically limited inventions (mechanical)

<2> Clarity requirement (chemistry (1))

<3> Inherent properties in novelty assessment (chemistry (2))

<4> Inventive-step assessment where the difference concerns business methods, game rules, or arrangements (electrical)

<5> Assessment of similarity of composite trademarks

Trial and Appeal Practitioner Study Group Report 2022 <Topic 3> — Inherent properties in novelty assessment

Original Ameblo publication: 2023-05-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804532673.html

Trial and Appeal Practitioner Study Group Report 2022 <Topic 3> — Inherent properties in novelty assessment

'…For a product defined by a use based on properties such as functions and effects, where those properties provide a new use and the claim states that use in a manner distinguishable from the cited invention, the invention should not be treated as lacking a difference on the basis of an inherent property.'

Trial and Appeal Practitioner Study Group Report 2022 <Case 3> Chemistry (2) — 2017 (Gyo-Ke) 10165

(Summary of the views discussed) In considering the conditions under which post-filing materials might have been taken into account in the judgment, participants expressed the view that such materials might have been considered if the specification had provided enough information to understand that the simulation would yield approximately the trough serum concentration stated in the package insert. Further views suggested that the simulation should have produced a better best score and that a comparison with 4/2/1 should have been made.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2022_houkokusyo_honpen.pdf

Trial and Appeal Practitioner Study Group Report 2022

<1> Support requirement for numerically limited inventions (mechanical)

<2> Clarity requirement (chemistry (1))

<3> Inherent properties in novelty assessment (chemistry (2))

<4> Inventive-step assessment where the difference concerns business methods, game rules, or arrangements (electrical)

<5> Assessment of similarity of composite trademarks

Trial and Appeal Practitioner Study Group Report 2022 <Topic 4> — Inventive step where the difference concerns …game rules…

Original Ameblo publication: 2023-05-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804687341.html

Trial and Appeal Practitioner Study Group Report 2022 <Topic 4> — Inventive step where the difference concerns …game rules…

‘To obtain a favorable inventive-step determination, when filing a patent application it appears important, even for …game rules…, to clarify technical matters utilizing natural laws in the detailed description or to explain …their significance, functions, and effects.’

Trial and Appeal Practitioner Study Group Report 2022 <Case 4> Electrical — 2021 (Gyo-Ke) 10056

‘The feature “where, in the server, …the seventh information has been transmitted to the information processing apparatus” does not contribute to specifying the function, structure, or the like of the “information processing apparatus,” the subcombination invention. The judgment was therefore appropriate in identifying the invention with that feature excluded….’

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2022_houkokusyo_honpen.pdf

Trial and Appeal Practitioner Study Group Report 2022

<1> Support requirement for numerically limited inventions (mechanical)

<2> Clarity requirement (chemistry (1))

<3> Inherent properties in novelty assessment (chemistry (2))

<4> Inventive-step assessment where the difference concerns business methods, game rules, or arrangements (electrical)

<5> Assessment of similarity of composite trademarks

IP High Court, 2022 (Ne) 10046, ‘Dwango Grand Panel Judgment’ — Patentee (Dwango) wins on reversal!!

Original Ameblo publication: 2023-05-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804751492.html

2022 (Ne) 10046, ‘Dwango Grand Panel Judgment’ — ★Patentee (Dwango) wins on reversal!!

⇒ Although the server is abroad, the conduct constitutes ‘production’ of the system within Japan.

The substantive value judgment—‘If merely locating the server abroad allowed a patent to be readily avoided, sufficient protection could not be afforded to the patent for the system invention, which would be inappropriate’—is the same as in the IP High Court judgment in the earlier case.

★Similar judgments have been issued in comparable cases abroad. My impression is that, worldwide, foreign-server issues are being treated as infringement by focusing on the place where the result (economic benefit) occurs.

⇒ Please see my YouTube video prepared before the Grand Panel judgment (below) and the presentation materials (in the video's description).

https://www.youtube.com/watch?v=nxFYw1cqaQI

(Excerpt from the summary) Even where a server is abroad, if, after comprehensive consideration of the specific manner of the act; the functions and roles in the invention of the system elements located domestically; the place where the effects of the invention are obtained through use of the system; the impact of that use on the patentee's economic interests; and other circumstances, the act can be regarded as having been performed within Japan's territory, it constitutes ‘production’ under Article 2(3)(i) of the Patent Act….

https://www.courts.go.jp/ip/vc-files/ip/2023/R4ne10046.pdf

[Trademarks] Trial and Appeal Practitioner Study Group Report 2022 <Topic 5> — Assessment of similarity of composite trademarks

Original Ameblo publication: 2023-05-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12804880741.html

[Trademarks] Trial and Appeal Practitioner Study Group Report 2022 <Topic 5> — Assessment of similarity of composite trademarks

‘A view was expressed that, after appearance (position, size, etc.), emphasis is placed on the well-known character or distinctiveness of each trademark component in the relevant trade for the designated goods or services….’

‘The majority view was that, for a composite trademark combining a device and words, …there is no need to require …a higher degree of similarity.’

[Trademarks] Trial and Appeal Practitioner Study Group Report 2022 <Case 5> — 2020 (Gyo-Ke) 10125

‘When considering matters from perspectives such as what inconveniences could arise if a trademark-infringement action were brought…, there is both a view that the scope of rights may vary in breadth with the designated goods or services and a view that breadth should not be considered…. Judgments are not uniform either.’

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2022_houkokusyo_honpen.pdf

Trial and Appeal Practitioner Study Group Report 2022

<1> Support requirement for numerically limited inventions (mechanical) *The group to which Takaishi belonged

<2> Clarity requirement (chemistry (1))

<3> Inherent properties in novelty assessment (chemistry (2))

<4> Inventive-step assessment where the difference concerns business methods, game rules, or arrangements (electrical)

<5> Assessment of similarity of composite trademarks

IP High Court, 2022 (Ne) 10093 [Use of Eribulin in Treating Breast Cancer] <Otaka>

Original Ameblo publication: 2023-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12805776749.html

2022 (Ne) 10093 [Use of Eribulin in Treating Breast Cancer] <Otaka>

*Appeal dismissed

The assertion that the patents prevented marketing authorization by the Minister of Health, Labour and Welfare was the plaintiff's argument. The court relied, among other circumstances, on the lack of sufficient evidence of a high likelihood of authorization and drug-price listing in the near future, and consequently of manufacture and sale.

⇒ No interest in obtaining declaratory relief

(i) An action seeking a declaration of illegality of inaction on an approval application is possible!!

(ii) Administrative appeals and the like to the Minister of Health, Labour and Welfare are possible!!

https://www.tokkyoteki.com/2023/05/2023-05-10-r4-ne-10093.html

‘Suspension of Examination of Divisional Applications’

Original Ameblo publication: 2023-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12805787815.html

‘Suspension of Examination of Divisional Applications’

Divisional applications for which examination was requested on or after April 1, 2023, and examination has not yet begun, may qualify for suspension if all requirements (1)–(3) below are met.

(1) The divisional application was divided after a decision refusing the original application.

(2) An appeal against the refusal of the original application has been filed, and that application is pending either in reconsideration by the examiner following the filing of the appeal or in the appeal proceedings.

(3) It is expedient to await the outcome of that reconsideration or the appeal concerning the original application.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e5%88%86%e5%89%b2%e5%87%ba%e9%a1%98%e3%81%ab%e5%af%be%e3%81%99%e3%82%8b%e5%af%a9%e6%9f%bb%e4%b8%ad%e6%ad%a2%e3%81%ae%e9%81%8b%e7%94%a8/

‘Relaxation of Restoration Requirements under Relief Provisions after Expiration of a Time Limit’

Original Ameblo publication: 2023-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12805788082.html

‘Relaxation of Restoration Requirements under Relief Provisions after Expiration of a Time Limit’

For procedures covered by the relief provisions where failure to meet the procedural time limit occurred on or after April 1, 2023, the requirement for restoration was relaxed from “having a legitimate reason” to the failure “being unintentional.”

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e6%9c%9f%e9%96%93%e5%be%92%e9%81%8e%e5%be%8c%e3%81%ae%e6%95%91%e6%b8%88%e8%a6%8f%e5%ae%9a%e3%81%ab%e4%bf%82%e3%82%8b%e5%9b%9e%e5%be%a9%e8%a6%81%e4%bb%b6%e3%81%ae%e7%b7%a9%e5%92%8c/

IP High Court, 2021 (Gyo-Ke) 10136 [Soldering Apparatus] <Honda>

Original Ameblo publication: 2023-06-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806199697.html

2021 (Gyo-Ke) 10136 [Soldering Apparatus] <Honda>

‘Solder with a flux content of 1 wt% was not commonly distributed in the flux-cored solder market at the filing date…. …It cannot be found that deliberately selecting …1 wt% solder to obtain …would have been readily achievable.’

⇒ In this case, adopting solder not commonly available on the market to obtain the claimed configuration was held not to be obvious!!

(Excerpt from the court's reasoning)

Solder with a flux content of 1 wt% was not commonly distributed in the flux-cored solder market at the filing date….

…Without knowing the problem solved by the configuration in which the molten solder invariably does not form a perfect sphere, or the functions and effects produced by that configuration, it cannot be found that deliberately selecting solder with a flux content of 1 wt% …to obtain that configuration would have been readily achievable….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91387.pdf

[U.S. Patents] May 2023, U.S. Supreme Court, Amgen v. Sanofi ⇒ Enablement requirement not satisfied

Original Ameblo publication: 2023-06-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806199800.html

[U.S. Patents] May 2023, U.S. Supreme Court, Amgen v. Sanofi

⇒ Enablement requirement not satisfied

The claims extend far beyond the exemplary antibodies disclosed in the specification. Although a reasonable amount of experimentation may be permissible, depending on the nature of the invention and the underlying technology, the Court held that the specification did not enable a person skilled in the art to make and use the full scope of what was claimed.

https://www.jetro.go.jp/ext_images/_Ipnews/us/2023/20230519.pdf

IP High Court, 2019 (Ne) 10007 [Apparatus Displaying a … Ladder Circuit] <Kanno>

Original Ameblo publication: 2023-06-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806199947.html

2019 (Ne) 10007 [Apparatus Displaying a … Ladder Circuit] <Kanno>

For an invention combining existing components, each existing component was held to be an indispensable article!!

⇒ Indirect infringement under Article 101(ii) established

⇒ At most approximately one quarter of the users of Defendant Product 1-2 could use the circuit-monitoring functions. The court held that this did not preclude an inference that a non-exceptional proportion of users was highly likely to produce directly infringing products.

⇒ The first-instance court ordered an injunction against the products at issue. On appeal, however, the patentee withdrew the injunction and related claims following expiry of the patent, and the corresponding portions of the first-instance judgment ceased to have effect.

The portion not used to produce directly infringing products is deducted from the relevant quantity as a circumstance preventing sales under Article 102(1)(i) of the Patent Act and constitutes a ground for rebutting the damages presumption under Article 102(2).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91445.pdf

[Trademarks] IP High Court, 2022 (Gyo-Ke) 10023 [Vegas Vegas Case]

Original Ameblo publication: 2023-06-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806493179.html

[Trademarks] 2022 (Gyo-Ke) 10023 [Vegas Vegas Case]

First JPO decision — Use established by Flyers 1 and 2

First judgment: use based on Flyers 1 and 2 was rejected. Although the judgment stated that no other evidence substantiated use, it did not decide the use shown in Flyers 3 and 4 as material facts necessary to its disposition.

Second JPO decision — Use not established by Flyers 1–4

Second court judgment — Use established by Flyers 3 and 4

Third JPO decision — Use established by Flyers 3 and 4

Third court judgment (this judgment)

The first judgment had not decided the use shown in Flyers 3 and 4 as material facts necessary to its disposition, so its binding effect did not extend to that issue. The JPO decision recognizing use based on those flyers therefore did not contravene that binding effect!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91357.pdf

Tokyo District Court, 2020 (Wa) 29897 <Kokubu> — ‘Claim for Remuneration for an Employee Invention’

Original Ameblo publication: 2023-06-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806558613.html

Tokyo District Court, 2020 (Wa) 29897 <Kokubu> — ‘Claim for Remuneration for an Employee Invention’

The ‘claim for a registration reward’ and ‘claim for reasonable remuneration’ were conceived as separate claims.

The invention rules and related provisions in this case did not specify when reasonable remuneration was payable or restrict the exercise of the right to claim it.

⇒ In this case, the limitation period for each claim began when the right to obtain the patent was transferred to the employer.

⇒ Under the former law applicable to this case, the limitation period was ten years for the statutory claim for reasonable remuneration and five years for the registration-reward claim under the invention rules (former Article 522 of the Commercial Code).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91237.pdf

IP High Court, 2022 (Gyo-Ke) 10030 [Laminate of a Polyester Resin Composition] <Kanno>

Original Ameblo publication: 2023-06-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806654365.html

2022 (Gyo-Ke) 10030 [Laminate of a Polyester Resin Composition] <Kanno>

*The correction introducing a disclaimer in this case was held not to introduce new technical matter in relation to the technical matters derivable from the specification and related documents, and the exclusion did not affect the invention's technical problem.

⇒ Correction requirements satisfied (inventive step after correction not decided)

★On remand in the opposition proceedings, a preliminary view denying inventive step even with the disclaimer claim was expressed, and a notice of reasons for revocation (advance notice of decision) was issued on May 19, 2023.

(Excerpt from the court's reasoning)

…The defendant argues that a correction to a 'disclaimer claim,' as in Correction 2, could mislead third parties concerning the disclosure in the specification, etc., and is highly likely to cause unforeseen disadvantage. However, even if such concerns existed, they should be considered in examining whether the corrected claims comply with the clarity, support, or other requirements. In any event, it is therefore inappropriate in this case to treat this point, by itself, as a reason to disallow the correction….

…Excluding, by the correction…, 'a laminate having a vapor-deposited inorganic-oxide film thereon and a gas-barrier coating film on that vapor-deposited film' does not introduce new technical matter or add new matter. The problem addressed by the invention is to provide a laminate with a layer made of a resin composition containing carbon-neutral polyester using biomass ethylene glycol: a laminate of polyester resin film comparable in physical properties, such as mechanical characteristics, to conventional laminates made from fossil-fuel-derived raw materials ([0008]). The exclusion has no effect on that technical problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91870.pdf

IP High Court, 2022 (Gyo-Ke) 10037 [Air-Outlet Adjustment Mechanism for Air-Conditioned Clothing] <Honda>

Original Ameblo publication: 2023-06-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12806886258.html

2022 (Gyo-Ke) 10037 [Air-Outlet Adjustment Mechanism for Air-Conditioned Clothing] <Honda>

*From four patent publications, the court found that a ‘well-known and self-evident problem’ existed at the filing date.

‘Accordingly, …it is appropriate to find that a person skilled in the art encountering the publicly worked invention at the filing date would recognize the foregoing problem.’

(Excerpt from the court's reasoning)

…a. Description in Exhibit Ko 15 …b. Description in Exhibit Ko 16 …c. Description in Exhibit Ko 17 …d. Description in Exhibit Ko 18…

…The respective descriptions in a–d establish that, at the filing date, in the technical field of clothing, there was a well-known and self-evident problem that tying two cord-like members together to adjust their length, or indeed tying two cord-like members together at all, is laborious and not easy…. Accordingly, …it is appropriate to find that a person skilled in the art encountering the publicly worked invention at the filing date would recognize that problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91755.pdf

IP High Court, 2016 (Gyo-Ke) 10152 [Charge Control Agent] <Mori>

Original Ameblo publication: 2023-06-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807097839.html

2016 (Gyo-Ke) 10152 [Charge Control Agent] <Mori>

*Problem addressed by the invention

⇒ ‘Means water with the lowest electrical conductivity possible so that conductivity attributable solely to the amount of inorganic salt at the surface of the charge control agent can be measured.’

⇒ ‘Ion-exchanged water’ satisfies clarity.

[Claim 1] …A charge control agent …having an electrical conductivity of 110 μS/cm or less when the metal complex salt compound is dispersed at 1 wt% in ion-exchanged water….

(Excerpt from the court's reasoning)

The invention focuses on the relationship between the quantity of inorganic salt on the surface of the charge control agent and image stability. It measures that surface inorganic-salt quantity by measuring the electrical conductivity when the metal complex salt compound is dispersed at 1 wt% in ion-exchanged water, and provides a charge control agent offering excellent image stability by controlling that conductivity within a specified range. It is therefore clear to a person skilled in the art that ‘ion-exchanged water’ in the invention means water with the lowest electrical conductivity possible, so that, as far as possible, only the conductivity attributable to the amount of inorganic salt at the surface of the charge control agent is measured….

…Because the conductivity difference between measurement samples 1 and 2, prepared under different dispersion conditions, is only 1 μS/cm, these experimental results can be said to indicate that differing dispersion methods cannot produce a substantial difference in the measured electrical conductivity.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87017.pdf

[Trademarks] IP High Court, 2021 (Gyo-Ke) 10087 (Cancellation for Nonuse) — ‘I R O PARIS’

Original Ameblo publication: 2023-06-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807098013.html

[Trademarks] 2021 (Gyo-Ke) 10087 (Cancellation for Nonuse)

Trademark Registration No. 5623868, ‘I R O PARIS,’ was not used for its designated goods, including ‘clothing made in France.’

⇒ Cancellation for nonuse upheld (being designed in France was insufficient).

Although ‘made in France’ was added in response to a refusal during examination, is a subsequent finding of nonuse in cancellation proceedings rather harsh…?

https://japan.marks-iplaw.jp/newsletter-151/

Tokyo High Court, 1999 (Gyo-Ke) 230 [Guide for Magnetic Tape] <Yamashita>

Original Ameblo publication: 2023-06-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807322755.html

Tokyo High Court, 1999 (Gyo-Ke) 230 [Guide for Magnetic Tape] <Yamashita>

*The court held that the registration was not invalid for an unauthorized application if the applicant had acquired the right to obtain the utility-model registration by the time of registration. In this case, it inferred that the right had been transferred no later than the filing of the opposition to registration.

‘The ground for invalidity under Article 37(1)(v) of the Utility Model Act (an unauthorized application) concerns the attribution of rights, namely whether the right was granted to the person properly entitled to it. Therefore, if the applicant had acquired the right to obtain utility-model registration by the time of registration, the registration granted on that application should be understood not to fall within the provision covering registration on an application by a person who was not the creator and had not acquired the right to obtain registration for the device.’

https://jitsuyou.hanrei.jp/hanrei/um/3952.html

IP High Court, 2021 (Gyo-Ke) 10093, ‘Antigen-Binding Proteins against PCSK9,’ Second Judgment (Regeneron) <Kanno>

Original Ameblo publication: 2023-06-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807460253.html

2021 (Gyo-Ke) 10093, ‘Antigen-Binding Proteins against PCSK9,’ Second Judgment (Regeneron v. Amgen) <Kanno>

=2021 (Gyo-Ke) 10094

Unlike the first judgment (the final judgment in the earlier action), the court rejected, for a functionally expressed reach-through claim, the approach that reciting the effect in the claim satisfies the support requirement.

First judgment: 2017 (Gyo-Ke) 10225 (Sanofi)

[Claim 1] An isolated monoclonal antibody capable of neutralizing the binding of PCSK9 to LDLR protein and competing, for binding to PCSK9, with an antibody comprising a heavy chain including a heavy-chain variable region consisting of the amino-acid sequence of SEQ ID NO: 49 and a light chain including a light-chain variable region consisting of the amino-acid sequence of SEQ ID NO: 23.

(Excerpt from the court's reasoning)

…The problem addressed by the invention is, in the first place, …to provide an antibody that neutralizes the binding between LDLR protein and PCSK9—which, by binding to LDLR protein, decreases the amount of LDLR protein and increases the amount of LDL in a subject—or a pharmaceutical composition containing that antibody. In relation to solving that problem, no independent significance can be found in competition with the reference antibody itself. From this perspective too, …the technical significance of the invention must be said to lie in identifying that an antibody competing with the 21B12 antibody possesses the functional characteristics of a binding-neutralizing antibody through the same mechanism as the 21B12 antibody….

The defendant argues …that even if antibodies existed that compete with the 21B12 antibody (the reference antibody) but cannot neutralize binding between PCSK9 and LDLR protein, such antibodies are excluded by the claim wording from the technical scope of Invention 1, and therefore do not provide a reason for finding a violation of the support requirement. However, as already explained, the technical significance of the invention must be said to lie in identifying that an antibody competing with the 21B12 antibody has the functional characteristics of an antibody neutralizing binding between PCSK9 and LDLR protein through the same mechanism as the 21B12 antibody. If antibodies competing with 21B12 include antibodies without binding-neutralizing ability, the premise of that technical significance plainly collapses. (In a case such as this, if it were sufficient merely to exclude antibodies lacking binding-neutralizing ability by claim wording, extremely broad definitions of the antibody's binding site on PCSK9—for example, most of PCSK9—would also be permitted. That would allow claims to be broadened without legitimate grounds and is therefore inappropriate.) …

In the separate action to revoke the JPO decision concerning the invention, …Sanofi's arguments regarding violation of the support requirement were rejected. However, this can also be understood as resulting from the assumption, taken for granted in light of the allegations and evidence then presented, that antibodies competing with the 21B12 antibody bind to substantially the same location on PCSK9 and have the same function as that antibody. In contrast, in this action, new arguments based on new evidence—including structural analyses in the respective statements of Dr. [A] and Dr. [B] and the expert report of Professor [F] …, and relevant documentary evidence concerning 'EGFa-mimic antibodies'…—have cast doubt on that premise, yet no material supporting it can be found. There is therefore a commensurate reason for the conclusion of the separate judgment and the determination in this case to differ.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e6%a9%9f%e8%83%bd%e7%9a%84%e3%81%ab%e8%a1%a8%e7%8f%be%e3%81%95%e3%82%8c%e3%81%9f%e3%83%aa%e3%83%bc%e3%83%81%e3%82%b9%e3%83%ab%e3%83%bc%e3%82%af/

IP High Court, 2021 (Gyo-Ke) No. 10140 [Electroformed Tube Case] <Kanno> — PBP claim fails the clarity requirement

Original Ameblo publication: 2023-06-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807610190.html

2021 (Gyo-Ke) No. 10140 [Electroformed Tube Case] <Kanno>
Within the cases known to the author when the original article was published, the first and only lower-court decision to require ‘impossible or impractical circumstances’ for the clarity of a product invention defined by its manufacturing process, and to find a violation of the clarity requirement. (The legal standard is the same as in other IP High Court judgments.)
⇒ PBP Claims 6 and 9 fail the clarity requirement.
*Violation of the clarity requirement for a PBP claim
⇒ If, at the filing date, the structure or properties of the resulting product are unambiguously clear from the claims, specification, drawings, and common general technical knowledge, the clarity requirement is not violated even without impossible or impractical circumstances.
⇒ This invention is not unambiguously clear.
⇒ Impossible/impractical circumstances were denied.
*How is this consistent with the earlier cases finding that claims were not PBP claims within the meaning of the Supreme Court judgment?
(Excerpt from the court's reasoning)
…Even where claims for a patent on a product invention recite the manufacturing process for that product, if, unlike the general situation described above, it is unambiguously clear at the filing date from the claims, specification, drawings, and common general technical knowledge what structure or properties the product manufactured by that process represents, third parties' interests are not unjustly harmed. It is therefore understood that there is no violation of the clarity requirement even in the absence of impossible or impractical circumstances….
…The specification neither states nor suggests anything concerning the inner-surface accuracy of electroformed tubes manufactured by the processes of Invention 6 and Corrected Invention 9. The specification describes the following methods of removing the fine wire: (i) forming a gap between the electrodeposit, etc. and the fine wire by heating and thermally expanding the electrodeposit, etc. or cooling and shrinking the wire; (ii) making the contact area between the fine wire and the electrodeposit, etc. slippery by immersing it in liquid or pouring liquid over it; (iii) pulling from one or both ends to deform it so as to reduce its cross-sectional area and thereby form a gap between the fine wire and the electrodeposit, etc., then gripping and pulling it, suctioning it, physically pushing it, or forcing it out by ejecting gas or liquid; and (iv) melting or dissolving it with heat or a solvent ([0041], [0116]). However, there is no description whatsoever of the technical relationship between these methods and the inner-surface accuracy of the electroformed tube produced, much less any statement or suggestion that the manufacturing processes of Invention 6 and Corrected Invention 9 (included in method (iii) above) signify a particular inner-surface accuracy different from that of tubes produced by other methods. Nor can it be found that there was common general technical knowledge as to whether these methods produce differences in inner-surface accuracy. Accordingly, the structure or properties of electroformed tubes produced by the manufacturing processes of Invention 6 and Corrected Invention 9 cannot be said to be unambiguously clear….
For the foregoing reasons, Invention 6 and Corrected Invention 9 can be regarded as clear only if, at the filing date of this application, there were impossible or impractical circumstances preventing the electroformed tubes of those inventions from being defined directly by their structure or properties. The defendant acknowledges that no such circumstances existed.
https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e8%a3%bd

%e9%80%a0%e6%96%b9%e6%b3%95%e3%81%ab%e3%82%88%e3%82%8a%e7%89%b9%e5%ae%9a%e3%81%95%e3%82%8c%e3%81%9f%e7%89%a9%e3%81%ae%e7%99%ba%e6%98%8e%e3%81%ae/

IP High Court, 2021 (Gyo-Ke) 10096 [Light Source] <Honda>

Original Ameblo publication: 2023-06-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807819959.html

2021 (Gyo-Ke) 10096 [Light Source] <Honda>

A case permitting a coherent technical concept to be extracted from several paragraphs of a cited reference, and denying inventive step by treating a numerical limitation unsupported by data as a design matter.

‘The application specification contains …no experimental results whatsoever for contents exceeding 10 wt %…. There is no particular criticality.’

(Excerpt from the court's reasoning)

…Paragraphs [0012], [0013], and [0015] of the cited reference disclose that the FWHM (full width at half maximum) of the respective emission peaks of the green-emitting and red-emitting semiconductor nanocrystals is, or may be, approximately 45 nm or less. In the surrounding context of the reference, these disclosures are understood to apply generally to the inventions disclosed therein. …There is no statement or suggestion that adopting the feature ‘the FWHM (full width at half maximum) of the emission peaks of the green-emitting and red-emitting semiconductor nanocrystals is approximately 45 nm or less’ …would preclude adopting the feature …in the cited invention. Accordingly, …it is entirely possible for both features to coexist in a single invention based on one coherent technical concept. The JPO decision therefore did not err in identifying the cited invention as including the former feature.

…That cost reduction is a technical problem common to many technical fields can be recognized as self-evident even without an express statement or suggestion in publications such as the cited reference….

…(Difference) For the ‘light conversion layer,’ the amended invention at issue ‘contains a scattering agent,’ with ‘the scattering agent present at 10 wt% or less relative to the total weight of the light conversion layer,’ whereas the presence or absence of a ‘scattering agent’ in the cited invention is unclear….

…The feature ‘the scattering agent is present at 10 wt% or less relative to the total weight of the light conversion layer’

…The application specification merely states, for example, ‘may be contained at 10 wt% or less’…; ‘preferably contained at 10 wt% or less, and more preferably at 1 wt% or more and 5 wt% or less’…; and ‘preferably 10 wt% or less’…. Moreover, …the maximum content stated in the working examples is only 6 wt%…, and the specification contains no experimental results whatsoever for contents exceeding 10 wt% …. It must therefore be said that setting the scattering-agent content to 10 wt% or less of the total weight of the light conversion layer has no particular criticality. In addition, …adjusting the proportions of scattering agent, red quantum-dot material, and green quantum-dot material in the light conversion layer permits adjustment of the color coordinates of white light. Paragraph [0137] of the specification also establishes that adjusting the scattering-agent content permits adjustment of the luminance and the like of white light. Taking into account as well the statement in paragraph [0116] of Well-Known Reference 1 that ‘in a preferred embodiment, the concentration range of scatterers is 0.1 to 10 wt%,’ the proportion of scattering agent relative to the total weight of the light conversion layer could have been designed as appropriate by a person skilled in the art according to the desired white light produced by that layer.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e4%b8%bb%e8%a6%81%e5%88%a4%e6%b1%ba%e5%85%a8%e6%96%87%e7%b4%b9%e4%bb%8b/

[Trademarks] IP High Court, 2022 (Gyo-Ke) 10002 <Shoji>

Original Ameblo publication: 2023-06-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12807981602.html

[Trademarks] 2022 (Gyo-Ke) 10002 <Shoji>

Class 44…

A trademark displaying ‘Onjaku-kyu’ in hiragana and ‘温石灸’ (‘heated-stone moxibustion’) on two lines

(i) Indicates the quality of the services in an ordinarily used manner.

(ii) If used for anything other than ‘moxibustion (treatment) using heated stones,’ it risks misleading consumers as to the quality of the services.

⇒ Refusal decision upheld

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e5%95%86%e6%a8%99%e6%b3%95%e2%98%85%e3%80%91%e7%ac%ac%ef%bc%94%ef%bc%94%e9%a1%9e%e3%80%8c%e3%81%82%e3%82%93%e6%91%a9%e3%83%bb%e3%83%9e%e3%83%83%e3%82%b5%e3%83%bc%e3%82%b8%e5%8f%8a%e3%81%b3/

Osaka District Court, 2005 (Wa) 10821 [Cart Securing Device]

Original Ameblo publication: 2023-06-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808175182.html

Osaka District Court, 2005 (Wa) 10821 [Cart Securing Device]

*‘Use’ means employing a product embodying the invention in a manner that achieves the invention's purpose.

⇒ In this case, merely inspecting, repairing, and replacing parts of the cart securing device did not constitute ‘use.’

* In this case, exhaustion was recognized for the particular products sold before patent registration by the party that later became the patentee.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33337.pdf

IP High Court, 2021 (Gyo-Ke) 10144 [Dot Pattern] <Kanno>

Original Ameblo publication: 2023-06-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808175358.html

2021 (Gyo-Ke) 10144 [Dot Pattern] <Kanno>

*Language was added to the claims, but this did not constitute narrowing.

⇒ Correction requirements not satisfied

=2021 (Gyo-Ke) 10146 <Kanno>

Before correction — Information represented using any eight directions at 45° intervals as available dot-placement directions

After correction — Four vertical/horizontal directions used for dot placement…

(Excerpt from the court's reasoning)

The configuration before correction represents information using any eight directions at 45° intervals as available dot-placement directions, while the configuration after correction represents information using the four vertical/horizontal directions. The types of information dots defining the information and the manner of representing data therefore differ. In short, the two are different configurations and do not stand in a relationship of inclusion or broader and narrower concepts. Accordingly, Correction 1 cannot be said to have the purpose of ‘narrowing the claims’ under item (i) of the proviso to Article 134-2(1) of the Patent Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91467.pdf

[Copyright / Provider Liability] IP High Court, 2022 (Ne) 10019 — Claim for disclosure of sender information

Original Ameblo publication: 2023-06-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808385994.html

[Copyright / Provider Liability] 2022 (Ne) 10019 — Claim for disclosure of sender information

⇒ The person requesting disclosure of sender information must plead and prove both infringement of the right and the absence of circumstances suggesting grounds that would preclude unlawfulness.

⇒ Lawful quotation

In this case, considering that the timeline display varied with the specifications of Twitter and similar services and that clicking an image displayed it in full, the court held that displaying only part of the image was a modification deemed unavoidable under Article 20(2)(iv) of the Copyright Act.

Cf. The Supreme Court decision concerned the right of attribution.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91469.pdf

[Unfair Competition Prevention Act, Article 2(1)(iii)] Tokyo District Court, 2021 (Wa) 3418 <Kokubu> — ‘Date first sold’

Original Ameblo publication: 2023-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808612896.html

[Unfair Competition Prevention Act, Article 2(1)(iii)] 2021 (Wa) 3418 <Kokubu>

‘Date first sold’

Even assuming that the plaintiff had developed and marketed the first-generation products at its own expense and effort, the court considered it reasonable to regard almost all of that investment as having been devoted to developing the shape of the shade.

⇒ The later replacement of light bulbs with fluorescent lamps or LEDs, and the addition of remote controls, were not found to have required particular expense or effort.

⇒ The first generation already possessed the product configuration for which protection was sought.

Cf. 2018 (Ne) 10038, ‘Saxophone Strap’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91401.pdf

[Article / Designs] ‘Considerations on Assessing Creative Difficulty’ (Patent Attorney Masato Sasaki) (Patent, 2021, Vol. 74, No. 3)

Original Ameblo publication: 2023-06-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808933388.html

[Article / Designs] ‘Considerations on Assessing Creative Difficulty’ (Patent Attorney Masato Sasaki) (Patent, 2021, Vol. 74, No. 3)

Some judgments assess creative difficulty separately for each difference, based on the ‘novelty or originality of the design concept’ identified through that difference, while others assess it on the basis of the design's overall configuration.

https://jpaa-patent.info/patent/viewPdf/3767

[Article] ‘Novelty and Effects of Use Inventions’ (Patent, March 2021) (Former Judge Shigeru Osuga)

Original Ameblo publication: 2023-06-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12808933489.html

[Article] ‘Novelty and Effects of Use Inventions’ (Patent, March 2021) (Former Judge Shigeru Osuga)

The article examines important cases concerning novelty and the technical scope of use inventions, and introduces influential scholarly views.

The author argues that, to protect the public domain (PD), incidental uses that are neither publicly known as a technical matter nor publicly practiced should be addressed through appropriate adjustments at the enforcement stage, rather than as a question of novelty.

Novelty and Effects of Use Inventions—In Light of Scholarly Views Emphasizing Protection of the Public Domain—(jpaa-patent.info)

[Article] Examples of Strategic Use of Divisional Applications (Patent Attorney Mamoru Suzuki and Attorney Tomoaki Yasui) (Patent, 2020, Vol. 73, No. 1)

Original Ameblo publication: 2023-06-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809136567.html

[Article] Examples of Strategic Use of Divisional Applications (Patent Attorney Mamoru Suzuki and Attorney Tomoaki Yasui) (Patent, 2020, Vol. 73, No. 1)

Example 2: Sibling divisional applications pursued claims covering the defendant's products or design changes while preserving an application directed to the original invention to keep prosecution pending.

Example 5: The divisional family includes a registered child application whose intermediate parent application was withdrawn.

Example 6: A divisional was tailored to the defendant's product, and the drawings were also changed.

Examples of Strategic Use of Divisional Applications (jpaa-patent.info)

[Trademarks / Article] Current State of Actions to Revoke JPO Decisions on Color-Only Trademarks (Masahiko Otsuka) (Patent, 2021, Vol. 74, No. 4)

Original Ameblo publication: 2023-06-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809280408.html

[Trademarks / Article] Current State of Actions to Revoke JPO Decisions on Color-Only Trademarks (Masahiko Otsuka) (Patent, 2021, Vol. 74, No. 4)

At the time the article was written in 2021, among new types of trademarks, the only types without examples of registration were single-color and position-specified color-only trademarks.

⇒ Both were rejected in the Hydraulic Excavator case.

⇒ Evaluation of surveys

https://jpaa-patent.info/patent/viewPdf/3780

[Article / General] ‘My Bookshelf (Books Useful for Patent Practice and Japanese-Language Information Sources)’ — Corporate Legal Affairs A to Z, June 2023

Original Ameblo publication: 2023-06-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809338876.html

[Article / General] ‘My Bookshelf (Books Useful for Patent Practice and Japanese-Language Information Sources)’ (Corporate Legal Affairs A to Z, June 2023 issue) *I reproduce my article with permission from Dai-Ichi Hoki.

My specialties are patents and designs, and I have written case-law encyclopedias covering important decisions in each field. Patent practice, in particular, combines technology and law. It is also unusual among areas of administrative litigation in that a substantial proportion of JPO decisions are overturned by the courts (for example, among patent cases in revocation actions that reached judgment in 2022, 18.2% for ex parte appeals and 20.0% for inter partes trials), so a practitioner cannot discuss patent practice independently of patent case law. On the other hand, even though Japanese patent filings are declining, there are still approximately 300,000 applications annually, with approximately 230,000 applications annually subject to requests for examination, compared with only about 150 patent-infringement suits per year. Since a patent right arises only upon registration following allowance, examination at the JPO may superficially account for 99.9% of the time devoted to patent practice. Even without reaching the 0.1% of cases litigated, however, patents provide deterrence and are used in cross-licensing. Unlike other fields of law, judicial trends on patent-law issues change over periods of a few years. The JPO's Examination Guidelines and Handbook are likewise revised every few years in response to recent decisions, so they align on most issues.

(1) JPO Examination Guidelines and Handbook (including the accompanying case examples)

These set out the substantive and procedural policies followed by examiners on all patent-law issues. For JPO procedures, following the Guidelines and related materials will generally keep one on the right track; when uncertain, one can also telephone the JPO with questions. On substantive law, however, some issues diverge somewhat from the majority of court decisions. Arguments in court, in JPO trial and appeal proceedings, and when enforcing patents must follow the case law. If the aim is to obtain a patent at the examination stage without proceeding to appeal, however, one sets aside the court-oriented approach and develops arguments wholly aligned with the Examination Guidelines. (The same applies to designs and trademarks.)

<Audience> All patent practitioners

<Use> Examination practice at the JPO (case law takes precedence in litigation and trial/appeal proceedings)

(2) Industrial Property Laws: Article-by-Article Commentary [20th Edition], edited by the JPO

This provides the JPO's interpretation of every provision of the Patent Act. Its explanations are limited to matters on which disagreement with the courts is not expected, so it does not explain issues disputed in practice and often does not resolve practical uncertainty; it is a substantial, 2,132-page volume. Conversely, the matters it does explain can be checked as an indication that there is generally no practical dispute. In that sense, advanced practitioners are unlikely to be unfamiliar with its contents. Nevertheless, because matters stated in the Commentary carry persuasive weight, it is a book one constantly consults in examination, trial/appeal, litigation, negotiation, and other practice. (The same applies to designs and trademarks.)

<Audience> All patent practitioners (essential for beginners)

<Use> An indication that there is generally no practical dispute on the issue

(3) Patent Filing Strategies and Examination Response Practice for Japan, the United States, Europe, and China (Revised Edition) (Patent Attorney Kenji Tachibana)

Businesses using patents operate globally, and protection is often sought in Japan, the United States, Europe, China, and Korea. It is therefore important to consult not only Japan's Examination Guidelines but also the U.S. MPEP, European patent-examination guidelines, China's examination guidelines and Supreme People's Court explanations, and Korea's Examination Guidelines, and to understand, issue by issue, their differences from Japanese guidelines and related materials. Japanese translations of each are published, and I prepare comparison tables for each issue. There are, however, national patent-office practices that cannot be discerned from the text of their examination guidelines alone. This book explains approaches to dealing with the patent offices in Japan, the United States, Europe, and China, drawing on experience with examination of numerous foreign applications, and is a bible for practitioners involved in foreign filings. The free email newsletter published by LEXIA Partners, where Patent Attorney Tachibana practices, provides even more practice-oriented content.

<Audience> Those involved in foreign filings (intermediate and advanced practitioners)

<Use> Understand, issue by issue, differences between foreign examination practice and Japan's Examination Guidelines and related materials

(4) Encyclopedia of Patent Case Law [3rd Edition] (Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

An encyclopedic book classifying important Japanese patent decisions by issue and by whether they favor or disfavor the right holder. For example, when an issue such as ‘inventive step of parameter inventions’ arises in practice and one wishes to check the case law, reviewing the cases listed under that issue enables either the patentee or the alleged infringer to identify decisions favorable and unfavorable to its company, as well as changes in trends over time. Important passages from judgments are quoted, with the critical portions in red for at-a-glance understanding. Each case also carries a brief description, making it easy to see which cases within an issue should be checked. (The same applies to the Encyclopedia of Design Case Law.)

<Audience> Advanced practitioners able to begin with the issue in patent practice

<Use> Identify cases favorable/unfavorable to one's company on issues arising in practice, and develop strategy and tactics

(5) New Commentary on the Patent Act [2nd Edition]

The most substantial book on patents (in three volumes). Scholars, attorneys, and patent attorneys explain the Patent Act provision by provision in detail, introducing scholarly views as well as case law. It is valuable when comprehensively organizing scholarly views, such as where lower-court decisions diverge or when petitioning the Supreme Court to accept a final appeal. It is also essential when a less common issue with little accumulated case law arises in practice (for example, compulsory licenses or the presumption concerning a manufacturing process) and is not covered in the Article-by-Article Commentary, because arguments then need to be developed by reference to scholarship.

<Audience> Advanced practitioners

<Use> Check scholarly views on less common issues with little accumulated case law

(6) Theory and Practice of Orders to Produce Documents [2nd Edition]

In court, the patentee must identify the defendant's product/process and prove that it satisfies the technical scope of the patented invention. This is often difficult for apparatus inside the defendant's factory or B-to-B products. Patentees therefore apply for orders to produce documents (Code of Civil Procedure, Article 220; Patent Act, Article 105), but in patent cases these are often denied for insufficient prima facie showing of

infringement. (The inspection system effective from October 2020 has a higher threshold than document-production orders.) Nevertheless, courts often convey to defendants their provisional view that a case warrants a document-production order, and defendants then submit evidence voluntarily. Understanding the theory and practice of document-production orders in court is therefore important in practice. (The same applies to IP cases other than patents.)

<Audience> Attorneys and those handling litigation

<Use> Establish a strategy for arguments and proof in court

(7) Other Japanese-Language Information Sources Useful for Patent Practice

(i) ‘Random Thoughts on European IP Practice’ (Kan Hasegawa, Japanese and German Patent Attorney) https://hasegawa-ip.com

Kan Hasegawa, who qualified as a Japanese patent attorney and also obtained the German qualification, generously shares knowledge of European patents acquired through patent-filing practice at a German firm. As a Japanese-language source for learning European patent practice, it is ideal and provides firsthand information.

(ii) ‘Open Legal Community’ (Koji Noguchi, U.S. Patent Attorney)

https://openlegalcommunity.com/blog/

U.S. Patent Attorney Koji Noguchi provides the latest information on U.S. patent practice in Japanese, including U.S. Supreme Court and CAFC judgments. The information arrives overwhelmingly faster than magazine articles.

(iii) ‘Pharmaceutical Patent Case Law Blog’ (anonymous / Fubuki) https://www.tokkyoteki.com

In addition to pharmaceutical case law, the blog covers JPO decisions, developments abroad, and rights relating to pharmaceuticals. It is essential reading for IP professionals in the pharmaceutical industry and is frequently cited in academic papers.

(iv) ‘Sotoku Diary’ (anonymous / Sotoku) https://thinkpat.seesaa.net

Introduces carefully selected cases. It considers them from perspectives different from academic papers, taking account of their relationship to other relevant cases, and is an extremely useful, must-read blog for patent practitioners. It is frequently cited in scholars' papers. Many perspectives have been identified only by this blog.

(v) ‘The Crossroads of Patent Law’ (Kohsuke Tanaka, Patent Attorney) https://patent-law.hatenablog.com

Examines cases from perspectives different from academic papers and is an extremely useful, must-read blog for patent practitioners. It is also cited in academic papers.

(vi) ‘IP Guideposts’ (Tadashi Matsushita, Patent Attorney) www.furutani.co.jp/matsushita/001/

A blog comprehensively introducing cases across all IP fields. By posting immediately after judgments are published, without adding commentary, it offers the fastest coverage in Japan. (All IP fields.)

(vii) Attorney Hideki Takaishi's Patent Channel (Hideki Takaishi) https://www.youtube.com/@tokkyo

A YouTube channel explaining patent-law issues through videos. By watching the relevant issue when it arises in practice, one can learn topic by topic. It can also be used to train newcomers assigned to IP departments. (The same applies to designs.)

(viii) Channels useful for IP practice featuring guest speakers

• IP Practice Online (Hiromoto Kashima, Patent Attorney, and Masamune Oshitani, Patent Attorney)

https://www.youtube.com/channel/UC9wUmfwG0y4sYYGh5GApneA

• Chizai Jitsumu Joho Lab. (IP Practice Information Lab.) (Masaharu Takahashi, Patent Attorney) https://chizai-jj-lab.com

• e-patent (Atsushi Nozaki) https://www.youtube.com/@ePatent

End

Original published pages

特許実務家が参照すべき実務上有用な書籍、その他の日本語の発信

弁護士・弁理士・カリフォルニア州弁護士 高石秀樹



筆者の専門分野は特許および意匠であり、それぞれについて重要裁判例を網羅した裁判例事典を執筆している。特に、特許実務は、技術と法律の融合であることに加えて、特許庁の審決が相当割合（数十％）裁判所で覆されるという行政訴訟としては珍しい状況であるため、実務家としては特許裁判例を離れて実務を語ることができない。他方、日本の特許出願数が減少傾向であるといっても年間約三〇万件あるのに対し、特許権侵害訴訟が年間一五〇件程度にすぎないことを考えると、特許査定を得られない限り権利は存在しない以上、特許実務に費やされる時間は見掛け上特許庁の審査が九九・九％であるかもしれない。もっとも、〇・一％の裁判に至らなくても特許権は抑止力を供し、クロスライセンスに使われる。特許裁判例は、他の法分野と異なり、特許法上の諸論点について裁判例の判断傾向が数年単位で変化する。もっとも、最新裁判例を受けて、特許庁の審査基準やハンドブックも数年ごとに改定されているから、ほとんどの論点で整合する。

特許庁
『特許・実用新案審査基準』❶
『特許・実用新案審査ハンドブック』（附属事例集を含む）（注1）❷

特許法上の全論点について、実体法上・手続法上の、審査官が従う方針が記載されている。特許庁における手続は審査基準等に従えばほぼ間違いがなく、迷ったときは特許庁に電話で質問することもできる。他方、実体法については、多数裁判例と若干ずれている論点もあり、裁判所、特許庁審判で主張するとき、特許権行使時は裁判例に沿って主張する必要があるが、審判に進まずに審査段階で特許化をねらう場合は、裁判所的な考え方を封印して、審査基準に完全に沿った主張を展開することとなる（意匠、商標も同じ）。

特許庁編
『工業所有権法（産業財産権法）逐条解説（第二二版）』❸

特許法の全条文について、特許庁の解釈が示されている。裁判所と見解が分かれることがないと見込まれる事項に絞って解説されているため、実務上争いがある論点は解説がなく、実務上の迷いを解決できる場合は多くない。逆にいえば、逐条解説で解説されている事項は実務上ほぼ争いがないことの指標として確認できる。その意味で、上級者は内容を知らないということはないが、逐条解説に記載されている事項は説得力があるため、審査、審判、裁判、交渉等の実務において常に確認する書籍である（意匠、商標も同じ）。

立花顕治著
『日米欧中に対応した特許出願戦略と審査対応実務（改訂版）』❹

特許権はグローバルであるから、日米欧中韓で権利化を目指すことが多い。そうすると、日本の審査基準のみならず、米国MPEP（特許審査便覧）、欧州特許審査ガイドライン、中国審査指南および最高人民法院の解説、韓国の審査基準を確認し、各論点ごとに日本の審査基準等との相違点を把握することが重要である。それぞれの日本語訳が公表されているから、私は論点ごとの対比表を作成しているが、各国審査基準の文章のみからは読み取れない各国特許庁実務が存在する。本書は、多数の外国出願における審査も踏まえた日米欧中の特許庁の特許庁対応方針が解説されており、諸外国出願に携わる実務家のバイブルである。著者である立花弁理士所属のレクシア特許法律事務所が発行する無料メールマガジンもさらに実務的なコンテンツを提供している。

高石秀樹著
『論点別 特許裁判例事典（第三版）』❺

日本の重要特許裁判例を、論点ごとに権利者有利・不利という視点から分類した事典的書籍。例えば、実務で「パラメータ発明の進歩性」という論点が問題となり、裁判例を確認したいときは、同論点の項目に上がっている裁判例群を確認することにより、権利者側であっても、被疑侵害者側であっても、自社に有利な裁判例、不利な裁判例を把握することが可能となり、時期的なトレンドの変化も把握できる。判決文中の重要箇所を引用し、核心的部分を赤字にしたため一目で理解できる。各裁判例を一言でまとめた説明が付されているため、各論点中のどの裁判例について確認すればよいかもわか

（注1）▶https://www.jpo.go.jp/system/laws/rule/guideline/patent/index.html
（注2）長谷川寛▶https://hasegawa-ip.com
（注3）野口剛史▶https://openlegalcommunity.com/blog/
（注4）Fubuki▶https://www.tokkyoteki.com
（注5）想特一三▶https://thinkpat.seesaa.net
（注6）田中禾介▶https://patent-law.hatenablog.com

特集
my法務BOOKs 私の書棚

りやすい（高石秀樹著、吉田和彦監修『論点別 意匠裁判例事典』（経済産業調査会、二〇二〇年）⑤も同じ）。

中山信弘・小泉直樹編「新・注解特許法（第二版）」⑦

特許に関する最も厚い書（三分冊）。学者、弁護士、弁理士が特許法の条文ごとに詳述した書籍であり、裁判例に加えて、諸学説まで紹介されている。下級審裁判例が割れているとき、最高裁に上告受理申立てをするときに、学説まで網羅的に整理する場面において重宝する。また、マイナーな論点で裁判例が蓄積していない論点が実務で問題となったとき（例えば、強制実施権、製造方法の推定など）、逐条解説に記載がないときは、学説に依拠した議論を展開する必要があるため、必読である。

山本和彦・須藤典明・片山英二・伊藤尚編「文書提出命令の理論と実務（第二版）」⑥

裁判所においては、特許権が被告製品／方法を特定し、特許発明の技術的範囲を充足することを立証する必要があるところ、被告工場内の装置や、BtoB製品では特許権者がこれを特定することは困難である場合が多い。そのため、特許権者としては裁判所に文書提出命令（民事訴訟法220条、特許法105条）を申し立てるが、特許事件においては侵害の疎明が足りないとして否定されることも多い（二〇二〇年に査証制度が導入されたが、文書提出命令よりもハードルが高い）。もっとも、裁判所が文書提出命令を発令する事案である旨の心証を被告に伝え、被告が任意に証拠を提出することも多いため、裁判所における文書提出命令の理論と実務を把握することは、実務上重要である（特許以外の知財事件も同じ）。

その他の特許実務上有用な日本語の発信

長谷川寛「徒然なるままに欧州知財実務」（注2）

日本弁理士資格を有し、ドイツ弁理士資格も取得し欧州特許訴訟代理人としても登録されている長谷川寛先生が、ドイツの事務所で特許出願実務を遂行する中で得た欧州特許に関する知見を惜しみなく提供している。欧州特許実務を日本語で学習する情報源としては、一次情報でもあり最適である。

野口剛史「Open Legal Community」（注3）

米国特許弁護士である野口剛史先生が、米国連邦最高裁判決、CAFC（米国連邦巡回区控訴裁判所）判決を含む米国特許実務の最新情報を日本語で提供してくれる。雑誌記事よりも圧倒的に情報が早い。

匿名／Fubuki「医薬系特許的判例ブログ」（注4）

医薬分野の裁判例に加えて、審決、諸外国動向、医薬品の権利関係について紹介しており、医薬業界の知財関係者必読のブログ。学者の論文中でも多数引用されている。

匿名／想特一三「そーとく日記」（注5）

厳選した裁判例について紹介している。学者の論文とは異なる視点から、他の関連裁判例との関係も踏まえて考察しており、実務上極めて有用な特許実務家必見のブログ。各学者の論文中でも多数引用されている。同ブログでしか指摘していない視点も多い。

田中永介「特許法の八衢」（注6）

学者の論文とは異なる視点から裁判例を考察しており、実務上極めて有用な特許実務家必見のブログ。学者の論文中でも引用されている。

松下正「知財みちしるべ」（注7）

知財全分野の裁判例を完全網羅して紹介するブログ。考察を付さずに判決公開後直ちにアップすることにより、国内最速の紹介スピードを誇る（知財全分野）。

高石秀樹「弁護士・高石秀樹の特許チャンネル」（注8）

特許法上の諸論点について動画で説明しているYouTubeチャンネル。特許実務において、問題となった論点について視聴することにより単元ごとに学習できる。知財部に配属された新人教育にも使える（意匠も同じ）。

ゲストがスピーカーとして登壇する形式の特許実務上有用なチャンネル

- 加島広基・押谷昌宗「知財実務オンライン」（注9）
- 高橋政治「知財実務情報Lab.®」（注10）
- 野崎篤志「野崎篤志のイーパテントチャンネル―調査・分析系中心―」（注11）



たかいし・ひでき

東京工業大学工学部卒業、同大学院修了。弁護士（55期）、弁理士、Duke Law修了、米国カリフォルニア州弁護士、米国パテント・エージェント試験合格。中村合同特許法律事務所パートナー。特許・意匠裁判例を網羅的に研究し、『論点別　特許裁判例事典（第三版）』（経済産業調査会、2022年）、『論点別　意匠裁判例事典』（経済産業調査会、2020年）を出版するとともに、SNS（Twitter、FB、Ameblo）で特許裁判例等を毎日1個情報発信しています。また、特許・意匠の各重要論点を10分程度の動画で説明するYouTubeチャンネル「弁護士・高石秀樹の特許チャンネル」を運営しています。

（注7）松下正▶www.furutani.co.jp/matsushita/
（注8）高石秀樹▶https://www.youtube.com/@tokkyo
（注9）▶https://www.youtube.com/channel/UC9wUmfwG0y4sYYGh5GApneA
（注10）▶https://chizai-jj-lab.com
（注11）▶https://www.youtube.com/@ePatent

English text accompanying the published pages

My Bookshelf — Books Patent Practitioners Should Consult and Other Japanese-Language Information Sources. Hideki Takaishi, attorney-at-law, patent attorney, and California attorney. Corporate Legal Affairs A to Z, June 2023, pp. 16–17.

The article reproduced in these two pages corresponds to the English article text above. The author profile and the additional bibliographic details printed in the pages are translated below.

Author profile: Hideki Takaishi. Graduated from the Faculty of Engineering, Tokyo Institute of Technology, and completed graduate studies at the same institution. Attorney-at-law (55th class), patent attorney, graduate of Duke Law, California attorney, and successful candidate in the U.S. patent-agent

examination. Partner at Nakamura & Partners. He comprehensively researches patent and design decisions and has published Encyclopedia of Patent Case Law by Issue (Third Edition) (Keizai Sangyo Chosakai, 2022) and Encyclopedia of Design Case Law by Issue (Keizai Sangyo Chosakai, 2020). He also publishes information on one patent decision or similar matter each day on social media (Twitter, Facebook, and Ameblo). He operates the YouTube channel Attorney Hideki Takaishi's Patent Channel, explaining important patent and design issues in videos of approximately ten minutes.

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Printed series headings: Latest BOOKS — My Bookshelf. Intellectual Property Library.

IP High Court, 2022 (Gyo-Ke) 10092 [Program] <Shoji> — Intermediate generalization held not to add new matter

Original Ameblo publication: 2023-06-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809491228.html

2022 (Gyo-Ke) 10092 [Program] <Shoji> — Intermediate generalization held not to add new matter

*A case in which an amendment claiming a broader concept based on specific original disclosure, in light of common general technical knowledge at filing (intermediate generalization), was held not to add new matter.

⇒ The JPO decision finding a violation of Patent Act Article 17-2(3) was revoked!!

[Second Amendment] = ‘Strength’ in the game was narrowed not to the expressly disclosed ‘sum of attack power and defensive power,’ but to the intermediate concept (broader than the specific disclosure) ‘strength, a predetermined parameter whose higher numerical value enables more advantageous progress in the competitive game.’

[Claim 1 (after the Second Amendment)] …A program …determining the user's strength stage among stages defined by lower and upper limits of strength, a predetermined parameter whose higher numerical value enables more advantageous progress in the competitive game…. (*The underlined portion was added in the Second Amendment.)

(Excerpt from the court's reasoning)

…The invention described in the original specification, etc. and that described after the Second Amendment address the same problem and have the same technical significance…. …Regarding common general technical knowledge in the ‘game’ field, it was common knowledge at filing that a ‘user's’ ‘strength’ includes, in addition to attack and defensive power, stamina, agility, the number of items held, and the like…. …In light of the invention's technical significance—selecting an opponent appropriate for the user rather than one differing greatly in strength—it is appropriate to understand ‘strength’ in the original specification, etc. as an indicator of a user's strength in the game, requiring only a parameter affecting victory or defeat. Defining ‘strength’ as the ‘sum of attack power and defensive power’ may be one embodiment, but no reason can be found for deliberately excluding stamina, agility, the number of items held, and other elements commonly understood to constitute ‘strength,’ and limiting it to that sum. Put differently, whether ‘strength’ is limited to the ‘sum of attack power and defensive power’ is merely an optional, additional matter that may or may not be adopted in light of the invention's technical significance….

Cf. Examination Handbook for Patent and Utility Model, Annex A, “Case Examples of Amendments Adding New Matter,” Example 7.

⇒ In Example 7, the shape of the molding surface is treated as an optional additional element because it is not directly related to solving the problem or indispensable to the solution. Deleting that limitation is therefore considered not to introduce new technical matter.

=2017 (Gyo-Ke) 10089 [Flexible Medical Container] <Takabe>; 2014 (Gyo-Ke) 10087 [Rack Conveying Apparatus] <Shitara>

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91983.pdf

IP High Court, 2022 (Gyo-Ke) 10009 [Gas Fire-Extinguishing Equipment] <Otaka>

Original Ameblo publication: 2023-06-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809639656.html

2022 (Gyo-Ke) 10009 [Gas Fire-Extinguishing Equipment] <Otaka>

Even if a feature of the secondary reference (a rupture disk) could be adopted to solve the primary reference's problem (preventing room pressurization), another solution (staggering cylinder-valve opening times to release gas sequentially from multiple cylinders) was not readily conceivable.

(Excerpt from the court's reasoning)

The ‘cylinder valve’ on the nitrogen-gas storage cylinder described in Exhibit Ko 1 and the ‘rupture disk’ of the technical matters in Exhibit Ko 2 differ in operation and function. Neither Exhibit Ko 1 nor Exhibit Ko 2 describes or suggests preventing pressurization of a protected area or room by staggering the opening and closing times of storage-cylinder valves or gas-cylinder valves to release gas sequentially from multiple cylinders. In light of these matters, even if a person skilled in the art encountering Exhibits Ko 1 and Ko 2 might consider applying the rupture disk described in Exhibit Ko 2 to the Exhibit Ko 1 invention to prevent pressurization of the protected area or room, it cannot be found that such a person could readily conceive of achieving that result, without a rupture disk, by staggering the opening times of the ‘cylinder valves’ on the respective ‘nitrogen-gas storage cylinders’ to release gas sequentially from multiple cylinders.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91973.pdf

[Article] Settlement of Pharmaceutical Patent Disputes and Antitrust Law (Naoko Mariyama, September 2021)

Original Ameblo publication: 2023-06-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809785175.html

[Article] Settlement of Pharmaceutical Patent Disputes and Antitrust Law (Naoko Mariyama, September 2021)

U.S. Supreme Court, Actavis — Potential justifications for a reverse payment include litigation expenses avoided through settlement and fair value for services that the generic manufacturer provides to the originator.

⇒ The article, published in September 2021, states that such agreements had not previously been taken up as violations in Japan. The Japan Fair Trade Commission's website publishes a joint research report describing reverse-payment cases in Europe and the United States and recommending stronger monitoring in Japan.

https://www.inpit.go.jp/content/100872973.pdf

IP High Court, 2021 (Gyo-Ke) 10027 [Information Providing Apparatus] <Otaka>

Original Ameblo publication: 2023-06-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12809923843.html

2021 (Gyo-Ke) 10027 [Information Providing Apparatus] <Otaka>

Changing information processing over a network to processing solely on the user terminal is not invariably a design matter regardless of the service's content.

⇒ No motivation was found to change to a standalone information-providing apparatus; the change was therefore not readily conceivable.

(Excerpt from the court's reasoning)

In general, when providing an information service, performing the necessary processing through an entire system including a server, as opposed to performing it solely on the user terminal, cannot be said to be freely selectable irrespective of the service's content. Nor is there any recognized necessity or rational basis for a person skilled in the art to modify the ‘learning/life support system 1’ of the Exhibit Ko 1 invention—which comprises learning/life support server 2 connected over network N and user terminals 3 used by multiple course participants/students, allowing communication among them—so that all processing required by the system is performed on a single user terminal 3. Accordingly, changing that system to a standalone information-providing apparatus cannot be said to fall within ordinary design matters….

Paragraph [0022] of Exhibit Ko 1 merely states that various information stored in the storage unit of learning/life support server 2 may instead be stored on user terminal 3. It neither describes nor suggests providing the server's other functions on the user terminal. Thus, no motivation can be found for a person skilled in the art encountering Exhibit Ko 1 to replace the entire configuration of its ‘learning/life support system 1’ with a standalone information-providing apparatus. It cannot therefore be found that such a person could readily have conceived of the configuration of Invention 1 corresponding to Difference 3. … The invention cannot be said to have been readily made by a person skilled in the art….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91607.pdf

IP High Court, 2016 (Ne) 10093 [Cosmetic for … Skin Care] <Shimizu>

Original Ameblo publication: 2023-06-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810053036.html

2016 (Ne) 10093 [Cosmetic for … Skin Care] <Shimizu>

‘…Even if the citric acid functions as an astringent, this does not affect the conclusion that it satisfies the “pH adjuster” limitation.’

*Ultimately, the invalidity defense succeeded.

(Excerpt from the court's reasoning)

The appellant argues that the webpages in Exhibits Otsu 34 and Otsu 35 are merely articles by anonymous persons calling themselves ‘Yokko’ and ‘*Ihasa*,’ respectively, with no substantiation of their accuracy or reliability. As to publication dates, both the blog article in Exhibit Otsu 34 and the review in Exhibit Otsu 35 could readily have their past content edited at any time…. …It is therefore doubtful that they were actually …publicly accessible, and the Exhibit Otsu 34 webpage does not deserve to be admitted as evidence.

However, before this patent application, disclosure of all cosmetic ingredients was mandatory…, and the appellant does not dispute the accuracy of the full ingredient list of its former product on the Exhibit Otsu 34 webpage. Nor does it make any specific allegation, such as that the webpage's author could not have consulted the complete ingredient list of that product, which was released on January 15, 2007, before the patent application. Furthermore, the Exhibit Otsu 34 and Otsu 35 webpages are different pages, with different author pen names, and were written by different people. The full ingredient lists of the appellant's former product agree in both ingredient names and order. Taking these matters into account, it is natural and reasonable to conclude that both authors consulted the complete ingredient labeling on the former product's container or the like. Since multiple different persons thus consulted that ingredient labeling, it can be inferred that the Exhibit Otsu 34 webpage was written on January 17, 2007 (Exhibit Otsu 34), after the product's January 15 release, even if the possibility of later alteration cannot be entirely excluded…. …

The invention at issue and the Exhibit Otsu 34 invention differ in that the former specifies a pH range of 5.0–7.5, whereas the latter does not specify pH, and agree in all other respects. …Before the patent application, setting cosmetic pH within the weakly acidic to weakly alkaline range was common general technical knowledge. Giving the Exhibit Otsu 34 invention, a cosmetic with unspecified pH, a weakly acidic to weakly alkaline pH is therefore a matter that a person skilled in the art could appropriately select. Moreover, given that cosmetics are often made weakly acidic like the skin's surface, choosing any value within ‘5.0–7.5,’ itself within that range, would not have been particularly difficult and would have been within ordinary selection by a person skilled in the art….

The appellant argues that, because the Exhibit Otsu 34 webpage lists all ingredients of its former product, a person skilled in the art would recognize the disclosure as concerning that concrete, specific product. The Exhibit Otsu 34 invention should therefore be identified as containing every listed ingredient and as having the former product's pH (7.9–8.3). However, the webpage does not state the pH of that specific product or the quantity of each ingredient. Even taking account of common general technical knowledge at filing, its disclosure cannot be understood to identify a cosmetic serum with a specific pH. In other words, the complete ingredient information disclosed there yields only an invention of a ‘skin-care cosmetic’ containing each listed ingredient, but with unknown ingredient quantities and unknown pH. The appellant's argument amounts merely to saying that testing the former product itself would reveal its pH. Even in light

of common general technical knowledge, it cannot be found that the webpage's content itself permits a conclusion that the skin-care cosmetic has a pH of 7.9–8.3.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87249.pdf

[Trademarks] IP High Court, 2022 (Gyo-Ke) 10122 <Honda> — ‘Sakuhoku Curry’ case

Original Ameblo publication: 2023-06-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810113612.html

[Trademarks] 2022 (Gyo-Ke) 10122 <Honda> — ‘Sakuhoku Curry’ case

A case in which separate observation and examination of the essential part of a composite trademark led to comparison of ‘朔北’ (Sakuhoku) in the applied-for mark ‘朔北カレー’ (Sakuhoku Curry) with the cited mark ‘サクホク’ (Sakuhoku). The court found them dissimilar (Trademark Act, Article 4(1)(xi), inapplicable) and revoked the refusal decision that had found them similar (and the provision applicable).

(Excerpt from the court's reasoning)

(a) Appearance

The essential part of the applied-for mark comprises the two kanji ‘朔北,’ whereas the cited mark comprises the four katakana ‘サクホク.’ Their appearances are clearly different.

(b) Sound

The essential part of the applied-for mark is pronounced ‘sakuhoku,’ and the cited mark is also pronounced ‘sakuhoku’; they are identical in sound.

(c) Concept

The essential part of the applied-for mark evokes ‘the northern direction’ or ‘a northern land.’ In contrast, ‘サクホク’ is a coined word not listed in dictionaries and evokes no particular concept. Their concepts are clearly different.

(d) As explained above, although the essential part of the applied-for mark and the cited mark share the same sound, they clearly differ in appearance and concept. There are no actual trading circumstances in which consumers or traders associate ‘朔北’ with the cited mark ‘サクホク’ or its owner. Nor can it be found that, for the designated goods of these marks, consumers or traders identify goods and their source solely by pronunciation. Distinctiveness based on sound therefore cannot be said to outweigh distinctiveness based on appearance and concept. Accordingly, use of the applied-for mark and the cited mark on identical or similar goods cannot be said to create a likelihood of confusion concerning source. The applied-for mark therefore cannot be regarded as similar to the cited mark.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e5%95%86%e6%a8%99%e6%b3%95%e2%98%85%e3%80%91%e7%b5%90%e5%90%88%e5%95%86%e6%a8%99%e3%81%ae%e5%88%86%e9%9b%a2%e3%83%bb%e8%a6%81%e9%83%a8%e8%a6%b3%e5%af%9f%e3%81%ab%e3%82%88%e3%82%8a%e6%9c%ac/

Hideki Takaishi Article Collection

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English Edition

171 articles

Complete English translations of the revised Ameblo articles

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17 2023-07-16 Dwango v. U.S. FC2: IP High Court Grand Panel Judgment (the foreign-server issue, including a comparison with the earlier judgment)

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27 2023-07-30 Intellectual Property High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System] <Shoji>

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31 2023-08-02 [Article] Laser Processing Apparatus Case (IP Management, Vol. 73, No. 6, 2023; Masaharu Takahashi and Shunsuke Migita)

32 2023-08-03 Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheet]

33 2023-08-04 Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor] Rebuttal of the Article 102(2) presumption: 90% rebutted

34 2023-08-07 Tokyo District Court, 2019 (Wa) 2675 [Blowgun Darts] <Damages> Rebuttal of the Article 102(2) presumption: 65% rebutted for profits during part of the sales period

35 2023-08-07 Tokyo District Court, 2017 (Wa) 7207 [Vacuum Cleaning Apparatus] <Damages> Rebuttal of the Article 102(2) presumption: 50% rebutted

36 2023-08-07 Tokyo District Court, 2016 (Wa) 25436 [Method for Constructing Amino Acid-Producing Bacteria] <Damages>

37 2023-08-08 Intellectual Property High Court, 2022 (Gyo-Ke) 10003 [Method for Preventing Attachment of Marine Organisms] <Kanno>

38 2023-08-09 [Unfair Competition Prevention Act / Imitation of Product Configuration] Osaka District Court, 2019 (Wa) 11484: "Reliance" found ⇒ Violation of Article 2(1)(iii) of the Unfair Competition Prevention Act

39 2023-08-10 [Trademark] Osaka District Court, 2020 (Wa) 4272

40 2023-08-11 Intellectual Property High Court, 2021 (Gyo-Ke) 10150 [Vessel] <Shoji> = 2021 (Gyo-Ke) 10151 ⇒ Inventive step upheld through a disclaimer claim

41 2023-08-11 Intellectual Property High Court, 2022 (Gyo-Ke) 10029 [Antiglare Film] <Shoji>

42 2023-08-15 Tokyo District Court, 2022 (Wa) 9716 [5-Aminolevulinic Acid Phosphate] <Shibata>

43 2023-08-17 Intellectual Property High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

44 2023-08-18 Osaka District Court, 2018 (Wa) 5189 [Nutrient Supplement for Farmed Fish and Shellfish and Method for Producing It] <Tani>

45 2023-08-19 [Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10073 <Kanno>, the zhiyun case

46 2023-08-22 [Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10090, the HEAVEN case

47 2023-08-23 [Article] Methods of Calculating Royalties Based on ‘Use’ in U.S. Case Law (Hiroshi Takahashi, Patent 2022)

48 2023-08-24 [Trademark / Two JPO Trial Decisions] Appeal 2022-10002; Invalidation 2022-890031

49 2023-08-25 [Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10114, Nonchallenge Obligation under a Settlement Agreement (‘will not interfere’)

50 2023-08-28 Osaka District Court, 2020 (Wa) 7486 [Device for Instantaneously Removing Blood from Fish] ⇒ Joint inventorship affirmed

51 2023-08-29 Intellectual Property High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

52 2023-08-30 Intellectual Property High Court, 2020 (Ne) 10004 [Light Irradiation Device] <Otaka>

53 2023-08-31 [Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10151, the CORE ML case

54 2023-09-01 IP High Court Grand Panel, 2019 (Ne) 10003 [Beauty Device] <Damages> Rebuttal circumstances: 50% under the proviso to Article 102(1)

55 2023-09-03 Tokyo District Court, 2017 (Wa) 29228 [Fluid Supply Device] <Damages> Rebuttal of the Article 102(2) presumption: 40%

56 2023-09-03 Osaka District Court, 2017 (Wa) 7576 [Spacer for Foundation Packing] Grounds for rebutting the Article 102(2) presumption: 70%

57 2023-09-04 Tokyo District Court, 2015 (Wa) 23843 [Raw Seaweed Foreign-Matter Removal Machine] <Damages> No rebuttal of the Article 102(2) presumption

58 2023-09-05 Tokyo District Court, 2015 (Wa) 16829 [Termite-Control Composition] <Damages> Grounds for rebutting the Article 102(2) presumption: 30%

59 2023-09-06 Intellectual Property High Court, 2016 (Ne) 10082 [Raw Seaweed Foreign-Matter Separation and Removal Apparatus] No grounds to rebut the Article 102(2) presumption; contribution rate 100%

60 2023-09-07 Osaka District Court, 2021 (Wa) 10032 [Chip-Type Fuse] <Takemiya>

61 2023-09-08 Tokyo District Court, 2021 (Wa), 26762 [Hardener for Ground-Stabilization Chemical Solution] <Kokubu>

62 2023-09-09 Tokyo District Court, 2012 (Wa) 35757 [Water-Erasable Ink Composition for Calligraphy and Painting]

63 2023-09-10 [Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10108, the Sushi Zanmai case

64 2023-09-11 [Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10167, the GUZZILLA case <Takabe>

65 2023-09-12 [Article] 'Intellectual Property Local Benchmark' (Tomohiko Inui) (Patent, 2020, Vol. 73, No. 9)

66 2023-09-12 <IP LAB ①> Why Does 'the Problem of the Invention at Issue' Affect Inventive-Step Assessment?

67 2023-09-13 [Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10126, the Matsumoto Kiyoshi case <Otaka>

68 2023-09-14 [Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10017, the Air-Conditioned Clothing case <Takabe>

69 2023-09-15 [Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036, the Pore-Care Lotion case

70 2023-09-18 [Copyright] Osaka High Court, 2019 (Ne) 1735, the Goldfish Telephone Booth case

71 2023-09-18 [Unfair Competition Prevention Act] Osaka District Court, 2019 (Wa) 7786, Kyoto City University of Arts and Kyoto University of the Arts

72 2023-09-18 [Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10047, the Fukumai case — Article 50(1) of the Trademark Act: an implied license was found

73 2023-09-19 [Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) 35263, 2WAY-Compatible Oxygen Chamber

74 2023-09-20 Intellectual Property High Court, 2006 (Gyo-Ke) 10053 [Tissue-Paper Storage Box] <Shinohara>

75 2023-09-22 Intellectual Property High Court, 2010 (Gyo-Ke) 10407 [Method for Operating a Wind Park] <Iimura>

76 2023-09-22 [Copyright] Intellectual Property High Court, 2020 (Ne) 10018 <Tsuruoka>

77 2023-09-24 Intellectual Property High Court, 2009 (Gyo-Ke) 10153 [Method for Making a Cutting-Tool Insert ...] <Nakano>

78 2023-09-24 Intellectual Property High Court, 2007 (Gyo-Ke) 10241 [Exhaust Valve for a Storage Bag]

79 2023-09-25 Intellectual Property High Court, 2005 (Gyo-Ke) 10677 [Memory Control Device] <Mimura>

80 2023-09-26 Intellectual Property High Court, 2009 (Gyo-Ke) 10142 [Apparatus for Mixing Powder and Granules and Removing Fine Powder ...] <Nakano>

81 2023-09-27 Intellectual Property High Court, 2011 (Gyo-Ke) 10193 [Chair-Type Massage Machine] <Shiotsuki>

82 2023-09-28 Intellectual Property High Court, 2010 (Gyo-Ke) 10318 [Storage Case for a Recording-Medium Disc] <Iimura>

83 2023-09-29 Intellectual Property High Court, 2011 (Gyo-Ke) 10364 [... Electric Motor with High Specific Output]

84 2023-09-30 Intellectual Property High Court, 2021 (Gyo-Ke) 10053 [Method for Making a Container for Microwave-Heated Food] <Otaka>

85 2023-09-30 Tokyo District Court, 2011 (Wa) 3292 [Battery-Powered Alarm] (Damages) <Osuga>

86 2023-10-02 Intellectual Property High Court, 2013 (Ne) 10017 and 2013 (Ne) 10041 [Open-Type Fermentation Treatment Apparatus]

87 2023-10-03 Intellectual Property High Court, 2019 (Gyo-Ke) 10043 [High-Contrast Tire Pattern] <Tsuruoka>

88 2023-10-04 Intellectual Property High Court, 2017 (Gyo-Ke) 10146 [Light-Guide Film] <Tsuruoka>

89 2023-10-05 Intellectual Property High Court, 2022 (Gyo-Ke) 10012 and 10045 [Touch-Operated Input Device] <Kanno>

90 2023-10-06 Intellectual Property High Court, 2022 (Ne) 10061 [Magnetic Screen Device] <Honda>

91 2023-10-10 Tokyo District Court, 2021 (Wa) 26762 et al. [Hardener for Ground-Stabilizing Chemical Solution] <Kokubu>

92 2023-10-10 Intellectual Property High Court, 2021 (Gyo-Ke) 10152 [Method for Resin-Sealing Permanent Magnets] <Honda>

93 2023-10-11 Tokyo District Court, 2015 (Wa) 25780 [Ground-Improvement Device] <Shimasue>

94 2023-10-12 Tokyo District Court, 2012 (Wa) 15621 [Cu-Ni-Si Alloy with Excellent Strength and Bendability] <Presiding Judge Takano; signed on his behalf by Judge Mitsui>

95 2023-10-13 Intellectual Property High Court, 2019 (Gyo-Ke) 10126 <Tsuruoka> [Steel Sheet-Pile Press-In and Extraction Machine], third judgment

96 2023-10-14 Intellectual Property High Court, 2020 (Gyo-Ke) 10054 [Nucleic-Acid Decomposition Treatment Apparatus] <Kanno>, second judgment

97 2023-10-16 Intellectual Property High Court, 2014 (Gyo-Ke) 10057 [Deposit Terminal] <Ishii>

98 2023-10-17 Intellectual Property High Court, 2011 (Gyo-Ke) 10115 [Cyclohexane Compound] <Takizawa>

99 2023-10-18 Osaka District Court, 2008 (Wa) 10819, and its appellate judgment, Intellectual Property High Court, 2013 (Ne) 10026 <Iimura>

100 2023-10-19 Intellectual Property High Court, 2022 (Gyo-Ke) 10094 [Insole] <Honda>

101 2023-10-20 Intellectual Property High Court, 2022 (Ne) 10094 [Composition Containing ... Tetrafluoropropene] <Hibiku Shimizu>

102 2023-10-20 [U.S. Patents] Netflix v. DivX (CAFC, September 11, 2023) – Analogous Art

103 2023-10-23 Tokyo District Court, 2020 (Wa) 25891 [... Filtered Cigarette] <Shibata>

104 2023-10-24 [Article / United States] Appellate Judgment on Licensing ‘Standard-Essential Patents’ Across Industries (Intellectual Property Management 73)

105 2023-10-25 [Article / Copyright] Comparison of How Copyright Law Operates in Real Space and in Virtual and Digital Space (Intellectual Property Management)

106 2023-10-26 [Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10148 <Kanno>, the NICO case

107 2023-10-27 [Trademark] Intellectual Property High Court, 2011 (Gyo-Ke) 10093 <Iimura>, the PAG case

108 2023-10-30 [Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10121 <Kanno>, the TART case

109 2023-10-30 [Article] Legality of Dismissal of Amendments Under Article 53(1) of the Patent Act: ... (Patent Studies, March 2013; Hiroshi Yoshida)

110 2023-10-30 [Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10005 <Otaka>, the KAZE case

111 2023-10-31 [Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10119 <Honda>, the CLEAR case

112 2023-11-01 [Trademark] Tokyo District Court, 2021 (Wa) 33526 <Sugiura>

113 2023-11-02 Osaka District Court, 2020 (Wa) 3473 [Lighting Fixture] <Matsuami> <Damages> Rebuttal of the presumption under Article 102(2): rebutted by 80%

114 2023-11-03 An IP High Court Judgment on the Meaning of a ‘Trademark Widely Recognized Among Consumers’ as a Requirement for Registration of a Defensive Mark

115 2023-11-04 Intellectual Property High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

116 2023-11-05 Intellectual Property High Court, 2022 (Gyo-Ke) 10017 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

117 2023-11-07 [Trademark] Osaka District Court, 2020 (Wa) 4272, the LEADERBIKES case

118 2023-11-08 Tokyo District Court, 2021 (Wa) 29388 [HFO-1234yf] <Sugiura> — Fourth generation of the patent in 2019 (Wa) 30991

119 2023-11-09 Intellectual Property High Court, 2022 (Gyo-Ke) 10061 [Excavator] <Kanno>

120 2023-11-10 [Unfair Competition Prevention Act, Article 2(1)(i)] Imitation of a Well-Known Product Configuration <Damages> Intellectual Property High Court, 2022 (Ne) 10095 and 10112 <Honda>

121 2023-11-12 * Cases in which a party and its supporting intervenor shared the same attorney

122 2023-11-12 [Copyright / Provider Liability Act] Intellectual Property High Court, 2022 (Ne) 10102 ⇒ Reversal and disclosure order

123 2023-11-13 Intellectual Property High Court, 2021 (Gyo-Ke) 10091 [Adhesive Tape] <Honda>

124 2023-11-14 Intellectual Property High Court, 2022 (Gyo-Ke) 10001 [Ultra-High-Sensitivity Micromagnetic Sensor] <Kanno>

125 2023-11-15 Intellectual Property High Court, 2022 (Gyo-Ke) 10111 [Beltline Molding for a Vehicle Door] <Honda>

126 2023-11-16 [Trademark / Contract] Osaka District Court, 1996 (Wa) 6700 — Abuse of the right to terminate

127 2023-11-17 [Portrait Rights] Tokyo District Court, 2021 (Wa) 28420 <Principal Action> <Nakashima>

128 2023-11-18 Intellectual Property High Court, 2022 (Gyo-Ke) 10099 [Laser Processing Apparatus] <Honda>

129 2023-11-18 Osaka District Court, 2022 (Wa) 2695, Employee Invention

130 2023-11-20 [Article] Individual Directors' Liability for Damages to Patentees in Patent-Infringement Cases (Keijiro Miwa and Kazunari Sugimitsu)

131 2023-11-21 Osaka District Court, 2017 (Wa) 7384 [Massage Machine] <Damages>

132 2023-11-22 Intellectual Property High Court, 2021 (Ne) 10088 and 2022 (Ne) 10014 [Information Communication Unit]

133 2023-11-23 Tokyo District Court, 2012 (Wa) 12351 [Rice Cake]

134 2023-11-24 Tokyo District Court, 2013 (Wa) 33070 [Agricultural-Produce Sorting Apparatus] <Hasegawa>

135 2023-11-25 [Article] Judicial Decisions on Infringement Warnings and Notification of False Facts Under the Unfair Competition Prevention Act (Patent Supplement, 2023; Professor Toshiya Kaneko)

136 2023-11-26 [Article] Supplementing Unfair-Competition Protection Through Civil Code Tort Law (Patent Supplement, 2023; Professor Tatsuhiro Ueno)

137 2023-11-27 [U.S. Patents] November 6, 2023, CAFC <ACTELION v. MYLAN> — Interpretation of Numerical Limitations and Rounding

138 2023-11-28 [Article] The Relationship Between ‘Confusion’ and ‘Business Interests’ Under Article 2(1)(i) of the Unfair Competition Prevention Act (Professor Hisayoshi Yokoyama)

139 2023-11-29 [Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2014 (Wa) 1397, the Shoe Last case

140 2023-11-30 [Design / Estoppel] Intellectual Property High Court, 2021 (Gyo-Ke) 10067 <Honda>

141 2023-12-02 [Trademark] Osaka High Court, 2021 (Ne) 2608, the Roller Sticker case — * The acts of removing or obliterating the registered trademark and related acts in this case do not, in themselves, constitute trademark infringement.

142 2023-12-02 [Copyright / Publication Right] Tokyo District Court, 2021 (Wa) 13720 <Kokubu>

143 2023-12-03 [Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10157, the NUDE NAIL case <Kanno> <Agent of a foreign trademark owner>

144 2023-12-04 [Examination Handbook for Patent and Utility Model / Annex A] Addition of New Matter: Amendments Based on Drawings (8 Examples), p. 549

145 2023-12-05 Osaka District Court, 2011 (Wa) 15499 [Lid and Container Equipped with the Lid]

146 2023-12-06 Osaka District Court, 2011 (Wa) 6878 [Method for Stabilizing the Coloration of a Colored Plaster Composition] <Damages> Article 102(2)

147 2023-12-07 Osaka District Court, 2009 (Wa) 10811 [Method and Apparatus for Manufacturing a Rotary Toothbrush] <Damages> Article 102(1)

148 2023-12-08 Osaka District Court, 2011 (Wa) 3850 [Flexible Plastic Container]

149 2023-12-09 Intellectual Property High Court, 2011 (Ne) 10002 [Rice Cake] <Iimura> <Damages> Article 102(2)

150 2023-12-09 [Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10063 <Miyasaka>, the VENTURE case — Composite marks

151 2023-12-10 Intellectual Property High Court, 2010 (Ne) 10032 and 2010 (Ne) 10041 [Solid Golf Ball] Damages, Article 102(1)

152 2023-12-11 Intellectual Property High Court, 2010 (Ne) 10091 [Treatment Agent for Immobilizing ... Heavy Metals in Fly Ash] <Damages> Articles 102(1) and 102(3)

153 2023-12-13 Tokyo District Court, 2008 (Wa) 2944 [Normally Closed Flow-Control Valve] <Damages> Article 102(2)

154 2023-12-13 Osaka District Court, 2007 (Wa) 13513 [X-Ray Foreign-Matter Inspection Apparatus] <Damages> Article 102(2)

155 2023-12-14 Tokyo District Court, 2003 (Wa) 19926 [Coagulant Composition for Tofu] <Damages> Article 102(1)

156 2023-12-15 [Trademark] Tokyo District Court, 2022 (Wa) 18610 <Kokubu>

157 2023-12-16 [Trademark] Intellectual Property High Court, 2016 (Gyo-Ke) 10164 and 2017 (Gyo-Ke) 10169

158 2023-12-19 Intellectual Property High Court, 2021 (Gyo-Ke) 10097 [Golf Swing Monitoring System] <Otaka>

159 2023-12-19 Tokyo District Court, 2022 (Wa) 5905 [Composition for Promoting Increased Subcutaneous Tissue] <Shibata>

160 2023-12-19 Intellectual Property High Court, 2018 (Gyo-Ke) 10146 [Pachinko Machine] <Otaka>

161 2023-12-20 [Design] Intellectual Property High Court, 2023 (Gyo-Ke) 10001 <Shoji> — Ease of creation denied

162 2023-12-21 Intellectual Property High Court, 2022 (Gyo-Ke) 10125 <Hibiku Shimizu>, Disclaimer Claims and Correction Requirements

163 2023-12-22 [Unfair Competition Prevention Act, Article 2(1)(iii)] Tokyo District Court, 2017 (Wa) 21145 <Sato>

164 2023-12-23 [Article / Europe] Intermediate Generalization — A Special EPC Patent Procedure

165 2023-12-26 [Article / Foreign Jurisdictions] Selection Inventions at the EPO (Patent, Vol. 73, No. 14, 2020; Charles Renney and Eleanor Maciver)

166 2023-12-27 Intellectual Property High Court, 2015 (Gyo-Ke) 10190 [Method for Reducing Environmental Pollutants in Oils or Fats] <Tsuruoka>

167 2023-12-28 Intellectual Property High Court, 2005 (Gyo-Ke) 10717 [... Siloxane ...] <Tsukahara>

168 2023-12-30 Tokyo High Court, 2003 (Gyo-Ke) 405 [Substituted 1,3-Oxathiolanes with Antiviral Activity] <Sato>

169 2023-12-30 Intellectual Property High Court, 2008 (Gyo-Ke) 10366 [Gastritis Treatment Agent] <Iimura>

170 2023-12-30 <New YouTube Video> [Patents] IP Strategy That Serves Business (Publicly Releasable Extracts from a Five-Hour Paid Lecture)

171 2023-12-31 Intellectual Property High Court, 2013 (Gyo-Ke) 10209 [Agent for Suppressing Vascular Intimal Thickening] <Shimizu>

[Trademark] Intellectual Property High Court, 2020 (Ne) 10017, the Morihan case <Honda>

Original Ameblo publication: 2023-07-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810193045.html

[Trademark] Intellectual Property High Court, 2020 (Ne) 10017, the Morihan case <Honda>

Morihan: No enforcement for nearly 40 years. The defendant, too, had contributed to the accumulation of goodwill.

⇒ Abuse of rights!!

Morihan Sohonpo: The defendant began using this in 2006. Its trademark application was also refused (Trademark Act, Article 4(1)(xi)). It would alter the relationship among the three Morihan entities.

⇒ Not an abuse of rights!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91601.pdf

Osaka District Court, 2015 (Wa) 4292 (the first-instance judgment underlying the Grand Panel judgment) [Carbon Dioxide-Containing Viscous Composition]

Original Ameblo publication: 2023-07-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810335103.html

Osaka District Court, 2015 (Wa) 4292 (the first-instance judgment underlying the Grand Panel judgment) [Carbon Dioxide-Containing Viscous Composition]

<Damages> Rebuttal of the presumption under Article 102(2) rejected

① There is insufficient evidence to establish that the effects and efficacy of carbon dioxide on the skin differ substantially between the plaintiff's and defendant's products.

② Advertising for the defendant's products emphasized their ability to achieve improvements in cosmetic skin problems and localized obesity through carbon dioxide, which considerably influenced consumers' purchase motivations.

③ There is insufficient evidence to establish that the defendant's products fall within the technical scope of inventions covered by the plaintiff's patents other than the patents at issue.

④ For a competing product to constitute a ground for rebutting the presumption, it must have effects equivalent to those of the patents at issue and compete as an equivalent alternative for consumers, the relevant customers.

⑤ There was a factor teaching away from combining the common general technical knowledge asserted by the defendant with the prior art, and the combination cannot be found to have been easily conceivable. The technical value of the inventions at issue therefore cannot be said to be low.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87963.pdf

IP High Court (Grand Panel), 2018 (Ne) No. 10063, judgment of June 7, 2019 (Presiding Judge Takabe) <Damages>

Original Ameblo publication: 2023-07-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810340433.html

IP High Court (Grand Panel), 2018 (Ne) No. 10063, judgment of June 7, 2019 (Presiding Judge Takabe) <Damages>

[Carbon Dioxide-Containing Viscous Composition] <Damages> Rebuttal of the presumption under Article 102(2) rejected

<General principles>

"These are understood to be circumstances that disrupt an adequate causal relationship between the profits obtained by the infringer and the damage suffered by the patentee. Examples include: ① differences in the business models and other circumstances of the patentee and infringer (different markets); ② the existence of competing products in the market; ③ the infringer's sales efforts (brand strength and advertising); and ④ the infringing product's performance (features other than the patented invention, such as functions and design)."

"Where the patented invention is worked in only part of the infringing product ..., this is determined by comprehensively considering such circumstances as the position within the infringing product of the part in which the invention is worked and the invention's customer-attracting power."

<Application to the facts>

• The sales periods, market shares, and other details of the alleged competing products are unknown, and the evidence is insufficient to establish that they compete with the defendant's products in the market.

• Even if ingenuity or sales efforts within the ordinary range were employed, they cannot be regarded as grounds for rebutting the presumption.

• Even if an infringing product has superior efficacy compared with the patentee's product, this does not immediately warrant rebuttal of the presumption; circumstances showing that the superior efficacy contributed to the infringer's sales are necessary.

• Even if an infringing product embodies another patented invention, this does not immediately warrant rebuttal of the presumption; circumstances such as a contribution to sales of the infringing product from working that other patented invention are necessary.

[Patent ★★] Carbon Dioxide-Containing Viscous Composition case: A decision on the calculation of damages and the factors to consider under Article 102(2) and (3) of the Patent Act. - NAKAMURA & PARTNERS (nakapat.gr.jp)

IP High Court (Grand Panel), 2012 (Ne) No. 10015, judgment of February 1, 2013 (Presiding Judge Iimura) <Damages>

Original Ameblo publication: 2023-07-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810342559.html

IP High Court (Grand Panel), 2012 (Ne) No. 10015, judgment of February 1, 2013 (Presiding Judge Iimura) <Damages>

[Waste Storage Cassette and Waste Storage Device] <Damages> Rebuttal of the presumption under Article 102(2) rejected

• The plaintiff (a foreign company) sells its cassettes in Japan through Combi, and Combi is not the only entity earning profits from sales of the plaintiff's products in Japan.

• It is argued that Product I does not produce the effects of the invention when used with the Mark II main unit, but the number used with the Mark II main unit is unknown and cannot be determined.

• Like the plaintiff's cassettes, Product I is ordinarily used together with the plaintiff's main unit solely for that purpose. (The invention is claimed as a subcombination.)

• The price difference between Product I and the plaintiff's cassette is small (approximately 167 yen per unit).

• Combi, which the plaintiff designated as its distributor in Japan, is not inferior in brand strength in Japan to Aprica (the defendant).

Full judgment (Courts of Japan)

Tokyo District Court, 2020 (Wa) 19221 [Auxiliary Laundry Washing Product] <Kokubu>

Original Ameblo publication: 2023-07-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810766628.html

Tokyo District Court, 2020 (Wa) 19221 [Auxiliary Laundry Washing Product] <Kokubu>

* A purity of 99.95% was held to fall within "substantially 100% by weight."

* Includes cases in which it is used solely to work the inventions at issue.

⇒ Not a mere standard or general-purpose product.

⇒ Indirect infringement established

Note: Recently, the various requirements of Article 101 have almost always been found satisfied!!

(Extract from the court's reasoning)

The defendant's product consists of "metallic magnesium particles having a purity of approximately 99.95% ..." ...; these are ... "a plurality of metallic magnesium particles" (Configuration c), and thus there are "a plurality" of metallic magnesium particles (Element 1A). ... They fall within "particles containing substantially 100% by weight of elemental metallic magnesium (Mg)" (Element 2A).

The specification states that, as to the composition of metallic magnesium particles used as an auxiliary laundry washing product, particles containing substantially 100% by weight of elemental metallic magnesium (Mg) are more preferred ([0020]), and that an average particle diameter of 4.0–6.0 mm is most preferred for the metallic magnesium particles used as an auxiliary laundry washing product ([0022]). ... The defendant's product satisfies both of these points. It follows that enclosing the defendant's product in a laundry net necessarily completes an auxiliary laundry washing product satisfying the elements of each invention at issue. The defendant's product is therefore found to include cases of use solely to work those inventions ... and cannot be described as a mere standard or general-purpose product.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91828.pdf

Intellectual Property High Court, 2022 (Ne) 10008 [Information Providing Device, System and Program] <Otaka>

Original Ameblo publication: 2023-07-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12810902603.html

Intellectual Property High Court, 2022 (Ne) 10008 [Information Providing Device, System and Program] <Otaka>

The first-instance court found lack of novelty, but because the invalidation trial resulted in a decision maintaining the patent, the patentee did not raise a rebuttal to the invalidity defense based on correction of the patent claims from the beginning of the appeal and first raised it at the first oral argument hearing.

⇒ Rejected as untimely

⇒ If only the rebuttal to the invalidity defense based on claim correction had been raised in the alternative ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91603.pdf

Intellectual Property High Court, 2021 (Ne) 10099 [Hydrogen Gas Supply Device for Living Organisms] <Kanno>

Original Ameblo publication: 2023-07-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811056503.html

Intellectual Property High Court, 2021 (Ne) 10099 [Hydrogen Gas Supply Device for Living Organisms] <Kanno>

The difference between Product I and the invention did not concern an essential part (focusing on the generated hydrogen gas ... and maintaining it below a certain concentration outside the explosive range by ...), but there was no motivation to make the substitution.

⇒ The first and second requirements of the doctrine of equivalents were satisfied, but the third was not (the fifth was not addressed)

Note: The third requirement must be considered independently of the essential part!!

(Extract from the court's reasoning)

In Corrected Invention 6, "an electrolytic chamber into which raw water to be electrolyzed is introduced" refers to a chamber whose interior and exterior are completely separated by a diaphragm so that water does not communicate between the inside and outside, allowing them to remain separate, independent states. ...

Corrected Invention 6 focuses on the generated hydrogen gas and maintains it below a certain concentration outside the explosive range by blowing a diluting gas onto the cathode or the cathode water surface. This should be regarded as the essential part of Corrected Invention 6. Therefore ... because it does not concern the hydrogen gas concentration, it cannot be said to replace an essential part. Accordingly, Defendant's Product 1 satisfies the first requirement for equivalence.

... Defendant's Product 1 also blows air onto the cathode water surface approximately 6 cm above the cathode, and supplies a living organism with a mixed gas containing hydrogen gas and air at a hydrogen gas concentration of 2.6 vol%. It can therefore be said to produce the same effect as Corrected Invention 6. Accordingly, Defendant's Product 1 satisfies the second requirement. ...

None of the well-known technologies asserted by the appellant can be regarded as providing motivation to replace the configuration of "one or more diaphragms separating the inside and outside of the electrolytic chamber" in Corrected Invention 6 with the configuration of "① part of the side wall of inner tank 6, ② the bottom of inner tank 6 having outflow hole 3, and ③ four polymer membranes 10" in Defendant's Product 1. On these facts, such a substitution cannot be said to have been easy, and Defendant's Product 1 does not satisfy the third requirement for equivalence.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91706.pdf

[Copyright] Intellectual Property High Court, 2022 (Ne) 10059

Original Ameblo publication: 2023-07-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811246567.html

[Copyright] Intellectual Property High Court, 2022 (Ne) 10059

A post-termination noncompete clause in an exclusive management agreement between a music agency and performers (a band)

⇒ Although the noncompete period was six months, it was unrelated to recovery of upfront investment

⇒ Contrary to public policy

Note: Noncompete obligations upon leaving employment are a separate issue because confidentiality is involved.

I think there is often a need to recover upfront investment. Even then, just as an acceptable noncompete period varies with the type of work, the period that does not violate public policy will vary according to the need to recover the upfront investment.

I am not speaking specifically about this case. My point is that, just as the threshold for violating public policy in noncompete cases differs by type of work, where there is a need for "recovery of upfront investment," as discussed in this case, the threshold will likely differ depending on the degree of that need.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91677.pdf

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10067 <Kanno>

Original Ameblo publication: 2023-07-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811305482.html

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10067 <Kanno>

* Japan Patent Office

The registration of the trademark at issue (OLYMBEER) was revoked for violating Article 4(1)(vi) in relation to the cited signs "OLYMPIAD" and "Olympiad" in katakana.

* Court

The signs were found dissimilar and the decision was set aside

Although the four letters OLYM are identical ...

The court considered the voiced sound "bi" in the trademark at issue and the semi-voiced sound "pi" in the cited signs as supporting dissimilarity!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91704.pdf

【本件商標】



[Article / Foreign Law] European Patent Strategy after the Entry into Force of the Unified Patent Court (UPC) Agreement: Effective Use of the German Patent System for Japanese Companies

Original Ameblo publication: 2023-07-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811464796.html

[Article / Foreign Law] European Patent Strategy after the Entry into Force of the Unified Patent Court (UPC) Agreement: Effective Use of the German Patent System for Japanese Companies (IP Management, Vol. 73, No. 5, 2023) (Toshiko Takenaka, Christoph Karl)

The patentee win rate in Germany is approximately 65% (approximately 50% of cases end before judgment)

In Japan, approximately 25%

In the United States, 75% for jury verdicts, but 95–97% of cases end before trial

[Copyright / Directors' Personal Liability] Tokyo District Court, 2021 (Wa) 20472 <Nakashima>

Original Ameblo publication: 2023-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811600750.html

[Copyright / Directors' Personal Liability] 2021 (Wa) 20472 <Nakashima>

No practice was recognized of "not seeking a license from creators, at least for a manner of posting ... without measures to prevent unauthorized copying ..."

+ Personal liability of the representative director was upheld: "The company's internal system for preventing infringement of intellectual property rights was inadequate."

092100_hanrei.pdf (courts.go.jp)

[Patent] Different novelty determinations on the same patent and the same cited reference by the same division on the same day. A rebuttal to the invalidity defense based on claim correction rejected as untimely.

Original Ameblo publication: 2023-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811616256.html

[Patent] IP High Court judgments by the same division on the same day, involving the same patent and the same cited reference (an action to revoke a JPO trial decision and an appeal in an infringement action) **that reached different conclusions on novelty. A case in which a rebuttal to the invalidity defense based on claim correction was rejected as untimely.**

(1) Judgment in the action to revoke a JPO trial decision finding novelty ⇒ Inventive step also upheld

Judgment delivered November 29, 2022 **[Information Providing Device] case**

Intellectual Property High Court, 2021 **(Gyo-Ke)** No. 10027 <Otaka>

Oral argument concluded September 22, 2022

091607_hanrei.pdf (courts.go.jp)

Patent No. 6538097

Primary cited reference: Japanese Unexamined Patent Application Publication No. 2015-102994 (Exhibit Ko 1)

⇒ The JPO decision held that the "learning and daily-life support system 1" of the Ko 1 invention differed from the "information providing device" of the invention at issue.

⇒ The judgment was the same. (It upheld the JPO decision finding novelty. Inventive step was also upheld.)

(Quotation from the judgment) The "learning and daily-life support system 1" of the Ko 1 invention "comprises a learning and daily-life support server 2 connected via a network N, and user terminals 3 used by multiple course participants and students." It comprises multiple elements (devices) and therefore differs from the "information providing device" of Invention 1, which, as stated above, means a single device. Accordingly, there is no error in the JPO decision's finding of Difference 3.

(2) Judgment on appeal in the infringement action finding lack of novelty

Judgment delivered November 29, 2022 **[Information Providing Device] case**

Intellectual Property High Court, 2022 **(Ne)** No. 10008 <Otaka> (first instance: Tokyo District Court, 2019 (Wa) No. 25121 <Tanaka>)

Oral argument concluded September 22, 2022

091603_hanrei.pdf (courts.go.jp)

Patent No. 6538097

Primary cited reference: Japanese Unexamined Patent Application Publication No. 2015-102994 (Exhibit Otsu 8)

⇒ The defendant (appellee), taking into account **the point identified as a difference in the JPO decision—that the invention's "information providing device" is a single device**—asserted the "invention of a learning and daily-life support server" (Otsu 8 Invention 1) as a supplementary argument on appeal in the infringement action. In short, taking into account that the cited reference's "learning and daily-life support system 1" had been distinguished because it included both a "learning and daily-life support server 2" and "user terminals 3," unlike in the invalidation trial, **it successfully converted that difference into a**

common feature by redoing the comparison using only the "learning and daily-life support server 2" as the cited prior art!!

Note: The first-instance judgment, however, also compared it with the "learning and daily-life support server of the Otsu 8 invention"; the comparison was not changed only on appeal.

<Some observations>

(1) Identification of the cited invention (limits on generalizing or particularizing a cited invention; here, the limits on particularization)

To avoid a difference between a single element and multiple elements, where the cited reference contained multiple elements, the comparison was narrowed to the single element needed for comparison with the invention, successfully turning a difference into a common feature. (Like teaching-away factors and switching the primary and secondary references, this is one type of case in which novelty and inventive-step determinations may differ depending on the reasoning even with the same cited reference.)

Of course, there is the question of whether a cited reference′ confined to a single element can be identified from the cited reference (the limits on generalizing or particularizing the cited invention; here, the limits on particularization). In this case, partly because the plaintiff was self-represented, it did not raise the issue of "identification of the cited invention" or thoroughly contest whether the cited invention called "Otsu 8 Invention 1" could be identified—that is, whether the primary reference could be understood to disclose only the "learning and daily-life support server 2" as the primary cited invention, disregarding the "user terminals 3," rather than the "learning and daily-life support system 1."

A review of the case law indicates that the limits on generalizing or particularizing cited inventions in novelty and inventive-step assessments depend on whether one can discern, from the cited reference (or publicly worked products, etc.), **"a coherent body of technical matters"**. This parallels the analysis of the disclosure in the specification when determining whether new matter has been added.

(2) Rejection as untimely (new arguments after submission of the statement of reasons for appeal)

The patentee did not raise a rebuttal to the invalidity defense based on claim correction at the initial stage of the infringement appeal (by submission of the statement of reasons for appeal). It raised the rebuttal at the first oral argument hearing on September 22, 2022, on the basis of its fourth preparatory brief dated September 5. On the appellee’s application, the court rejected it as an untimely means of attack or defense.

Since there had been a JPO decision maintaining the patent and finding novelty and inventive step over the same primary cited reference, one can understand the patentee's strategy of challenging the matter without raising a rebuttal to the invalidity defense based on claim correction, hoping that novelty and inventive step would be recognized without correction. The judgment may thus seem harsh. However, regarding the decisive "Difference 3" on which the JPO based its decision to maintain the patent (novelty and inventive step upheld), the defendant had changed the comparison so that "Difference 3" in that decision became a common feature and argued lack of novelty; the first-instance judgment then found lack of novelty. In those circumstances, it is difficult to call excessively harsh the appellate judgment emphasizing that the patentee had failed to raise its rebuttal to the invalidity defense based on claim correction in a timely manner at first instance or before the written preparatory proceedings on appeal concluded. (In my view, if the patentee was to raise this rebuttal on appeal, it should have done so at the initial stage, by the time it submitted its statement of reasons for appeal. As a tactical matter, it could also have raised a rebuttal to the invalidity defense based on claim correction for only some claims from the outset of the appeal.)

This was an unusual case because a JPO decision maintaining the patent had recognized novelty and inventive step over the same primary cited reference. Generally, however, in cases where new arguments (new invalidity grounds, a rebuttal to the invalidity defense based on claim correction, the doctrine of equivalents, other defenses, etc.) were first raised on appeal, many were not rejected as untimely if raised at the initial stage (by submission of the statement of reasons for appeal). Conversely, many were rejected as untimely if raised after submission of that statement, particularly after the first oral argument hearing on appeal.

In any event, when making new arguments on appeal, they should probably be raised in the statement of reasons for appeal, using such approaches as raising them for only some claims.

[Patent / Utility Model] Tokyo District Court, 2020 (Wa) 15955 <Shibata>

Original Ameblo publication: 2023-07-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12811878964.html

[Patent / Utility Model] Tokyo District Court, 2020 (Wa) 15955 <Shibata>

Before presentation of the utility model technical evaluation report, no intent or negligence regarding infringement of the utility model right was found.

(Infringement itself was established. This differs from a claim for compensation. The defendant knew of the right itself, but ...)

⇒ The unjust-enrichment restitution claim was upheld because intent or negligence is not required!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91693.pdf

[Unfair Competition Prevention Act] Tokyo District Court, 2020 (Wa) 21047 <Kokubu>

Original Ameblo publication: 2023-07-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812006613.html

[Unfair Competition Prevention Act] Tokyo District Court, 2020 (Wa) 21047 <Kokubu>

The plaintiff's employees freely used surplus promotional USB drives.

⇒ Ownership lay with the defendant (a former employee)

There was no evidence that the defendant had used or disclosed confidential information up to the present time

⇒ The claim based on the confidentiality agreement was dismissed without prejudice (as an improper action) because there was no "necessity to make the claim in advance" (Code of Civil Procedure, Article 135)!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91485.pdf

[Article / Foreign Law] Patentability Requirements for Computer-Implemented Inventions in Europe: An Examination of "Technical Features" — Patent 2019

Original Ameblo publication: 2023-07-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812168083.html

[Article / Foreign Law] "Patentability Requirements for Computer-Implemented Inventions in Europe: An Examination of ‘Technical Features’" (Nobukazu Ito, Hidetoshi Kitade, Seiji Sogo, Kumiko Yamada; Patent, 2019, Vol. 72, No. 10)

"If there is a difference and that difference makes a technical contribution, an objective technical problem is formulated on the basis of that technical effect."

Introduces numerous EPO decisions with both positive and negative outcomes

https://jpaa-patent.info/patent/viewPdf/3415

[Article] "The Geographical Indication System: From a Comparative Perspective with Trademark Law" (Reiko Tonomura) (Patent, 2020, Vol. 73, No. 2)

Original Ameblo publication: 2023-07-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812168334.html

[Article] "The Geographical Indication System: From a Comparative Perspective with Trademark Law" (Reiko Tonomura) (Patent, 2020, Vol. 73, No. 2)

* For regional collective trademarks, the applicant must have legal personality

* The geographical indication system does not require well-known status

* Regional collective trademarks are easier to adapt when designing a regional brand in a wide variety of variations

https://jpaa-patent.info/patent/viewPdf/3491

Dwango v. U.S. FC2: IP High Court Grand Panel Judgment (the foreign-server issue, including a comparison with the earlier judgment)

Original Ameblo publication: 2023-07-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812260523.html

Dwango v. U.S. FC2: Grand Panel Judgment (including a comparison with the earlier case)

— (Earlier case) IP High Court, 2018 (Ne) No. 10077 <Presiding Judge Honda> —

A case in which transmitting a program from a server located abroad to users in Japan was assessed as an act in Japan. The finding on satisfaction of the claim elements was reversed, and the patentee won on appeal.

— (Later case) IP High Court Grand Panel, 2022 (Ne) No. 10046 <Presiding Judge Otaka> —

A case in which U.S. FC2's act of "producing" a "(comment delivery) system" that includes a server located abroad was assessed as an act in Japan. The patentee won on appeal.

◆ Full text of the judgment (later case)

★ Commentary on the earlier judgment (Nakamura & Partners)

★Explanatory video covering the earlier case: Extending the reasoning on "provision of a program" to "transfer of tangible goods"

★Related materials

[Summary of the IP High Court Grand Panel Judgment and Some Observations (Including a Comparison with the Earlier Case)]

1. Claims (JP6526304 / the patent found infringed in the Grand Panel judgment)

(1) Claim 1

1A A comment delivery system comprising a server and a plurality of terminal devices connected thereto via a network, wherein:

1B the server receives a first comment and a second comment concerning a video, added by users viewing the video transmitted from the server;

1C the server transmits the video and comment information to the terminal devices;

1D the comment information includes the first comment and the second comment, and comment addition times that are video playback times indicating elapsed video time measured from the beginning of the video, corresponding to the times when the first comment and the second comment were respectively added;

1E the system comprises means for displaying on a display device of a terminal device, on the basis of the video and the comment information, the video and the first comment and the second comment moving horizontally while overlapping at least part of the video at the video playback times corresponding to the comment addition times;

1F a determination unit that determines whether the display position at which the second comment is displayed on the one video overlaps the display position of the first comment; and

1G a display position control unit that, when overlap is determined, adjusts the first comment and the second comment to be displayed at positions where they do not overlap, wherein, in the comment delivery system:

1H by the server transmitting the video and the comment information to the terminal devices, the display device of a terminal device displays the video and the first comment and the second comment moving horizontally while overlapping at least part of the video at the video playback times corresponding to the comment addition times, such that the first comment and the second comment do not overlap;

1I comment delivery system.

(2) Claim 2

2A A comment delivery system comprising a video delivery server and a comment delivery server, and a plurality of terminal devices connected thereto via a network, wherein:

2B the comment delivery server receives a first comment and a second comment concerning a video, added by users viewing the video transmitted from the video delivery server;

2C1 the comment delivery server transmits comment information to the terminal devices;

2C2 the video delivery server transmits the video to the terminal devices;

2D the comment information includes the first comment and the second comment, and comment addition times that are video playback times indicating elapsed video time measured from the beginning of the video, corresponding to the times when the first comment and the second comment were respectively added;

2E the system comprises means for displaying on a display device of a terminal device, on the basis of the video and the comment information, the video and the first comment and the second comment moving horizontally while overlapping at least part of the video at the video playback times corresponding to the comment addition times;

2F a determination unit that determines whether the display position at which the second comment is displayed on the one video overlaps the display position of the first comment; and

2G a display position control unit that, when overlap is determined, adjusts the first comment and the second comment to be displayed at positions where they do not overlap, wherein, in the comment delivery system:

2H by the comment delivery server transmitting the comment information and the video delivery server transmitting the video, respectively, to the terminal devices, the display device of a terminal device displays the video and the first comment and the second comment moving horizontally while overlapping at least part of the video at the video playback times corresponding to the comment addition times, such that the first comment and the second comment do not overlap;

2I comment delivery system.

2. The principle of territoriality

(1) First-instance judgment (Tokyo District Court, 2019 (Wa) No. 25152): "Production" in Japan denied

Based on the principle of territoriality, the first-instance court established the rule that, to constitute "production" under Article 2(3)(i) of the Patent Act ("production" in Japan), a product satisfying all claim elements of the patented invention must be newly created in Japan. It then held that the appellees could not be found to have "produced" the defendants' systems in Japan, because all the defendants' servers constituting those systems were in the United States, and the user terminals in Japan alone did not satisfy all claim elements of the invention covered by the patent. (Note: The first-instance court found that the defendants' systems fell within the technical scope of the patented invention, but denied "production" in Japan.)

(2) This judgment (IP High Court Grand Panel): "Production" in Japan affirmed (summary based on the court's case summary)

For an invention such as Invention 1, involving a system in which a server and terminals are connected through a network such as the Internet and perform an integrated function as a whole (a network-type system), "production" is understood to mean the act of newly creating the system by connecting, through the network, multiple elements that individually do not satisfy all claim elements of the invention, so that they have an organic relationship with one another and, as a whole, acquire functions satisfying all claim elements of the invention.

In the FLASH version of Defendants' Service 1, when the user terminal receives the files, Appellee Y1's servers and the user terminal are connected via an Internet-based network, making it possible to display comments overlaid on a video in the user terminal's browser. Accordingly, **Defendants' System 1, equipped with functions satisfying all claim elements of Invention 1, is newly created when the user terminal receives those files**. (This act is referred to below as "Production 1-1".)

In Production 1-1, the transmission of the files from a server in the United States to user terminals in Japan, and the terminals' receipt of them, take place across the United States and Japan. The newly created Defendants' System 1 also exists across the United States and Japan.

In network-type systems, it is now common for servers to be installed outside Japan (abroad). Moreover, the country in which a server exists is no obstacle to using a network-type system. Thus, even if a server is abroad, if a terminal constituting the system is in Japan (domestically), that terminal can be used to utilize the system in Japan, and such use may affect the economic interests that the patentee could obtain by working the invention in Japan. Accordingly, for inventions of network-type systems, it would be inappropriate to construe territoriality strictly and uniformly exclude them from "working" under Article 2(3) of the Japanese Patent Act merely because the server, one constituent element of the system, is abroad. That would make patents easy to evade simply by locating servers abroad and would prevent sufficient protection of patents for such system inventions.

As to whether an act newly creating a network-type system constitutes "production" in Japan, even where a server, one constituent element of the system, is abroad, the specific manner of the act, the functions and roles in the invention of those system elements located in Japan, the place where the invention's effects are obtained through use of the system, and the effects of that use on the patentee's economic interests, among other circumstances, must be considered comprehensively. Where the act can be regarded as having been carried out within Japanese territory, it is appropriate to construe it as "production" under Article 2(3)(i) of the Patent Act.

Production 1-1 occurs through transmission of the files from a server in the United States to user terminals in Japan and receipt of them by those domestic terminals. Transmission and receipt are performed as an integrated whole, and Defendants' System 1 is completed when a domestic user terminal receives the files. Accordingly, that transmission and receipt can conceptually be regarded as taking place in Japan. Next, Defendants' System 1 consists of Appellee Y1's server in the United States and user terminals in Japan. Those domestic terminals perform the functions of the determination unit in Element 1F and the display position control unit in Element 1G, which are necessary to display comments on a video at nonoverlapping positions, a principal function of Invention 1. Furthermore, Defendants' System 1 can be used from within Japan through user terminals. The effect of Invention 1—enhancing the entertainment value of communication using comments—arises in Japan, and domestic use may affect the economic interests that the appellant derives from using the system of Invention 1 in Japan. Considering these circumstances comprehensively, Production 1-1 can be regarded as having been carried out within Japanese territory.

As regards Defendants' System 1, U.S. FC2 installs and manages the web server, video delivery server, and comment delivery server. Those servers transmit HTML files, SWF files, video files, and comment files to user terminals. The terminals receive those files automatically in accordance with the instructions in the

program uploaded to the servers by U.S. FC2, without any separate user operation. Accordingly, the entity that "produced" Defendants' System 1 must be considered to be Appellee Y1 (U.S. FC2).

(3) The appellee's (U.S. FC2's) arguments in the Grand Panel case and the court's reasoning in response

... The appellees argue that: ① Appellee FC2's acts relating to "production" of the defendants' systems consist solely of making the programs corresponding to those systems and uploading them to servers, all of which are completed in the United States. Thereafter, before comments and videos are displayed on user terminals, there are acts of use by users, including uploading comments and videos, but the display device of a user terminal is a general-purpose browser and those acts of use are unrelated to the characteristic parts of the inventions. ② In Defendants' System 1, a user terminal merely passively displays videos and comments in accordance with the instructions in the program uploaded to the server by Appellee FC2, and the content of comments uploaded by third parties to Appellee FC2's server and videos uploaded to Appellee FC2's server (in Defendants' Systems 2 and 3, videos uploaded to third-party servers). Display of videos and comments on a user terminal is merely the result of the user utilizing an already produced device (the defendants' systems) through the terminal's general-purpose browser; there is no act of "newly" "creating" a "product." ③ Exhibit Otsu 311 states: "Generally, communication systems involve transmission and receipt of data. An interpretation of ‘production’ encompassing repeated production and disposal of a first, second, third, ... nth communication system each time data are transmitted or received would mean that the system is reproduced each time data are exchanged within it, and is difficult to adopt." In view of that observation, Appellee FC2's acts should not constitute "production" of Invention 1.

However, regarding ①, **Appellee FC2's merely making the program corresponding to Defendants' System 1 and uploading it to the server does not complete Defendants' System 1 equipped with functions satisfying all claim elements of Invention 1, as described in a above**.

Regarding ②, as stated in a above, Appellee FC2's video delivery server and comment delivery server are connected to the user terminal through an Internet-based network, and **receipt of the necessary files by the user terminal newly creates Defendants' System 1 equipped with functions satisfying all claim elements of Invention 1**. If the user terminal does not receive those files, Defendants' System 1 cannot perform its functions.

Regarding ③, as stated above, Defendants' System 1 is newly created when Appellee FC2's video delivery server and comment delivery server are connected to the user terminal through an Internet-based network and the terminal receives the necessary files. It continues to exist until the files stored in the terminal browser's cache are discarded. Moreover, even if **Defendants' System 1 is created each time those files are received repeatedly**, that fact does not justify concluding that the act is not "production."

Accordingly, the appellees' above arguments are without merit.

3. Comparison with the earlier case (Dwango v. U.S. FC2)

(1) IP High Court, 2018 (Ne) No. 10077 <Presiding Judge Honda> (earlier case)

Some of the patented inventions at issue in the earlier case concerned a "program." As to whether U.S. FC2's act of delivering a "program" from a server it owned in the United States to users located in Japan constituted "provision" under the Japanese Patent Act, the judgment reasoned as follows and held that it constituted (domestic) "provision" under that Act. (Indirect infringement of the "display device" claims was also established.)

"... If infringement of a patent for an invention capable of transmission through a network required ... every act to be completed within Japanese territory even in a formal sense, ... liability for patent infringement could easily be avoided by moving some equipment, such as a server, abroad. ... Allowing such evasive conduct would be gravely contrary to justice. ...

① Whether the provision can clearly and easily be divided into a part taking place outside Japanese territory and a part taking place within it;

② whether control over the provision takes place within Japanese territory;

③ whether the provision is directed at customers or others located within Japanese territory; and

④ whether the effects of the patented invention obtained through the provision arise within Japanese territory, among other circumstances, are to be considered;

where, viewed substantively and as a whole, the provision can be assessed as taking place within Japanese territory, it constitutes "provision" under the Japanese Patent Act—that is the appropriate interpretation."

"…The delivery at issue is initiated and completed when a user located within Japanese territory accesses a website for one of the appellees' services ... ,

① It is difficult to divide the delivery clearly and easily into a part taking place outside Japanese territory and a part within it;

② control over the delivery is exercised by users located within Japanese territory; and

③ the delivery is directed at users located within Japanese territory who wish to view videos. Furthermore,

④ only through the delivery can users located within Japanese territory view ... videos to which comments and the like have been added. The effects of Inventions 1-9 and 1-10 obtained through that delivery arise within Japanese territory.

In light of these circumstances, even if part of the delivery takes place outside Japanese territory, when considered substantively and as a whole, it is appropriate to assess it as having taken place within Japanese territory."

(2) Comparison between the Grand Panel judgment (later case) and the earlier judgment

For provision of a program from a foreign server to Japan, the earlier judgment identified and considered the above factors ①②③④. These factors seem always to be satisfied when a program is transmitted from a foreign server to a user in Japan in response to that user's request. The judgment likewise applied them naturally and recognized provision of the "program" in Japan.

This IP High Court Grand Panel judgment (the later case) calls for comprehensive consideration, even where a server is abroad, of the specific manner of the act, the functions and roles in the invention of the system elements located in Japan, the place where the invention's effects are obtained through use of the system, and the effects of that use on the patentee's economic interests, among other circumstances. The test itself thus remains evaluative and strikes a balance between the patentee and the alleged infringer.

However, the application of "the specific manner" consists of "transmitting the files from a server in the United States to user terminals in Japan, and receipt of them by those domestic terminals, with transmission and receipt being performed as an integrated whole and Defendants' System 1 being completed when a domestic user terminal receives the files"—an abstract description of transmitting and receiving files that always holds true for a cross-border network.

On the other hand, as to "the functions and roles in the invention of the system elements located in Japan", the court stated in its application that "the user terminals located in Japan perform the principal function of Invention 1 of displaying comments on the video at positions where they do not overlap, by performing the necessary functions of the determination unit in Element 1F and the display position control unit in Element 1G". It identifies the fact that an important part relating to the invention's solution to its problem is realized by user terminals in Japan. Arguments concerning the technical significance and essential part of the invention therefore become important. (This type of discussion has something in common, for example, with the way the invention's problem affects the conclusion when discussing the support requirement.) In

any event, under this criterion, network-related inventions generally exhibit the patented invention's functions and roles at the terminal location rather than the server location. The criterion is therefore readily satisfied where the server is abroad and the terminals are in Japan. (Note: Conversely, it is difficult to satisfy where the server is in Japan and the terminals are abroad; but would the court find no domestic working in such a case? Furthermore, it would be necessary to consider whether one would feel any discomfort if a foreign court in that situation found infringement of a patent in that foreign country.)

Next, as to "the place where the invention's effects are obtained through use of the system", this too seems always to be satisfied when a program is transmitted from a foreign server to users in Japan.

Finally, as to "the effects of that use on the patentee's economic interests, among other circumstances", because transmitting a program from a foreign server to users in Japan causes the above "effects" to arise in Japan, this too seems always to be satisfied for a Japanese patentee, particularly one conducting a competing business in Japan.

Thus, among the four factors in the test set out by this IP High Court Grand Panel judgment (the later case), the factor with a major influence on the conclusion is "the functions and roles in the invention of the system elements located in Japan". This is not invariably satisfied when a server is abroad: the server itself may perform important functions and roles, in which case domestic working might be denied. Conversely, even where the server is in Japan and the terminals are abroad, domestic working might be affirmed if the server performs important functions and roles in the invention. As a patent application strategy anticipating that some component, not necessarily the server, will be abroad, there is therefore room to devise claims locating the invention's problem-solving principle in the server, in the terminal device, and in various other configurations. (However, as stated above, network-related inventions generally exhibit the patented invention's functions and roles at the terminal location rather than the server location. The criterion is therefore readily satisfied where the server is abroad and the terminals are in Japan.)

4. Some observations

(1) Appropriateness of the Grand Panel judgment's test and its application (later case)

In the later case, concerning the finding that the appellee (U.S. FC2) was the entity "producing" the system of the patented invention, the court held: "Appellee FC2 installs and manages the above web server, video delivery server, and comment delivery server, and those servers transmit HTML files, SWF files, video files, and comment files to user terminals. The terminals receive those files automatically in accordance with the instructions in the program uploaded to the servers by Appellee FC2, without any separate user operation. In view of this, the entity that ‘produced’ Defendants' System 1 must be considered to be Appellee FC2. ... The users' acts are confined to those performed through browsing webpages managed by Appellee FC2, and the users cannot be assessed as themselves independently carrying out the act of ‘producing’ Defendants' System 1."

There is nothing particularly troubling about treating the appellee (U.S. FC2) as the entity "producing" the patented system. In determining that entity, however, the judgment emphasizes the importance of the servers: "Appellee FC2 installs and manages the above web server, video delivery server, and comment delivery server, and those servers transmit HTML files, SWF files, video files, and comment files to user terminals. The terminals receive those files automatically in accordance with the instructions in the program uploaded to the servers by Appellee FC2, without any separate user operation."

By contrast, in determining how to assess the place of "production" of the patented system, the judgment states: "The user terminals located in Japan perform the functions necessary to display comments on a video at nonoverlapping positions, a principal function of Invention 1: the function of the determination unit in Element 1F and the function of the display position control unit in Element 1G." This emphasizes the importance of the functions and roles of user terminals. In response to the appellee's counterarguments, it also states: "**Appellee FC2's merely making the program corresponding to**

Defendants' System 1 and uploading it to the server does not complete Defendants' System 1 equipped with functions satisfying all claim elements of Invention 1, as described in a above. ... Appellee FC2's video delivery server and comment delivery server are connected to the user terminal via an Internet-based network, and **receipt of the necessary files by the user terminal newly creates Defendants' System 1 with functions satisfying all claim elements of Invention 1**; without receipt of those files by the user terminal, Defendants' System 1 cannot perform its functions." In short, the patented system is not completed by the servers alone; it is completed through "**receipt of the necessary files by the user terminal**", that is, **newly created**. The judgment thus emphasizes the importance of the functions and roles of user terminals.

In this way, with respect to "production" of the patented system, the Grand Panel judgment in the later case (this judgment) emphasizes the servers' importance in identifying the actor, but emphasizes the importance of the functions and roles of user terminals when assessing the place of production. Even if this is not outright contradictory, there is a tension.

(The earlier Dwango judgment rejected a normative theory of conduct treating users' acts as U.S. FC2's acts. Also, although it was a copyright case, **the Supreme Court (First Petty Bench), in its judgment of October 24, 2022 (2021 (Ju) No. 1112)**, rejected a normative theory of conduct treating students' performances as performances by the music school. In light of these decisions, the Grand Panel judgment in this case likewise does not adopt reasoning that treats users' acts as U.S. FC2's acts.)

(2) Extending the reasoning on "provision of a program" in the earlier Dwango judgment to "transfer of tangible goods"

Even previously, numerous judgments in non-use cancellation cases (Trademark Act, Article 50) addressed whether trademark use could be assessed as occurring in Japan in the context of the "foreign-server issue." Where the use was directed at Japanese people, in Japanese, with payment in Japanese yen, it has been assessed as use of the trademark in Japan.

I consider this judgment (the later Dwango case), together with the earlier Dwango case, groundbreaking in introducing a similar value judgment for patents.

Both Dwango cases concern network inventions. They are qualified by statements such as "from the perspective of appropriately protecting patent rights for inventions of network-type systems" (this judgment / the later Dwango case), and "in today's digital society, where numerous useful network-related inventions exist, allowing such evasive conduct would be gravely contrary to justice" (the earlier Dwango case). Whether similar reasoning is appropriate for tangible goods is therefore a separate question.

On the other hand, Article 2(3)(i) of the Patent Act defines working a patented invention as, "in the case of an invention of a product (including a program, etc.; the same applies hereinafter), acts of producing, using, transferring, etc. (meaning transfer or lease, and, where the product is a program, etc., including provision through a telecommunications line; the same applies hereinafter), exporting or importing the product, or offering it for transfer, etc. (including displaying it for the purpose of transfer, etc.; the same applies hereinafter)." Under Japanese patent law, a program is a product and provision of a program falls within "transfer, etc." of a product. There is therefore room to treat provision of a program and transfer of tangible goods as parallel to a certain extent, and the earlier Dwango case may influence cases concerning transfers of tangible goods.

Indeed, looking at case law concerning transfer of tangible goods, **Tokyo District Court, 2016 (Wa) 25436 "Method for Producing L-Glutamic Acid" case <Presiding Judge Yamada>** recognized an "offer for transfer" and ruled for the patentee because, although the place of transfer was abroad (Indonesia), the destination was Japan. Using this Glutamic Acid judgment and the earlier Dwango case as starting points, the limits on extending the reasoning of the Dwango judgments to transfers of tangible goods will likely be debated.

There have also been numerous judgments on the "foreign-server issue" in other countries. Because the results of litigation in different countries influence one another from the perspective of international harmonization as well, constant monitoring is essential.

[Unfair Competition Prevention Act / Communication and Dissemination of False Statements] Tokyo District Court, 2021 (Wa) 18135 ⇒ Claim dismissed on the merits

Original Ameblo publication: 2023-07-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812541903.html

[Unfair Competition Prevention Act / Communication and Dissemination of False Statements] 2021 (Wa) 18135

⇒ Claim dismissed on the merits

"The essential point is ... to seek whatever cooperation could be envisaged to advance the work promptly without inconveniencing those concerned in the Kurihara City project, whose delivery deadline was approaching. ... There is insufficient basis to find that the identity of the business partner ... was actually given importance."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91558.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10010 [CNS Delivery of Therapeutic Agents] <Honda>

Original Ameblo publication: 2023-07-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12812811737.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10010 [CNS Delivery of Therapeutic Agents] <Honda>

The wording of Claim 1 makes clear that the pharmaceutical composition of Invention 1 "comprises phosphate." It is clear that any amount of phosphate, however small, satisfies the invention-defining feature relating to phosphate in Invention 1, provided it is no more than 50 mM ...

⇒ Clarity requirement satisfied

In light of common general technical knowledge, it is necessary to find not only that the priority specification substantially disclosed the ... composition, but also that the delivery effect of the ... composition was substantially disclosed as an effect in the case of ICV administration.

⇒ Priority claim rejected (but inventive step upheld)

The disclosure of a "formulation invention" in the secondary reference was questioned; even assuming such disclosure, obviousness was rejected: "It is questionable whether Ko 6 describes the ... formulation sufficiently to identify a cited invention as an invention of a formulation in the first place; even assuming that it does ... it was not easily conceivable ..."

[Claim 1] ... A pharmaceutical composition characterized in that it is administered intracerebroventricularly to a subject suffering from, or susceptible to, a lysosomal storage disease involving a reduced level or activity of a lysosomal enzyme, wherein the composition comprises the replacement enzyme at a concentration of 5 mg/ml–100 mg/ml and up to 50 mM phosphate, and further characterized in that the composition has a pH of 5.5–7.0.

(Extract from the court's reasoning)

... The wording of Claim 1 of the patent makes clear that the pharmaceutical composition of Invention 1 "comprises phosphate." It is clear that any amount of phosphate, however small, satisfies the invention-defining feature relating to phosphate in Invention 1, provided it is no more than 50 mM. It is therefore evident that the failure to specify a lower limit for phosphate causes no unforeseen harm to third parties.

... In light of common general technical knowledge, for Invention 1 to be recognized as an invention disclosed in Ko 17, it is necessary to find not only that Ko 17 substantially disclosed the composition of Invention 1, but also that it substantially disclosed the delivery effect of that composition as an effect in the case of ICV administration. ... Although Ko 17 can be said to describe ICV and IT administration as alternative administration routes, it contains no description clarifying that delivery can occur similarly through either route, or the like. ... It therefore does not describe the delivery effect of the composition of Invention 1 in the case of ICV administration ... and the application cannot claim priority based on Priority Application 2.

... It is difficult to find immediately that Ko 6 specifically describes delivery or therapeutic effects when the ... formulation is administered; nor is there any description clarifying that the therapeutic effects of IT and ICV administration can be equated. ... It is questionable whether Ko 6 describes the ... formulation sufficiently to identify a cited invention as an invention of a formulation in the first place. Even assuming that it does, there are insufficient circumstances to find that a person skilled in the art could readily have arrived at the configuration of Invention 1 by applying the ... formulation for IT administration to the Ko 2′ invention concerning ICV administration. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92007.pdf

[Article] A Study of Prior User Rights under the Patent Act (2) (Professor Yoshiyuki Tamura)

Original Ameblo publication: 2023-07-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813146811.html

[Article] A Study of Prior User Rights under the Patent Act (2) (Professor Yoshiyuki Tamura)

A situation in which one must rely solely on a prior user right, rather than an invalidity argument based on public prior use

= Where a later patent coexists as a selection invention and the two rights block each other

⇒ In that situation, unless "encroachment" is permitted, even a prior user right will not protect the earlier patentee (whether it should do so is a separate question)

https://eprints.lib.hokudai.ac.jp/repo/huscap/all/76026/

[Article] Analysis of Recent Reversals in Actions to Revoke JPO Trial Decisions (IP Management, Vol. 73, No. 7, 2023)

Original Ameblo publication: 2023-07-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813218328.html

[Article] Analysis of Recent Reversals in Actions to Revoke JPO Trial Decisions (IP Management, Vol. 73, No. 7, 2023)

<Rates of judgments revoking JPO decisions, 2018–2020>

Decisions on appeals against refusal: 22% (19/85)

Opposition decisions: 72% (18/25)

Decisions finding invalidity: approximately 22% (35/161)

Decisions rejecting invalidity: 26% (79/305)

<Author’s observation> Some actions to revoke decisions on appeals against refusal result from a choice to maintain broad claims without amendment and contest the refusal.

⇒ The main pattern is a challenge for broad coverage after securing the principal claims in a divisional application. (Note: Slightly off topic, the Lipase Supreme Court case likewise involved challenging claims without the qualifier "Ra" after already securing rights to Ra lipase.)

In oppositions, the revocation rate is low, and even after a revocation decision there are many reversals finding validity.

⇒ Possible reasons for the low revocation rate include that patentees can have interviews, that there is no accused product and thus no reluctance to seek correction to preserve the patent, and that decisions maintaining patents are not reviewed by courts.

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2307

[Article] The Significance of "Unforeseeable Remarkable Effects" in Inventive-Step Assessment (Professor Takeshi Maeda) (Patent 2021)

Original Ameblo publication: 2023-07-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813344179.html

[Article] The Significance of "Unforeseeable Remarkable Effects" in Inventive-Step Assessment (Professor Takeshi Maeda) (Patent, 2021, Vol. 74, No. 7)

Because the earlier judgment is binding ... if one proceeds on the premise of the determination that application to the ... use was easily conceivable ... the human conjunctival mast cell-stabilizing action falls within the range of what could be expected ... and might not be regarded as an unforeseeable remarkable effect.

https://jpaa-patent.info/patent/viewPdf/3816

Intellectual Property High Court, 2020 (Gyo-Ke) 10143 [Vinylidene Chloride Resin Wrapping Film] <Otaka>

Original Ameblo publication: 2023-07-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813478705.html

Intellectual Property High Court, 2020 (Gyo-Ke) 10143 [Vinylidene Chloride Resin Wrapping Film] <Otaka>

* The specification identifies a particular measuring instrument and states "in accordance with JIS"

⇒ It is natural to understand this as stating that measurements followed the instrument's instruction manual, and that matters not covered in the manual followed JIS.

⇒ Enablement requirement satisfied

* Even without working examples reaching both ends of a numerical range, general descriptions in the specification can satisfy the support requirement!!

Tear strength (cN)

Invention at issue: 2–6

Working examples: 2.4–3.0

Tensile modulus (MPa)

Invention at issue: 250–600

Note: The patentee also won the infringement action

[Claim 1] (Elements A, B, and D specify the “physical-property values”; E–G specify what the judgment calls “composition values,” including film thickness; and C and H identify the product. ⇒ Cited Invention 1-2 (Otsu 12) is a vinylidene chloride resin wrapping film that meets the requirements of E–G, but whether it meets the physical-property values in A, B, and D is unknown.)

A Having a tear strength of 2–6 cN in the TD direction (width direction of the wrapping film), and

B a tensile modulus of 250–600 MPa in the MD direction (machine direction of the wrapping film),

C a vinylidene chloride resin wrapping film,

D having a low-temperature crystallization onset temperature of 40–60°C measured by a temperature-modulated differential scanning calorimeter,

E comprising, relative to a polyvinylidene chloride resin containing 72–93% vinylidene chloride repeating units,

F 0.5–3% by weight of epoxidized vegetable oil and 3–8% by weight of at least one compound selected from the group consisting of citrate esters and dibasic acid esters, and

G having a thickness of 6–18 μm,

H a vinylidene chloride resin wrapping film.

(Extract from the court's reasoning)

... From paragraph [0038] of the specification, it can be understood that the TD-direction tear strength of the "wrapping film of this embodiment" (the invention at issue) was set at "2–6 cN" because, if it is "2 cN or more," it can "reduce tearing, particularly when drawing wrapping film from the roll, and suppress unintended tearing problems during use of the wrapping film," while, if it is "6 cN or less," it is "easy to tear when cutting the film in the TD direction with the serrated blade attached to the dispensing box,

improving cuttability." The specification also shows that Working Examples 1–6, with TD-direction tear strengths of "2.4 cN" to "3.0 cN," were rated "◎" or "○" for "suppression of tearing problems" and all rated "◎" for "cuttability." This confirms the invention's effect of "reducing tearing problems when drawing film from the roll and when picking out the film end that has wound back into the dispensing box, while maintaining the vinylidene chloride resin wrapping film's cuttability with the film-cutting blade." Although the specification provides no working examples in the range "above 3 cN up to 6 cN," paragraph [0038] indicates that increasing "TD-direction tear strength" to "2 cN or more" suppresses tearing problems. It can thus be understood that film in the range "above 3 cN up to 6 cN" also reduces tearing problems. As for "cuttability," paragraph [0009] states: "Although it is possible to increase the film's tear strength by methods such as making the film thicker to suppress tearing problems, this made the film difficult to cut and less convenient to use." In light of this, the object can be understood not so much as improving cuttability with the cutting blade itself, but as "maintaining cuttability" without reducing it through methods such as thickening the film to increase tear strength. Paragraph [0038] further indicates that, at "6 cN or less," the film is "easy to tear when cutting it in the TD direction with the serrated blade attached to the dispensing box, improving cuttability." Accordingly, film in the range "above 3 cN up to 6 cN" can also be understood to maintain cuttability. ...

From paragraph [0039] of the specification, it can be understood that the "MD-direction tensile modulus" of the "wrapping film of this embodiment" (the invention at issue) was set at "250–600 MPa" because, at "250 MPa or more," it "suppresses elongation of the film in the MD direction when force is applied to cut it with the serrated blade, allowing the blade to bite into the film more readily and improving cuttability," while, at "600 MPa or less," the "film is soft, allowing clean cutting along the shape of the serrated blade and suppressing the formation of numerous tears on the cut edge." The specification shows that Working Examples 1–6, with MD-direction tensile moduli of "510 MPa" to "540 MPa," were rated "◎" or "○" for "suppression of tearing problems" and all rated "◎" for "cuttability." This confirms the invention's effect of "reducing tearing problems when drawing film from the roll and when picking out the film end that has wound back into the dispensing box, while maintaining the vinylidene chloride resin wrapping film's cuttability with the film-cutting blade." Although the specification gives no working examples in the range "250 MPa to 500 MPa," there is no evidence suggesting that paragraph [0039] is unreasonable. That paragraph therefore allows one to understand that film within that range also produces the invention's stated effects. Accordingly, a person skilled in the art can recognize from the detailed description that the invention's stated effects are achieved throughout the entire numerical range of "250–600 MPa" for its "tensile modulus," and can recognize that the invention's problem—providing a vinylidene chloride resin wrapping film with those effects—can be solved. ...

Working Examples 1–6 in the specification all concern the specific "distribution and storage" condition of being "stored for one month in a constant-temperature chamber set at 28°C." ... However, ... the specification enables understanding of the meaning of the invention's "low-temperature crystallization onset temperature" and of the mechanism by which controlling it within "40–60°C" suppresses "tearing problems when drawing film from the roll and when picking out the film end that has wound back into the dispensing box." ...

... The plaintiff argues that, although the specification states ... that "tear strength" was measured using a light-load tear tester (manufactured by Toyo Seiki), in accordance with JIS-P-8116, ... the method using that tester ... and the method specified in JIS-P-8116 ... differ in measuring equipment, number of test pieces (and consequently their thickness), and tear length. Thus ... the equipment and the JIS standard to be followed do not correspond, and the method of measuring the invention's "tear strength" is not uniquely determined ... so the enablement requirement is not satisfied. ...

Considering this argument, the specification states regarding tear-strength measurement: "To simulate distribution after shipment and storage in the home, the manufactured wrapping film was stored for one month in a constant-temperature chamber set at 28°C before measurement. Measurements were made with

a light-load tear tester (manufactured by Toyo Seiki), and evaluation was performed in an atmosphere of 23°C and 50% RH. The tear strength of the wrapping film was measured in accordance with the method described in JIS-P-8116." ... A person skilled in the art would have no particular difficulty preparing test pieces of vinylidene chloride resin wrapping film, operating the device (the "light-load tear tester"), and measuring the pieces' "tear strength" based on the sections headed "Intended Use of the Equipment," "Specifications" (test piece dimensions, measurement range, number of test pieces, etc.), "Test Piece Preparation," and "Measurement Principle" in Toyo Seiki's instruction manual ... entitled "Model D, Product Name: Light-Load Tear Tester," issued before the application. ... In context, the statements that "measurements were made with a light-load tear tester (manufactured by Toyo Seiki)" and "measured ... in accordance with the method described in JIS-P-8116" are naturally understood to mean that the invention's "tear strength" was measured according to the instruction manual of the light-load tear tester actually used, and that matters not covered by that manual (for example, the definition of "tear strength" or "expression of test results") followed JIS-P-8116. Therefore, differences between the tear-strength measurement method in JIS-P-8116 and the method using the light-load tear tester do not mean that the method for measuring the invention's "tear strength" is not uniquely determined.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91270.pdf

[New YouTube Video] Dwango v. U.S. FC2 Grand Panel Judgment (Later Action): 10-Minute Condensed Version

Original Ameblo publication: 2023-07-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813605661.html

[New YouTube Video] Dwango v. U.S. FC2 Grand Panel Judgment (Later Action): 10-Minute Condensed Version

(Hideki Takaishi, Attorney-at-Law, Patent Attorney, and California Attorney)

https://www.youtube.com/watch?v=J-ybGVNq6OU

◆ AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12812260523.html

★ Presentation materials for this video

https://www.takaishihideki.com/_files/ugd/324a18_0bf5a828b98a472fa747ce104a5ee595.pdf

◆ Full text of the judgment (this Grand Panel judgment / later case)

https://www.courts.go.jp/ip/vc-files/ip/2023/4n10046chizaisaishuu.pdf

★ Commentary on the earlier judgment (Nakamura & Partners website)

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E5%9B%BD%E5%A4%96%E3%81%AB%E6%89%80%E5%9C%A8%E3%81%99%E3%82%8B%E3%82%B5%E3%83%BC%E3%83%90%E3%81%8B%E3%82%89%E6%97%A5%E6%9C%AC%E3%81%AE%E3%83%A6/

★ Explanatory video covering the earlier case: Extending the reasoning on "provision of a program" to "transfer of tangible goods"

https://www.youtube.com/watch?v=nxFYw1cqaQI

⇒ Related materials

https://www.takaishihideki.com/_files/ugd/324a18_a2d829f6a90746178fb8549d5b8da7ff.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10012 [Touch-Operated Input Device] <Kanno>

Original Ameblo publication: 2023-07-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813742811.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10012 [Touch-Operated Input Device] <Kanno>

* Combining even well-known technology requires motivation and the like

⇒ The court criticized combining the primary reference and well-known technology after generalizing their respective technical fields.

Note: The patentee previously prevailed at first instance in an infringement action against the plaintiff Apple on the same patent (336,641,920 yen awarded). 2007 (Wa) Nos. 2525 and 6312

(Extract from the court's reasoning)

... Ground for Revocation 1-1 (error in assessing inventive step of Patented Invention 1 with the Ko 1 invention as the primary reference) ...

Even if Well-Known Technology 1 is understood at a generalized level as a technology that generates some input information by confirming a touch-panel selection with a push switch, the Ko 1 invention lacks the function to be assigned to the push switch (confirming a selection) in the first place. Although Ko 1 describes continuous control of magnetic tape travel direction and speed using a touch panel, it neither describes nor suggests an operation confirming the travel direction or speed selected with the touch panel, or a button or other configuration corresponding to that operation. There is therefore no motivation to apply Well-Known Technology 1 to the Ko 1 invention. ...

... Ground for Revocation 2-1 (error in assessing inventive step of Patented Invention 1 with the Ko 2 invention as the primary reference) ...

The Ko 2 invention addresses the fact that conventional jog dials increase the number of parts and have limits on thickness reduction, hindering thinner operation panels. It therefore aims to provide a jog-dial-like switch that, with a simple configuration, allows a thinner operation panel and improved operability. ... Applying the push button of Well-Known Technology 1 would increase the number of parts and run counter to the demand for reduced thickness; there is thus a teaching-away factor. ...

... Ground for Revocation 3-1 (error in assessing inventive step of Patented Invention 1 with the Ko 3 invention as the primary reference) ...

Deliberately dividing among multiple components a composite function already achieved by a single key would also contradict the Ko 3 invention's problem and effects ... of "reducing switch thickness and cost."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91805.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System] <Shoji> Specific problems need not be common unless the problems to be solved differ greatly

Original Ameblo publication: 2023-07-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12813872860.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System] <Shoji>

* When selecting a primary reference, the specific problems need not be common unless the problems to be solved differ greatly

"At the stage of selecting a primary reference, unless the problems to be solved by the claimed invention and the primary cited invention differ greatly in the first place, their specific problems need not be common ..."

⇒ In Europe, the closest prior art is an important issue!!

(Extract from the court's reasoning)

At the stage of selecting a primary reference, unless the problems to be solved by the claimed invention and the primary cited invention differ greatly in the first place, their specific problems need not be common. ... In this case, the ... problem of the claimed invention ... is not particularly new, but is, so to speak, a self-evident problem. It can be said to have been solved in the cited invention, which adopts carbon dioxide as the heat transport medium.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91747.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System] <Shoji>

Original Ameblo publication: 2023-07-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12814140381.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System] <Shoji>

* When selecting a primary reference, the specific problems need not be common "unless the problems to be solved by the claimed invention and the primary cited invention differ greatly"

⇒ ... If the problems to be solved differ greatly, would suitability as a primary reference be denied even in Japan!?

⇒ In Europe, the closest prior art is an important issue!!

Note: Intellectual Property High Court, 2010 (Gyo-Ke) 10237, Water Treatment Apparatus <Takizawa>: The Hanrei Times commentary explains that it is necessary to demonstrate that selecting the cited reference was easy. The judgment, however, treats the issue as an error in identifying common features and differences: the cited invention concerns "hydrothermal reaction treatment" and is not within the category of "water treatment" of the invention at issue. This is not necessarily the same as the Hanrei Times explanation.

(Extract from the court's reasoning)

At the stage of selecting a primary reference, unless the problems to be solved by the claimed invention and the primary cited invention differ greatly in the first place, their specific problems need not be common. ... In this case, the ... problem of the claimed invention ... is not particularly new, but is, so to speak, a self-evident problem. It can be said to have been solved in the cited invention, which adopts carbon dioxide as the heat transport medium.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91747.pdf

[Article] "Legal Liability for Improper Enforcement of Trademark Rights: From the Perspective of Japanese Law" (Professor Toshiya Kaneko)

Original Ameblo publication: 2023-07-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12814140650.html

[Article] "Legal Liability for Improper Enforcement of Trademark Rights: From the Perspective of Japanese Law" (Professor Toshiya Kaneko)

Within the cases covered by this article, in the category of communicating or disseminating false statements, there had been only one case since 2011 in which unlawfulness was excluded on the basis of legitimate conduct. Findings of no negligence have also decreased.

(FY 2022 Japan–China Joint Research Report on Intellectual Property, p. 198)

E.g., 2021 (Wa) 22940

https://www.jpo.go.jp/resources/report/takoku/nicchu_houkoku/2022.html

表-2　権利侵害警告（知的財産権）関連損害賠償請求事例（21 号該当肯定事例に限定）

	請求認容・棄却				違法性		故意過失		全損害×	消滅時効完成
	全部棄却	（一部）認容	合計	全部棄却率	（一部）阻却△×	阻却否定○	（一部）否定（△×）	全部肯定○		
2000 年以前	21	25	46	45.7%	1	0	11	15	5	4
2001～2010 年	12	37	49	24.5%	8	10	8	24	0	1
2011 年以降	9	27	36	25.0%	1	14	6	25	2	0
合計	42	89	131	32.1%	10	24	25	64	7	5

Table 2. Damages claims relating to warnings of infringement of intellectual property rights (limited to cases found to fall within Article 2(1)(xxi) of the Unfair Competition Prevention Act)

Outcome	2000 or earlier	2001–2010	2011 onward	Total
Claims entirely dismissed	21	12	9	42
Claims upheld in whole or in part	25	37	27	89
Total	46	49	36	131
Rate of complete dismissal	45.7%	24.5%	25.0%	32.1%
Unlawfulness excluded in whole or in part (△/×)	1	8	1	10
Exclusion of unlawfulness rejected (○)	0	10	14	24
Intent/negligence not established in whole or in part (△/×)	11	8	6	25
Intent/negligence established in full (○)	15	24	25	64
Damages entirely denied (×)	5	0	2	7
Limitation period expired	4	1	0	5

Osaka District Court, 2020 (Wa) 3473 [Lighting Fixture]

Original Ameblo publication: 2023-07-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12814274660.html

Osaka District Court, 2020 (Wa) 3473 [Lighting Fixture]

<Damages> Rebuttal of the Article 102(2) presumption: 80% rebutted

① Functions and elements that should naturally be ensured in the product

② The extent of cost reduction was unknown

③ Competing products

④ Availability of alternative technology: The plaintiff's successor product achieves similar effects using technology different from the invention

⇒ Substantial rebuttal of the presumption

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91850.pdf

[Article] A Group Company Sells the Patented Products ... An IP High Court Judgment Allowing Application of Patent Act Article 102(2) (Hideki Takaishi)

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[Article] "An IP High Court Judgment Allowing Application of Patent Act Article 102(2) on the Ground That a Group Company Sells the Patented Products: The Fracture Fixation System Case" (IP Management, Vol. 73, No. 7, 2023, Hideki Takaishi)

The reach of the framework: "Where there are circumstances indicating that the patentee would have earned profits but for the infringer's patent infringement"

— Including a comparison with the Waste Storage Device Grand Panel judgment —

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https://www.takaishihideki.com/_files/ugd/324a18_7c43370f2fed4ec5809c5d5f8933212e.pdf

[Article] Laser Processing Apparatus Case (IP Management, Vol. 73, No. 6, 2023; Masaharu Takahashi and Shunsuke Migita)

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[Article] Laser Processing Apparatus Case — ① Disclaimer Claims, Addition of New Matter, Narrowing of Claims, and Inventive Step; ② Amendments and Corrections Based on Drawings — (IP Management, Vol. 73, No. 6, 2023; Masaharu Takahashi and Shunsuke Migita)

In the authors' practical experience, the tendency to treat amendments based on drawings as new matter is greatest in the following order:

Europe > China >> Japan ≈ Korea > United States

⇒ Put the information in the drawings into words in the Japanese priority application, and review it again when filing the PCT application to supplement that verbal description

https://chizai-jj-lab.com/2023/07/04/0704/

Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheet]

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12814697441.html

Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheet] <Damages> Rebuttal of the Article 102(2) presumption: 20% rebutted

The plaintiff's lower-priced product rebuts the presumption, but because its sales volume might be greater, substantial rebuttal is inappropriate.

It is inappropriate to regard products as competing products while disregarding their prices, performance, and other features.

<Grounds for rebutting the presumption>

The defendants' argument, which posits a technical feature by focusing on only part of the invention, lacks a proper premise.

The appropriateness of the conditions and environment of weather-resistance tests on the defendants' old and new products is not necessarily clear, so the results do not establish an absence of substantial differences.

Catalogues and websites for the defendants' old products contain numerous statements emphasizing superior water resistance, weather resistance, and hue performance—the invention's technical features.

Even if the defendants possess the brand strength of the 3M group, there is no evidence establishing the extent of its contribution to sales of their old products.

Even if sales did not change substantially before and after switching from the defendants' old products to their new products, it is uncertain whether customers recognized the differences. The possibility that the old products' previous customer-attracting power influenced subsequent sales of the new products cannot therefore be ruled out.

To qualify as a competing product, a product must compete with the infringing product in the market. It is inappropriate to treat retroreflective sheets as competing products merely because they serve similar uses, disregarding their prices, performance, and other features.

The plaintiff's lower unit selling price rebuts the presumption, but because its sales volume might exceed the defendants' sales volume, substantial rebuttal is inappropriate.

(Extract from the court's reasoning <Rebuttal circumstances>)

Considering the points asserted by the defendants as grounds for rebutting the presumption under the proviso to Patent Act Article 102(1), it is appropriate to allow a 20% rebuttal, as follows.

(a) The defendants argue that the limitation on the area of the printed regions in the print layer, identified as a feature distinguishing the invention from prior inventions, contributes nothing to attracting customers; that the weather resistance of their old and new products does not substantially differ; that even in the catalogue for their old products the size of the print-layer area is not presented as a selling point; and that the plaintiff does not sell products embodying the invention in Japan. They therefore argue that the invention cannot be said to contribute to sales of their old products.

However, as explained in 1(9) above, the invention's technical feature distinguishing it from the prior art lies in combining the following configurations in the print layer of a retroreflective sheet: "the printed regions form independent regions arranged in a repeating pattern without forming a continuous layer," "the

area of each independently printed region is 0.15–30 mm²," and "containing a white organic pigment ... colorant." This combination improves adhesion around the print layer, improves water and weather resistance, and improves hue. The defendants' argument that isolates only part of that combination to posit the technical feature therefore lacks a proper premise. As for the weather-resistance test results for the defendants' old and new products (Otsu 45–49), the appropriateness of the test conditions and environment is not necessarily clear, and those results cannot immediately establish an absence of substantial differences in weather resistance. Moreover, the evidence (Ko 3, 4, 9, 10, 23, 67–70) and the entire purport of oral argument establish that catalogues and websites for the defendants' old products contain numerous statements emphasizing superior water resistance, weather resistance, and hue performance, which are the invention's technical features.

It is therefore inappropriate to recognize the defendants' above arguments as grounds for rebutting the presumption.

(b) Next, the defendant argues that the invention does not contribute to sales of the old products to customers; rather, the defendants' credibility, track record, and name recognition backed by the 3M brand make an extremely large contribution. It points out that sales in fact did not change substantially before and after the switch from the old products to the new products.

However, even assuming that the defendants possess the brand strength of the 3M group, no adequate evidence has been submitted establishing how much it contributed to sales of the old products. Even if sales did not change substantially before and after the switch, it is uncertain whether customers recognized the differences between the old and new products. The possibility that the old products' previous customer-attracting power influenced subsequent sales of the new products cannot be ruled out, and this does not immediately establish that the invention made no contribution to sales to customers.

It is therefore inappropriate to recognize the defendants' above arguments as grounds for rebutting the presumption.

(c) The defendants also argue that, for long-roll products including their products used for road signs on major national roads and expressways, they have an extremely large sales share as pioneers in retroreflective sheets, and the plaintiff lacks the capacity to work the invention for the quantity of the defendants' old products sold. They argue that the sales ratios of their products and their other products (Diamond-grade and Engineering-grade retroreflective sheets) are respectively ●(omitted)●, while the plaintiff's products have a 10% ratio; thus, if Defendant Product (1) could no longer be sold, only ●(omitted)● (= 10 / (10 + ●(omitted)●)) of that demand would shift to the plaintiff's products.

However, to qualify as a competing product in the first place, a product must compete with the infringing product in the market. The defendants assume that their Diamond-grade and Engineering-grade retroreflective sheets are competing products. The entire purport of oral argument suggests, however, that the former costs at least ●(omitted)● of the price of their old products, and that the latter does not have performance equivalent to their old products. It is inappropriate to disregard these products' prices, performance, and other features and treat them as competitors simply because they are retroreflective sheets serving similar uses. Accordingly, the Diamond-grade and Engineering-grade retroreflective sheets asserted by the defendants cannot be recognized as competing with their old products in the market. Demand for the old products therefore cannot be said to be allocated in proportion to the sales shares of those Diamond-grade and Engineering-grade sheets and the plaintiff's products.

It is therefore inappropriate to recognize the defendants' above arguments as grounds for rebutting the presumption.

(d) Furthermore, the defendants argue that, even if all demand for the old products shifted to the plaintiff's products, the plaintiff's lost profits would be limited to the quantity of old products sold multiplied by the plaintiff's marginal profit rate. The plaintiff's unit selling price is in a range of approximately ●(omitted)●

of that of the old products, while deductible costs, including production costs, should likewise be approximately ●(omitted)●, as for the old products. They argue that the plaintiff's marginal profit rate can therefore be inferred to be only approximately ●(omitted)● of that of the defendants' products, and that damages presumed under Patent Act Article 102(2) would substantially exceed the plaintiff's lost profits.

On this point, the entire purport of oral argument establishes that the plaintiff's unit selling price is in a range of approximately ●(omitted)● of that of the defendants' old products. Even if the old products had not been sold, it is difficult to find that the plaintiff could have earned marginal profits equal to those of the old products. It is therefore appropriate to allow rebuttal of the presumption to a certain extent on this ground. On the other hand, the low unit selling price of the plaintiff's products might have resulted in a sales volume exceeding that of the defendants' products. Accordingly, substantial rebuttal of the presumption cannot be considered appropriate either.

(e) Considering all these circumstances comprehensively, among the grounds asserted by the defendants, only the difference between the unit selling prices of the plaintiff's products and the defendants' old products should be considered as a ground for rebuttal. A rebuttal rate of 20% is appropriate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90776.pdf

Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor] Rebuttal of the Article 102(2) presumption: 90% rebutted

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Osaka District Court, 2016 (Wa) 4815 [Oil-Cooled Screw Compressor]

<Damages> Rebuttal of the Article 102(2) presumption: 90% rebutted

Approximately 1.38 billion yen awarded

The plaintiff's advertisements neither directly describe nor suggest the effects of the invention.

The plaintiff itself does not work the invention either.

The plaintiff's and defendant's business models differ substantially.

<Grounds for rebutting the presumption>

Advertisements prepared by the plaintiff for its products contain neither direct descriptions nor specific statements suggesting the effects of the invention. The plaintiff itself does not work the invention either.

The substantial difference between the plaintiff's and defendant's business models suggests that demand for the infringing NewTon system and demand for the plaintiff's products have qualitatively different aspects.

⇒ It is unreasonable to assume that, absent sales of the defendant's plants incorporating its products, all demand would have shifted to the plaintiff's products, screw compressors incorporating them, or plants using them. Rather, such demand would be very limited. (★ The 90% rebuttal relates to the high monetary value. High sales suggest added value apart from the patent.)

⇒ Reversed on appeal (inventive step rejected)

In the appellate judgment of May 19, 2021, IP High Court, 2020 (Ne) No. 10019, the invention was found to lack inventive step; the portion adverse to the defendant was reversed ⇒ the claim was dismissed on the merits.

(Extract from the court's reasoning)

"C. Rebuttal of the presumption

(A) Underlying circumstances

a. The NewTon system, Defendant Products 2-2 and 2-3, and related matters

(a) Features of the NewTon system and promotional activities

The NewTon system was commercialized as NewTon3000 in 2007 and has been sold for use in the defendant's plants since 2008 (Ko 8-3, Otsu 45). It is essentially not sold separately and independently from freezing and refrigeration plants. Not only Defendant Products 2-2 and 2-3 but all Defendant Products 2 are compressors dedicated to the NewTon system (Ko 3), necessarily purchased when buying a defendant-manufactured plant using that system. Like the NewTon system itself, these are essentially not sold separately and independently. NewTon3000 was also said to achieve 20% energy savings over conventional models through such measures as an IPM motor. Initial sales targets were 200 units per year at launch and 800 units per year after ten years (Otsu 45, 116).

The defendant continued development of the NewTon system. In 2012 it expanded the series to include NewTonC exclusively for chilled applications, NewTonF exclusively for freezers, and other models, selling

a cumulative total exceeding ●(omitted)● units by 2016. In July 2016 it also began selling F-300, F-600, and other freezer-only models that maintained energy efficiency while reducing refrigerant charge, improving maintainability, and reducing size and weight (Ko 8-3, Otsu 45).

The NewTon system was described as featuring greater economy and energy efficiency through such measures as an IPM motor developed by the defendant itself; an indirect cooling method using the natural refrigerant ammonia to cool carbon dioxide as a response to fluorocarbon refrigerants scheduled for complete phaseout in 2020, with safe ammonia use enabled by confining it to the machine room and rapid response to leaks enabled by leak sensors and other equipment; a compact unit design facilitating installation; and a 24-hour, 365-day support system including remote monitoring and maintenance diagnostic systems. Promotional activities emphasized these points (Ko 8-3, Otsu 38, 45).

Advertisements for the NewTon system and Defendant Products 2-2 and 2-3 contain no direct reference to, or specific indication of, the invention's effects as described in the specification (Ko 3, 8-3, Otsu 38, 66-1).

(b) Assessments by businesses that installed the NewTon system

In articles it produced entitled "Customer's Point of View," the defendant introduces customers' reasons for installing the NewTon system and the results after installation. They include the following statements.

• In addition to eliminating fluorocarbons, the customer particularly valued energy efficiency and system completeness, with improvements in operational management also decisive in adopting the NewTon system. The results included eliminating fluorocarbon use, an average 15–18% reduction in electricity consumption, and a safer, less labor-intensive operational management system through a maintenance contract (Otsu 67).

• The customer adopted the NewTon system because it could support highly efficient production without fluorocarbons and because it valued the defendant's comprehensive construction and maintenance capabilities. This enabled an efficiency-focused production line, increased production capacity, and enhanced environmental and energy-saving measures. The packaged approach also shortened construction time, while fully automated operation provided a safe, less labor-intensive operational management system (Otsu 68).

• The customer adopted the NewTon system because of its energy efficiency, cooling speed, and continuous operating time compared with conventional equipment. It achieved approximately 40% lower annual electricity consumption, stable production of high-quality frozen bread dough, reduced environmental burden by addressing the complete phaseout of fluorocarbons, and less maintenance effort through fully automated operation.

This customer reportedly received proposals from several companies and investigated and considered them thoroughly when renewing its equipment (Otsu 69).

• The customer adopted the NewTon system because of its energy efficiency and safety compared with direct ammonia cooling. Compared with facilities of the same scale, it achieved an average reduction of approximately 38% in electricity consumption, lower carbon dioxide emissions, reduced construction work and time, and improved safety (reduced risk of ammonia leaks, remote monitoring, etc.) (Otsu 70).

(c) The Ministry of the Environment's website contains a "Collection of Interviews with Company Representatives Introducing Energy-Saving Natural-Refrigerant Equipment," with articles on customers apparently using the NewTon system. These include the following statements.

• As part of advancing one of the company's key themes, its "plan to eliminate all fluorocarbon refrigeration machines," it is replacing refrigeration equipment with equipment using natural refrigerants (Otsu 60).

• The customer installed the high-efficiency natural-refrigerant refrigeration machine "NewTon" in a refrigerated warehouse. It chose a natural-refrigerant machine because subsidies could reduce initial installation costs and it expected energy savings to reduce electricity bills. It received proposals from several companies on the premise of natural-refrigerant refrigeration, and selected the defendant's proposal as a model that could be installed at an economically viable level using the subsidy. Although some aspects of the energy-saving effect remained unclear because little time had passed since installation, a substantial reduction in peak electricity demand was one benefit (Otsu 61).

• Energy-saving natural-refrigerant equipment was installed to comply with fluorocarbon regulations. In addition to avoiding risks by selecting a natural refrigerant, the customer considers reduced electricity bills a major benefit. Installation costs are approximately 10–15% higher than for the previous equipment, but the customer considers that difference unavoidable in view of global warming (Otsu 62).

• Among the benefits of installing energy-saving natural-refrigerant equipment, average electricity consumption was reduced by 15–20%. However, company-wide policy prioritizes eliminating fluorocarbons over energy savings, and a certain degree of reduction has also been achieved in that respect (Otsu 63).

(d) Presentation materials entitled "Initiatives to Introduce Natural-Refrigerant Equipment" at a Japan Association of Refrigerated Warehouses seminar state that installation of ten refrigeration machines in total, covering two NewTon-series models, together with other equipment, achieved approximately 50% lower electricity consumption and a reduction of 2,073 tonnes of carbon dioxide emissions annually (Otsu 118).

(e) In the articles and other materials described in (b)–(d), none of the customers directly mentions the invention's effects either as a reason for adopting the NewTon system or as a result of doing so, and there are no specific statements suggesting its contribution.

(f) Awards received by the defendant in connection with the NewTon system

• The defendant received the Minister of the Environment's FY 2008 Commendation for Global Warming Prevention Activities for its efforts to eliminate fluorocarbons by using ammonia and carbon dioxide as refrigerants and for developing highly efficient, energy-saving refrigeration equipment (Otsu 64).

• The large refrigeration machine "NewTon3000" received the Nikkei Superior Products and Services Award 2008 for adopting a refrigeration system using natural refrigerants such as ammonia and carbon dioxide without any alternative fluorocarbons, and for reducing electricity consumption by approximately 30% compared with conventional models through permanent magnets in its independently developed motor (Otsu 65).

• The MAYEKAWA Freezer Pack, combining the high-efficiency natural-refrigerant NewTon F refrigeration system with various freezer models, received the FY 2015 "Nisshoku Excellent Food Machinery, Materials and Ingredients Award," which recognizes products supporting development of the food industry through cost reduction and other benefits (Otsu 66).

None of the stated reasons for these awards directly mentions or specifically suggests the invention's effects (Otsu 64–66).

(g) Articles concerning the NewTon system

An interview report entitled "Co-Creating Innovation: Co-Creation with Customers and with Sales" (Marketing Journal, Vol. 35, No. 4 (2016); Otsu 45) features the defendant's NewTon system. It identifies such features as outstanding energy-saving performance, environmental responsiveness, shorter construction periods through standardized production, high reliability and safety, and services providing "predictive maintenance" through a 24-hour remote monitoring network. It also states that continual

performance improvements and other measures maintain the product's competitive advantage. Although operating costs are 20–40% lower, the product price is three to four times that of competitors' products using alternative fluorocarbons. As the reason for growing adoption despite this, the report cites a business model that packages the manufactured product with other refrigerated-warehouse equipment and handles everything through construction and maintenance. This absorbs some of the product price difference within plant orders and reduces total costs while providing customers with reassurance and confidence.

The report, however, contains no direct reference to, or specific statement suggesting, the invention's effects.

(h) Manufacturing cost ratio

The evidence (Ko 6) and the entire purport of oral argument establish that, within the NewTon systems incorporating Defendant Products 2-2 and 2-3, not only the portions alleged by the defendant to be infringing (compressor body, oil separator, and piping) but also the oil cooler, filter, drive motor, and controller are necessary components of an oil-cooled screw compressor. Conversely, the evidence (Otsu 109) and the entire purport of oral argument establish that the oil-return component in those systems is not a necessary component of an oil-cooled screw compressor.

The evidence (Otsu 75, 84, 109, 110) and the entire purport of oral argument establish that the manufacturing costs of the components necessary for the oil-cooled screw compressor account for ●(omitted)●% of the NewTon system's manufacturing costs.

b. The plaintiff's products

(a) Features of the plaintiff's products

Among the plaintiff's products, those called compressor units correspond to screw compressors, and those called condensing units correspond to screw compressors equipped with condensers (Ko 13). The entire purport of oral argument establishes that none of the plaintiff's products works the invention.

Among those products, the SHN series improves reliability against gas and oil leaks and is advertised as environmentally friendly refrigeration equipment that does not deplete the ozone layer and has a low global-warming potential (Ko 13).

An article entitled "Two-Stage Semi-Hermetic Ammonia Refrigeration Machine" (Kobe Steel Engineering Reports, Vol. 63, No. 2 (Sept. 2013); Ko 13-5) describes the iZ series as refrigeration equipment featuring superior energy efficiency, greater refrigerating capacity, and quiet operation. Improved energy efficiency contributes to reducing customers' operating costs and carbon dioxide emissions; greater refrigerating capacity reduces initial costs and improves the quality of the objects being cooled. The semi-hermetic ammonia refrigeration machines are also said to fit the trends toward preventing global warming and environmental conservation, with cumulative shipments exceeding 200 units as of September 2013. Advertising emphasized high energy efficiency, elimination of concern over ammonia leakage and improved maintainability through semi-hermetic construction, increased refrigerating capacity compared with conventional machines, and emergency-response capability through constant monitoring of operating conditions (Ko 13).

The plaintiff's advertisements for its products, however, contain no direct description of, or specific statement suggesting, the invention's effects (Ko 13).

(b) Promotional activities by distributors of the plaintiff's products

A business claiming to "provide comprehensive factory energy-saving solutions" through "compressor sales and system proposals" introduces the plaintiff's iZ series among its offerings. Alongside the achievement of receiving the "FY 2003 Japan Machinery Federation Chairman's Award," it emphasizes a 40% improvement in refrigerating capacity over conventional machines, emergency-response capability through constant monitoring of operating conditions, and energy-saving performance (Ko 15-2).

(c) Awards received by the plaintiff's products

Among the plaintiff's products, the iZ series received the FY 2003 Japan Machinery Federation Chairman's Award for outstanding energy-saving equipment (Ko 15-2), and in 2004 received a technology award from the Japan Refrigeration and Air Conditioning Industry Association (Ko 15).

c. Sales records of the NewTon system and the plaintiff's products

The evidence (Ko 13-4, Otsu 73) and the entire purport of oral argument establish that the market for oil-cooled screw compressors used in refrigeration machines for ammonia/carbon dioxide refrigerant refrigeration facilities is effectively a duopoly of the plaintiff and defendant, and that sales trends from 2008 to 2016 for the defendant's NewTon systems incorporating Defendant Products 2-2 and 2-3 and for the plaintiff's products are as shown in the following graph.

●(omitted)●

Meanwhile, the evidence (Ko 18, 19, Otsu 73, 85, 93, 110) and the entire purport of oral argument establish that, during the same period, the defendant's sales of NewTon systems incorporating Defendant Product 2-1 totaled no more than ●(omitted)●.

(B) Analysis

a. As found above, the defendant essentially does not sell Defendant Products 2-2 and 2-3, which are oil-cooled screw compressors, independently. The same is true of the NewTon systems incorporating them: the defendant sells plants using those NewTon systems. By contrast, the plaintiff merely sells its products consisting of screw compressors or screw compressors with added condensers. At the plant level, those products are sold as components of packages proposed to customers by other businesses, sometimes called "set manufacturers." This substantial difference in business models suggests that demand for the infringing NewTon system and demand for the plaintiff's products have qualitatively different aspects. Accordingly, even if NewTon systems incorporating Defendant Products 2-2 to 2-3 had not been sold, it is difficult to envisage any of the plaintiff's products directly substituting for Defendant Product 2-2 or 2-3. On the other hand, all or part of the demand corresponding to the quantity of Defendant Products 2-2 and 2-3 transferred might in that case have shifted to plants using systems incorporating the plaintiff's products. In that event, demand would ultimately have shifted to the plaintiff's products. However, the plaintiff merely sells compressors constituting part of a plant, and its influence over the overall configuration and price of the plant and over promotional activities directed at customers appears limited.

The existence and extent of rebuttal of the presumption are considered below with these perspectives also in mind.

b. Since Defendant Products 2-2 and 2-3 fall within the technical scope of the invention, they can generally be expected to produce its effects, and no circumstances suggest that they fail to do so. The defendant argues that those products do not produce the invention's effects, but that argument cannot be accepted.

Nevertheless, the invention's effects consist of reducing vibration and noise with a simple, compact structure by, among other things, increasing the thrust bearing's load capacity, increasing the balance piston's pressure-receiving area, and eliminating reverse-thrust load conditions. Whatever their technical significance, these effects are not necessarily of a nature to have a strong impact on the economic value of products embodying the invention or systems incorporating them. This is supported by the defendant's failure to refer directly to those effects in promotional activities for Defendant Products 2-2 and 2-3; the absence of external evaluations of the NewTon system directly related to, or suggesting, those effects; and the fact that even the plaintiff patentee does not work the invention in its own screw compressors and other products. Accordingly, the invention's effects themselves should be regarded as having relatively weak customer-attracting power.

The entire purport of oral argument also establishes that the NewTon system forms the core of the customer-attracting power of the defendant's plants and that Defendant Products 2-2 and 2-3 are indispensable components for operating the system. Considering the NewTon system's customer-attracting power, the defendant's promotional activities emphasize energy savings, safety, support arrangements, and other features. These features are also positively evaluated by third parties: they have been cited as reasons for awards, motivated adoption, and reportedly produced actual results. (The plaintiff argues that energy savings and safety are also effects of the invention. However, the NewTon system's energy savings and safety appear attributable to measures such as adoption of an IPM motor and indirect cooling, unrelated to the invention's effects. The plaintiff's argument on this point cannot be accepted.)

c. The proportion of the NewTon system's manufacturing costs attributable to Defendant Products 2-2 and 2-3 does not directly reflect their technical or commercial value, but is one circumstance from which it may be estimated. Although those products are indispensable to operation of the NewTon system, their manufacturing costs account for only ●(omitted)● of the system's manufacturing costs.

d. Because the market for oil-cooled screw compressors used in refrigeration machines for ammonia/carbon dioxide refrigerant refrigeration facilities is effectively a duopoly of the plaintiff and defendant, sales of defendant-manufactured plants using NewTon systems and of other similar plants can be inferred to correspond roughly to deliveries of compressors manufactured by the defendant and plaintiff, respectively. Sales of defendant-manufactured plants using NewTon systems have the upward trend ●(omitted)●. It is also difficult to envisage compressors not manufactured by the defendant (naturally, the plaintiff's products would be the candidates) being incorporated into NewTon systems used in the defendant's plants. Accordingly, if the defendant sold, or could easily sell, noninfringing products, it is reasonable to think that, even without sales of NewTon systems incorporating Defendant Products 2-2 and 2-3, much of the demand would have shifted to plants using NewTon systems incorporating noninfringing products manufactured by the defendant.

In addition to Defendant Products 2-2 and 2-3, the defendant manufactures Defendant Product 2-1 as a NewTon-specific product that does not infringe the invention, and it could substitute for Products 2-2 and 2-3. The plaintiff points out that sales of NewTon systems incorporating Product 2-1 were low. However, because there were actual deliveries, the possibility of demand shifting to substitution with Product 2-1 cannot be excluded so long as it meets customers' needs.

At the time of infringement, the defendant did not manufacture NewTon-specific oil-cooled screw compressors other than Defendant Products 2. Nevertheless, the entire purport of oral argument suggests relatively few physical constraints on, for example, adding an oil pump and providing a pressurized flow path in the NewTon system to avoid infringement, and the associated costs do not appear sufficiently high to be problematic. It therefore appears relatively easy to have responded to customers wanting the defendant's plants by customizing an existing model and thereby avoiding infringement. Although in reality Product 2-1 was the only NewTon-specific noninfringing compressor, and no such customization occurred, it is reasonable to consider this point as a circumstance warranting rebuttal. The plaintiff argues that only products actually present in the market can be considered competing products, but, as stated above, that argument cannot be accepted.

e. On the premise that the defendant's NewTon business has a higher marginal profit rate than the plaintiff's compressor business, the defendant argues that, where profits calculated under Patent Act Article 102(2) exceed the profits the plaintiff patentee could have earned based on its capacity to work the invention, the presumption is rebutted to that extent.

However, even if the defendant's NewTon business has a higher marginal profit rate, that does not mean that the plaintiff's compressor business has less capacity to work the invention than the defendant's NewTon business. The argument therefore lacks a proper premise.

The defendant's argument on this point cannot therefore be accepted.

f. Considering the foregoing circumstances comprehensively, it is unreasonable in this case to assume that, absent sales of defendant-manufactured plants using NewTon systems incorporating Defendant Products 2-2 and 2-3, all corresponding demand would have shifted to the plaintiff's products, screw compressors incorporating them, or plants using them. Rather, such demand is considered very limited. Accordingly, the presumption under Patent Act Article 102(2) should be rebutted to the extent of 90%."

089306_hanrei.pdf (courts.go.jp)

Tokyo District Court, 2019 (Wa) 2675 [Blowgun Darts] <Damages> Rebuttal of the Article 102(2) presumption: 65% rebutted for profits during part of the sales period

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815238520.html

Tokyo District Court, 2019 (Wa) 2675 [Blowgun Darts] <Damages> Rebuttal of the Article 102(2) presumption: 65% rebutted for profits during part of the sales period

<Grounds for rebutting the presumption>

Most of the defendant's products were purchased by customers connected with the blowgun association, and a considerable proportion were purchased because they were association-approved equipment.

⇒ Because the plaintiff's blowgun equipment was not association-approved, not all demand for the defendant's products would have shifted to darts manufactured and sold by the plaintiff.

(Extract from the court's reasoning)

It is appropriate to find that most of the defendant's products were purchased by customers connected with the blowgun association. A considerable proportion were purchased by persons connected with the association because the products were association-approved equipment. Since the plaintiff's blowgun equipment was not association-approved from December 1, 2020 onward, not all demand for the defendant's products purchased for that reason would have shifted to darts manufactured and sold by the plaintiff. On the other hand, some people apparently would have bought the plaintiff's darts even without the association's approval, so it cannot be said that none of the demand would have shifted to the plaintiff's blowgun equipment.

The defendant seeks rebuttal of the presumption concerning its sales from December 1, 2020 onward because the plaintiff's equipment was not association-approved. In light of the above circumstances, it is appropriate to find the presumption of damages rebutted by 65% for profits from that date onward.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90335.pdf

Tokyo District Court, 2017 (Wa) 7207 [Vacuum Cleaning Apparatus] <Damages> Rebuttal of the Article 102(2) presumption: 50% rebutted

Original Ameblo publication: 2023-08-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815238865.html

Tokyo District Court, 2017 (Wa) 7207 [Vacuum Cleaning Apparatus] <Damages> Rebuttal of the Article 102(2) presumption: 50% rebutted

<Grounds for rebutting the presumption>

The invention concerns the drying process of a vacuum cleaning apparatus. The apparatus's principal purpose is cleaning workpieces. The patent contributes only to part of the defendant's product as a whole.

Customers are particularly interested in whether the desired workpieces can be cleaned. The invention's rapid-drying effect has less influence on attracting customers than cleaning capacity does.

Because both are "non-immersion" types, the plaintiff's product is more substitutable for the defendant's product than competitors' products are.

(Extract from the court's reasoning)

Patent Act Article 102(2) establishes a presumption. If the infringer alleges and proves that some or all of its profits lack an adequate causal relationship with the patentee's damage, the presumption is rebutted to that extent. As considered below, the presumption should be rebutted by 50%; the damage suffered by the plaintiffs from manufacture and sale of the defendant's product itself can therefore be found to be 321,115,130 yen.

A. Patent Right 2 concerns the drying process of a vacuum cleaning apparatus. As also described in paragraphs [0023]–[0031] of the specification and related documents, the apparatus performs a series of operations including preparation, loading, cleaning, drying, and unloading. Although drying also plays an important role, the apparatus's principal purpose is cleaning workpieces. The patent can therefore be said to contribute only to part of the defendant's product as a whole.

Customers purchasing a vacuum cleaning machine are also considered particularly interested in whether it can clean the desired workpieces. The rapid-drying effect of Invention 2 therefore has less influence on attracting customers than cleaning capacity does.

B. The evidence (Ko 36, attachment) establishes that market shares for vacuum cleaning apparatuses in the fiscal year ended March 2015 were: Nachi-Fujikoshi, 52.5%; the plaintiff, 25.0%; Aqua Chemical Co., Ltd., 7.5%; Cleanvy Co., Ltd., 4.5%; and the defendant, 4.5%.

On the other hand, for example, market leader Nachi-Fujikoshi is strong in "immersion" products (washing by immersing products in cleaning liquid within the cleaning chamber), whereas both the plaintiff and defendant also focused on developing and selling "non-immersion" products (washing using vapor, showers, etc.) (Ko 50).

In fact, the defendant's product is a "non-immersion" type that enables rapid drying through a large-capacity L-shaped vacuum valve and a water-cooled baffle. Its product brochure (Ko 37) states, for example, "Rapidly dries products. Drastically shortens conventional drying time from 10 minutes to 1–2 minutes." Compared with competitors' brochures emphasizing cleaning performance and the like (Ko 38–43), it was, like the plaintiff's product (Ko 44), a product that appealed to customers by highlighting rapid drying.

Accordingly, even if some customers would have purchased vacuum cleaning apparatuses from competitors rather than the plaintiff absent infringement of Patent Right 2, the defendant's product's non-immersion type and emphasis on rapid drying mean that the plaintiff's product is more substitutable for it than competitors' products are.

C. The defendant argues that Invention 2 has a low degree of inventive step. (Since this argument concerns damages, the plaintiffs' contention that it is an untimely means of attack or defense and should be rejected is without merit.)

However, to solve the problem that the conventional method of evacuating cleaning and drying chambers with a vacuum pump to reduce pressure requires a long drying process, Invention 2 adopts configurations including "a condensing chamber depressurized by the vacuum pump independently of the cleaning chamber and maintained in that depressurized state" (Element 2D), and

"drying the workpiece by placing the cleaning chamber ... in communication with the condensing chamber" (Element 2G). It achieves rapid drying through condensation caused by communication between the condensing and cleaning chambers. There is insufficient evidence that the invention's technical concept or characteristic configuration was publicly known when Patent 2 was applied for.

Accordingly, in this case it is inappropriate to consider the degree of inventive step of Invention 2 as a circumstance concerning inability to sell the defendant's product.

D. Considering these circumstances comprehensively, the above presumption of damages under Patent Act Article 102(2) should be rebutted to the extent of 50%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90438.pdf

Tokyo District Court, 2016 (Wa) 25436 [Method for Constructing Amino Acid-Producing Bacteria] <Damages>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815239110.html

Tokyo District Court, 2016 (Wa) 25436 [Method for Constructing Amino Acid-Producing Bacteria] <Damages>

<Rebuttal of the Article 102(2) presumption: 50% rebutted>

Competing products (allocation according to market share)

<Grounds for rebutting the presumption>

Sales of competing products (reduction according to market share)

⇒ There is no evidence establishing the volume imported from Indonesia by businesses other than the plaintiff. Nevertheless, at least approximately 50% of the demand for the MSG sold by the defendants may have shifted to monosodium glutamate imported and sold by parties other than the plaintiff.

<Contribution rate> Production of glutamic acid by fermentation includes fermentation and purification stages, with multiple reactions within the strain during fermentation. Even if the invention concerns only a particular stage or reaction, this does not establish that the patented inventions made a low contribution to production of the MSG at issue.

(Extract from the court's reasoning)

Grounds for rebutting the presumption

(A) Sales of competing products (reduction according to market share)

a. The evidence (Otsu 101, 117) and the entire purport of oral argument establish that imports of monosodium glutamate into Japan from each country during the periods in which the defendants' respective processes were used were as stated in columns ①–⑩ of Appendix 16, "Imports of Monosodium Glutamate during the Periods of Use of the Defendants' Respective Processes." Of these, all imports from ① Thailand and ② Brazil were imported by the plaintiff and sold in Japan. Imports from ③ Indonesia included imports by the plaintiff as well as the quantities sold by the defendants (③A). For calculation of the 2017 figures, the quantities in Attachment 7, rather than Attachment 6, to Exhibit Otsu 101 were used as data comparable to the 2011–28 materials (Otsu 117).

b. The MSG at issue is monosodium glutamate. All monosodium glutamate described in a above that was imported during the periods of use of the defendants' respective processes is found to constitute products competing in the Japanese market as equivalents of the MSG sold by the defendants.

The existence of these competing products, in addition to those sold by the defendants and imported and sold by the plaintiff, should be considered a circumstance warranting rebuttal of the presumption under Patent Act Article 102(2) for part of the total marginal profits of the defendants described in E above.

c. The rebuttal rate based on these circumstances is considered below.

Regarding the quantity (③B) of imports from ③ Indonesia other than the defendants' sales (③A), the defendant argues that half is presumed attributable to businesses other than the plaintiff. However, there is no evidence establishing the volume imported from Indonesia by such other businesses.

Taking account of the plaintiff's assertion that it accounted for almost all of quantity ③B, and assuming that this quantity was imported by the plaintiff, the plaintiff's imports and sales (⑪) are calculated. The ratio of those imports and sales (⑪) to the quantity obtained by deducting the defendants' sales (③A) from

total imports (⑩), is then calculated. As shown in that appendix, the annual ratios during the periods of use of the defendants' processes range from ●(omitted)●% to ●(omitted)●%, and the annual average is calculated as 44.7%.

Regarding the Ministry of Finance trade statistics submitted by the defendant (Otsu 117, Materials 3–10), the plaintiff also argues that quantities not included in those materials were imported as glutamic acid and processed domestically into monosodium glutamate, and that almost all such imports were by the plaintiff. However, it has submitted no specific supporting materials, and the evidence (Otsu 101, Attachment 7) suggests that imports of such glutamic acid were small compared with imports of monosodium glutamate.

Thus, even taking the plaintiff's arguments into account, it is appropriate to find that, had the defendants' quantities not been sold during the periods of use of their respective processes, at least approximately 50% of the demand for the MSG they sold might have shifted to monosodium glutamate imported and sold by parties other than the plaintiff. A 50% rebuttal of the presumption on this basis is appropriate.

(B) Degree of contribution of the patents at issue to damages

The defendant argues that the inventions covered by these patents contribute only to a very small part of the complex and diverse processes for producing glutamic acid, and that their respective contributions to producing the MSG at issue are low. It therefore argues that calculation of damages under Patent Act Article 102(2) should take account of each patent's contribution rate, or alternatively that rebuttal should be allowed according to those contribution rates.

However, Invention 1-1 (Corrected Invention 1-1), Invention 1-2 (Corrected Invention 1-2), Invention 1-4 (Corrected Invention 1-3), and Invention 2-5 (Corrected Invention 2-5), all found to have been worked during the periods of use of the defendants' respective processes, are inventions of methods of producing glutamic acid (an amino acid) using strains with particular characteristics. Where working of these patented inventions is established through sales or other acts involving MSG produced with those strains, each patented invention must be regarded as worked in relation to the entirety of the MSG sold.

Production of glutamic acid by fermentation includes fermentation and purification stages, with multiple reactions within the strain during fermentation. Even if these patented inventions concern only particular stages or reactions, that does not establish that their contributions to production of the MSG were low. Nor does any other evidence establish circumstances warranting rebuttal of the Article 102(2) presumption for the claims based on these patents on grounds of their contribution rates. The defendant's argument cannot therefore be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90053.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10003 [Method for Preventing Attachment of Marine Organisms] <Kanno>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815371164.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10003 [Method for Preventing Attachment of Marine Organisms] <Kanno>

"The Ko 5 invention ... addresses the problem that adding an available-chlorine-generating agent in the Ko 1 invention generates trihalomethanes ... and solves that problem on the premise of using a chlorine agent ... by adding that agent at a specified concentration. No motivation can therefore be found for a person skilled in the art deliberately to replace the chlorine agent with chlorine dioxide."

⇒ Inventive step upheld

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92064.pdf

[Unfair Competition Prevention Act / Imitation of Product Configuration] Osaka District Court, 2019 (Wa) 11484: "Reliance" found ⇒ Violation of Article 2(1)(iii) of the Unfair Competition Prevention Act

Original Ameblo publication: 2023-08-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815506613.html

[Unfair Competition Prevention Act / Imitation of Product Configuration] Osaka District Court, 2019 (Wa) 11484: "Reliance" found ⇒ Violation of Article 2(1)(iii) of the Unfair Competition Prevention Act

"The defendant, being in the same business as the plaintiff, could have made its product based on the plaintiff's product. ... The configuration of the defendant's product is substantially identical to that of the plaintiff's product. ... Furthermore, the defendant argues that, around the summer of 2017, it communicated its desired functions and image to a Chinese manufacturer and completed the design based on a product (sample) already manufactured by that manufacturer, but its explanation of that process lacks specificity. ... There are no instructions, proposals, or other evidence of communications with the manufacturer substantiating the design process. It is difficult to believe that, merely by communicating abstract functions and an image to the manufacturer by telephone as the defendant's representative testified, a product closely resembling the plaintiff's product was created by coincidence. ... Considering these circumstances together, the defendant's product is found to have been created based on the plaintiff's product."

⇒ Violation of Article 2(1)(iii) of the Unfair Competition Prevention Act

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91609.pdf

[Trademark] Osaka District Court, 2020 (Wa) 4272

Original Ameblo publication: 2023-08-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815639374.html

[Trademark] Osaka District Court, 2020 (Wa) 4272

Where five years have elapsed from registration of the trademark right without a request for an invalidation trial based on Article 4(1)(xi) of the Trademark Act, an abuse-of-rights defense based on that ground of invalidity cannot be raised absent special circumstances, such as the opposing party in the infringement action being the owner of the other person's registered trademark relevant to Article 4(1)(xi).

* The Emax Supreme Court case concerned Article 4(1)(x)

⇒ This judgment concerns Article 4(1)(xi)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91719.pdf

Intellectual Property High Court, 2021 (Gyo-Ke) 10150 [Vessel] <Shoji> = 2021 (Gyo-Ke) 10151 ⇛ Inventive step upheld through a disclaimer claim

Original Ameblo publication: 2023-08-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815755637.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10150 [Vessel] <Shoji> = 2021 (Gyo-Ke) 10151 ⇒ Inventive step upheld through a disclaimer claim

① "There is no reason to interpret the specification and related documents as describing only flood-prevention chambers that also function as tanks."

+ The disclaimer claim does not change the invention's effects.

⇒ Does not introduce new technical matter

② Replacing a tank that functions as a "flood-prevention chamber" with a "flood-prevention chamber" having no tank function requires new space for a tank and prevents use as a tank of a location previously available for that purpose.

⇒ Teaching-away factor exists

⇒ Inventive step upheld through a disclaimer claim

<Some observations>

(1) Relationship between addition of new matter and inventive-step assessment for disclaimer claims. This is the fourth court decision recognizing inventive step through a disclaimer claim, although more than 1,000 disclaimer claims per year are patented through JPO examination and trial proceedings. Like the preceding three court decisions recognizing ‘inventive step’ through disclaimer claims, this judgment reasoned, in its inventive-step analysis, that excluding a particular configuration involved a teaching-away factor in relation to the problem of the primary cited invention. On the other hand, like many other decisions, when finding the correction permissible because it did not add new matter, the judgment held that the correction to a disclaimer claim did not change the invention's effects. Disclaimer claims thus involve a tension: the relationship to the problem of the invention at issue matters when assessing new matter, whereas the relationship to the cited invention's problem matters when assessing inventive step. Some say this is overly convenient for right holders. Still, this may be only a minor tension compared with the larger tension in current practice: a difference between the invention's problem and the cited invention's problem is a reason to uphold inventive step, whereas in infringement analysis, whether the accused product or process addresses the invention's problem is not treated as an issue. (2) New-matter assessment of disclaimer claims (different approaches to earlier-filed, later-published applications and inventive step). It seems that new-matter assessment for disclaimer claims is applied more strictly to amendments/corrections avoiding lack of inventive step than to those avoiding conflict with an earlier-filed, later-published application. The application passages from four decisions are quoted below. Intellectual Property High Court, 2021 (Gyo-Ke) No. 10151, Vessel <this judgment>, found that ‘because a flood-prevention chamber is permitted to have a tank function, flood-prevention chambers include both those that also function as tanks and those that do not.’ It thus adopted substantive reasoning going beyond the formal proposition that the invention’s original effects are unchanged and no new effects arise. Intellectual Property High Court, 2021 (Gyo-Ke) No. 10111, Laser Processing Apparatus, likewise found that ‘it would be unnatural to describe planned cutting lines while deliberately not describing grooves,’ adopting substantive reasoning going beyond that same formal proposition that the invention’s original effects are unchanged and no new effects arise. In Intellectual Property High Court, 2018 (Ne) No. 10006, System Operating Method (Capcom v. Koei),

addition of new matter was not disputed. The first judgment in Intellectual Property High Court, 2017 (Gyo-Ke) No. 10032, Method for Producing Conductive Material (Silver Flakes), addressed a correction adding a mechanism of action to Claim 10, separately from the disclaimer in Claim 9, and held: ‘It cannot be said that the specification, claims, or drawings attached to the application lack an express description that the “fusion” in Corrected Invention 10 results from “locally oxidizing some of the silver particles” ... and thus no new matter is added.’ This has something in common with the European Patent Office Guidelines, which permit undisclosed disclaimers in certain circumstances to restore novelty over earlier-filed applications and certain other disclosures, but do not permit them to contribute to inventive-step assessment. Where the excluded subject matter was disclosed in the application as filed, a different test applies: whether the invention remaining after the exclusion is directly and unambiguously derivable from the application as filed.

(Extract from the court's reasoning)

① ... Because a "flood-prevention chamber" is permitted to have a tank function, such chambers are recognized as including both those that also function as tanks and those that do not. There is no reason to interpret the specification and related documents as describing only chambers that also function as tanks. They therefore disclose both a "flood-prevention chamber" with a tank function and one without it. Since both inventions—with and without a tank function—were disclosed, ... correcting Claim 1's "flood-prevention chamber" to a "flood-prevention chamber (excluding a tank)" without a tank function, thereby excluding the invention with a tank function, clearly introduces no new technical matter. Nor is there any reason to interpret the correction as transforming the invention into one producing new effects without producing its original effects: even if the side wall near a partition is damaged, only the flood-prevention chamber floods, not multiple rooms, thereby preventing flooding across multiple rooms when the vessel is damaged while restraining enlargement of those rooms and increasing design freedom. There is therefore no room to regard new technical matter as introduced through a change in the invention's effects caused by the correction.

② ... The "stern trimming tank (ballast water tank)" in the Ko 6 invention inherently functions as a tank, faces the side wall, and is a room with a watertight structure that prevents flooding of the "room" in which it is installed even if the side wall is damaged and water enters. It therefore also qualifies as a "flood-prevention chamber" and is a chamber that also functions as a tank [the source here uses the expression ‘watertightness-prevention chamber’]. However, there is no evidence suggesting separate construction of the tank and a "flood-prevention chamber" without a tank function in place of a chamber serving both purposes. Nor is there evidence suggesting placement of a nontank "flood-prevention chamber" at the location of a tank originally designed to function as a tank and also understood to function as a flood-prevention chamber, while placing a separate tank elsewhere. Thus no motivation is recognized in the Ko 6 invention to construct the "stern trimming tank (ballast water tank)" separately as a tank and a nontank "flood-prevention chamber," or to replace it with an empty space serving as a "flood-prevention chamber."

Moreover, separately constructing a tank and a "flood-prevention chamber" without a tank function, and replacing a tank originally designed to function as a tank and also understood to function as a flood-prevention chamber with a nontank flood-prevention chamber, would require new space to house the tank. It would also make a location previously usable as a tank unavailable for that purpose, impairing design freedom. There is therefore a teaching-away factor against doing so. Accordingly, a person skilled in the art could not readily have conceived of replacing the Ko 6 invention's "stern trimming tank (ballast water tank)" with an empty space serving as a "flood-prevention chamber" and placing a "stern trimming tank (ballast water tank)" in the rear room.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91422.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10029 [Antiglare Film] <Shoji>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12815756027.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10029 [Antiglare Film] <Shoji>

① Enablement upheld even if the embodiments described in the specification include shapes and structures outside the claims (support requirement also upheld)

② Measurement conditions are inherently subject to limits, and a person skilled in the art measures reasonably ⇒ Clarity requirement satisfied

③ Where two parameters are interrelated, the court found no suggestion to adjust only one parameter of the primary cited invention independently of the other ⇒ Inventive step upheld

[Claim 1] "An antiglare film ... having a haze value within the range of 60% to 95%, inclusive, and an internal haze value within the range of 0.5% to 8.0%, inclusive."

(Extract from the court's reasoning)

① Even if some antiglare films obtainable by the first embodiment cannot be made by the second or third embodiment, this does not negate the ability to work the inventions through the first embodiment. Even if some second-structure antiglare layers made by the second embodiment and third-structure antiglare layers made by the third embodiment have shapes and structures different from the first-structure antiglare layer and do not satisfy the inventions' three optical characteristics, this merely means that those layers do not embody the inventions; it does not negate enablement of the inventions.

② ... A person skilled in the art would seek to set measurement conditions to avoid fluctuations in the results. There is no evidence showing that conditions avoiding fluctuations cannot be set when obtaining the standard deviation of the luminance distribution in the inventions. Moreover, ... it cannot be supposed that a person skilled in the art would measure ... luminance distribution under conditions that produce a marked divergence from the sparkle perceived by display users. Accordingly, permissible conditions for measuring luminance distribution in the inventions are subject to limits, such as setting them so that results for the same antiglare film remain constant without fluctuation. A person skilled in the art can be inferred to set and measure under conditions within a reasonable range subject to those limits. ...

③ Difference 1-1: In Invention 1 the "antiglare layer" has "an internal haze value within the range of 0.5% to 8.0%, inclusive," whereas the cited invention's "internal haze value" is unknown. ...

Reference 2 ... states that specifying surface haze more specifically expresses the degree of unevenness (the surface diffusion element). ... The surface haze value defines the shape of the unevenness, which is technically inseparable from sparkle, so Reference 2 cannot be understood as suggesting adjustment of sparkle independently of surface haze. ... Well-Known Reference A1 also states that "internal haze is preferably 5–30%," but also states that "surface haze is preferably 20–50%." ... It therefore does not suggest adjusting sparkle independently of surface haze either.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91988.pdf

Tokyo District Court, 2022 (Wa) 9716 [5-Aminolevulinic Acid Phosphate] <Shibata>

Original Ameblo publication: 2023-08-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12816299668.html

Tokyo District Court, 2022 (Wa) 9716 [5-Aminolevulinic Acid Phosphate] <Shibata> July 28, 2023

<Whether the claim limitations are met>

An invention of a novel substance: the claim is satisfied even without isolation and even at low concentration!!

Cf. Tokyo High Court, 2003 (Ne) 3034 <Shinohara>

[Process for Producing a Morphologically Homogeneous Form of a Thiazole Derivative]

* The mixture was prior art ⇒ The invention was a particular crystalline form!

"... Taking the prosecution history into account ... on the premise that a mixture of Form A ... and Form B ... existed ... it was limited to the particular crystalline form ‘Form B famotidine.’"

<Invalidity>

Novelty upheld: The reasoning is the same as in Intellectual Property High Court, 2022 (Gyo-Ke) 10091 [5-Aminolevulinic Acid Phosphate] <Shoji>, March 22, 2023

⇒ Even if a substance's name appears in a cited reference, disclosure is not recognized unless a person skilled in the art is found able to carry it out without exercising creative ability through thought, trial and error, or similar efforts.

⇒ The cited reference and other materials, together with common general technical knowledge, must have enabled production of ‘the phosphate,’ at least as part of a mixture.

★ At the filing date, the phosphate was difficult to produce!!

⇒ This connects with the third requirement of the doctrine of equivalents!!

<Some observations>

In its analysis of whether the claim limitations were met, this judgment held that the accused products satisfied the claim merely by containing the invention's 5-aminolevulinic acid phosphate in a mixture, even though it was not isolated. At the beginning of its novelty analysis, the judgment stated, ‘It is not recognized that technology for obtaining 5-aminolevulinic acid in its free form was well known at the priority date.’ One might hastily think this contradicts the infringement analysis. Reading further, however, it stated that ‘it cannot be assessed that the compound 5-aminolevulinic acid phosphate was produced.’ The lack-of-novelty argument was rejected because a person skilled in the art was not found to have been able to produce the novel compound without exercising creative ability through thought, trial and error, or similar efforts at the priority date. In this case, the cited reference stated the substance's name (the invention's 5-aminolevulinic acid phosphate), but because a person skilled in the art was not found to have been able to carry it out without exercising creative ability through thought, trial and error, or similar efforts, disclosure in the reference was not recognized, or its eligibility as a cited invention was denied. Not only this judgment but many court decisions require that, for a cited invention to be recognized as disclosed in a reference, a person skilled in the art must be able to carry out the relevant configuration and other features without exercising creative ability through thought, trial and error, or similar efforts, based on the reference's disclosure and common general technical knowledge. Applied here, it was necessary that a person skilled in the art could produce ‘5-aminolevulinic acid phosphate’ at least as part of a mixture

without exercising creative ability through thought, trial and error, or similar efforts. However, the state of the art at the priority date made it difficult not only to isolate the substance but also to produce 5-aminolevulinic acid ‘phosphate’ even in a mixture. The lack-of-novelty argument was therefore rejected despite the name appearing in the reference. One should always keep in mind the possible counterargument, as in this case, that even if a published document names the compound of the invention, a person skilled in the art could not produce it without exercising creative ability through thought, trial and error, or similar efforts at the state of the art at the priority date. Thus there is no contradiction between this judgment's infringement and invalidity analyses. At the filing date (priority date), the skilled person could not produce the compound without exercising creative ability through thought, trial and error, or similar efforts, whereas infringement was found because the accused products actually contained the claimed compound. This was not a finding that the specification’s disclosure caused manufacture to become possible. Enablement and support are separate issues. This situation has something in common with the third requirement of the doctrine of equivalents. The third requirement concerns whether the substitution would have been easy at the time of manufacture or other relevant acts. The fourth concerns whether the accused product or process was identical to, or readily inferable from, the prior art at filing. The different assessment dates offer a point of comparison, but the subjects of the two inquiries also differ; equivalence does not require that a single form of ease change over time. However, under the general approach adopted by this and many other judgments, even where a published reference names the compound, novelty and inventive step are not immediately negated unless it can be proved that the skilled person could produce the compound without exercising creative ability through thought, trial and error, or similar efforts at the state of the art at the filing date (priority date). The first person to succeed in producing a particular compound within a mixture may therefore obtain a product patent without isolating it, provided the other patentability requirements are also met, and may enforce that patent against persons working mixtures containing the compound. Here, 5-aminolevulinic acid was known, the novel substance was its ‘phosphate,’ and the compound ‘5-aminolevulinic acid phosphate’ itself was expressly named in published literature. Where the invention's technical significance lies in first enabling manufacture of the ‘phosphate,’ there is room to debate whether granting a product patent rather than a manufacturing-process patent strikes the right balance, and whether enforcement should be allowed against alleged infringers who produce or otherwise deal in mixtures containing the compound through processes other than the one actually invented. This issue also relates to IP High Court, 2007 (Gyo-Ke) No. 10378 [Crystalline Azithromycin Dihydrate]. That judgment asked whether a skilled person could understand the cited reference as describing a product identical to the invention on the basis of the common general technical knowledge and state of the art before the priority date. It did not treat the mere factual existence of an identical product before that date as decisive. The court held that the cited reference did not disclose the invention’s configuration, without deciding whether the crystal described in that reference could objectively be identified as azithromycin dihydrate. Taking that reasoning as a starting point, one can consider the hypothetical case in which the substance was not actually new but the inventor first recognized its presence. Whether granting a product patent in that situation strikes the right balance, and whether enforcement should be allowed against alleged infringers continuing to manufacture and sell the prior art—products actually containing the substance although no one had noticed it—are matters of debate in relation to the public domain.

(Extract from the court's reasoning)

<Whether the claim limitations are met> ⇒ Because this is an invention of a novel substance, the claim is satisfied even without isolation and even at low concentration!!

The defendant argues that its products do not fall within the technical scope of the invention because they are amino-acid-containing foods, the 5-aminolevulinic acid phosphate is not isolated, and its purity is low. However, the invention concerns a novel chemical substance. Its purpose is to provide 5-aminolevulinic acid phosphate as a novel chemical substance, not to increase its purity. If it is the

invention's 5-aminolevulinic acid phosphate, it can be said to produce the invention's effects even if it is not isolated and even if its concentration in the containing product is not high.

<Invalidity (novelty)>

⇒ Novelty upheld (same reasoning as Intellectual Property High Court, 2022 (Gyo-Ke) 10091 <Shoji>)

... References Otsu 16–18 cannot be said to disclose technology for obtaining 5-aminolevulinic acid in its free form. In addition, ... the cited reference states that '5-ALA is ... chemically extremely unstable' and that 'only acidic aqueous solutions of 5-ALA HCl are shown to be sufficiently stable' ([0007]). Considering also that these matters were common general technical knowledge at the priority date, technology for obtaining 5-aminolevulinic acid in its free form cannot be recognized as well known at that date.

On this point, the plaintiff argues that production of 5-aminolevulinic acid phosphate does not require 5-ALA to have been extracted as a substance, and that it may remain mixed with culture-medium components and the like in a fermentation liquid. However, at the priority date, adding acid or base to a mixture containing various components was not recognized as common general technical knowledge for producing a salt compound. A skilled person encountering the cited reference at that date therefore could not, without exercising creative ability such as thought or trial and error, have found the method of adding phosphoric acid to fermentation liquid containing 5-aminolevulinic acid mixed with medium components (or adding that fermentation liquid to a phosphoric acid solution) as a method for producing the compound 5-aminolevulinic acid phosphate. Furthermore, ... as is also evident from Otsu 17's description of yeast extract, tryptone, and other ingredients in the medium, fermentation liquid mixed with medium components contains various ions as impurities. Even if phosphoric acid is added to such liquid, it cannot be assessed that the compound 5-aminolevulinic acid phosphate has been produced through neutralization of equal molar amounts of acid and base. ... There are no other circumstances indicating that a skilled person at the priority date could have found a method of producing or otherwise obtaining 5-ALA phosphate. ...

Accordingly, a skilled person encountering the cited reference at the priority date could not, without exercising creative ability such as thought or trial and error, have found a method of producing or otherwise obtaining 5-ALA phosphate based on the common general technical knowledge at that date. Thus 5-ALA phosphate cannot be identified as a cited invention from that reference.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92268.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12816621161.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

* The court identified the invention's problem as distinct from its physical-property requirements, and held that it was unnecessary for a product meeting the composition requirements to be likely to meet the physical-property requirements.

⇒ Glass meeting the composition requirements but not the physical-property requirements simply falls outside the claims.

Distinguished from Intellectual Property High Court, 2016 (Gyo-Ke) 10189 [Optical Glass] <Tsuruoka>!!

[Claim 1] ... Glass that is oxide glass having a liquidus temperature of 1140°C or below, a glass transition temperature of 672°C or above, a refractive index nd in the range of 1.825–1.850, and an Abbe number vd of 41.5–44

(Extract from the court's reasoning)

The plaintiff argues ... that some glass meets the composition requirements but not the physical-property requirements, making it impossible to find a correlation between satisfying the two sets of requirements ... .

However, the invention's problems are ... to further enhance the usefulness of high-refractive-index, low-dispersion glass by reducing the proportions of Gd, Ta, and Yb in its composition; to provide glass with superior thermal stability; and to provide glass suitable for machining. It seeks to solve those problems by adopting a configuration satisfying both the composition and physical-property requirements.

Accordingly, the composition and physical-property requirements cannot be said to stand in a problem-and-solution relationship. It is therefore unnecessary to recognize a relationship under which glass defined by the composition requirements has a high probability of satisfying every physical-property requirement, including glass transition temperature. The claims cover glass satisfying both sets of requirements; they do not assert that, throughout the entire numerical ranges of the composition requirements, every glass satisfying those requirements also satisfies the physical-property requirements. Any glass meeting the former but not the latter simply falls outside the claims. Moreover, in light of the numerical ranges described as preferred in the specification and the reasons for selecting them, it is difficult to find the composition ranges excessively broad. ...

(The plaintiff argues that the support requirement should be assessed here using the standard stated in another IP High Court judgment (Ko 7): ‘A person skilled in the art can recognize, from the description or suggestions in the detailed description or common general technical knowledge at the filing date, that the optical glass defined by the composition requirements is highly likely to satisfy the physical-property requirements.’ However, support must be assessed in relation to the invention's problem. In that other judgment, the problem was ‘providing optical glass with specified optical constants, a high refractive index and high dispersion, and a small partial dispersion ratio.’ It is inappropriate simply to apply to this case reasoning given as a fact-specific determination concerning a different problem in a different invention.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92153.pdf

Osaka District Court, 2018 (Wa) 5189 [Nutrient Supplement for Farmed Fish and Shellfish and Method for Producing It] <Tani>

Original Ameblo publication: 2023-08-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12816730871.html

Osaka District Court, 2018 (Wa) 5189 [Nutrient Supplement for Farmed Fish and Shellfish and Method for Producing It] <Tani>

* Working by a co-owner exhausted the patent right.

⇒ The manufacturing-process patent is exhausted with respect to those products already sold, too!!

= Appeal, Intellectual Property High Court, 2019 (Ne) 10065

"Where the defendant's products were manufactured as embodiments of the jointly owned patented invention and sold to the defendant company, the jointly owned patent right ... is exhausted."

※The IP High Court Grand Panel judgment in the Ink Tank case (not the Supreme Court judgment) stated in obiter dicta, broadly speaking, that a manufacturing-process patent is exhausted in circumstances where indirect infringement would otherwise arise. However, the passage '(... whether this is called "exhaustion" of the patent right or an "implied license" is merely a matter of expression)' has also been criticized.

⇒ By contrast, Osaka District Court, 2018 (Wa) 5189 is noteworthy for unequivocally stating that the right is 'exhausted.'

https://www.courts.go.jp/ip/vc-files/ip/file/10021.pdf

(Extract from the court's reasoning)

Defendant P2, a co-owner of the jointly owned patent right, ... can work the jointly owned patented invention without the plaintiff's consent. Thus, if P2 manufactured the defendant's products as embodiments of that invention and sold them to the defendant company, the jointly owned patent right would be exhausted as having achieved its purpose. The plaintiff, as another co-owner, could not exercise the patent right against the defendant company's transfer or other disposal of those products. The defendant company also sold to third parties products it had purchased from the dissolved company. Those products had been manufactured under a license from the plaintiff and Defendant P2, the joint patentees, and sold to the defendant company; the jointly owned patent right is therefore likewise considered exhausted for those products.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88930.pdf

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10073 <Kanno>, the zhiyun case

Original Ameblo publication: 2023-08-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12816838841.html

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10073 <Kanno>, the zhiyun case

Violation of Article 4(1)(vii) (contrary to public policy)

"This is a case of making large numbers of plagiaristic trademark applications under the guise of the first-to-file principle ... unrelated to the function of identifying commercial origin, to obtain financial gain ... . It is not merely a private issue between particular parties; there is a serious violation concerning the fair trading order itself."

(Extract from the court's reasoning)

Before September 24, 2018, the filing date of the trademark application at issue, the defendant had achieved substantial overseas sales of stabilizers and other products bearing the cited mark or similar marks. In Japan as well, gimbal heads and stabilizers bearing the cited mark or similar marks had been sold on Amazon Japan since no later than July 13, 2016. The defendant participated in a trade fair in 2017 and entered the Japanese market in earnest in 2018.

According to C above, this application was one of a large number filed by the plaintiff between September 25, 2017 and May 11, 2021. Twenty-two of those registrations were transferred within one or two years after registration; at least eighteen had been applied for after others began using similar marks. Many of the plaintiff's marks were distinctive coined words that could not plausibly have coincidentally matched the earlier marks, and the plaintiff also sought royalties for the mark at issue.

These circumstances compel the conclusion that the plaintiff is in the business of obtaining financial gain by filing applications for marks similar to others' earlier-used marks under the guise of the first-to-file principle. The mark at issue, too, is a coined word that cannot be regarded as Japanese or English and cannot be found independently devised by the plaintiff. It can be inferred that, knowing of the defendant's substantial overseas sales of stabilizers and gimbal heads bearing the cited mark, the plaintiff sought financial gain by obtaining the first Japanese registration for the same designated goods. In light of the circumstances leading to the application, granting registration would be gravely contrary to the fair trading order envisaged by the Trademark Act. The registration must therefore be regarded as contrary to public policy.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91769.pdf

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10090, the HEAVEN case

Original Ameblo publication: 2023-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12817283359.html

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10090, the HEAVEN case

Application: Class 43, ‘provision of food and drink at host clubs ...’

Cited mark: Class 43, ‘provision of Indian curry and Indian cuisine’

There are no special circumstances requiring Indian cuisine such as curry to be excluded from the food and drink provided at host clubs.

⇒ Likelihood of confusion as to commercial origin

⇒ Similar services

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91756.pdf

[Article] Methods of Calculating Royalties Based on ‘Use’ in U.S. Case Law (Hiroshi Takahashi, Patent 2022)

Original Ameblo publication: 2023-08-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12817384954.html

[Article] Methods of Calculating Royalties Based on ‘Use’ in U.S. Case Law (Hiroshi Takahashi, Patent, 2022, Vol. 75, No. 13)

In damages analysis in Japanese patent litigation, I have not found examples based on ‘use’ rather than sales volume.

⇒ Examines valuation based on ‘use,’ drawing on U.S. case law.

https://jpaa-patent.info/patent/viewPdf/4114

[Trademark / Two JPO Trial Decisions] Appeal 2022-10002; Invalidation 2022-890031

Original Ameblo publication: 2023-08-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12817552871.html

[Trademark / Two JPO Trial Decisions]

Appeal 2022-10002

Application: ‘チョコモ～モ～’ (‘Choco Moo Moo’)

Cited mark: ‘モーモーチョコ’ (‘Moo Moo Choco’)

⇒ Dissimilar

Invalidation 2022-890031

Registered mark: ‘Swan Angel’

Cited mark: ‘ANGEL SWAN’

⇒ Similar

‘It is natural to consider that consumers ... recognize and understand the constituent words as merely appearing in reverse order’; ‘No circumstances such as the generation of distinct concepts are recognized.’

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10114, Nonchallenge Obligation under a Settlement Agreement (‘will not interfere’)

Original Ameblo publication: 2023-08-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12817646544.html

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10114

A nonchallenge obligation under a settlement agreement (‘will not interfere’)

⇒ A request for non-use cancellation (Trademark Act, Article 50) violates good faith

⇒ The JPO decision allowing non-use cancellation was revoked

The defendant did not appear.

However, the clause does not automatically prevent an independent third party that is not bound by the agreement from requesting non-use cancellation, so the trademark owner cannot rely on the clause alone. A contracting party’s use of another person’s name requires a separate assessment under the agreement and the principle of good faith.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90916.pdf

Osaka District Court, 2020 (Wa) 7486 [Device for Instantaneously Removing Blood from Fish] ⇛ Joint inventorship affirmed

Original Ameblo publication: 2023-08-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818054706.html

Osaka District Court, 2020 (Wa) 7486 [Device for Instantaneously Removing Blood from Fish]

⇛ Joint inventorship affirmed

‘A creative contribution to completion of the characteristic part of the invention is required in the process of conceiving and concretizing a solution to the problem. The characteristic part ... means the part not found in the prior art ... that forms the basis of the invention's distinctive means of solving the problem.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90980.pdf

Intellectual Property High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

Original Ameblo publication: 2023-08-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818180628.html

Intellectual Property High Court, 2018 (Ne) 10034 [Solenoid] <Kanno>

<Damages for a jointly owned patent>

* Calculation under Patent Act Article 102(2)

— Deduct the royalty-equivalent amount payable to a co-owner under paragraph (3).

* Calculation under Patent Act Article 102(1)

— Unlike the presumption of damages under paragraph (2), the royalty-equivalent amount payable to a co-owner under paragraph (3) cannot be deducted.

(Extract from the court's reasoning)

For damages calculated under Patent Act Article 102(1), the amount obtained by multiplying the quantity of the articles constituting the infringing act transferred by the infringer by the profit per unit of the products the patentee or other right holder could have sold absent infringement does not include the nonworking co-owner's royalty-equivalent damages corresponding to the transferred quantity. Nor does that amount constitute a circumstance preventing the patentee or other right holder from selling all or part of that quantity. Therefore, unlike the presumption of damages under paragraph (2) discussed below, the nonworking co-owner's royalty-equivalent amount cannot be deducted.

... Royalty-equivalent damages may be claimed irrespective of whether the patent is worked. Even a co-owner who does not work the jointly owned patent may therefore receive royalty-equivalent damages presumed under Patent Act Article 102(3) when it is infringed. If the entire amount presumed under paragraph (2) were treated as the working co-owner's damage, the infringer would become liable for damages exceeding its actual profits. Accordingly, when a working co-owner claims the infringer's profits as damages under paragraph (2), the nonworking co-owner's damages presumed under paragraph (3) should be deducted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91122.pdf

Intellectual Property High Court, 2020 (Ne) 10004 [Light Irradiation Device] <Otaka>

Original Ameblo publication: 2023-08-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818315731.html

Intellectual Property High Court, 2020 (Ne) 10004 [Light Irradiation Device] <Otaka>

Note: Damages where the other co-owner also worked the invention

(The issue of ‘encroachment’ under a prior user right is also important!!)

‘... When the infringer alleges and proves that another co-owner works the patented invention, the presumption under paragraph (2) is rebutted ... through apportionment according to the extent of the other co-owner's working (the ratio of profits from working among the co-owners) ...’

(Extract from the court's reasoning)

The fact that the patent is jointly owned and that another co-owner earns profits from working the patented invention may constitute grounds for rebutting the presumption. Where the infringer alleges and proves joint ownership, the presumption is rebutted to the extent of royalty-equivalent damages under paragraph (3) corresponding to the other co-owner's ownership share. Where the infringer alleges and proves that another co-owner works the invention, it is appropriate to construe the paragraph (2) presumption as rebutted to the extent of damages apportioned according to that co-owner's extent of working (the ratio of profits from working among co-owners).

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E3%80%8C%E9%A3%9F%E3%81%84%E8%BE%BC%E3%81%BF%E3%80%8D%E3%81%AB%E3%82%88%E3%82%8B%E5%85%88%E4%BD%BF%E7%94%A8%E6%A8%A9%E3%81%AF%E4%B8%8D%E6%88%90/

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10151, the CORE ML case

Original Ameblo publication: 2023-08-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818452732.html

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10151, the CORE ML case

Applied-for mark: CORE ML

Cited trademarks: CORE and コア (Koa)

<Summary of the JPO decision and the defendant's argument> ML is an abbreviation for Machine Learning.

⇒ Recognized as a term indicating product quality

⇒ The first component, CORE, gives a strong, dominant impression and can therefore be extracted as the essential part

⇒ The JPO and the defendant considered the marks similar under Article 4(1)(xi) of the Trademark Act.
<Court's holding> In relation to the designated goods, CORE did not give a strongly dominant impression, and the source-identifying function of ML could not be said to be particularly weak. It was therefore impermissible to extract CORE alone for the similarity analysis.
⇒ Comparing the marks as a whole, the court found the applied-for mark dissimilar to both cited marks, CORE and コア (Koa), and revoked the JPO decision.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89516.pdf

IP High Court Grand Panel, 2019 (Ne) 10003 [Beauty Device] <Damages> Rebuttal circumstances: 50% under the proviso to Article 102(1)

Original Ameblo publication: 2023-09-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818608181.html

IP High Court Grand Panel, 2019 (Ne) 10003 [Beauty Device]

<Damages> Rebuttal circumstances: 50% under the proviso to Article 102(1)

Price difference: Plaintiff's product, 24,000 yen; defendant's products, 3,000–5,000 yen

Circumstances applicable to both parties' products

⇒ Not rebuttal circumstances

The plaintiff's product generates a microcurrent

⇒ The defendant's products have weaker customer-attracting power

⇒ Not rebuttal circumstances

<Rebuttal circumstances> Proviso to Article 102(1): Circumstances preventing the plaintiff from selling its product

Price difference: The plaintiff's product costs 24,000 yen, while the defendant's products cost 3,000–5,000 yen. Purchasers of the defendant's products would not necessarily have purchased the plaintiff's product if the defendant's products had not existed.

It is difficult to recognize any rule of experience that people buying goods from major mail-order retailers or department stores do not buy goods at discount stores or variety shops. Apart from the price difference, the differences in sales methods between the plaintiff's and defendant's products are not found to influence purchase motivations and cannot be recognized as circumstances preventing sales.

Competing products: There is insufficient evidence that products competing with the plaintiff's product were sold in the market, so this cannot be recognized as a circumstance preventing sales.

The defendant's asserted circumstance that ‘the bearing portion cannot be recognized from external appearance’ applies to both parties' products. Its existence therefore cannot mean that, absent the defendant's products, demand would not shift to the plaintiff's product. These circumstances cannot be recognized as preventing sales.

The plaintiff's product has a mechanism generating a microcurrent, whereas the defendant's products do not. This means that the defendant's products have weaker customer-attracting power than the plaintiff's product, and can hardly be considered a circumstance preventing demand from shifting to the plaintiff's product in their absence.

<Contribution rate>

The fact that Invention 2 is characterized by only part of the beauty device has already been considered in calculating the plaintiff's profit per unit, so it need not be considered again.

(Extract from the court's reasoning)

Circumstances under the proviso to Article 102(1)

(A) The first-instance defendant asserts differences in prices and retail outlets between the parties' products as circumstances preventing sales.

a. As stated in (2)C and (3)A above, the plaintiff's product is sold by major mail-order retailers and department stores for 23,800 yen or a similar price, whereas the defendant's products are sold at discount stores and variety shops for approximately 3,000–5,000 yen. The plaintiff's product is thus a relatively expensive beauty device, while the defendant's products cost only approximately one-eighth to one-fifth as much. Purchasers of the defendant's products would not necessarily have purchased the plaintiff's product in their absence. The price difference can therefore be recognized as a circumstance preventing sales.

Because this price difference is not small, the quantity corresponding to sales prevented by it is likewise recognized as not small.

On the other hand, both products are beauty devices. Given the nature of such goods, it can be inferred that a considerable number of customers do not prioritize price: they buy an inexpensive product if available, but buy an expensive one if no inexpensive option exists. Moreover, as stated in (3)A above, the plaintiff's product has platinum-coated roller surfaces and a solar panel generating a microcurrent, so its quality is higher than that of the defendant's products lacking these features. Thus, even at approximately 24,000 yen, the plaintiff's product can attract a certain number of customers for the defendant's products priced around 3,000–5,000 yen. Accordingly, the quantity corresponding to sales prevented by the price difference cannot be recognized as particularly large.

b. The price difference can thus be said to influence purchase motivations. However, it is difficult to recognize any rule of experience that people buying goods from major mail-order retailers or department stores do not buy goods at discount stores or variety shops. Apart from price, the differences in sales methods are not found to influence purchase motivations and cannot be recognized as circumstances preventing sales.

(B) The first-instance defendant asserts the existence of numerous competing products as a circumstance preventing sales.

At least 29 kinds of products of the same type as the parties' products were sold as of April 2019 (Otsu 176 and the entire purport of oral argument). However, the evidence is insufficient to establish that products competing with the plaintiff's product were sold in the market during the infringement period (December 4, 2015 to May 8, 2017). This cannot therefore be recognized as a circumstance preventing sales.

(C) The first-instance defendant argues that Invention 2 concerns a bearing, whose manufacturing cost is only a small part of the defendant's products' total manufacturing costs, and that the bearing is akin to an accessory; it asserts this as a circumstance preventing sales.

However, the fact that Invention 2 is characterized by only part of the beauty device has already been considered in calculating the plaintiff's profit per unit. It need not be considered again as a circumstance preventing sales.

(D) The first-instance defendant asserts that the bearing portion is not externally visible and that alternative technology exists, among other circumstances preventing sales.

However, these circumstances apply to both parties' products. Their existence therefore cannot mean that demand for the defendant's products would not shift to the plaintiff's product in their absence, and they cannot be recognized as circumstances preventing sales.

(E) The first-instance defendant asserts as a circumstance preventing sales that the plaintiff's product has a microcurrent-generating mechanism, whereas the defendant's products do not.

As stated in (3)A above, the plaintiff's product indeed has a microcurrent-generating mechanism, while the defendant's products do not. However, this means that the defendant's products have weaker customer-attracting power. It can hardly be considered a circumstance preventing demand from shifting to the plaintiff's product in their absence. It cannot therefore be recognized as a circumstance preventing sales.

(F) The first-instance defendant asserts its own sales efforts as a circumstance preventing sales. However, the evidence does not establish sales efforts of a degree sufficient to qualify as such a circumstance.

C. In view of the foregoing, taking account of the circumstances discussed in B(A)a above, it is appropriate to find that the quantity corresponding to the circumstance preventing sales is approximately 50% of the total.

Contribution rate

As stated in (3) and (5) above, when calculating the plaintiff's profit per unit, it is appropriate to deduct 60% from the full marginal profit to account for the degree to which Invention 2 contributes to profits from sales of the plaintiff's product. It is also appropriate to deduct 50% under the proviso to Patent Act Article 102(1) from the first-instance plaintiff's damages calculated by multiplying the defendant's sales quantity by that profit per unit. Even if the first-instance defendant's argument seeks a further reduction, separate from these deductions, based on Invention 2's contribution to sales of the defendant's products, there is no statutory provision or other basis permitting it. Such a further contribution-based reduction cannot be allowed.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E2%98%85%E3%80%91%E3%80%8C%E7%BE%8E%E5%AE%B9%E5%99%A8%E3%80%8D%E4%BA%8B%E4%BB%B6%EF%BC%8D%E7%89%B9%E8%A8%B1%E6%B3%95%EF%BC%91%EF%BC%90%EF%BC%92%E6%9D%A1%EF%BC%91/

Tokyo District Court, 2017 (Wa) 29228 [Fluid Supply Device] <Damages> Rebuttal of the Article 102(2) presumption: 40%

Original Ameblo publication: 2023-09-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818904762.html

Tokyo District Court, 2017 (Wa) 29228 [Fluid Supply Device]

<Damages> Rebuttal of the Article 102(2) presumption: 40%

(Note) The following concerns the damages analysis in the first-instance judgment. The appellate judgment of the Intellectual Property High Court of June 28, 2021, 2020 (Ne) 10044 [Fluid Supply Device] <Tsuruoka>, reversed the portion of the first-instance judgment in which the plaintiff prevailed and dismissed the claims relating to that portion.

In addition to market circumstances surrounding setting devices at gas stations, 'the defendant had strong business and other relationships with former EMG-affiliated gas stations.'

⇒ It could not be found that the plaintiff could have sold as many setting devices as the defendant sold.

<Rebuttal circumstances>

In light of market circumstances surrounding gas-station setting devices and the defendant's strong business and other relationships with former EMG-affiliated stations, the plaintiff could not be found capable of selling as many devices as the defendant sold. Rebuttal at a rate of 40%.

(Extract from the court's reasoning)

The presumption under Patent Act Article 102(2) is understood to be rebutted where circumstances disrupting an adequate causal relationship between the infringer's profits and the patentee's damage are established.

In light of the market circumstances described above and indications that the defendant had strong business and other relationships with former EMG-affiliated gas stations, it cannot be found that the plaintiff could have sold as many setting devices as the defendant sold. Circumstances disrupting an adequate causal relationship between the infringer's profits and the patentee's damage are therefore recognized. The foregoing establishes that the plaintiff could not have sold equivalent devices for at least 40% of the defendant's unit sales (total unit sales ●(omitted)● × 0.4 = ●(omitted)●). Consequently, the presumption of damages under Patent Act Article 102(2) arising from sales of the defendant's setting devices is rebutted by 40%.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%E3%80%90%E7%89%B9%E8%A8%B1%E2%98%85%E3%80%91%E7%89%B9%E8%A8%B1%E6%A8%A9%E4%BE%B5%E5%AE%B3%E5%B7%AE%E6%AD%A2%E7%AD%89%E8%AB%8B%E6%B1%82%E4%BA%8B%E4%BB%B6%EF%BC%88%E7%89%B9%E8%A8%B1%E6%A8%A9%E8%80%85/

Osaka District Court, 2017 (Wa) 7576 [Spacer for Foundation Packing] Grounds for rebutting the Article 102(2) presumption: 70%

Original Ameblo publication: 2023-09-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12818905126.html

Osaka District Court, 2017 (Wa) 7576 [Spacer for Foundation Packing]

<Damages> Grounds for rebutting the Article 102(2) presumption: 70%

The defendant's catalogue emphasizes matters other than the invention (strength and ventilation performance; stability of supply, quality, and price; and a labor-saving installation product with a distinctive, easy-to-cut shape, among other things).

The product may be used without producing the invention's effects.

<Grounds for rebutting the presumption>

The defendant's catalogue does not conclusively establish that the effect ‘does not hurt when held with bare hands’ arises from the ‘tapered portion.’ Nor does it mention the invention's effects.

The catalogue lists ‘fast installation’ among ‘six features,’ but does not explain the structure of the connecting portion described as a ‘coupling structure,’ how connection occurs, or its effects.

⇒ The catalogue emphasizes matters other than the invention (the product's strength and ventilation performance; stability of supply, quality, and price; and a labor-saving installation product with a distinctive, easy-to-cut shape, among other things).

This also applies to the plaintiff’s catalogues and those of other companies in the industry. Although the plaintiff’s catalogues mention the “tapered portion” and “connecting portion,” their structures are not specifically shown, and their effects are emphasized less than other features.

The defendant's product may be used in a manner that does not produce the invention's effects.

The defendant points to increased sales after changing the product's shape, but the data merely aggregate sales for four months after the change.

(Extract from the court's reasoning)

Rebuttal grounds

• Products asserted by the defendant to be competitors ⇒ Rejected because they were not recognized as competing products

• Considering the existence and degree of the technical significance of Patents 2 and 3 in Defendant Product 2 from the perspective of customer-attracting power, first, the defendant's catalogue states among its ‘six features’ that Product 2 ‘does not hurt when held with bare hands.’ Taking account also of the defendant's interpretation of ‘tapered portion,’ this could be understood to suggest such a portion, but it does not specifically explain what configuration makes the product painless to hold with bare hands. The accompanying photograph shows fingers inserted through the anchor-bolt opening and the entire palm gripping one of the members forming the long sides around that opening (Ko 4, Otsu 32). It therefore cannot be conclusively said that the effect arises from the tapered portion. Nor is there any reference to Effect 2 of Invention 2.

The catalogue also lists ‘fast installation’ among its six features, with the description ‘coupling structure’ attached to the connecting portion at one end of Defendant Product 2. However, it does not explain the structure of that connecting portion, the manner of connection, or its effects.

Rather, as found above, the catalogue emphasizes Product 2's strength and ventilation performance; stability of supply, quality, and price; and its labor-saving installation and distinctive, easy-to-cut shape, among other things.

This is also common to the plaintiff's and competitors' catalogues and other materials. Although the plaintiff's materials mention the tapered and connecting portions, their structures are not specifically shown, and their effects receive less emphasis than other descriptions.

Instead, easy installation around the entire perimeter and specially structured ventilation slits and rodent-proofing materials are prominently emphasized.

In addition to these circumstances, it cannot be denied that Defendant Product 2 may be used without producing Invention 2's effects. (However, because the proportion of such use in practice is unknown, this circumstance cannot be overemphasized in rebutting the presumption.) There are also, as stated above, other methods of preventing movement of the foundation packing member in the width direction. In view of this, although Inventions 2 and 3 have some customer-attracting power through ease of installation, the customer-attracting power attributable to Invention 2's tapered portion and the configurations in Elements 3C–3G of Invention 3 is relatively small.

The defendant points out that sales increased after changing Product 2's shape. However, the supporting material (Otsu 60) merely aggregates four months' sales after the change, and various factors may cause sales fluctuations. This circumstance therefore cannot immediately substantiate that Patents 2 and 3 have only a small influence on demand for Product 2.

Considering these circumstances comprehensively, it is appropriate to find the presumption under Patent Act Article 102(2) rebutted to the extent of 70%. The contrary arguments of both the plaintiff and defendant cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89022.pdf

Tokyo District Court, 2015 (Wa) 23843 [Raw Seaweed Foreign-Matter Removal Machine] <Damages> No rebuttal of the Article 102(2) presumption

Original Ameblo publication: 2023-09-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819017561.html

Tokyo District Court, 2015 (Wa) 23843 [Raw Seaweed Foreign-Matter Removal Machine]

<Damages> No rebuttal of the Article 102(2) presumption

The invention avoids co-rotation, prevents clogging of the clearance, and achieves efficient, continuous separation of foreign matter. It concerns a central structural part of the raw seaweed foreign-matter removal apparatus. ... A reduction in its contribution rate is inappropriate.

<Contribution rate>

The invention avoids co-rotation, prevents clogging of the clearance, and achieves efficient, continuous separation of foreign matter. It concerns a central structural part of the raw seaweed foreign-matter removal apparatus.

⇒ It is inappropriate to reduce the invention's contribution rate to sales of the defendant's products.

(Extract from the court's reasoning)

Contribution rate

The defendants argue that the inventions' contribution should be fully considered when calculating damages, specifying contribution rates of 10% for the defendant's apparatus, 25% for the fixed ring at issue, and 100% for the plate-shaped member at issue.

However, the inventions avoid co-rotation, prevent clearance clogging, and achieve efficient, continuous foreign-matter separation. They must be regarded as concerning a central structural part of the raw seaweed foreign-matter removal apparatus.

Even if conventional raw seaweed foreign-matter removal apparatuses passed a raw seaweed mixture through a clearance between a sorting casing (fixed ring) and a rotating disc to separate and remove foreign matter unable to pass through, those conventional devices clearly had the problems solved by the inventions. This is inferred to have a strong influence on customers' purchasing behavior. Considering this, and the absence of allegations or proof concerning current sales of conventional devices, working the inventions appears indispensable to customers for raw seaweed foreign-matter removal apparatuses.

Conversely, the defendants' arguments for reducing the inventions' contribution to their products all lack specificity.

It is therefore inappropriate to reduce the inventions' contribution rate to sales of the defendant's products.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87343.pdf

Tokyo District Court, 2015 (Wa) 16829 [Termite-Control Composition] <Damages> Grounds for rebutting the Article 102(2) presumption: 30%

Original Ameblo publication: 2023-09-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819157728.html

Tokyo District Court, 2015 (Wa) 16829 [Termite-Control Composition]

<Damages> Grounds for rebutting the Article 102(2) presumption: 30%

The invention's effects are among the most important effects of the defendant's product, a termite-control composition.

The defendant's customers are building contractors and the like; its sales efforts and continuing customer relationships played a substantial role in its sales.

<Rebuttal circumstances>

The invention's effects are among the most important effects of the defendant's termite-control composition and are strongly connected to customers' willingness to buy.

On the other hand, the customers are building contractors and the like, and the product is not of a nature to be retailed to ordinary consumers. It cannot be denied that factors such as the defendant's sales efforts and continuing customer relationships played a substantial role in its sales.

⇒ Substantial rebuttal of the presumption under Article 102(2) is not warranted. The presumption is rebutted to the extent of 30%.

(Extract from the court's reasoning) Rebuttal rate

The corrected invention's above effects are among the most important effects of the defendant's termite-control composition and are strongly connected to customers' willingness to buy.

On the other hand, the defendant's product is a termite-control agent applied to building materials in the foundation area beneath floors to form a coating. Its customers are building contractors and the like, and it is not of a nature to be retailed to ordinary consumers. It cannot be denied that the defendant's sales efforts and continuing customer relationships played a substantial role in sales. The evidence (Ko 6, 63, 64-1 and 64-2, 68, 76-1 and 76-2) establishes that distributors and architects who used the product offered opinions concerning its boric-acid content and introduced the inclusion of charcoal and boric acid as characteristics of the product. These facts also suggest that the defendant had built continuing relationships with customers.

As stated above, the corrected invention concerns the entire coating-forming termite-control composition, and its effects are strongly connected to customers' willingness to buy. Substantial rebuttal of the Article 102(2) presumption is therefore not warranted. On the other hand, it cannot be denied that the defendant's sales efforts and continuing customer relationships played a major role in sales. It is consequently appropriate to rebut the presumption in A above by 30% and find the plaintiff's damage from the defendant's patent infringement to be 70% of the damage stated in A.

https://gkchizai.exblog.jp/26142053/

Intellectual Property High Court, 2016 (Ne) 10082 [Raw Seaweed Foreign-Matter Separation and Removal Apparatus] No grounds to rebut the Article 102(2) presumption; contribution rate 100%

Original Ameblo publication: 2023-09-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819293124.html

Intellectual Property High Court, 2016 (Ne) 10082 [Raw Seaweed Foreign-Matter Separation and Removal Apparatus]

<Damages> No grounds to rebut the Article 102(2) presumption; contribution rate 100%

Even if the plaintiff is merely a manufacturer without personnel assigned to after-sales service, it cannot be said that, despite the invention's customer-attracting power, the plaintiff could not have had opportunities to sell to those customers.

<Contribution rate> <Grounds for rebutting the presumption>

Even if the plaintiff is merely a manufacturer without enough personnel to provide after-sales service like the defendant company, a distributor, it cannot be said that, despite the customer-attracting power of products embodying the invention, the plaintiff could not have had opportunities to sell to those customers. ⇒ Insufficient to rebut the presumption under Patent Act Article 102(2).

(Extract from the court's reasoning)

<Contribution rate>

Regarding the arguments concerning the inventions' contribution to sales, the inventions avoid co-rotation, prevent clearance clogging, and achieve efficient, continuous foreign-matter separation. They may be regarded as concerning a central structural part of the raw seaweed foreign-matter removal apparatus. Even if, as first-instance defendants Wanman and Seibu Kihan point out, conventional apparatuses passed a raw seaweed mixture through a clearance between a sorting casing (fixed ring) and a rotating disc to separate and remove foreign matter unable to pass through, those conventional devices clearly had the problems the inventions solve. This is inferred to have a strong influence on purchasing behavior. Considering this and the absence of allegations or proof concerning current sales of conventional devices, working the inventions appears indispensable to customers for such apparatuses.

Conversely, all grounds advanced by first-instance defendants Wanman and Seibu Kihan for reducing the inventions' contribution to the apparatus lack specificity.

Accordingly, it is inappropriate to reduce the inventions' contribution rate to sales of the apparatus and its components.

<Rebuttal grounds>

As to grounds for rebuttal, first-instance defendants Wanman and Seibu Kihan essentially argue only that, because the first-instance plaintiff is a manufacturer rather than a distributor, it cannot earn profits comparable to Wanman, which both manufactures and sells, or Seibu Kihan, which distributes. That asserted fact alone does not establish that, despite the customer-attracting power of products embodying the inventions, the plaintiff could not have had opportunities to sell to those customers. Nor are there any other special circumstances negating the loss of business opportunities.

The circumstances identified by Wanman and Seibu Kihan must therefore be regarded as insufficient to rebut the presumption under Article 102(2).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86532.pdf

Osaka District Court, 2021 (Wa) 10032 [Chip-Type Fuse] <Takemiya>

Original Ameblo publication: 2023-09-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819437709.html

Osaka District Court, 2021 (Wa) 10032 [Chip-Type Fuse] <Takemiya>

‘Even where an accused product lacks some claim elements of the patented invention, infringement by equivalence can arise if those elements are not essential parts ... and the other requirements are satisfied.’

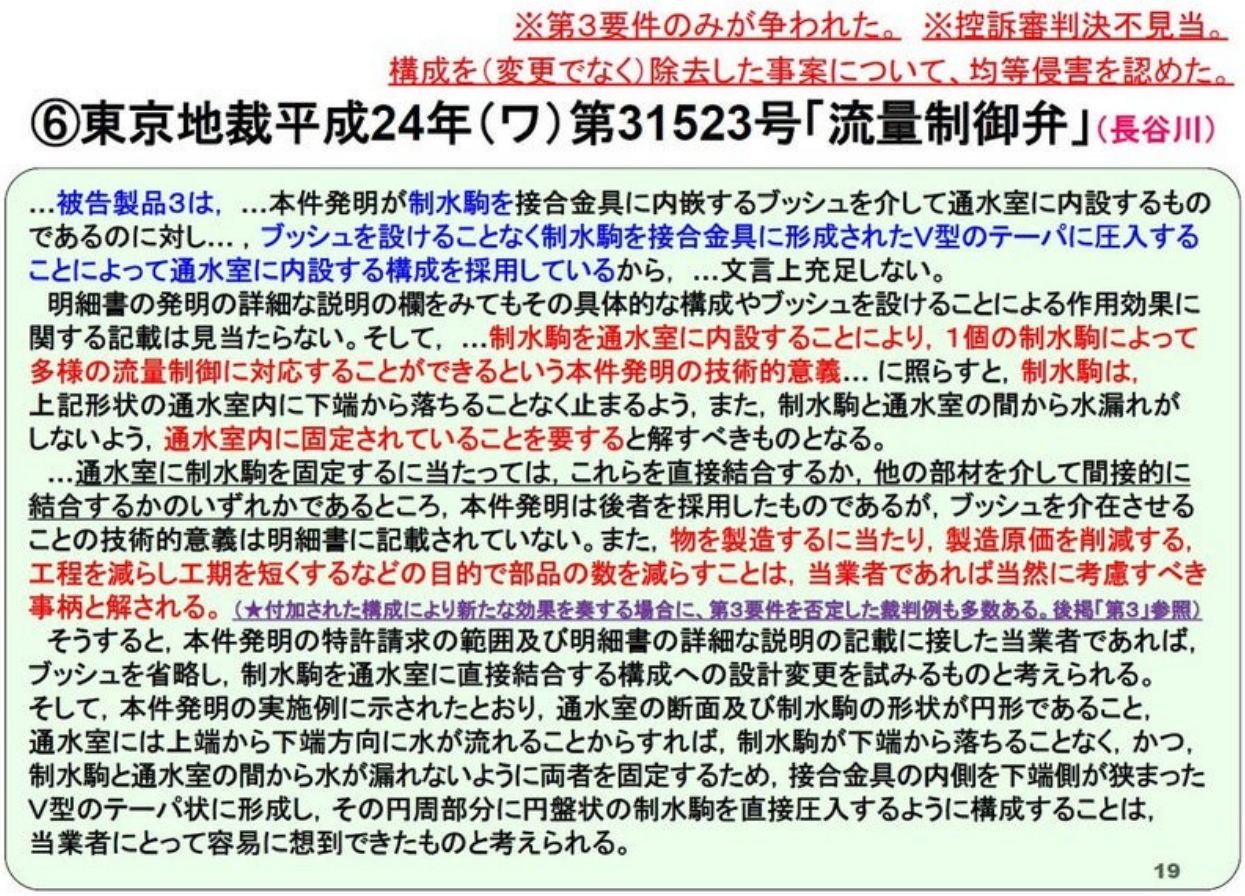
⇒ Equivalence not established in this case

Cf. Tokyo District Court, 2012 (Wa) 31523 <Hasegawa>: equivalence established

(Extract from the court's reasoning)

Even where an accused product or process lacks some claim elements of the patented invention, infringement by equivalence can arise if those elements are not essential parts and the other requirements for equivalence are satisfied. The defendant argues that applying the doctrine of equivalents where some elements are missing impermissibly expands the claims. However, there is no rational reason to distinguish replacing some elements with other configurations from omitting some elements. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92171.pdf



English translation of the slide — Tokyo District Court, 2012 (Wa) 31523, “Flow control valve” <Hasegawa>

The author’s introductory notes: Only the third requirement of the doctrine of equivalents was disputed. The slide states that no appellate judgment was located. The court found infringement by equivalence in a case involving the removal, rather than alteration, of a component.

Quoted reasoning (English translation of the slide, checked against the official judgment):

“… Defendants’ product 3 … differs from the invention, in which the water-control insert is installed in the water-flow chamber through a bushing fitted inside the coupling. … Product 3 instead omits the bushing and installs the insert in the chamber by press-fitting it into a V-shaped taper formed in the coupling. It therefore … does not literally satisfy [Element D].

“… Even the detailed description of the invention contains no description of the bushing’s specific construction or of the operation and effects achieved by providing it. In view of … the invention’s technical significance—namely, that installing the water-control insert in the water-flow chamber enables a single insert to accommodate various flow-control requirements …—the insert must be secured within the chamber of the shape described above so that it cannot fall out through the lower end and water cannot leak between the insert and the chamber.

“… The insert can be secured in the chamber either by joining the two directly or by connecting them indirectly through another component. The invention adopts the latter approach, but the specification does not explain the technical significance of interposing a bushing. Moreover, when manufacturing an article, reducing the number of components to cut manufacturing costs, reduce process steps, or shorten production time is a matter that a person skilled in the art would naturally consider.

“Accordingly, a person skilled in the art who read the claims and detailed description of the invention would be expected to attempt a design change that omitted the bushing and joined the insert directly to the chamber. As shown in the embodiment, the chamber has a circular cross-section and the insert is circular, and water flows from the upper end of the chamber toward its lower end. It would therefore have been easy for a person skilled in the art to conceive of forming the inside of the coupling as a V-shaped taper narrowing toward the lower end and directly press-fitting the disk-shaped insert into that circular tapered portion, thereby securing the insert so that it would not fall out through the lower end and water would not leak between the insert and the chamber.”

The author’s additional note on the slide: There are also many decisions finding that the third requirement is not satisfied where an added feature produces a new effect. The note refers to “Part 3” later in the source presentation.

Tokyo District Court, 2021 (Wa), 26762 [Hardener for Ground-Stabilization Chemical Solution] <Kokubu>

Original Ameblo publication: 2023-09-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819564286.html

Tokyo District Court, 2021 (Wa) 26762 [Hardener for Ground-Stabilization Chemical Solution] <Kokubu>

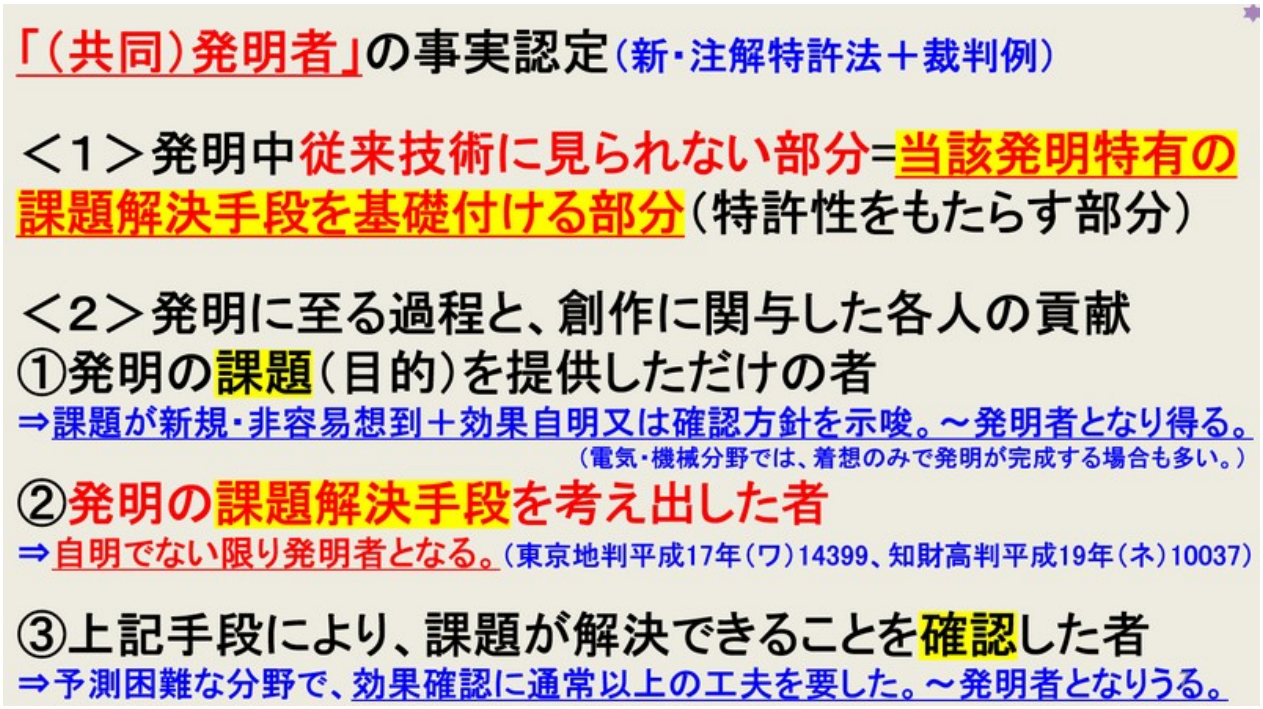
‘The hardener invention ... is encompassed by the patented invention ... but there is no evidence that Bi and Ci ... contributed to the creative activity ... of conceiving the configurations corresponding to the differences and concretizing them to complete the patented invention.’

⇒ Unauthorized appropriation of the invention not established (prior user right established)

(Extract from the court's reasoning)

The hardener invention is encompassed by the patented invention in Elements B2, D, G, H, and I, and the two are recognized as differing in those respects. They therefore cannot be considered identical. ... There is insufficient evidence that Bi and Ci contributed to creative activity conceiving and concretizing the configurations corresponding to the differences to complete the patented invention. Nor does the evidence as a whole establish that they invented it. They therefore cannot be recognized as the inventors of the patented invention. ... The patent cannot be said to have been granted on an application filed by a person not entitled to the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92102.pdf



English translation of the diagram — Determining inventorship, including joint inventorship

The author’s framework, based on Shin Chūkai Tokkyohō (“New commentary on the Patent Act”) and case law:

1. Identify the part of the invention that is absent from the prior art: the part that underpins the invention’s distinctive means of solving the problem (the part that gives rise to patentability).

2. Examine the process leading to the invention and each person’s contribution to its creation.

(i) A person who merely provided the problem or objective of the invention: if the problem is novel and not readily conceivable, and the effect is self-evident or the person suggested how to verify it, that person may qualify as an inventor. In the electrical and mechanical fields, an invention can often be completed through conception alone.

(ii) A person who conceived the means of solving the problem: that person qualifies as an inventor provided those means are not self-evident. The slide cites Tokyo District Court, 2005 (Wa) 14399, and IP High Court, 2007 (Ne) 10037.

(iii) A person who confirmed that those means solve the problem: in a field where results are difficult to predict, that person may qualify as an inventor if verifying the effect required more than routine ingenuity.

Tokyo District Court, 2012 (Wa) 35757 [Water-Erasable Ink Composition for Calligraphy and Painting]

Original Ameblo publication: 2023-09-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819765702.html

Tokyo District Court, 2012 (Wa) 35757 [Water-Erasable Ink Composition for Calligraphy and Painting]

<Damages> No rebuttal of the Patent Act Article 102(2) presumption; no contribution-based reduction

The defendant's product is named ‘Ink That Washes Out,’ its advertisements include comparative photographs from washing tests, and it features the ability to ‘remove stains accidentally transferred to clothing.’ This is the principal purchase motivation.

<Rebuttal circumstances>

The defendant's product is named ‘Ink That Washes Out,’ its advertisements include comparative photographs from washing tests, and it is sold with the ability to ‘remove stains accidentally transferred to clothing’ as its foremost feature. Producing the same effects as the inventions is the principal purchase motivation.

⇒ A post-infringement change in configuration does not establish that the invention's contribution was low.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84867.pdf

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10108, the Sushi Zanmai case

Original Ameblo publication: 2023-09-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819835642.html

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10108, the Sushi Zanmai case

The wording ‘Sushi Zanmai’ gives traders and consumers a strong, dominant impression as an indicator of the origin of goods and services.

⇒ The wording can be extracted as the essential part when assessing similarity.

The brush-calligraphy style is also common to both

⇒ Similar (violation of Trademark Act Article 4(1)(xi))

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90016.pdf

1　登録商標



引用商標 1

1　登録商標



English guide to the trademark images: The first image, labelled “Registered trademark,” shows the mark at issue. It contains “宅配専門” (“specializing in home delivery”) and “寿司ざんまい” (“Sushi Zanmai”). The second image, labelled “Cited trademark 1” and “Registered trademark,” contains “つきじ喜代村” (“Tsukiji Kiyomura”), “すしざんまい” (“Sushi Zanmai”), and “SUSHIZANMAI.” The original Japanese lettering is retained to show the marks as registered.

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10167, the GUZZILLA case <Takabe>

Original Ameblo publication: 2023-09-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12819972193.html

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10167, the GUZZILLA case <Takabe>

The further the opposition or invalidation proceedings progress without division of the trademark right, the more the party asserting invalidity comes to rely on the right remaining undivided.

⇒ Asserting division of the trademark right in this action is an abuse of rights.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89644.pdf

[Article] ‘Intellectual Property Local Benchmark’ (Tomohiko Inui) (Patent, 2020, Vol. 73, No. 9)

Original Ameblo publication: 2023-09-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820114048.html

[Article] ‘Intellectual Property Local Benchmark’ (Tomohiko Inui) (Patent, 2020, Vol. 73, No. 9) This article examines six intellectual property indicators modeled on the Local Benchmark formulated by the Ministry of Economy, Trade and Industry in March 2016.

① IP growth rate (IP sustainability)

② IP contribution rate (contribution)

③ IP productivity (productivity)

④ Licensing income–expense balance (soundness)

⑤ Average years of maintenance (efficiency)

⑥ Ratio of self-worked, self-owned IP (safety)

https://jpaa-patent.info/patent/viewPdf/3604

<IP LAB ①> Why Does ‘the Problem of the Invention at Issue’ Affect Inventive-Step Assessment?

Original Ameblo publication: 2023-09-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820114434.html

<IP LAB> Attorney Hideki Takaishi's Patent Channel ①

Why Does ‘the Problem of the Invention at Issue’ Affect Inventive-Step Assessment?

This is the first video I made when I started YouTube three years ago. It explains Japanese courts' approach to inventive step, the most important patentability requirement. (Recently, the JPO has generally taken a similar approach.)

https://www.youtube.com/watch?v=jIR0ckvmv3c

https://www.takaishihideki.com/_files/ugd/324a18_a734b0f7356e4b72891f8a16f910c022.pdf

This article fills in what is left between the lines in that video and explains the subject more fully.

<Contents>

1. Japanese Examination Guidelines, case law before establishment of the IP High Court, and European and U.S. practice

2. Japanese case law: ‘the problem of the invention at issue’ affects inventive-step assessment

3. Why does ‘the problem of the invention at issue’ affect inventive-step assessment?

<Main text>

1. Japanese Examination Guidelines, case law before establishment of the IP High Court, and European and U.S. practice

(1) JPO Examination Guidelines (Japan)

The Examination Guidelines treat a common problem between the primary and secondary cited inventions as one factor in assessing motivation to combine. A difference in their problems may weigh against motivation and in favor of inventive step, but related technical fields, common functions or operations, suggestions in the references, and other relevant factors are also considered together.

However, the Guidelines also explain: ‘Where the problem to be solved by the claimed invention is novel and is not one that a person skilled in the art would ordinarily conceive, the problems to be solved by the claimed invention and the primary cited invention are usually substantially different. Accordingly, the fact that the claimed invention's problem is novel and not one ordinarily conceived by a person skilled in the art may be a circumstance favoring inventive step.’ They thus explain [i] that differences between the problems of the invention at issue and the primary cited invention can affect inventive-step assessment.

(2) Case law before establishment of the IP High Court (Japan)

Some commentators on pre-IP High Court case law say that many judgments rejected inventive step where, even though the problems of the invention at issue and the primary cited invention differed, a skilled person at the priority date could readily combine the primary and secondary cited inventions using another problem or other consideration as a starting point. The Tokyo High Court's 2003 Sewing Machine judgment [ii] is sometimes cited as an example.

A close reading, however, shows that even the Sewing Machine judgment stated: ‘Where two inventions differ in configuration, it may be found that the configuration corresponding to the difference is not easily conceivable because the purpose of providing the configuration common to both differs; even then, the

difference in purpose does not itself become a difference between the inventions.' It thus held that different 'purposes' of the invention at issue and the primary cited invention could affect obviousness. Since 'purpose' and 'problem' here have essentially the same meaning, it too recognized that the invention's problem could matter.

Of course, based on my own detailed review of patent cases dating back to the Showa era, I perceive an increase around the establishment of the IP High Court—more precisely, from around 2010—in pro-patent inventive-step judgments emphasizing and specifically identifying the invention's problem. However, I consider this a change in the tendencies of problem identification and obviousness assessment themselves, not a change in the legal test as to whether 'the problem of the invention at issue' is a factor in inventive-step assessment.

(3) Current U.S. practice

Under current U.S. practice, even if the invention's 'problem' differs from the primary reference's problem, the invention is deemed obvious if the primary and secondary references can be combined for a problem different from the invention's own. This differs from Japanese practice. Explaining this distinction consciously when Japanese clients enter the U.S. phase, or when U.S. counsel requests Japanese entry, helps prosecution proceed smoothly and appropriately.

(4) Current European practice

The European Examination Guidelines (GL G-VII 5.2) adopt the 'problem-and-solution approach.' They state that, after identifying the closest prior art (CPA), obviousness is assessed by: a) identifying the distinguishing features over the CPA; b) identifying the technical effects of those features; and c) formulating the technical problem. They expressly note that the objective technical problem derived in this manner may differ from the 'problem' presented by the applicant in its application.

Thus, the European Guidelines differ somewhat from Japanese practice in determining the 'objective technical problem' to be solved by comparison with the prior art without being bound by the specification's wording. They are, however, the same as Japanese practice in that 'the problem of the invention at issue' affects inventive-step assessment.

French courts are said to have an approach close to the EPO. In a French judgment in a case with which I am actually involved, one of two asserted primary references was rejected because it was not the closest prior art (CPA). European strategy therefore must take account of differences from Japanese practice. For example, in Japan it is sometimes effective to use as the primary reference a known invention with many structural differences but the same problem. In Europe, strategy must account for a possible objection that it is not the CPA.

2. Japanese case law: 'the problem of the invention at issue' affects inventive-step assessment

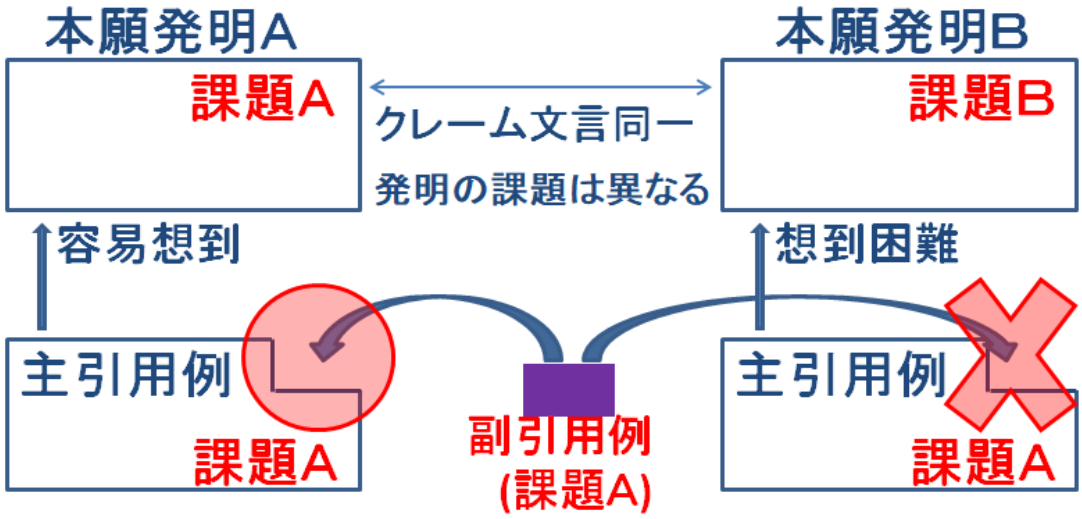
Since around 2008, inventive-step assessment has tended to emphasize differences between the problems of the invention at issue and the cited invention as a factor negating motivation to combine, and many cases identify the invention's 'problem' specifically[iii]. This tendency is, of course, an important factor favoring inventive step, but it is not the principal subject of this article and will not be explored further here.

That 'the problem of the invention at issue' affects inventive-step assessment in Japanese case law is illustrated, for example, by the IP High Court's 2011 Ventilation Fan Filter judgment [iv]. It held: 'Whether an invention could readily have been conceived is a comprehensive assessment. To find an invention easily conceivable, it is not enough merely that "adopting a particular configuration to solve the problem was easy"; it may also be necessary that "setting the problem to be solved was easy." In other words, even if adopting a particular configuration to solve the problem was easy, where "the setting of or focus on the problem was unique" (for example, where a problem not ordinarily conceived was identified), the invention cannot automatically be said to have been easily conceivable.'

Among recent judgments, the IP High Court's X-Ray Fluoroscopic Imaging Apparatus judgment [v] held: ‘It is entirely possible to evaluate the claimed invention as significant in newly identifying, from the operator's perspective, a problem concerning facilitating image adjustment. ... It cannot be said that, assuming the existence of that problem, ... there is motivation to adopt the configuration corresponding to the difference. ...’

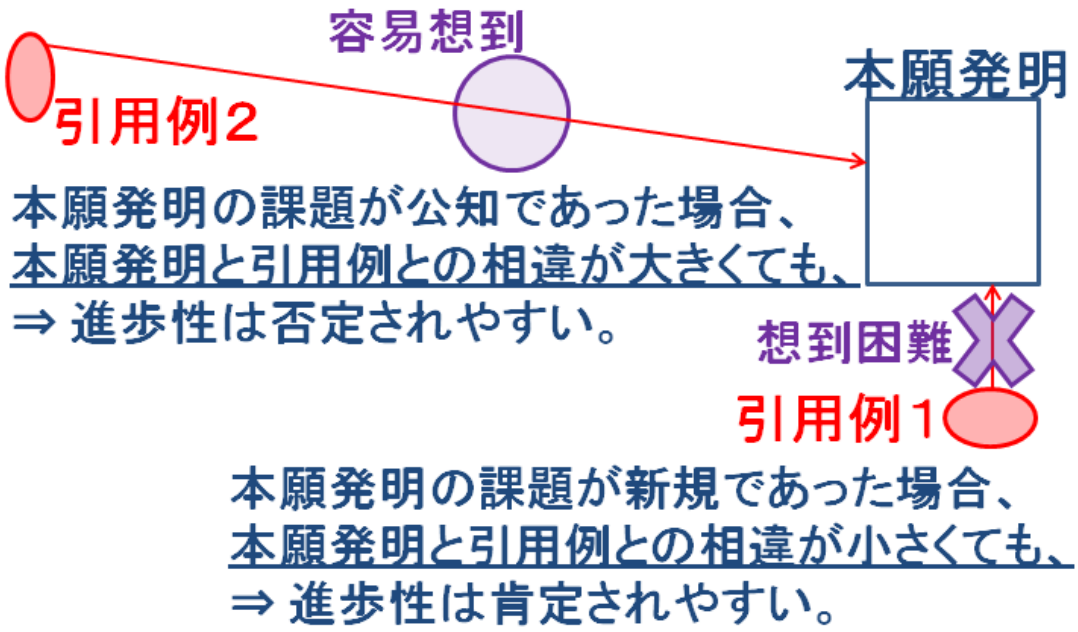
Figures 1 and 2 below illustrate this schematically. Even where the prior art is close to the claimed invention (there are few differences), inventive step is more readily affirmed if the invention's problem is novel. To understand this consistently with the JPO Examination Guidelines, one can view a problem different from the prior art's as producing a ‘qualitatively different effect’ through its solution. This makes the understanding more coherent.

Conversely, even where the prior art is distant from the claimed invention (there are many differences), inventive step is more readily denied if the problem is known. By analogy with climbing a mountain, climbing a cliff from the ninth station is harder than following a mountain path from the foot. Thus, even with the same inventive configuration (identical claim wording), there is room for ingenuity in describing the ‘problem.’ When filing a patent application, it may therefore be necessary to reconsider working-example data from new perspectives.



<Figure 1: Even with identical claim wording, the invention's problem may affect the inventive-step determination.>

Figure 1 — translation of labels: Claimed Invention A / Claimed Invention B; Problem A / Problem B; identical claim wording; the problems of the inventions differ; obvious / not obvious; primary reference; secondary reference (Problem A).



<Figure 2: Prioritize as the primary reference an invention sharing the same problem over one with fewer differences.>

Figure 2 — translation of labels: Reference 2; obvious; claimed invention; Reference 1; not obvious. If the problem addressed by the claimed invention was already known, inventive step tends to be denied even when the differences between the claimed invention and the reference are substantial. If the problem addressed by the claimed invention was new, inventive step tends to be recognized even when the differences are small.

In summary, identifying the invention's ‘problem’ abstractly at a higher level of generality (a lower level of demand) tends toward denying inventive step, whereas identifying it concretely at a lower level of generality (a higher level of demand) tends toward affirming it. (This tendency is the reverse of the support requirement. For support, an abstract, less demanding problem may suffice even without high-level working examples or disclosure of a mechanism. Conversely, a concrete, more demanding problem raises the issue whether disclosure allows the skilled person to understand that the problem can be solved at that level, making support harder to satisfy. These interrelationships among patent-law issues complicate practice while leaving substantial room for ingenuity in the original specification even for exactly the same invention.)

When acting for a petitioner seeking invalidation for lack of inventive step, it is often more effective to use as the primary reference prior art sharing the invention's problem, even if it has many differences, and fill the differences with a secondary reference, rather than choosing prior art with few differences—provided the issue of ‘obviousness upon obviousness’ does not arise[vi]. Therefore, where combining two prior-art teachings leads to the invention, the ease of combination is at issue, but the conclusion may change depending on which is the primary reference[vii]. Arguing both directions of the combination is therefore worth considering in practice[viii].

3. Why does ‘the problem of the invention at issue’ affect inventive-step assessment?

(1) If an invention is understood as a ‘configuration,’ then even if the primary cited invention's problem differs from the invention's problem, shared problems between the primary and secondary references should lead to a finding of lack of inventive step whenever at least the invention's ‘configuration’ is easily conceivable. Thus, while similarities and differences between the primary and secondary references' problems would matter, similarities and differences between the invention's problem and that of the primary (or secondary) reference should not affect inventive-step assessment.

On this point, the courts' view is that an invention is a ‘technical idea (a technical problem and the means for solving it)’[ix]. When deciding whether one could arrive from the references at the ‘technical idea’ constituting the invention, the issue is whether the invention's problem can be solved. The predominant case law therefore treats similarities and differences between the invention's problem and that of the primary (or secondary) reference as affecting inventive-step assessment.

This article attempts to construct a rationale that reasonably explains this case-law trend, putting aside whether it is desirable.

(2) Patent Act Article 2(1) provides: ‘In this Act, “invention” means a highly advanced creation of technical ideas utilizing the laws of nature.’ Paragraph (2) provides: ‘In this Act, “patented invention” means an invention for which a patent has been granted.’ An invention possessing inventive step is therefore a ‘technical idea.’

The term ‘technical idea’ appears nowhere else in the Patent Act outside Article 2. Considering its ordinary meaning, in light of the description in the Industry–Academia Collaboration Keyword Dictionary, technology can be understood as concrete means for achieving a specified purpose that can be used in practice and transmitted as knowledge. Also, the Seisenban Nihon Kokugo Daijiten (Selected Edition of the Great Dictionary of the Japanese Language) defines ‘idea’ as ‘the content of what is thought ... the meaning understood within logical structures such as sentences and inferences.’ Redefined in patent terminology, a ‘technical idea’ can therefore be understood as ‘the thought content of concrete means for achieving the invention's problem-solving objective.’

Thus, an ‘invention’ under Japanese patent law can be understood as including not only the configuration (for a product invention) or steps (for a method invention) that are the concrete means of achieving the problem-solving objective, but also the ‘problem of the invention’ itself. This is why an IP High Court judgment expressly describes an ‘invention’ as a ‘technical idea (a technical problem and the means for solving it)’[x].

For example, in Japan, a ‘use invention’ (‘an invention based on (i) discovering an unknown attribute of a product and (ii) finding that the attribute makes the product suitable for a new use’) may have novelty and inventive step because its ‘use’ is an invention-defining feature, even when the product itself is known. As one instance, case law has recognized novelty and inventive step through limiting the patient population, for example by disease progression, even with the same active ingredient for the same disease[xi]. Thus, because novelty and inventive step may be recognized in Japan even where the configuration as a product is identical to the prior art, it is accepted in practice as a fundamental premise that an ‘invention’ under Japanese patent law is not confined to the configuration constituting concrete means for solving its problem.

As stated above, current U.S. practice finds an invention obvious even if its problem differs from the primary reference's, provided the primary and secondary references can be combined for a different problem. This is consistent with the U.S. patent-practice view that an ‘invention’ is a configuration and that intended use does not constitute an invention-defining feature for a product invention.

(Note) MPEP 2111.02 states that "The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case". For a statement of the purpose or intended use of the claimed invention, it requires an evaluation of whether the statement results in a structural difference (or, for process claims, a manipulative difference) between the claimed invention and the prior art, and states: "If so, the recitation serves to limit the claim." https://www.uspto.gov/web/offices/pac/mpep/s2111.html

Moreover, the Supreme Court's 2019 Topical Ophthalmic Formulations judgment [xii] held that, even where an earlier judgment finding both the configuration and use of a use invention easily conceivable had become final and binding, inventive step could still be recognized if there were ‘unforeseeable remarkable effects’[xiii]. On remand, the IP High Court found such effects and upheld inventive step[xiv]. Japan thus

goes beyond the use inventions described above, where the defining feature of use differs: even where an earlier judgment determining that all invention-defining features, including ‘use,’ were easily conceivable by the skilled person at the priority date [xv] has become final, inventive step may still be recognized depending on the invention's effects[xvi].

Patent Act Article 29(2) provides: ‘Where, before the patent application, a person with ordinary knowledge in the technical field to which the invention pertains could easily have made the invention based on inventions listed in the items of the preceding paragraph, a patent may not be granted for that invention notwithstanding that paragraph.’ Thus, if inventive step can be recognized depending on effects (= the invention could not ‘easily have been made’) even though the invention-defining features, including use, were easily conceivable at the priority date, ‘invention’ must encompass not only those features but at least its ‘effects’ as well.

The Supreme Court's Topical Ophthalmic Formulations judgment shows that it too proceeds on the fundamental premise that an ‘invention’ under Japanese patent law is not confined to the configuration constituting concrete means for solving the problem. Effects are the reverse side of a problem[xvii] (although it should be noted that the reverse side of an effect is not necessarily a problem: different problems may be solved to produce the same effect, so there is no one-to-one correspondence). Moreover, considering the invention's problem and effects when assessing whether its defining features were easily conceivable presents a relatively lower hurdle than recognizing inventive step from effects where those features were easily conceivable. The Supreme Court can therefore be understood as also presupposing this Japanese practice.

Accordingly, in light of the statutory text and the Supreme Court's Topical Ophthalmic Formulations judgment, an ‘invention’ may be understood not merely as configurations, steps, or invention-defining features, but as the concept comprising those together with the invention's problem and effects. This understanding accords with the majority of lower-court decisions and provides a coherent explanation of inventive-step assessment. It also more reasonably explains why the invention's problem affects support, addition of new matter, and other patent-law issues.

End

[i] Examination Guidelines, Part III, Chapter 2, Section 2, Inventive Step 3.3(2)

[ii] Tokyo High Court, February 27, 2003, Courts website / 2002 (Gyo-Ke) 58, Sewing Machine <Presiding Judge Yamashita>

[iii] Cases in which specific consideration of the invention’s problem, its effects, or its relationship to cited inventions supported a finding of inventive step

• IP High Court, December 25, 2008, Hanrei Jiho No. 2046, p. 134 / 2008 (Gyo-Ke) No. 10130, Radar

• IP High Court, January 28, 2009, Hanrei Jiho No. 2043, p. 117 / 2008 (Gyo-Ke) No. 10096, Circuit Connection Member

• IP High Court, May 27, 2010, Courts website / 2009 (Gyo-Ke) No. 10361, Method for Evaluating Resistance to Oil Staining

• IP High Court, November 30, 2011, Hanrei Jiho No. 2134, p. 116 / 2011 (Gyo-Ke) No. 10018, Use of Carbazole Compounds in Treating Congestive Heart Failure

• IP High Court, March 21, 2013, Courts website / 2012 (Gyo-Ke) No. 10262, Method for Forming a Glass Melt

• IP High Court, March 6, 2013, Hanrei Jiho No. 2197, p. 119 / 2012 (Gyo-Ke) No. 10278, Ventilation Fan Filter and Method for Producing It

• IP High Court, April 10, 2013, Courts website / 2012 (Gyo-Ke) No. 10328, Odor-Neutralizing and Liquid-Absorbing Waste Bag

• IP High Court, July 17, 2014, Courts website / 2013 (Gyo-Ke) No. 10242, Lighting Device

• IP High Court, December 10, 2015, Courts website / 2015 (Gyo-Ke) No. 10059, Agricultural Produce Sorting Apparatus

• IP High Court, November 16, 2016, Courts website / 2016 (Gyo-Ke) No. 10079, Tire

• IP High Court, February 7, 2017, Courts website / 2016 (Gyo-Ke) No. 10068, Pneumatic Tire;

• IP High Court, February 8, 2021, Courts website / 2020 (Gyo-Ke) No. 10001, (Meth)acrylic Acid Ester Copolymer <Presiding Judge Tsuruoka>

• IP High Court, April 15, 2021, Courts website / 2019 (Gyo-Ke) No. 10159, X-Ray Fluoroscopic Imaging Apparatus <Presiding Judge Kanno>; and many other cases

[iv] IP High Court, January 31, 2011, Hanrei Jiho No. 2107, p. 131 / 2010 (Gyo-Ke) No. 10075, Ventilation Fan Filter <Presiding Judge Iimura>

[v] IP High Court, April 15, 2021, Courts website / 2019 (Gyo-Ke) No. 10159, X-Ray Fluoroscopic Imaging Apparatus <Presiding Judge Kanno>

[vi] Hideki Takaishi, ‘The Reach of “Obviousness upon Obviousness” (The Position of a Third Prior-Art Reference)’ (Patent, Vol. 71, No. 13, 2018)

[vii] IP High Court, March 30, 2016, Courts website / 2014 (Ne) No. 10080 and related cases, Method for Producing Spinel-Type Lithium Manganate <Presiding Judge Shimizu>

[viii] IP High Court, January 17, 2017, Hanrei Times No. 1440, p. 137 / 2016 (Gyo-Ke) No. 10087, Surface Decoration Structure of an Article <Presiding Judge Takabe>, decided the issue in an action to revoke a JPO trial decision where both parties sought an assessment switching the primary and secondary references considered in that decision. Conversely, without both parties' agreement, an invalidity ground alleging lack of inventive step by switching the primary and secondary references cannot be raised in such an action because the subject matter of the litigation differs.

(Note) The official case summary of this judgment states (in translation): "This judgment held that, in this case, where Cited Inventions 1 to 3 were publicly known facts examined in the trial as inventions falling under Article 29(1)(iii) of the Patent Act, both parties accepted that the alternative argument be examined and determined in this action and did not wish it to go through examination and determination at the JPO, and the parties' arguments and evidence on that point had been fully presented, examining and determining the alternative argument was also permissible from the viewpoint of resolving the dispute in a single proceeding." The judgment thus cited, as reasons for permitting examination of the argument with the primary and secondary references switched, that the prior-art facts had been examined in the trial, that both parties accepted examination and determination in this action and did not wish it to go through the JPO, that the parties' arguments and evidence on that point had been fully presented, and the viewpoint of resolving the dispute in a single proceeding. https://www.courts.go.jp/assets/hanrei/hanrei-point_pdf-86435.pdf

[ix] IP High Court, March 17, 2021, Courts website / 2020 (Ne) No. 10052, Appeal Concerning a Claim for Registration of Partial Transfer of a Share in a Patent Right and Related Relief <Presiding Judge Otaka>

[x] Same as [ix].

[xi] IP High Court, January 12, 2023, Courts website / 2021 (Gyo-Ke) Nos. 10157 and 10155, Therapeutic Agent for Motor Disorders <Presiding Judge Honda>

[xii] Supreme Court, August 27, 2019, Shumin Vol. 262, p. 51 / 2018 (Gyo-Hi) No. 69, Topical Ophthalmic Formulations Containing ... Doxepin Derivatives

[xiii] Hideki Takaishi, ‘Supreme Court Judgment of August 27, 2019, 2018 (Gyo-Hi) No. 69, Eye Drops for Treating Allergic Eye Disease: The Comparator and Role of “Unforeseeable Remarkable Effects” in Inventive-Step Assessment’ (Patent, Vol. 73, No. 1, 2020)

[xiv] IP High Court, June 17, 2020, Hanrei Jiho No. 2461, p. 30 / 2019 (Gyo-Ke) No. 10118 <Presiding Judge Mori> (remand proceedings following the Supreme Court judgment)

[xv] IP High Court, July 30, 2014, Courts website / 2013 (Gyo-Ke) No. 10058 <Presiding Judge Tomita>

[xvi] The view that inventive step may be recognized depending on effects even where the invention-defining features are easily conceivable is called the independent-requirement theory. For example, Tokyo High Court, March 28, 2002, Courts website / 2000 (Gyo-Ke) No. 312, Baked Confectionery, held: ‘Effects that justify patentability for an invention whose configuration itself is found easily conceivable must be difficult to predict or discover for that configuration and, on that premise, would have to be exceptionally remarkable compared with the effects predicted or discovered for it.’ Tokyo High Court, December 25, 2003, Courts website / 2001 (Gyo-Ke) No. 499, Method for Producing Concrete Products, was to the same effect. These decisions indeed develop their general reasoning on the independent-requirement theory, but may also be understood as mere lip service while denying inventive step. One of the few cases actually recognizing inventive step under that theory is IP High Court, July 24, 2013, Courts website / 2012 (Gyo-Ke) No. 10207, Acid Addition Salts of Optically Active Piperidine Derivatives and Processes for Their Preparation <Presiding Judge Shitara>. (See Hideki Takaishi, ‘The Significance of “Qualitatively Different Effects” in Inventive-Step Assessment: An Integrated Understanding of “Problems” and “Qualitatively Different Effects” in the Obviousness Inquiry,’ Patent, Vol. 69, No. 5 [Supplement No. 15], 2016.)

[xvii] IP High Court, July 15, 2010, Hanrei Jiho No. 2088, p. 124 / 2009 (Gyo-Ke) No. 10238, Sunscreen Composition <Presiding Judge Iimura>

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10126, the Matsumoto Kiyoshi case <Otaka>

Original Ameblo publication: 2023-09-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820247573.html

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10126, the Matsumoto Kiyoshi case <Otaka>

Where, in light of the actual circumstances of trade, it is not found that, at the time of the trademark application, persons encountering a sound mark would ordinarily associate or recall a person's full name from the sounds constituting it ... the mark does not constitute a trademark containing ‘another person's name’ under Article 4(1)(viii) of the Trademark Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90553.pdf

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10017, the Air-Conditioned Clothing case <Takabe>

Original Ameblo publication: 2023-09-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820397901.html

[Trademark] Intellectual Property High Court, 2020 (Gyo-Ke) 10017, the Air-Conditioned Clothing case <Takabe>

To fall within ‘causing confusion with goods or services connected with another person's business’ under Article 51(1) of the Trademark Act, the specific manner in which the trademark is displayed must give rise to a concrete likelihood of confusion with goods, etc. connected with another person's business.

⇒ No confusion as to commercial origin

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89794.pdf



English guide to the trademark image: “空調風神服” (Kūchō Fūjin Fuku), comprising “空調” (air conditioning), “風神” (wind god), and “服” (clothing).

[Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036, the Pore-Care Lotion case

Original Ameblo publication: 2023-09-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820519455.html

[Unfair Competition Prevention Act] Tokyo District Court, 2018 (Wa) 29036, the Pore-Care Lotion case

⇒ Claim under Article 2(1)(i) of the Unfair Competition Prevention Act upheld

‘... When sold in stores, products are ordinarily displayed with the front of the outer box visible to consumers ... the central part that performs the function of distinguishing one's goods from others' goods or identifying commercial origin is the design on the front.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90083.pdf



English guide to the comparison image: The left pair shows the outer boxes, and the right pair shows the containers. In each pair, the plaintiff’s LaboLabo Super-Keana Lotion is on the left and the defendant’s Juliette Ray KEANA LOTION is on the right. The Japanese product descriptions “毛穴ローション” and “毛穴化粧水” both mean pore-care lotion.

[Copyright] Osaka High Court, 2019 (Ne) 1735, the Goldfish Telephone Booth case

Original Ameblo publication: 2023-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820915962.html

[Copyright] Osaka High Court, 2019 (Ne) 1735, the Goldfish Telephone Booth case

— Copyrightability upheld

‘It expresses an extraordinary scene ... bubbles could not ordinarily emerge from the earpiece of a telephone receiver either. ... It evokes the image of a telephone conversation in progress and makes a strong impression on the viewer. ... Individuality is manifested.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90019.pdf

[Unfair Competition Prevention Act] Osaka District Court, 2019 (Wa) 7786, Kyoto City University of Arts and Kyoto University of the Arts

Original Ameblo publication: 2023-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820916055.html

[Unfair Competition Prevention Act] Osaka District Court, 2019 (Wa) 7786

Plaintiff: Kyoto City University of Arts

Defendant: Kyoto University of the Arts

⇒ No violation of Article 2(1)(i) or (ii) of the Unfair Competition Prevention Act

Although well known,

'They differ in appearance and pronunciation. ... Their concepts ... differ as to whether they evoke Kyoto City as the operating entity. Actual trading circumstances ... if even a part differs ... they are distinguished as different universities.'

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89685.pdf

[Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10047, the Fukumai case — Article 50(1) of the Trademark Act: an implied license was found

Original Ameblo publication: 2023-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12820916209.html

[Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10047, the Fukumai case

Article 50(1) of the Trademark Act: an implied license was found

‘Given that the sticker at issue ... displays the registration certificate for the trademark at issue, the plaintiff ... knew that Katsuragaoka Development was selling “Fukumai 2018” with that sticker affixed to the rice-bag packaging ...’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91355.pdf



[Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) 35263, 2WAY-Compatible Oxygen Chamber

Original Ameblo publication: 2023-09-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821056781.html

[Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) 35263, 2WAY-Compatible Oxygen Chamber

Constitutes a trade secret under Article 2(6) of the Unfair Competition Prevention Act (secrecy management, usefulness, and non-public nature)

‘The ... assertion that the purpose was to inspect or check it is unnatural and unreasonable. ... However ... there is no ... evidence that the data were actually read out and acquired ... .’

Commentary including quotations from the judgment: https://www.ip-bengoshi.com/archives/5812

Intellectual Property High Court, 2006 (Gyo-Ke) 10053 [Tissue-Paper Storage Box] <Shinohara>

Original Ameblo publication: 2023-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821189126.html

Intellectual Property High Court, 2006 (Gyo-Ke) 10053 [Tissue-Paper Storage Box] <Shinohara>

* For a mechanical invention, the effect and function itself—'locking recesses (which press against each other at the innermost portions of the locking recesses) biting into the respective push-up pieces are formed'—was incorporated into the claim.

⇒ Treating this as a difference, novelty and inventive step were upheld

* Incorporating effects into claims has worked for a long time. It simply had not attracted attention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33572.pdf

Intellectual Property High Court, 2010 (Gyo-Ke) 10407 [Method for Operating a Wind Park] <Iimura>

Original Ameblo publication: 2023-09-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821507010.html

Intellectual Property High Court, 2010 (Gyo-Ke) 10407 [Method for Operating a Wind Park] <Iimura>

For an electrical invention, a function (= setting at 0–100% of rated output power) was incorporated into the claim; treating this as a difference, novelty and inventive step were upheld.

'The cited invention and the claimed invention differ in their problems to be solved ... and their means for solving them.' ⇒ A teaching away exists

(Extract from the court's reasoning)

In the invention disclosed in Reference 1, the purpose of adjusting individual wind-power installations within a range of 0 to 100% of their rated output power is to set the output power of the entire wind-power facility at the maximum permissible transmission capacity of the grid according to the grid voltage, not to make the output power of the entire wind-power facility lower than the grid's maximum permissible transmission capacity. In the invention disclosed in Reference 1, moreover, the maximum output power of the wind-power facility, obtained by adding the rated output power of the individual wind-power installations, exceeds the grid's maximum permissible transmission capacity. Therefore, setting the output power of the entire wind-power facility at 100% of rated output power would exceed that maximum permissible transmission capacity, and a setting producing output power exceeding the grid's maximum permissible transmission capacity in this way is not contemplated either. Accordingly, Reference 1 cannot be said to substantially disclose 'setting the output power of the entire wind-power facility at a desired value within a range of 0 to 100% (of its rated output power) according to the grid voltage.' ... The cited invention and the claimed invention differ in the problems to be solved. ... They differ in the means for solving those problems. ... There is a teaching away from combining the configuration relating to Difference 2 with the cited invention ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81852.pdf

[Copyright] Intellectual Property High Court, 2020 (Ne) 10018 <Tsuruoka>

Original Ameblo publication: 2023-09-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821507077.html

[Copyright] Intellectual Property High Court, 2020 (Ne) 10018 <Tsuruoka>

Unauthorized copying of fan-created works constitutes copyright infringement

‘Even where ... infringement of the copyright in the original work is established ... it cannot be said to constitute an abuse of rights to claim infringement of the copyright in the respective manga and seek damages, etc. ... on the basis of the portions in which copyright in a derivative work may arise.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89748.pdf

Intellectual Property High Court, 2009 (Gyo-Ke) 10153 [Method for Making a Cutting-Tool Insert ...] <Nakano>

Original Ameblo publication: 2023-09-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821732714.html

Intellectual Property High Court, 2009 (Gyo-Ke) 10153 [Method for Making a Cutting-Tool Insert ...] <Nakano>

* A case holding that the drawings in the cited reference did not disclose the claimed method invention

‘Figures 3 to 5 ... of the cited document ... do not describe a sequence of steps of providing a retaining member having geometrical features ... and joining that provided retaining member ... to a cutting body.’

(Extract from the court's reasoning)

Figures 3 to 5 ... of the cited document illustrate the recesses formed in the hard metal, and it is stated that a desired cross-sectional shape can be selected for those recesses ... . With respect to a method of forming a cutting tool for a lathe, the cited document ... describes the formation of geometrical features comprising grooves, dovetails, etc. in the cutting body, and the close fixation of hard metal to a retaining member by die-casting, pressing, molding, or casting. However, it cannot be said to describe that geometrical features comprising grooves, dovetails, etc. are formed in the retaining portion before the hard metal is fixed to that portion by casting or the like ... . Accordingly, the cited document cannot be said to describe a sequence of steps of providing a retaining member having geometrical features ... and joining that provided retaining member to a cutting body through those geometrical features.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-38193.pdf

Intellectual Property High Court, 2007 (Gyo-Ke) 10241 [Exhaust Valve for a Storage Bag]

Original Ameblo publication: 2023-09-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821732857.html

Intellectual Property High Court, 2007 (Gyo-Ke) 10241 [Exhaust Valve for a Storage Bag]

* A case in which a configuration could not be read from the drawings in the cited reference

‘... It is not impossible to see the lid body 2 as being rotated approximately three times, but ... drawings attached to an application ... are not necessarily as detailed or accurate as engineering drawings. Therefore, the mere fact that the depicted relative positions of the threaded portion 11 and threaded portion 21 in Figures 1 to 3 of Exhibit Ko 1 appear as described above ... does not permit limiting the invention in Ko 1 to one in which the lid body 2 is rotated “several turns” ... .’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-36376.pdf

Intellectual Property High Court, 2005 (Gyo-Ke) 10677 [Memory Control Device] <Mimura>

Original Ameblo publication: 2023-09-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12821865301.html

Intellectual Property High Court, 2005 (Gyo-Ke) 10677 [Memory Control Device] <Mimura>

* Motivation to adopt technology older than the cited invention was denied

⇒ Inventive step upheld

‘The cited invention ... takes the limitations on the access unit in the ... system as its premise and has ... as its objective ... . Therefore ... it does not provide an occasion to change to page mode, departing from that specific premise.’

(Extract from the court's reasoning)

The cited invention takes as its premise the limitations on the access unit in the nibble-mode access system and has as its objective enabling support for both nibble-mode and normal-mode access. Therefore, the mere facts that nibble-mode access and page-mode access are generally known as high-speed memory-access systems, or that page-mode access is known to be an older technology, do not provide an occasion for a person skilled in the art encountering the cited invention to depart from its specific premise and change the particular nibble-mode access system adopted there to page mode.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33477.pdf

Intellectual Property High Court, 2009 (Gyo-Ke) 10142 [Apparatus for Mixing Powder and Granules and Removing Fine Powder ...] <Nakano>

Original Ameblo publication: 2023-09-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822005883.html

Intellectual Property High Court, 2009 (Gyo-Ke) 10142 [Apparatus for Mixing Powder and Granules and Removing Fine Powder ...] <Nakano>

* Identity of technical field alone does not establish obviousness; motivation is required

* Outcomes differed by claim

‘Even if the technical fields or technical content are identical or closely related, or the purposes and functions are similar ... there may be countless technologies that can be combined ... circumstances linking them, for example a common problem and motivation based on it, are required.’

(Extract from the court's reasoning)

Even if the technical fields or technical content are identical or closely related, or the purposes and functions are similar, there may be countless technologies capable of being combined, and it goes without saying that not every such combination can be called obvious. In that sense, for a combination of technologies having a certain relationship, etc. as described above to be obvious to a person skilled in the art (a person having ordinary knowledge in the technical field to which the invention belongs), circumstances linking them, for example a common problem and motivation based on it, are necessary, and these are absent in this case ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80063.pdf

Intellectual Property High Court, 2011 (Gyo-Ke) 10193 [Chair-Type Massage Machine] <Shiotsuki>

Original Ameblo publication: 2023-09-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822140937.html

Intellectual Property High Court, 2011 (Gyo-Ke) 10193 [Chair-Type Massage Machine] <Shiotsuki>

‘It arises generally and is not a problem peculiar to Ko 2 ... through Ko 4 ... . For a person skilled in the art ... to minimize the projection amount when moving ... the treatment elements ... in order to solve the above general problem ... is a measure that may be taken as appropriate, even without any suggestion, etc. in the Ko 1 publication itself.’

(Extract from the court's reasoning)

... In the technical field of massage machines, ... problems such as danger to the user's body or a large load on the drive device when treatment elements are moved with a large amount of projection arise generally from moving treatment elements along the human body; they are not problems peculiar to cases in which the treatment elements are provided in the backrest, etc., as in the massage machines disclosed in the Ko 2 through Ko 4 publications. ... When a person skilled in the art encounters the Ko 1 invention, which provides moving treatment elements for the legs, that person may recognize the above general problems concerning movement of the treatment elements and, to solve them, apply well-known technical matters to the Ko 1 invention. It should be said that, even without any suggestion, etc. in the Ko 1 publication itself, that person may appropriately minimize the projection amount, namely put the elements into a non-projecting state, or appropriately adjust that amount downward when the control circuit moves the treatment elements (together with the leg-support platform) in response to input such as operation of a switch.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82035.pdf

Intellectual Property High Court, 2010 (Gyo-Ke) 10318 [Storage Case for a Recording-Medium Disc] <Iimura>

Original Ameblo publication: 2023-09-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822273649.html

Intellectual Property High Court, 2010 (Gyo-Ke) 10318 [Storage Case for a Recording-Medium Disc] <Iimura>

* ‘As a result’ of applying well-known technology

⇒ Not ‘obviousness built upon obviousness’

‘On the basis of well-known technology, arranging ... at ... in the disc-storage case of the Ko 1 invention and, as a result, forming ... to project ... are ... matters that a person skilled in the art could readily conceive.’

(Extract from the court's reasoning)

... On the basis of the well-known technology exemplified in Ko 2 and Ko 13 through Ko 16, a person skilled in the art could readily conceive, in the disc-storage case of the Ko 1 invention, of arranging the peripheral walls at the upper and lower edges of the lid-side case member outside the peripheral walls at the upper and lower edges of the body-side case member, arranging the upper and lower hinge portions of the body-side case member outside those of the lid-side case member, and, as a result, forming the hinge shafts provided in the hinge portions of the body-side case member to project from the opposing inner surfaces of the upper and lower hinge portions.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81469.pdf

Intellectual Property High Court, 2011 (Gyo-Ke) 10364 [... Electric Motor with High Specific Output]

Original Ameblo publication: 2023-09-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822408137.html

Intellectual Property High Court, 2011 (Gyo-Ke) 10364 [... Electric Motor with High Specific Output]

* Enablement of an invention comprising multiple components should be examined component by component (Shojihomu, Analysis of Judgments Rescinding Patent Trial Decisions, p. 91)

* In this case, enablement was upheld despite some lack of clarity in the explanation of effects and in matters outside the claimed invention’s components.

* Enablement upheld although no upper limit was specified

* Enablement of the claimed invention, which comprises multiple components, should be examined for each component constituting the claimed invention. (* Analysis in Shojihomu, Analysis of Judgments Rescinding Patent Trial Decisions, p. 91.)

(Extract from the court's reasoning)

[Claim] A fluid-cooled electric motor comprising a motor housing made of a polymer material and containing a stator ... characterized by containing a thermally conductive, electrically insulating filler in an amount of at least 40% by weight

The claimed invention ... is a product invention, but it is an electric motor having the configuration recited in its claims (Section 2.2 above). Therefore, for the claimed invention to be enabled, it must be said that the detailed description of the invention in the application specification must specifically describe methods for producing the components constituting the claimed invention, or, even without such a description, a person skilled in the art must be able to produce those components on the basis of the specification and common general technical knowledge at the filing date.

... Paragraph [0006] of the application specification merely refers to the effects of the claimed invention and does not refer to a method of carrying it out. Therefore, even if that passage is unclear, this does not make it impossible for a person skilled in the art to produce the ‘polymer material’ and related components, which, among the components constituting the claimed invention, are particularly related to that passage. ...

... The defendant argues that the configuration of the claimed invention includes cases where the filler content is nearly 100% by weight, with the result that a person skilled in the art cannot readily implement a way of forming the motor housing. However, according to the description ... and Figure 1 of the application specification, it is clear that the ‘motor housing’ of the claimed invention is a structural component equipped with a pump, an electric micromotor, etc. It must be regarded as an obvious premise that it has sufficient strength, etc. to be usable as a ‘fluid-cooled electric motor with high specific output.’ As for the ‘polymer material’ constituting the motor housing, imagining the use of a material containing nearly 100% filler by weight and almost no duromer, its principal component, is itself an unreasonable premise. Accordingly, the defendant's argument cannot be accepted because it is inherently unreasonable.

The defendant also argues that, because the properties of the duromer (liquid epoxy resin) serving as the ‘polymer material’ of the claimed invention and the thermal conductivity of the filler (fine Al2O3 powder) are not uniquely determined, the effects of the claimed invention cannot be inferred; not only is the reason (criticality) why thermal conductivity markedly increases when duromer is contained in an amount of at least 40% by weight unclear, but the liquid epoxy resin and fine Al2O3 powder are also not specified sufficiently concretely for a person skilled in the art to carry out the invention. However, the existence of

effects and the technical significance of the weight ratio of duromer are each merely one of the factors that may be considered in assessing the obviousness of the claimed invention and do not directly relate to enablement. Moreover, the above liquid epoxy resin and fine Al2O3 powder are both readily obtainable as commercial products ... . Therefore, the absence of details of those materials in the application specification does not prevent a person skilled in the art from carrying out the claimed invention.

Paragraph [0014] of the application specification ... is somewhat unclear as Japanese ... and it would be desirable to amend it to make it clearer. However, ... neither the above ‘bearing’ nor the ‘shaft seal’ is a component constituting the claimed invention. Thus, even though the quoted passage is somewhat unclear as stated above, this does not make it impossible for a person skilled in the art to carry out the claimed invention. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82338.pdf

Intellectual Property High Court, 2021 (Gyo-Ke) 10053 [Method for Making a Container for Microwave-Heated Food] <Otaka>

Original Ameblo publication: 2023-09-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822614181.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10053 [Method for Making a Container for Microwave-Heated Food] <Otaka>

‘... In a container for microwave-heated food, the shape and extent of holes provided to release steam generated during heating are design matters that a person skilled in the art selects as appropriate, taking the amount of steam discharged into account.’

⇒ Inventive step denied

(Extract from the court's reasoning)

Reference 1 neither describes nor suggests limiting the shape of the ‘small holes’ provided in the lid of a container holding instant food to a particular shape, and neither describes nor suggests a specific method of forming those ‘small holes.’ ... In a container for microwave-heated food, the shape and extent of holes provided to release steam generated during heating are design matters that a person skilled in the art selects as appropriate, taking the amount of steam discharged into account. The opening area of each ‘small hole’ (opening 9) in the instant-food container of Example 1 described in Reference 1 is approximately 8.03 mm², and the total opening area is approximately 64.24 mm² (8.03 mm² × 8). ... In light of these matters, a person skilled in the art encountering References 1 and 5 would be motivated, in order to discharge to the outside the steam generated from the food contained in the instant-food container of Example 1 of Reference 1, to make the eight circular ‘small holes’ in the lid ‘elongated holes’ and, to form them, adopt the processing method disclosed in Reference 5, which uses laser irradiation to process a plastic structure to form through-holes no more than 200 μm wide, and attempt to set the width of those ‘elongated holes’ at no more than 200 μm (no more than 0.2 mm) so that their total opening area is approximately 64.24 mm². It is therefore found that that person could readily conceive of configuring the above ‘small holes’ as ‘an exhaust portion comprising a group of elongated exhaust holes formed by boring multiple elongated exhaust holes’ within the numerical range of ‘0.15–1.0 mm in width.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90972.pdf

Tokyo District Court, 2011 (Wa) 3292 [Battery-Powered Alarm] (Damages) <Osuga>

Original Ameblo publication: 2023-09-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822614433.html

2011 (Wa) 3292 [Battery-Powered Alarm] (Damages) <Osuga>

<Circumstances rebutting the presumption>

Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its products

It is appropriate to find that the proportions considered to have been substituted by other companies' competing products and the proportions considered to have been sold owing to the defendant's own sales capabilities, characteristics of the defendant's products other than the portions implementing the invention at issue, etc., taken together, constitute ‘circumstances under which [the plaintiff] would have been unable to sell’ its products. In light of the above circumstances, it is appropriate to regard the above quantity as 70%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84120.pdf

Intellectual Property High Court, 2013 (Ne) 10017 and 2013 (Ne) 10041 [Open-Type Fermentation Treatment Apparatus]

Original Ameblo publication: 2023-10-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822827625.html

Intellectual Property High Court, 2013 (Ne) 10017 and 2013 (Ne) 10041 [Open-Type Fermentation Treatment Apparatus]

<Proviso to Article 102(1)>

The only characteristic portion of the invention at issue is the ‘V-shaped scooping member’

Only a few of the numerous paddles

Minimal cost

The defendant’s pamphlet, the plaintiff’s website, and the product catalog do not present the adoption of a scooping member that prevents the accumulated material from spreading as a product feature.

<Grounds for rebutting the presumption> Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its products

The invention at issue is an improvement invention; the only characteristic portion forming the basis of the invention is the ‘V-shaped scooping member.’ The other configuration of the open-type fermentation apparatus lacks inventive step.

The ‘V-shaped scooping member’ is used only for one to a few paddles from the outer end of the rotary shaft located on the elongated open-side-face side, among the paddles comprising numerous long rods.

The cost of the ‘V-shaped scooping member’ is negligible compared with the cost of the open-type fermentation apparatus.

The defendant’s pamphlet, the plaintiff’s website, and the product catalog do not present the adoption of a scooping member that prevents the accumulated material from spreading as a product feature, and it cannot be said that the member’s shape made a major contribution to consumers’ motivation to purchase.

The ‘V-shaped scooping member’ is technically important.

The designs of the respective companies suggest that adoption of the shape of the ‘V-shaped scooping member’ was an essential improvement accompanying adoption of an open-type fermentation tank.

(Extract from the court's reasoning)

Grounds for rebuttal

Corrected Invention 2 at issue is an improvement invention over Invention 1 at issue, and the characteristic portion forming the basis of the invention is the V-shaped scooping member. As for the other configuration of the open-type fermentation apparatus, since Invention 1 at issue is invalid for lack of inventive step in comparison with the KS7-12 invention, as stated above, it does not possess inventive step. These circumstances should be considered as ‘circumstances under which sales could not have been made’ under the proviso to Article 102(1) of the Patent Act.

The configuration of Corrected Invention 2 other than the configuration relating to the V-shaped scooping member does not possess inventive step, and the characteristic portion forming the basis of the invention is confined to that scooping member. Furthermore, that scooping member is used only for at least one to a few paddles from the outer end of the rotary shaft located on the elongated open-side-face side, among the paddles comprising numerous long rods arranged axially around the peripheral surface of the rotary shaft. It

is also clear that the cost associated with the scooping member is negligible compared with the cost of the open-type fermentation apparatus. The defendant's pamphlet (Ko 5), plaintiff Nikkan Engineering's website (Otsu 12-1 to 12-3 and 68), and the product catalog (Ko 15) contain no description indicating as a feature the adoption of a scooping member capable of preventing the accumulated material from spreading toward the elongated open side face; it cannot be said that the shape of the scooping member made a major contribution to consumers' motivation to purchase.

However, as stated above, Corrected Invention 2 has the effect of preventing the accumulated material from spreading, collapsing, etc. when scooped outward, thereby eliminating inconveniences such as compost reaching the wheel tracks of the carriage traveling on the floor and obstructing smooth travel, and the need for the troublesome task of manually scooping up the material that has collapsed and spread outward with a shovel, etc. and piling it on the top surface of the accumulated material. As a configuration for this purpose, the V-shaped scooping member of Corrected Invention 2 was adopted for at least one to a few paddles from the outer end of the rotary shaft located on the elongated open-side-face side. The open-type fermentation apparatus does not adopt a pit-type fermentation tank with parallel elongated walls between which material to be treated is placed and accumulated; instead, one side is an elongated wall and the other is an elongated open side face. It is therefore inevitable that the accumulated material spreads toward the elongated open side face as the agitator reciprocates. In light of this, the V-shaped scooping member of Corrected Invention 2 is important as a configuration for preventing this. Indeed, according to the evidence cited below and the entire purport of the oral argument, the ‘Open-Type KS5-H1200 Mixer’ (the mixer at issue), manufactured by plaintiff Nikkan Engineering, sold to Ebara Corporation, and delivered and installed by that company at the ‘Compost Center’ located in [location omitted in source], underwent a post-delivery test run around March, 2000, but shortly thereafter, on May 8 of that year, its parts were replaced free of charge with triangular claws (V-shaped scooping members) (Ko 12-7; Otsu 15 and 16). Of the Type B apparatuses sold by the defendant to Suzuki Construction, the unit delivered to Masuda Farm likewise had its members replaced free of charge with scooping members 105d within two months of delivery, and when a unit was subsequently delivered to Oki Farm, scooping members 105d were fitted from the outset (Ko 6 and 7; Otsu 66). Embodiments of Patent 2 were not limited to the three units previously found to have been manufactured by plaintiff Nikkan Engineering under the contractually exclusive non-exclusive license at issue (License 2): V-shaped scooping members were also used in open-type fermentation apparatuses delivered and installed at ‘Eco Max Sendai,’ a compost manufacturing facility located in [location omitted in source], the ‘Oe Asahi Compost Center’ located in [location omitted in source], the ‘Namie Town Joint Organic Compost Center’ located in [location omitted in source], the ‘Sakegawa Village Compost Center’ located in [location omitted in source], and the ‘Nakayoshi Yuki Center’ located in [location omitted in source] (Ko 32–38, 57 and 61). Taking these matters together with the motivation and circumstances of development of Corrected Invention 2 described in Corrected Specification 2, it can be inferred that adoption of the V-shaped scooping member of Corrected Invention 2 was an essential improvement accompanying adoption of an open-type fermentation tank.

Considering the foregoing circumstances comprehensively, it is appropriate to find that, for 80% of the number of Type B apparatuses sold, there were circumstances under which plaintiff Nikkan Engineering would have been unable to make the sales.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84077.pdf

Intellectual Property High Court, 2019 (Gyo-Ke) 10043 [High-Contrast Tire Pattern] <Tsuruoka>

Original Ameblo publication: 2023-10-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12822964310.html

Intellectual Property High Court, 2019 (Gyo-Ke) 10043 [High-Contrast Tire Pattern] <Tsuruoka>

* Combining a secondary reference that solved a problem different from that of the primary reference was held obvious ‘for another reason’

⇒ Inventive step of a numerically limited invention denied

‘When combining it with the Ko 1 invention, setting surface roughness at 5 μm–30 μm is ... an appropriate design choice.’

⇒ Inventive step of the numerically limited invention denied

(Extract from the court's reasoning)

[Difference 2] Invention 3 at issue contains the feature that ‘the blade wall has, over at least one-quarter of its area, an average roughness Rz of 5 μm–30 μm, and the blade wall having this average roughness is located in the lower quarter of the blade height,’ whereas the Ko 1 invention does not specify the average roughness of the wall-like structure formed from numerous fine grooves 4. ...

... Improving the distinctiveness of a display mark is one means of improving the appearance of a tire, and if there is a means of further improving the appearance of the tire of the Ko 1 invention, it can be said to be desirable. ... Since the Ko 2 document is said to aim at improving appearance, a person skilled in the art encountering the Ko 1 invention would be expected to consider the content described in the Ko 2 document. ...

The matters described in the Ko 2 document are considered suitable for further improving the appearance of the tire of the Ko 1 invention, including the display-mark portion. Therefore, a person skilled in the art can be said to have sufficient motivation to attempt to combine the matters described in the Ko 2 document with the Ko 1 invention.

... The Ko 2 document contains no idea of increasing contrast; nevertheless, as is clear from the foregoing, combination with the Ko 1 invention would be attempted for another reason. ... When combining it with the Ko 1 invention, setting surface roughness at 5 μm–30 μm can be said to fall within the scope of matters that a person skilled in the art designs as appropriate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89248.pdf

Intellectual Property High Court, 2017 (Gyo-Ke) 10146 [Light-Guide Film] <Tsuruoka>

Original Ameblo publication: 2023-10-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12823106349.html

Intellectual Property High Court, 2017 (Gyo-Ke) 10146 [Light-Guide Film] <Tsuruoka>

* Inventive step of a parameter invention denied

‘The trial decision did not ... find obviousness ... by further combining the projections of Reference 3 ... with the cited invention and Reference 2 ... . The numerical ranges ... concerning the shape of the “bonded portion” of the claimed invention have no critical technical significance ... .’

(Extract from the court's reasoning)

... The plaintiff argues that ... although Reference 3 describes a structure in which projections are provided on the bottom surface of a prism having an upward-facing structure, those projections cannot immediately be moved to the prism's apex, and that further referring to Reference 3 after combining the technology described in Reference 2 with the cited invention constitutes so-called ‘obviousness built upon obviousness’ and is impermissible. However, the trial decision merely cites Reference 3 as one example (basis) for considering that a person skilled in the art could implement a shape (of a fixed portion) approximately 5 μm wide and 10 μm long within the range of well-known materials and production methods ... ; it did not find the configuration relating to the difference obvious by further combining the projections on the prism's bottom surface described in Reference 3 with the cited invention and the technology described in Reference 2. ... The numerical ranges in (1) through (3) above concerning the shape of the ‘bonded portion’ of the claimed invention are not found to have critical technical significance.

Full judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87773.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10012 and 10045 [Touch-Operated Input Device] <Kanno>

Original Ameblo publication: 2023-10-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12823240127.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10012 and 10045 [Touch-Operated Input Device] <Kanno>

* Even well-known technology requires motivation, etc. for combination

⇒ The court criticized combining the primary reference and the well-known technology after abstracting their respective technical fields to a higher level.

* Prevailed at first instance against Apple on the same patent: 2007 (Wa) 2525

⇒ Inventive step upheld

‘The Ko 1 invention does not, in the first place, have a function ... to be assigned to a push switch, and ... there is neither description nor suggestion of an operation ... confirming the running direction or running speed.’

(Extract from the court's reasoning)

... The touch panel of the Ko 1 invention for controlling the running direction and running speed of magnetic tape and Well-Known Technology 1 relating to a device for inputting positional data that does not include running direction or running speed differ in what they control. Even if both share the configuration of a touch panel, it cannot be said to be easy to apply Well-Known Technology 1, which relates to a device for inputting positional data, to the Ko 1 invention, which is a device for supplying magnetic-tape control signals. Ultimately, the plaintiffs' assertion that Well-Known Technology 1 can be applied to the Ko 1 invention attempts to apply substantially different technologies by abstracting them to a higher-level concept, and is inappropriate. ...

Even assuming that Well-Known Technology 1 is understood at a higher level of abstraction as technology that generates some input information by confirming a touch-panel selection with a push switch, the Ko 1 invention does not, in the first place, have a function to be assigned to a push switch (a function for confirming a selection). Moreover, although the Ko 1 document describes continuously controlling the running direction and speed of magnetic tape with a touch panel, it neither describes nor suggests an operation for confirming the running direction or speed selected on the touch panel or a configuration such as a button corresponding to that operation. There is therefore no motivation to apply Well-Known Technology 1 to the Ko 1 invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91805.pdf

Intellectual Property High Court, 2022 (Ne) 10061 [Magnetic Screen Device] <Honda>

Original Ameblo publication: 2023-10-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12823369472.html

Intellectual Property High Court, 2022 (Ne) 10061 [Magnetic Screen Device] <Honda>

(1) Addition or substitution of well-known, conventional technology + design matter

⇒ Violation of the extended prior-application rule

'The Otsu 10 publication contains no statement ... that there is a handle. ... At the time of filing, ... providing a handle on a case was a well-known and conventional means. ... It could be selected as appropriate when necessary for convenience in carrying, etc. ... .'

(2) Even if it does not fit entirely inside, it is 'housed'

⇒ Limitation satisfied

(Extract from the court's reasoning)

(1) ... The Otsu 10 publication discloses a configuration in which the pressing portion is fixed ... .

The Otsu 10 publication does not state that the pressing portion is rotatable. ... Making the portion that contacts a moving sheet-like object ... rotatable, and causing a roller to rotate as a result of sliding contact with a sheet, were ... well-known and conventional means at the time of filing, and this was likewise true in the field of magnetic screen devices such as Patent 1 at issue ... . Making a pressing portion whose cross-sectional shape is an arcuate surface rotatable, with the result that the pressing portion rotates owing to sliding contact with the screen that is unwound or wound while contacting it, is merely within the range of choices a person skilled in the art makes as appropriate in devising the configuration of the pressing portion ... .

The Otsu 10 publication contains no statement that the 'storage case' corresponding to ... the casing has a handle. ... At the time of filing, ... providing a handle on a case is found to have been a well-known and conventional means in the technical field of magnetic screen devices. Providing a handle on the storage case in Cited Invention 1-1 is also found to be something that a person skilled in the art could select as appropriate when necessary for convenience in carrying, etc.

(2) ... Regarding the position of the elongated member, Specification 1 contains statements concerning one embodiment such as 'The elongated member 30 is likewise housed inside the casing 40 adjacent to the screen sheet 10 in its wound state' ([0044]) and 'The elongated member 30 is positioned at the opening 46 of the casing 40' ([0048]); Figure 9 also depicts a configuration in which the elongated member is located inside the casing. However, there is no statement that the elongated member is housed inside the casing to protect it from dropping, vibration, collision, or soiling. Even in light of the remaining description in Specification 1, Invention 1 after the further correction cannot be interpreted as requiring the elongated member to be neatly contained inside the casing, without being exposed outside it, so as to be protected as much as possible from impact and soiling.

... In the appellee's product, most of the pressing roller is placed inside the main-body case, so the elongated member can be said to be housed in the casing. ... The limitation is satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91775.pdf

Tokyo District Court, 2021 (Wa) 26762 et al. [Hardener for Ground-Stabilizing Chemical Solution] <Kokubu>

Original Ameblo publication: 2023-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12823937535.html

2021 (Wa) 26762 et al. [Hardener for Ground-Stabilizing Chemical Solution] <Kokubu>

⇒ Prior-user right established; usurpation (unauthorized application by a non-entitled person) not found

‘The plaintiff filed ... the application ... more than fourteen years after leaving employment ... the possibility that the plaintiff completed the patented invention after leaving employment cannot be excluded ... and the defendants did not know the content of the patented invention ... .’

(Extract from the court's reasoning)

The hardener invention at issue is encompassed by the patented invention in respect of limitations B2, D, G, H, and I, and the two are found to differ in those respects. The patented invention and the hardener invention therefore cannot be said to be identical ... . There is insufficient evidence to find that Bi and Ci conceived the configuration relating to the differences between those inventions and contributed to the creative activity of concretizing it to complete the patented invention; nor can it be found from all the evidence in this case that the two invented the patented invention. Accordingly, Bi and Ci cannot be found to have been the inventors of the patented invention. ... The patent cannot be said to have been granted ... on an unauthorized application.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92102.pdf

Intellectual Property High Court, 2021 (Gyo-Ke) 10152 [Method for Resin-Sealing Permanent Magnets] <Honda>

Original Ameblo publication: 2023-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12823937904.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10152 [Method for Resin-Sealing Permanent Magnets] <Honda>

* A divisional application deleting a configuration essential to solving the problem

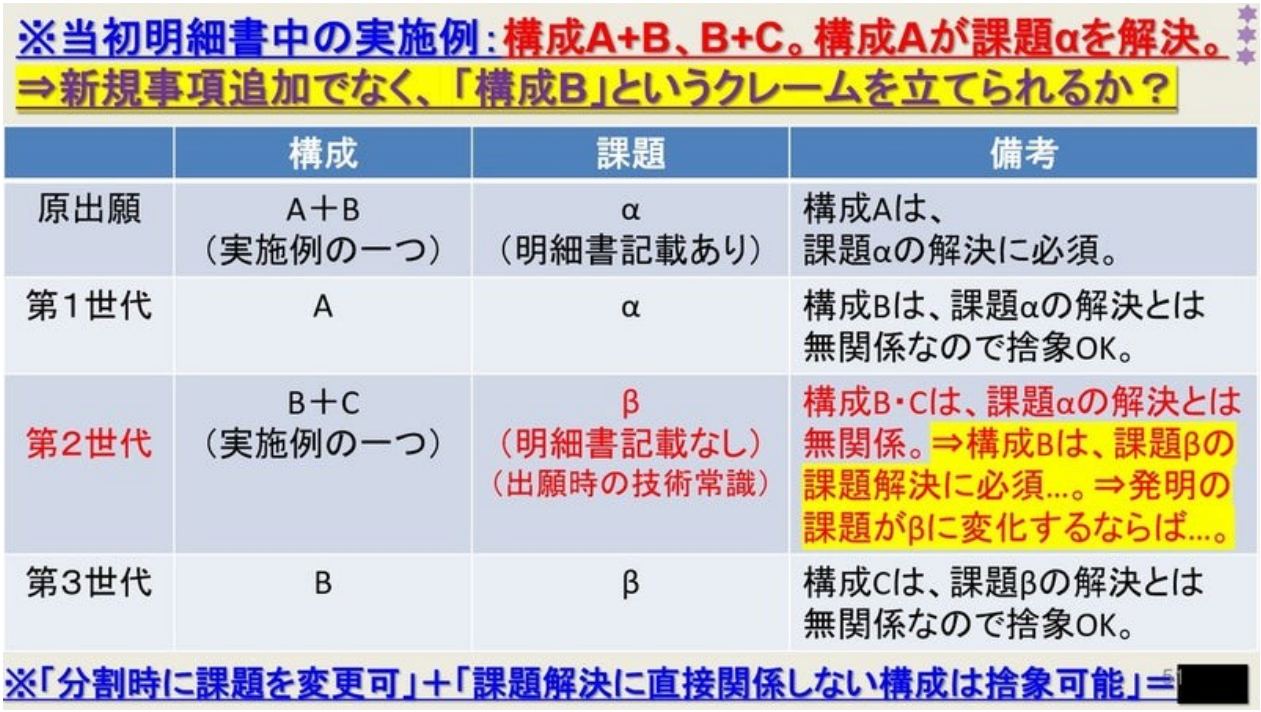
⇒ Support requirement not satisfied

‘According to ... the specification, a transport tray is an essential configuration for solving Problem 2 of the prior art ... nor is there evidence ... that an alternative configuration is clear ... to a person skilled in the art.’

(Extract from the court's reasoning)

Invention 1 includes not only an invention with a configuration including a transport tray carrying a laminated rotor core, but also an invention with a configuration without that transport tray. If the claims are taken as written without including the transport tray as a component, ... the invention cannot be said to fall within the scope in which it can be recognized that the problem of Invention 1—providing a method of resin-sealing permanent magnets permitting inexpensive operation—can be solved. ... Paragraph [0010] contains a detailed description of the invention premised on ... not making the transport tray an essential configuration. However, ... according to the detailed description in the specification, the transport tray is essential to solving Problem 2 of the prior art; thus, solving the problem of the invention without a transport tray is understood to require a configuration replacing it. Although the specification contains descriptions ... of the specific structure of the transport tray, it contains no description specifically suggesting a replacement configuration, and there is no evidence sufficient to establish that such a replacement would be clear to a person skilled in the art. Therefore, even in light of common general technical knowledge at filing, it cannot be said to fall within a scope in which a person skilled in the art could recognize, without any specific description in the detailed description, that the problem relating to the steps of fixing the laminated rotor core on the lower mold and removing it from that mold could be solved.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92382.pdf



Translation of the author’s explanatory diagram (a hypothetical sequence of divisional applications):

Premise and question: The embodiments in the original specification include feature combinations A + B and B + C. Feature A solves problem α. Can a claim directed to feature B be drafted without adding new matter?

The table has three substantive columns: Features; Problem; Remarks.

Original application — Features: A + B (one of the embodiments). Problem: α (stated in the specification). Remarks: Feature A is essential to solving problem α.

First generation — Features: A. Problem: α. Remarks: Feature B is unrelated to solving problem α, so it may be omitted.

Second generation — Features: B + C (one of the embodiments). Problem: β (not stated in the specification; common general technical knowledge at filing). Remarks: Features B and C are unrelated to solving problem α. Feature B is essential to solving problem β … Thus, if the problem addressed by the invention changes to β … .

Third generation — Features: B. Problem: β. Remarks: Feature C is unrelated to solving problem β, so it may be omitted.

The diagram’s concluding line reads: ‘The problem may be changed when filing a divisional application’ + ‘Features not directly related to solving the problem may be omitted’ ⇒ [text obscured in the source image].

Tokyo District Court, 2015 (Wa) 25780 [Ground-Improvement Device] <Shimasue>

Original Ameblo publication: 2023-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824047833.html

Tokyo District Court, 2015 (Wa) 25780 [Ground-Improvement Device] <Shimasue>

* Joint inventorship affirmed

⇒ Claim for confirmation of a co-ownership share upheld

‘It cannot be said that merely having the defendant's disclosure of the idea ... to the plaintiffs would make its construction as something concrete and objective and its repeated implementation no more than self-evident to the parties.’

(Extract from the court's reasoning)

The defendant merely showed the plaintiffs ... an idea for the basic configuration and handed over reference materials ... ; no fact is established that it went beyond this to provide a simple model, drawings, etc. ... The plaintiffs ... required more than six months, and manufacturing a product that actually operated required trial and error in adjusting the gears, etc. In view of these circumstances as well, it cannot be said that merely having the defendant's disclosure of the idea ... to the plaintiffs would make its construction as something concrete and objective and its repeated implementation no more than self-evident to the parties. Accordingly, in the process of concretizing the ... idea presented by the defendant's employees to a degree enabling implementation by a person skilled in the art, the plaintiffs made a commensurate creative contribution ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87456.pdf

Tokyo District Court, 2012 (Wa) 15621 [Cu-Ni-Si Alloy with Excellent Strength and Bendability] <Presiding Judge Takano; signed on his behalf by Judge Mitsui>

Original Ameblo publication: 2023-10-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824183089.html

Tokyo District Court, 2012 (Wa) 15621 [Cu-Ni-Si Alloy with Excellent Strength and Bendability] <Presiding Judge Takano; signed on his behalf by Judge Mitsui>

The ‘invention for which the patent application was filed’ is the invention after correction

⇒ The court rejected the defendant’s argument that the numerical range before correction should be used as the basis for determining the prior-user right.

★ This connects with the issue of ‘encroachment’ by a prior-user right!

Cf. Intellectual Property High Court, 2020 (Ne) 10004 [Light-Irradiation Device]

(Extract from the court's reasoning)

On the premise that the ‘invention for which the patent application was filed’ in Article 79 of the Act should be interpreted as meaning the invention in the application actually filed, the defendant argues that the local maximum values of the X-ray random intensity ratios of its respective prior-used products fell within the range of 2.0 to 10.0, inclusive, that applied before the First Correction at issue. However, because the trial decision concerning the Second Correction became final and binding, the patent application is deemed to have been filed on the basis of the specification, claims, or drawings after correction (Article 128 of the Act). It is therefore clear that the ‘invention for which the patent application was filed’ in this case is the invention after the Second Correction.

https://youtu.be/TwgRg2xPqa4

Intellectual Property High Court, 2019 (Gyo-Ke) 10126 <Tsuruoka> [Steel Sheet-Pile Press-In and Extraction Machine], third judgment

Original Ameblo publication: 2023-10-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824319969.html

Intellectual Property High Court, 2019 (Gyo-Ke) 10126 <Tsuruoka> [Steel Sheet-Pile Press-In and Extraction Machine], third judgment

Inventive step denied

No counterargument from the patentee throughout the trial decisions and judgments

Trial decision favorable to the patentee

Judgment unfavorable to the patentee

⇒ However, this is not a matter subject to deemed admission. This judgment reached its conclusion after assessing inventive step, etc.

(Extract from the court's reasoning)

It is established that similar invalidity grounds were asserted in the trial proceedings at issue and in the invalidation-trial proceedings relating to the second trial decision, so a conflict with the second trial decision, etc. is not entirely without issue. However, according to the same evidence, the invalidity grounds asserted in the two proceedings differed in their primary references as well as in the evidence submitted in support of them. Therefore, the plaintiff's assertion of lack of inventive step based on the Ko 1 invention in this case does not violate the effect of the second trial decision; nor is there sufficient evidence to find that the assertion reopens an already settled issue and thereby violates the principle of good faith.

★ For the scope of admissions, see Tokugikon No. 301 ↓↓

http://www.tokugikon.jp/gikonshi/301/301hanketsu.pdf

Intellectual Property High Court, 2020 (Gyo-Ke) 10054 [Nucleic-Acid Decomposition Treatment Apparatus] <Kanno>, second judgment

Original Ameblo publication: 2023-10-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824515153.html

Intellectual Property High Court, 2020 (Gyo-Ke) 10054 [Nucleic-Acid Decomposition Treatment Apparatus] <Kanno>, second judgment

* Second judgment after a request for correction following the first judgment denying inventive step

⇒ The court examined the obviousness of the configuration added by correction.

(* No discussion of its relationship to the other differences.)

‘It is further determined ... whether the configuration of Corrected Invention 2 ... can be called obvious.’

(Extract from the court's reasoning)

... Since actions to rescind trial decisions are governed by the Administrative Case Litigation Act, the binding effect of the above rescission judgment extends to the renewed examination and trial decision under Article 33(1) of that Act. This binding effect covers the factual findings and legal determinations necessary to derive the operative part of the judgment, and findings or determinations conflicting with those of the rescission judgment are impermissible (see Supreme Court, Third Petty Bench, judgment of April 28, 1992, Minshu Vol. 46, No. 4, p. 245). An action to rescind the trial decision challenging that trial must likewise be decided on that premise. ...

The trial decision at issue ... added to that difference the feature ‘characterized by maintaining the differential pressure inside the exposure chamber at a constant negative pressure,’ which was a configuration added to Corrected Invention 2 by the Correction at issue. In view of the foregoing sequence of events, assessing inventive step of Corrected Invention 2 requires ... further determining whether its configuration of ‘maintaining the differential pressure inside the exposure chamber at a constant negative pressure’ can be called obvious. ...

A person skilled in the art encountering Ko 1 and Ko 2 would be motivated, in order both to generate sterilizing gas of a stable concentration in the Ko 1 invention and to obtain a sufficiently assured sterilizing effect, to apply the configuration described in Ko 2 for controlling the formaldehyde-gas concentration, humidity, and temperature in the space to be sterilized to respective predetermined values and maintaining a constant pressure in that space. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90493.pdf

Intellectual Property High Court, 2014 (Gyo-Ke) 10057 [Deposit Terminal] <Ishii>

Original Ameblo publication: 2023-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824709803.html

Intellectual Property High Court, 2014 (Gyo-Ke) 10057 [Deposit Terminal] <Ishii>

* General principles for amendments increasing the number of claims

‘Article 17-2(5)(ii) of the Patent Act ... does not turn on whether the amendment increases the number of claims; rather, it is necessary and sufficient that (1) ... narrowing ..., (2) ... limitation ..., and (3) the industrial fields of application and the problems to be solved ... before and after amendment ... are the same.’

(Extract from the court's reasoning)

... Article 17-2(5)(ii) of the Patent Act ... clearly prescribes its requirements, including the parenthetical wording. Therefore, for an amendment to fall within one aimed at ‘narrowing the scope of claims’ under that item, the question is not whether it is a so-called amendment increasing the number of claims. Rather, it is necessary and sufficient to satisfy the requirements ... that (1) it narrows the scope of claims; (2) it limits matters necessary to specify the invention recited in the pre-amendment claim; and (3) the industrial fields of application and problems to be solved of the invention recited in that claim before amendment and the invention recited in that claim after amendment are identical ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84872.pdf

Intellectual Property High Court, 2011 (Gyo-Ke) 10115 [Cyclohexane Compound] <Takizawa>

Original Ameblo publication: 2023-10-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824853593.html

Intellectual Property High Court, 2011 (Gyo-Ke) 10115 [Cyclohexane Compound] <Takizawa>

* Eligible as a cited invention

The reference expressly states the dielectric-anisotropy and optical-anisotropy values of the cited invention, and thus its inventor had actually produced the cited invention.

The (pure) starting materials described in the reference were not difficult to obtain either.

(Extract from the court's reasoning)

There is no dispute that the claimed invention encompasses the cited invention, and the claimed invention ... claims a particular novel compound. Accordingly, for the claimed invention to be said to be described in the reference, a person skilled in the art must have been able to produce the cited invention encompassed by it by considering the reference's description and common general technical knowledge at the filing date. ...

... In attempting to synthesize the cited invention described in the reference, a person skilled in the art would recognize that the cited invention could be obtained by using ... . This is also corroborated by the fact that ... the reference expressly states the dielectric-anisotropy and optical-anisotropy values of the cited invention, and thus its inventor had actually produced it.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82053.pdf

Osaka District Court, 2008 (Wa) 10819, and its appellate judgment, Intellectual Property High Court, 2013 (Ne) 10026 <Iimura>

Original Ameblo publication: 2023-10-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12824994527.html

Osaka District Court, 2008 (Wa) 10819, and its appellate judgment, Intellectual Property High Court, 2013 (Ne) 10026 <Iimura>

[Method and Apparatus for Mixing Powder and Granules and Removing Fine Powder]

‘... The defendant's publicly worked invention cannot be said to fall within the technical scope of the respective patented inventions, and the assertion of a prior-user right lacks its premise ... .’

⇒ This decision, too, connects with the discussion of ‘encroachment’ by a prior-user right.

* Indirect infringement under item (iv) established for some of the Type B apparatuses

(Note) The first-instance court denied indirect infringement under Article 101(iv) of the Patent Act for the Type A product, but found indirect infringement under Article 101(v) in relation to Patented Invention 1 and under Article 101(ii) in relation to Patented Invention 2. For some Type B products, it found indirect infringement under Article 101(iv) in relation to Patented Invention 1. The following extract concerns the first-instance court’s determination under Article 101(iv) for the Type A product.

(Extract from the court's reasoning)

... The Type A product is not itself connected to a material supply source and is not an apparatus premised on processing multiple kinds of materials; its configuration also allows it to be used solely to remove fine powder from a single material. Accordingly, the Type A product is not a ‘product used exclusively for use of the process’ of Patented Invention 1. The defendant's acts concerning the Type A product therefore do not constitute indirect infringement under Article 101(iv) of the Patent Act of the patent right relating to Patented Invention 1.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83053.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10094 [Insole] <Honda>

Original Ameblo publication: 2023-10-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825135207.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10094 [Insole] <Honda>

‘For the cited invention ... in light of common general technical knowledge, etc., applying the Ko 2 technology based on the technical concept of adjusting a projection to an appropriate position, so as to adjust the position of the toe post more appropriately to an individual's foot ... and providing multiple toe-post mounting holes in the left-right direction as well would be ... readily conceivable.’

(Extract from the court's reasoning)

... The Ko 2 technology, too, can be said to present the technical concept of adjusting a projection to an appropriate position according to the dimensions and shapes of the shoe and foot, so that supporting the projection between the toes, etc. prevents friction between the toes and the shoe.

... It is a publicly known fact that the shapes, lengths, widths, etc. of toes differ among individuals, and it is found to be common general technical knowledge (the Technical Knowledge at issue) that the position of the interdigital cleft differs among individuals not only front-to-back but also left-to-right (Ko 3-1 and 3-2).

Furthermore, when walking in shoes, a foot can move within a certain range inside the shoe not only front-to-back but also left-to-right, depending on the dimensions and shapes of the shoe and foot, the direction of travel, road-surface conditions, etc. In such cases, the direction of movement is not clearly divided into front-to-back or left-to-right; movement in oblique directions can also be envisaged.

... In view of the foregoing, it should be said that a person skilled in the art encountering Ko 1 could readily conceive, with respect to the cited invention and in light of the ... common general technical knowledge, etc. described above, of applying the Ko 2 technology based on the technical concept of adjusting a projection to an appropriate position in order to adjust the toe-post position more appropriately to an individual's foot, and configuring the mounting position of toe post 14A located in the interdigital cleft between the first and second toes to have multiple toe-post mounting holes not only in the front-to-back direction of insole body 4A but also in the left-to-right direction.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92079.pdf

Intellectual Property High Court, 2022 (Ne) 10094 [Composition Containing ... Tetrafluoropropene] <Hibiku Shimizu>

Original Ameblo publication: 2023-10-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825253409.html

Intellectual Property High Court, 2022 (Ne) 10094 [Composition Containing ... Tetrafluoropropene] <Hibiku Shimizu>

Fourth generation of 2019 (Wa) 30991

The specification does not describe a problem.

⇒ Even if a problem could be inferred, the invention is not described in the specification, so the support requirement is not satisfied.

First instance, Tokyo District Court, 2021 (Wa) 29388: divisional-application requirements not satisfied (addition of new matter) ⇒ Novelty denied

(Extract from the court's reasoning)

... The specification can be said to state that HFO-1234yf is known to have a low global warming potential (GWP) and is a good candidate to replace high-GWP saturated HFC refrigerants; that small amounts of certain additional compounds are present when HFO-1234yf is prepared; that one of the additional compounds contained in the composition of the invention is less than approximately 1 weight percent HFC-143a; and that byproducts arising in the process of preparing HFO-1234yf, and impurities contained in HFO-1234yf or its starting materials (HCFC-243db, HCFO-1233xf, and HCFC-244bb), constitute additional compounds.

However, it is clear even from the wording of [0010] itself that HFO-1234yf was already known before the original filing date to be useful as a compound having a low global warming potential (GWP). Therefore, unless the specification describes what technical significance results from the presence of small amounts of additional compounds when preparing HFO-1234yf, what effects arise, and what problem is thereby solved, it cannot be said to describe the problem the invention sought to solve. Yet the specification says nothing about these points; nor does its remaining description contain any passage suggesting the problem the invention sought to solve. Under ‘Technical Field,’ the specification states: ‘The present disclosure relates to the field of compositions useful as heat-transfer compositions, aerosol propellants, foaming agents, blowing agents, solvents, cleaning agents, carrier fluids, displacement drying agents, buffing abrasives, polymerization media, expansion agents for polyolefins and polyurethanes, gaseous dielectrics, fire-extinguishing agents, and fire-extinguishing agents in liquid or gaseous form. In particular, the present disclosure relates to compositions useful as heat-transfer compositions, such as compositions containing 2,3,3,3,-tetrafluoropropene (HFO-1234yf or 1234yf), or 2,3-dichloro-1,1,1-trifluoropropane (HCFC-243db or 243db), 2-chloro-1,1,1-trifluoropropene (HCFO1233xf or 1233xf), or 2-chloro-1,1,1,2-tetrafluoropropane (HCFC-244bb)’ ([0001]). However, that passage merely explains the technical field to which the invention belongs and does not enable an understanding of the problem the invention seeks to solve. Accordingly, the ‘problem to be solved by the invention’ formally stated in the specification is insufficient as a description of the problem of this invention, and it must be said that the specification does not describe that problem. That being so, it also cannot be said that a person skilled in the art could recognize from the specification that the problem of the invention can be solved. ...

Even if the above wording of [0001] were understood as explaining the problem of the invention, ... that problem would have to be understood as ‘providing a composition useful as a heat-transfer composition,

such as a composition containing 2,3,3,3,-tetrafluoropropene (HFO-1234yf or 1234yf), or 2,3-dichloro-1,1,1-trifluoropropane (HCFC-243db or 243db), 2-chloro-1,1,1-trifluoropropene (HCFO-1233xf or 1233xf), or 2-chloro-1,1,1,2-tetrafluoropropane (HCFC-244bb).' The invention would then solve that problem through a composition containing (1) HFO-1234yf, (2) no more than 0.2 weight percent HFC-143a, and (3) no more than 1.9 weight percent HFC-254eb. However, the specification cannot be said to describe a composition containing (1) through (3). ... Moreover, the specification neither states nor suggests in what sense a composition having this configuration would be a 'useful' composition beyond the above usefulness of HFO-1234yf itself. Therefore, a person skilled in the art also could not understand from the specification that a composition having the configurations (1) through (3) is a composition 'useful' as a heat-transfer composition. Accordingly, a person skilled in the art would not recognize from the specification that the problem of the invention can be solved.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92407.pdf

[U.S. Patents] Netflix v. DivX (CAFC, September 11, 2023) – Analogous Art

Original Ameblo publication: 2023-10-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825329121.html

[U.S. Patents] Netflix v. DivX (CAFC, September 11, 2023) – Analogous Art

In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

⇒ The test for whether prior art constitutes 'analogous art' (eligibility as a cited invention)

– (1) Whether the art is from the same field of endeavor, regardless of the problem addressed;

or

– (2) If the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In Netflix, the PTAB held that Netflix had not argued (1), then rejected (2), and denied analogous-art status (eligibility as a cited invention).

By contrast, although the CAFC agreed with the PTAB on (2), it remanded to the PTAB for reconsideration of (1), holding that, viewed in substance, Netflix's arguments did address (1).

*** Even in the United States, (2) above from In re Bigio concerns the similarities and differences between the problem of the invention at issue and those of the primary and secondary references, so at first glance one might mistakenly think it is the same as in Japan. However, according to what I heard from U.S. counsel, in most cases the technical field is common under (1), so the analysis never reaches (2), making arguments under (2) weak. Indeed, in Netflix as well, (1) seems likely ultimately to be upheld on remand. Thus, differences between Japanese and U.S. inventive-step assessments still remain, and Netflix might even be understood as highlighting those differences instead.**

https://patent-law.hatenablog.com/entry/2023/09/24/210001

Tokyo District Court, 2020 (Wa) 25891 [... Filtered Cigarette] <Shibata>

Original Ameblo publication: 2023-10-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825643857.html

Tokyo District Court, 2020 (Wa) 25891 [... Filtered Cigarette] <Shibata>

'Mainstream smoke passes through without substantially contacting the smoke-modifying agent' means providing a channel to preserve taste quality, etc. that is not substantially altered by keeping the contents of the mainstream smoke from contacting the smoke-modifying agent.

⇒ The defendant's product has a smoke-modifying agent in a portion without a channel

⇒ Limitation not satisfied

= Appeal: Intellectual Property High Court, 2023 (Ne) No. 10015 <Hibiku Shimizu>

(Extract from the court's reasoning)

Limitation I provides that 'mainstream smoke passes through without substantially contacting the smoke-modifying agent.' As for the position on the cigarette of the 'smoke-modifying agent' that the mainstream smoke does not contact, the claims place a line break immediately before 'mainstream smoke passes through without substantially contacting the smoke-modifying agent' in limitation I, separating it from limitations A through H. In addition, the 'smoke-modifying agent' in limitation I is not worded, for example, as 'said smoke-modifying agent' so as to limit the agent concerned to a configuration described in another limitation. Accordingly, the claims can be understood as describing, respectively, the configurations of limitations A through H and the configuration of limitation I as configurations of the 'cigarette' (limitation J). On the face of the claims, the wording in limitation I that 'mainstream smoke passes through without substantially contacting the smoke-modifying agent' can be understood to mean that, in the cigarette of the invention, mainstream smoke generated in the tobacco rod does not substantially contact a smoke-modifying agent before reaching the mouth end.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92233.pdf

[Article / United States] Appellate Judgment on Licensing ‘Standard-Essential Patents’ Across Industries (Intellectual Property Management 73)

Original Ameblo publication: 2023-10-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825782275.html

[Article / United States] Appellate Judgment on Licensing ‘Standard-Essential Patents’ Across Industries — Continental Automotive Systems, Incorporated v. Avanci, L.L.C., et al. (Intellectual Property Management, Vol. 73, No. 6, 2023; Kazuyuki Saka)

U.S. Court of Appeals for the Fifth Circuit

In this case, the dismissal of the supplier’s claims under Sections 1 and 2 of the Sherman Act was affirmed with respect to licensing standard-essential patents to automobile manufacturers without licensing them to suppliers.

⇒ Implications for Japan's automobile industry and other industries

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2306

[Article / Copyright] Comparison of How Copyright Law Operates in Real Space and in Virtual and Digital Space (Intellectual Property Management)

Original Ameblo publication: 2023-10-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12825913447.html

[Article / Copyright] Comparison of How Copyright Law Operates in Real Space and in Virtual and Digital Space (Intellectual Property Management, Vol. 73, No. 6, 2023; Copyright Committee)

Dancing in real space = a performance

Metaverse space

⇒ A prevailing interpretation is that dancing in real space when motion data are captured constitutes a performance, but the linked avatar's simulated performance is not ‘that performance’

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2306

[Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10148 <Kanno>, the NICO case

Original Ameblo publication: 2023-10-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826045066.html

[Trademark] Intellectual Property High Court, 2021 (Gyo-Ke) 10148 <Kanno>, the NICO case

Applied-for mark: ‘natural baby soap / nico (stylized)’

Cited mark: ‘NICO / ニコ (Niko)’

⇒ The ‘nico’ portion of the applied-for mark may be assessed separately

Stylizing the letter o to depict a face is common

The illustration above the o is not unusual either and produces no particular concept

⇒ Similar

Cf. Intellectual Property High Court, 2011 (Gyo-Ke) 10093, the PAG case

https://www.fujimarks.jp/pdf/sp01_153.pdf



[Trademark] Intellectual Property High Court, 2011 (Gyo-Ke) 10093 <Iimura>, the PAG case

Original Ameblo publication: 2023-10-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826172582.html

[Trademark] Intellectual Property High Court, 2011 (Gyo-Ke) 10093 <Iimura>, the PAG case

Applied-for mark: ‘PAG (stylized)’

Cited mark: ‘PAG’

(1) ‘PAG’ and ‘!’ are in a distinctive typeface

(2) The letters PAG on the upper line evoke the initials of Point AD Game on the lower line

(3) An orange footprint-shaped figure provides an accent

⇒ Dissimilar

Cf. Intellectual Property High Court, 2021 (Gyo-Ke) 10148, the NICO case

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81715.pdf



[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10121 <Kanno>, the TART case

Original Ameblo publication: 2023-10-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826616882.html

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10121 <Kanno>, the TART case

Trademark at issue: Julius Tart

Cited mark: TART

‘There is a space, but ... the letters are in the same typeface and size ... and are not emphasized ... it cannot be called a well-known trademark ... “Tart” does not ... give a strong, dominant impression as an indication of commercial origin.’

⇒ Tart cannot be extracted as the essential portion

⇒ Dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92054.pdf

[Article] Legality of Dismissal of Amendments Under Article 53(1) of the Patent Act: ... (Patent Studies, March 2013; Hiroshi Yoshida)

Original Ameblo publication: 2023-10-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826617076.html

[Article] Legality of Dismissal of Amendments Under Article 53(1) of the Patent Act: Taking as a Starting Point a Case in Which Dismissal of an Amendment Was Held to Violate Due Process (Patent Studies, March 2013; Hiroshi Yoshida)

After a final notice of reasons for rejection, claim amendments are limited to deleting claims, restrictive narrowing, correcting errors, or clarifying ambiguous statements identified in the reasons for rejection. The article focuses on restrictive narrowing as an effective means of arguing patentability.

Under the statutory wording, the proviso to Article 50 does not require a notice of reasons for rejection when an amendment is dismissed under Article 53(1).

⇒ Rather than an inquiry, a notice of reasons for rejection should be issued to give the applicant an opportunity to amend.

https://www.inpit.go.jp/content/100526198.pdf

[Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10005 <Otaka>, the KAZE case

Original Ameblo publication: 2023-10-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826617253.html

[Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10005 <Otaka>, the KAZE case

Applied-for mark: KAZE (stylized)

Cited mark: KAZE

The stylized ‘A’ portion of ‘KAZE’ alone does not give a strong, dominant impression as an indication of commercial origin.

Both produce the pronunciation ‘kaze’ and share the concepts of ‘wind (air movement)’ and ‘a cold (illness).’

⇒ Similar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92195.pdf



[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10119 <Honda>, the CLEAR case

Original Ameblo publication: 2023-10-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826717183.html

[Trademark] Intellectual Property High Court, 2022 (Gyo-Ke) 10119 <Honda>, the CLEAR case

Applied-for mark: design + GINZA CLEAR

Cited marks: Clear, etc.

The ‘CLEAR’ lettering in the applied-for mark has strong source-identifying force, whereas the figurative portion and ‘GINZA’ lettering have weak source-identifying force

Pronounced stylization

Different typefaces

Gives a visually separate, independent impression

⇒ Extraction of the essential portion permitted

⇒ Similar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92087.pdf



[Trademark] Tokyo District Court, 2021 (Wa) 33526 <Sugiura>

Original Ameblo publication: 2023-11-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826858099.html

[Trademark] Tokyo District Court, 2021 (Wa) 33526 <Sugiura>

Trademark at issue: Barenai Futae (‘Undetectable Double Eyelids’)

Defendant's sign: Barenai Futae (‘Undetectable Double Eyelids,’ with different Japanese orthography)

‘It is perceived and understood as an explanation of the efficacy, etc. of the defendant's product—that the formation of double eyelids is not easily revealed to others ...—or as a catchphrase for such efficacy, etc.’

⇒ The right does not extend to the defendant's sign (Trademark Act, Article 26(1)(vi))

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92101.pdf

Osaka District Court, 2020 (Wa) 3473 [Lighting Fixture] <Matsuami> <Damages> Rebuttal of the presumption under Article 102(2): rebutted by 80%

Original Ameblo publication: 2023-11-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12826996220.html

Osaka District Court, 2020 (Wa) 3473 [Lighting Fixture] <Matsuami>

<Damages> Rebuttal of the presumption under Article 102(2): rebutted by 80%

<Grounds for rebutting the presumption>

(1) Significance 1 at issue—preventing deformation and damage to the exterior portion—is a function and element that a product should naturally ensure.

⇒ It can also be achieved through technologies other than the invention, such as choices of material, bracket-mounting method, and mounting-portion structure.

(2) Significance 3 contributes to reducing manufacturing costs by reducing the defect rate, but the extent of cost reduction (reflection in product prices) is unknown.

(3) Alternative technology: the fact that the plaintiff's successor product achieves similar effects through technology different from the invention is a circumstance rebutting the presumption to a large extent.

(4) Competing products: generally in approximately the same price range as the plaintiff's practicing product and the defendant's products.

(Extract from the court's reasoning)

Significance 1 at issue

Spotlight products generally had existed on the market long before the patented invention, and a mature market had already formed (Otsu 5; entire purport of the oral argument). According to a market-trend survey, development of spotlight products with high added value in color rendering, color temperature, etc. is expected (Otsu 30 and 31). Catalogs, etc. of the plaintiff, defendant, and competitors also appear to promote light-distribution control and characteristics, light color, lens design, energy savings, product size, lightness, design, etc. (Ko 5 and 6; Otsu 15, 16, and 25–29). By contrast, Significance 1, preventing deformation and damage to the exterior portion, may be said to be, so to speak, a function and element that a product should naturally ensure. Moreover, it can also be achieved through technologies other than the respective inventions, such as choices of material, bracket-mounting method, and mounting-portion structure, and is considered to be an effect generally achieved in practice by lighting-fixture manufacturers.

Since 2014, the plaintiff has also sold, under the same series and product names as its practicing product, a successor product that prevents deformation and damage to the exterior portion by attaching the bracket to the exterior portion rather than the heat-dissipating portion and making the exterior portion thick-walled (entire purport of the oral argument). In other words, Significance 1 can be assessed as having only such customer-attracting power that a product lacking it can still be sold to customers as the same series and product. This remains so even taking into account that, although the catalog does not expressly state Significance 1 in words, the characteristics relating to it can be perceived from the product photographs.

Significance 3 at issue

Significance 3 can be said to contribute to reducing manufacturing costs through a lower defect rate, but, considering that the extent of the cost reduction (reflection in product prices) due to Significance 3 is unknown, etc., it cannot be found to contribute greatly to profits on the defendant's products.

In view of these circumstances, the customer-attracting power of Significance 1 and Significance 3 is limited, and it must be said that their contribution to sales of the defendant's products is small.

Sales performance

The plaintiff has not manufactured its practicing product since the registration date at issue, its sales methods (channels), etc. are substantially limited, and the scale is extremely small. Although the plaintiff sells its successor product, that product achieves effects similar to those of the respective inventions through different technology. While these matters cannot be said to negate the underlying facts for the presumption under Article 102(2) of the Patent Act explained in (1) above, they should be regarded as circumstances rebutting the presumption to a large extent.

Competing products

During the relevant period, multiple products had the feature that the bracket was attached not to the exterior portion but to another portion, including the heat-dissipating portion: these included Panasonic's TOLSO series (Otsu 25), Odelic's C1000 series (Otsu 27-2 to 27-4), and Mitsubishi Electric's AK, Saimei, Senmei, and LED Spotlight series (Otsu 29). These products are generally in approximately the same price range as the plaintiff's practicing product and the defendant's products.

In view of the foregoing, competing products are found to exist for the defendant's products, and their existence also constitutes a circumstance rebutting the presumption.

Considering the foregoing circumstances comprehensively, with particular emphasis on the technical significance of the patented invention and the sales situation of the practicing product, the probability that, absent sales of the defendant's products, the corresponding demand would have been directed to the plaintiff's practicing or successor product should instead be regarded as low. It must therefore be said that 80% of the damages presumed under Article 102(2) of the Patent Act are rebutted. Neither the plaintiff's nor the defendant's arguments to the contrary can be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91850.pdf

An IP High Court Judgment on the Meaning of a ‘Trademark Widely Recognized Among Consumers’ as a Requirement for Registration of a Defensive Mark

Original Ameblo publication: 2023-11-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827166886.html

[Trademark / Article] An IP High Court Judgment on the Meaning of a ‘Trademark Widely Recognized Among Consumers’ as a Requirement for Registration of a Defensive Mark (Patent Studies, March 2011; Masaharu Miyawaki)

In 2009 (Gyo-Ke) 10189, the Intellectual Property High Court required strong distinctiveness—that is, fame—sufficient to cause confusion as to commercial origin even for dissimilar goods or services

⇒ The article regards the conclusion as appropriate but disagrees with the general proposition.

https://www.inpit.go.jp/content/100126269.pdf

Intellectual Property High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

Original Ameblo publication: 2023-11-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827279339.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

* Even if a purpose is not manifested in a publicly used product, an objectively ascertainable product effect is a point of identity. ⇒ Inventive step denied

Whether the ‘water’ in the publicly used product corresponds to the ‘volatilization-suppressing component’ of the invention is determined by whether it can objectively be understood to be a component for suppressing volatilization after spraying.

⇒ Not affected by the purpose of its addition or whether it was recognized as a volatilization-suppressing component.

* Correction requirements not satisfied

Merely describing the effects produced by a configuration does not constitute narrowing.

(Extract from the court's reasoning)

<Inventive step> ⇒ Inventive step denied

The ‘water having a vapor pressure of 2.3366 kPa at 20°C’ contained in Publicly Worked Invention 1-1 is found to correspond to the ‘volatilization-suppressing component’ of Invention 1, so Difference 1 is not found to be a substantive difference. ... On this point, the trial decision gives as one reason for finding Difference 1 substantive that, although Publicly Worked Invention 1-1 contains water, according to Ko 2 the water was added as a ‘solvent’ and cannot be found to have been recognized as a volatilization-suppressing component for suppressing volatilization after spraying. However, in light of the fact that the scope of claims of a patent for a product invention is specified by its structure, characteristics, etc., whether the ‘water’ contained in Publicly Worked Invention 1-1 corresponds to the ‘volatilization-suppressing component’ of Invention 1 should be determined by whether that water can objectively be understood to be a component for suppressing volatilization after spraying. The determination is therefore not affected by the purpose for which water was added or whether it was recognized as a volatilization-suppressing component for suppressing volatilization after spraying.

<Correction requirements> ⇒ Correction requirements not satisfied

Correction Item 1 ... changes ‘spray product’ to ‘spray product with reduced mucous-membrane irritation,’ and Correction Item 2 ... changes ‘spraying method’ to ‘spraying method that reduces mucous-membrane irritation.’ ... They are found to add to the respective descriptions ‘spray product’ and ... ‘spraying method’ wording concerning an action, namely ‘with reduced mucous-membrane irritation’ or ‘that reduces mucous-membrane irritation,’ respectively. ...

The specification neither describes nor suggests that, even with the respective configurations in pre-correction claims 1 and 3, there are cases in which the effect of ‘reducing mucous-membrane irritation’ is not produced. Accordingly, the wording concerning an action added by Correction Items 1 and 2, ‘with reduced mucous-membrane irritation’ or ‘that reduces mucous-membrane irritation,’ merely describes the effects produced by the respective configurations in pre-correction claims 1 and 3. Correction Items 1 and 2 therefore cannot be found to narrow the scope of claims for the respective inventions in pre-correction claims 1 and 3. ... Accordingly, Correction Items 1 and 2 cannot be found to aim at ‘narrowing the scope of claims’ ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91366.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10017 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

Original Ameblo publication: 2023-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827397676.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10017 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

<Clarity requirement>

* Products not satisfying the claimed effect ‘configured to be capable of causing paper tearing’ are excluded from the invention.

⇒ Clarity upheld even though the claims do not specify the frequency or conditions of occurrence of ‘paper tearing’

<Inventive step>

* Even if the numerical range overlaps the cited reference, the values are not disclosed as significant in relation to the claimed effect ‘capable of causing paper tearing.’ ⇒ A difference

* Configurations that do not cause ‘paper tearing’ are also explained as comparative examples.

Cf. Intellectual Property High Court, 2021 (Gyo-Ke) 10091 [Adhesive Tape] <Honda>

(Extract from the court's reasoning)

<Clarity requirement>

... Considering the description and drawings in the specification together, ‘paper tearing’ in Invention 1 can be understood as the phenomenon in which, when the adhesive layer of an adhesive product is peeled off, the surface layer of the paper adheres to the adhesive and the paper ruptures in its thickness direction. The feature specifying Invention 1 as ‘configured to be capable of causing paper tearing’ can be interpreted as selecting, from among ‘pressure-sensitive transfer adhesive tapes’ satisfying the other limitations, those configured to be ‘capable of causing paper tearing’; configurations ‘incapable of causing paper tearing’ can be understood not to fall within the technical scope of Invention 1. Accordingly, even though claim 1 relating to Invention 1 does not specify the frequency or conditions of occurrence of ‘paper tearing,’ the claims cannot be said to be so unclear as to cause unforeseen harm to third parties.

<Inventive step>

... Leaving aside the lack of evidence that all commercially available ‘permanent bonding type’ tape glues are ‘capable of causing paper tearing,’ ... Invention 1 ... presupposes ‘pattern coating.’ According to the specification ... none of the comparative examples subjected to pattern coating exhibited the property of being capable of tearing paper ... ; Comparative Example 9, etc. ... expressly state that ‘the adhesive layer was partially deactivated so that only the adhesive positioned in substantially the same locations as the adhesive arrangement in the coating pattern used in the pattern-coating suitability test exhibited adhesive force.’ ... The plaintiff also argues ... regarding Differences 3 and 4 that they fall within the scope of well-known technology because they overlap the numerical ranges stated in the respective documents it invokes. However, the numerical ranges in those documents are not disclosed as values significant in relation to paper tearing ... and the argument misses the point.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91543.pdf

[Trademark] Osaka District Court, 2020 (Wa) 4272, the LEADERBIKES case

Original Ameblo publication: 2023-11-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827678007.html

[Trademark] Osaka District Court, 2020 (Wa) 4272, the LEADERBIKES case

(1) Five years elapsed after registration

⇒ In this case, neither an invalidity defense for violation of Article 4(1)(xi) of the Trademark Act nor an Emax defense is available

(2) It is not improper for the plaintiff, which manufactured the former Leader company's products, to acquire the trademark right in the bankruptcy proceedings of the former Leader company, etc.

⇒ No abuse of rights

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91719.pdf

Tokyo District Court, 2021 (Wa) 29388 [HFO-1234yf] <Sugiura> — Fourth generation of the patent in 2019 (Wa) 30991

Original Ameblo publication: 2023-11-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827806311.html

Tokyo District Court, 2021 (Wa) 29388 [HFO-1234yf] <Sugiura>

Fourth generation of the patent in 2019 (Wa) 30991

The original application's initial specification neither describes nor suggests the technical significance of the ‘additional compounds’ incorporated into the claim!!

⇒ It merely described the presence of small amounts of impurities and byproducts

⇒ Divisional-application requirements not satisfied (addition of new matter)

⇒ Novelty denied

Cf. The appellate court, the Intellectual Property High Court, 2022 (Ne) No. 10094 <Hibiku Shimizu>, held that the invention claimed in the divisional application was not described in the specification and found that the support requirement was not satisfied.

(Extract from the court's reasoning)

... The original application's initial specification lists other compounds to be combined with HFO-1234yf as embodiments of the invention originally disclosed. Although HFC-143a is expressly included, HFC-254eb is not expressly mentioned and is not included among the compounds used to make the disclosed compositions ... ; it is merely shown in the above examples as one product of the uncatalyzed conversion of HCFC-244bb to HFO1234yf. Although these products could also be understood as certain additional compounds ... present in small amounts when preparing new low-global-warming-potential compounds such as HFO-1234yf, the original application's initial specification contains no description or suggestion of the technical significance, etc. of the presence of these ‘additional compounds.’ Accordingly, the products other than HFO-1234yf shown in Examples 15 and 16 are understood merely as descriptions that, when preparing HFO-1234yf, small amounts of impurities or byproducts ... contained in its starting materials, etc. are present as ‘additional compounds.’ ... The examples must be understood merely to state the compounds found by analysis and their proportions. ...

... The claims of the original application describe compositions, etc. containing HFO-1234yf and HFC-254eb together with at least one member selected from the group consisting of HFC-245cb and HFC-143a. Even taking that description into account, however, one cannot necessarily derive selecting HFC-143a and HFC-254eb in addition to HFO-1234yf from those compositions, specifying the amounts of those two components as no more than 0.2 wt% HCFC-143a and no more than 1.9 wt% HFC-254eb, and combining them with HFO-1234yf.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91940.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10061 [Excavator] <Kanno>

Original Ameblo publication: 2023-11-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12827950447.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10061 [Excavator] <Kanno>

An amendment was made on the basis of the description of the prior art.

⇒ (1) It does not disclose that the configuration described under [Embodiments for Carrying Out the Invention] has the prior-art configuration, and (2) there is no description suggesting that it presupposes the prior-art configuration.

⇒ Addition of new matter

(Extract from the court's reasoning)

... The statement '... issues a warning when there is danger' in [0002] of the initial specification ... explains prior art; it does not disclose that the configuration described under [Embodiments for Carrying Out the Invention] has such a prior-art configuration. Nor are there circumstances making the configuration described under [Embodiments for Carrying Out the Invention] untenable unless such a configuration is assumed. There is also no other description suggesting that the configuration described under [Embodiments for Carrying Out the Invention] presupposes the prior-art configuration. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91936.pdf

[Unfair Competition Prevention Act, Article 2(1)(i)] Imitation of a Well-Known Product Configuration <Damages> Intellectual Property High Court, 2022 (Ne) 10095 and 10112 <Honda>

Original Ameblo publication: 2023-11-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828064892.html

[Unfair Competition Prevention Act, Article 2(1)(i)] Imitation of a Well-Known Product Configuration <Damages> Intellectual Property High Court, 2022 (Ne) 10095 and 10112 <Honda>

Liability became final in Intellectual Property High Court, 2019 (Ne) 10002

First-instance judgment: 2020 (Wa) 17626 <Sugiura>

⇒ It is difficult to consider all Y's sales attributable to misidentification or confusion with X's products

⇒ A 40% deduction under Article 5(1) of the Unfair Competition Prevention Act for circumstances preventing sales

Appeal: Intellectual Property High Court, 2022 (Ne) 10095 and 10112 <Honda>

⇒ Even without actual misidentification or confusion, (1) there was strong competition, and (2) the sales method encouraged switching

⇒ No deduction for circumstances preventing sales under Article 5(1) of the Unfair Competition Prevention Act

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91955.pdf

* Cases in which a party and its supporting intervenor shared the same attorney

Original Ameblo publication: 2023-11-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828335509.html

* Cases in which a party and its supporting intervenor shared the same attorney

Tokyo District Court, April 27, 2022 (2020 (Wa) 29604): defendant and defendant's supporting intervenor

Tokyo District Court, May 29, 2019 (2017 (Wa) 44053): plaintiff and plaintiff's supporting intervenors

IP High Court, December 18, 2018 (2017 (Ne) 10086): appellee and appellee's supporting intervenor

Tokyo District Court, September 21, 2017 (2016 (Wa) 24175): defendant and defendant's supporting intervenor

Cf. Osaka District Court, December 18, 2018 (2016 (Wa) 6494): three defendants

[Copyright / Provider Liability Act] Intellectual Property High Court, 2022 (Ne) 10102 ⇛ Reversal and disclosure order

Original Ameblo publication: 2023-11-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828335651.html

[Copyright / Provider Liability Act] Intellectual Property High Court, 2022 (Ne) 10102 ⇒ Reversal and disclosure order

‘... Considering the circumstances particular to this case comprehensively, denying disclosure of sender information ... on the ground that Login 2, which is temporally closer to the tweet than Login 1, exists ... would be contrary to the purpose of Article 5 of the amended Act, which seeks to ensure effective relief.’

⇒ Reversal and disclosure order

091992_hanrei.pdf (courts.go.jp)

Intellectual Property High Court, 2021 (Gyo-Ke) 10091 [Adhesive Tape] <Honda>

Original Ameblo publication: 2023-11-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828468834.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10091 [Adhesive Tape] <Honda>

*In this case, obviousness was found in light of, among other matters, the overlap with the numerical range of the cited invention.

(Difference as described in the judgment and extract from the court's reasoning)

The peak temperature of the loss tangent based on the dynamic viscoelastic spectrum of adhesive portion (B), measured at a frequency of 1 Hz, is '−25°C to 5°C' in Invention 1, whereas the peak temperature of the loss tangent is unknown in the Ko 1 invention. (Hereinafter 'Difference γ.')

... Regarding Difference γ, it need not be found that the peak temperature of tan δ of the pressure-sensitive adhesive layer of the Ko 1 invention, readily conceivable from the Ko 1 invention and well-known technology, falls within '−25°C to 5°C.' If it is found to overlap that range even partially, the configuration of Invention 1 relating to Difference γ can be said to be obvious ... .

Cf. Intellectual Property High Court, 2022 (Gyo-Ke) 10017 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

* Even if the numerical range overlaps the cited reference, the values are not disclosed as significant in relation to the claimed effect 'capable of causing paper tearing.' ⇒ A difference

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91160.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10001 [Ultra-High-Sensitivity Micromagnetic Sensor] <Kanno>

Original Ameblo publication: 2023-11-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828594027.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10001 [Ultra-High-Sensitivity Micromagnetic Sensor] <Kanno>

Invalidation petitioner: Aichi Steel

Patentee: MagneDesign

(Extract from the court's reasoning)

‘Whether an effect is distinguishable from prior technology in a natural-scientific sense ... is unrelated to patentability requirements ... a patent is granted if the technical idea could not readily have been conceived.’

⇒ Support requirement satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91863.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10111 [Beltline Molding for a Vehicle Door] <Honda>

Original Ameblo publication: 2023-11-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828723031.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10111 [Beltline Molding for a Vehicle Door] <Honda>

The specification does not describe the technical significance of the stepped portion extending ‘substantially horizontally.’

Whether the stepped portion extends ‘substantially horizontally’ or ‘slightly downward’ does not change the effects produced by the invention.

⇒ Merely a design matter. Inventive step denied

* A feature specifying the invention whose technical significance is not described in the specification, and which does not affect the invention's effects.

⇒ Merely a design matter; inventive step denied

Technical significance is also at issue in parameter inventions

Intellectual Property High Court, 2021 (Gyo-Ke) 10096

Intellectual Property High Court, 2021 (Gyo-Ke) 10135

Intellectual Property High Court, 2010 (Gyo-Ke) 10296

Intellectual Property High Court, 2006 (Gyo-Ke) 10132

Intellectual Property High Court, 2005 (Gyo-Ke) 10665

Intellectual Property High Court, 2005 (Gyo-Ke) 10754

Intellectual Property High Court, 2005 (Gyo-Ke) 10189

(Extract from the court's reasoning)

The specification contains no description of the technical significance of the stepped portion extending inward ‘substantially horizontally’ from the lower portion of the vertical flange. ... Whether the stepped portion extends ‘substantially horizontally’ or ‘slightly downward’ does not change any of the effects produced by the invention. Accordingly, no technical significance is found in having the stepped portion extend ‘substantially horizontally.’ In the Ko 1 Invention 1 as well, no technical significance is found in the stepped portion extending ‘slightly downward’ from the lower portion of the vertical flange toward the vertically moving window glass (inward). Configuring the ‘slightly downward’ stepped portion of Ko 1 Invention 1 to extend ‘substantially horizontally’ should therefore be regarded as merely a design matter that a person skilled in the art may undertake as appropriate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92217.pdf

[Trademark / Contract] Osaka District Court, 1996 (Wa) 6700 — Abuse of the right to terminate

Original Ameblo publication: 2023-11-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828845326.html

[Trademark / Contract] Osaka District Court, 1996 (Wa) 6700

The plaintiff had tacitly permitted the defendant's submission of a written rebuttal.

⇒ In an ongoing contractual relationship, this cannot be assessed as a material contractual breach sufficient to destroy the relationship of trust.

⇒ In the circumstances of this case, exercising the right to terminate by invoking a violation of some contractual provisions constitutes an abuse of the right to terminate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13056.pdf

[Portrait Rights] Tokyo District Court, 2021 (Wa) 28420 <Principal Action> <Nakashima>

Original Ameblo publication: 2023-11-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12828975257.html

[Portrait Rights] 2021 (Wa) 28420 <Principal Action> <Nakashima>

‘It filmed ... the circumstances of the plaintiff's arrest in flagrante delicto ... on a street in broad daylight, with one of the plaintiff's hands handcuffed by a police officer ... . The content of the arrest video insults the plaintiff beyond the limits that should be tolerated under socially accepted norms ... .’

⇒ Infringement of portrait rights (JPY 300,000 awarded as compensation for emotional distress caused by infringement of both reputation and portrait rights)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91515.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10099 [Laser Processing Apparatus] <Honda>

Original Ameblo publication: 2023-11-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829167945.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10099 [Laser Processing Apparatus] <Honda>

Motivation to apply well-known technology denied

⇒ Inventive step upheld

‘A person skilled in the art encountering the description in Ko 1 cannot be said to understand that ... would cause ... a deterioration in quality. Accordingly, motivation to perform AF control in the Ko 1 invention cannot be found.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92185.pdf

Osaka District Court, 2022 (Wa) 2695, Employee Invention

Original Ameblo publication: 2023-11-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829168821.html

Osaka District Court, 2022 (Wa) 2695, Employee Invention

An agreement between a company and a former employee under which ‘all claims, including the right to claim reasonable remuneration, are extinguished’ in exchange for JPY 300,000 was held valid in light of the negotiation history.

⇒ Claim dismissed

The defendant sent a warning letter two months after the agreement.

⇒ It could not be found that, at the time of the agreement, the defendant knew that another company’s products infringed the patent at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91696.pdf

[Article] Individual Directors' Liability for Damages to Patentees in Patent-Infringement Cases (Keijiro Miwa and Kazunari Sugimitsu)

Original Ameblo publication: 2023-11-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829359437.html

[Article] Individual Directors' Liability for Damages to Patentees in Patent-Infringement Cases (Keijiro Miwa and Kazunari Sugimitsu) (Patent, Vol. 76, No. 5, 2023)

Factors for assessing the duty of due care of a prudent manager

(1) Duty to investigate, including obtaining an opinion from an impartial expert

(2) Cessation of working acts and reserving an amount equivalent to damages

⇒ At the time of the article's review, no uniform standard had been established.

https://jpaa-patent.info/patent/viewPdf/4202

Osaka District Court, 2017 (Wa) 7384 [Massage Machine] <Damages>

Original Ameblo publication: 2023-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829494841.html

Osaka District Court, 2017 (Wa) 7384 [Massage Machine] <Damages>

<Damages> Rebuttal of the presumption under Article 102(2): 98% rebutted (Invention 2), 85% rebutted (Invention 3)

JPY 5.5 billion claimed; approximately JPY 2.78 billion awarded

<Grounds for rebutting the presumption>

(1) Invention II made only a slight contribution, while Invention III made a limited contribution. Most of the defendant’s products relating to Invention II were purchased because of functions or other features unrelated to the characteristics of Invention II.

(2) Numerous competing products are made by Panasonic, which has the second-largest market share.

(* Although the percentages rebutted differ between Invention II and Invention III, the wording applying the law in the judgment is largely the same.)

(Extract from the court's reasoning)

Among the defendant's products at issue, those relating to Invention II received only a slight contribution from Invention II, and most are found to have been purchased because of functions, etc. other than the features of Invention II. Taking into account, in addition, the existence of numerous competing products made by Panasonic, which has the second-largest share of the massage-chair market, and other circumstances, there are circumstances substantially impairing the causal relationship between the defendant's profits and the plaintiff's damage. It is therefore appropriate to find the presumption rebutted for 98% of the defendant's profits.

For the defendant's products relating to Patent III, the contribution of Invention III can be said to be limited. Considering the existence of numerous competing Panasonic products mentioned above and other circumstances, there are circumstances impairing to a considerable degree the causal relationship between the defendant's profits and the plaintiff's damage. It is therefore appropriate to find the presumption rebutted for 85% of the defendant's profits.

For the defendant's products relating to both Patents II and III, it is appropriate, as with those relating to Patent III, to find the presumption rebutted for 85% of the defendant's profits.

<Application of Article 102(3) to the rebutted portion>

Even where rebuttal of the presumption under Article 102(2) of the Patent Act is accepted, so that the amount of lost profits from a reduction in the profits earned by the patentee from practicing the invention, etc., presumed from the infringer's profits, cannot be recognized as damages without adjustment, the invention was nonetheless worked without permission in respect of that portion. The assessment of damage for that portion therefore cannot be said to be exhausted, and it is appropriate to interpret that the patentee, etc. may seek compensation for the loss of royalties it should have received from the infringer. Accordingly, it is appropriate to interpret that damages under Article 102(3) may be claimed for the portion for which the presumption under paragraph (2) has been rebutted.

https://www.courts.go.jp/osaka/vc-files/osaka/attachmentfile/attachmentfile-file-204868.pdf

Intellectual Property High Court, 2021 (Ne) 10088 and 2022 (Ne) 10014 [Information Communication Unit]

Original Ameblo publication: 2023-11-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829616666.html

Intellectual Property High Court, 2021 (Ne) 10088 and 2022 (Ne) 10014 [Information Communication Unit]

<Damages> Rebuttal of the presumption under Article 102(2): 15% rebutted because of competing products

* ‘Responding to individual customer requests,’ ‘securing inventory,’ ‘clearly stating maintenance-service details on the website,’ etc. do not constitute exceptional sales efforts sufficient to rebut the presumption under Article 102(2)!!

(Extract from the court's reasoning)

<Grounds for rebuttal>

On the alleged absence or weakness of the customer-attracting power of the respective inventions: As stated in Part 2, Section 3(1)(c), c(a) above, the appellant argues that effects (1) and (2) of the respective inventions, to which the original judgment attributed customer-attracting power, do not enhance that power.

However, the respective inventions can be said to have customer-attracting power in the combination of compactness and communication speed, which should be evaluated together, through the combined action of effects (1) and (2). Indeed, according to the weekly reports of the appellant's sales representatives (Otsu 54), during the appellant's development process there were instances of losing sales competitions because the product it sold before the respective defendant's products was inferior to the appellee's product in ‘compactness’ and ‘communication speed.’ The appellant's argument therefore cannot be accepted.

On the alleged lack of identity of markets: As stated in Part 2, Section 3(1)(c), c(b) above, the appellant argues that the respective defendant's products and the plaintiff's product essentially do not compete in terms of direct customers and hardly compete even at the end-user level.

However, not only are the plaintiff's product and the respective defendant's products highly interchangeable as wall-embedded information-outlet-type wireless LAN access points compatible with JIS-standard outlet plates, but of the ●●●●●●● units sold by the appellant between 2016 and 2021, ●●● ●●● units are found to have been sold to the appellee's customers (Otsu 48; Ko 78). The argument that the markets are not identical therefore cannot be accepted.

On the existence of competing products: As stated in Part 2, Section 3(1)(c), c(c) above, the appellant argues that there are products competing with the plaintiff's product other than the Ko 56 product.

Indeed, according to the evidence (Ko 78; Otsu 60-2 to 60-4 and 61), Elecom sells, in addition to the Ko 56 product, three types of JIS-compatible wall-embedded information-outlet-type wireless LAN access points that can compete with the plaintiff's product; it is well known and has price competitiveness compared with the plaintiff's product.

According to the evidence (Ko 78; Otsu 61–66), Ruijie has sold wall-embedded information-outlet-type wireless LAN access points capable of competing with the plaintiff's product since 2020; its sales were JPY 170 million in 2020 and JPY 579 million from January through November, 2021.

Meanwhile, sales of the plaintiff's product were ●●●●●●

Tokyo District Court, 2012 (Wa) 12351 [Rice Cake]

Original Ameblo publication: 2023-11-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829752808.html

Tokyo District Court, 2012 (Wa) 12351 [Rice Cake]

<Damages> Patent Act, Article 102(2): 90% reduction for non-contribution (10% contribution); approximately JPY 800 million awarded

<Contribution rate>

(1) Significance of the invention (appearance of grilled rice cakes and suppression of eruption caused by sudden swelling)

(2) Advertising on the exterior packaging of the defendant's products: displaying the ‘slits made in the cut rice cakes’

(3) The defendant's securities reports, etc. describe improved performance from adding slits

(Extract from the court's reasoning)

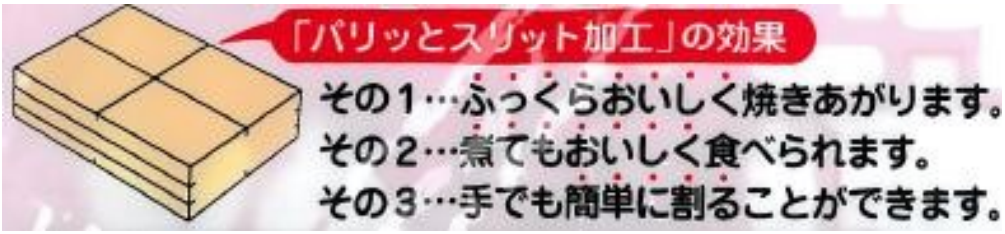
<Contribution rate>

As to the contribution rate of the invention covered by the patent, the plaintiff argues that 15% is appropriate and the defendant argues that approximately 1–1.5% is appropriate. This issue is examined below.

The evidence establishes the following facts, and there is no reliable evidence sufficient to overturn them.

A. With cut rice cakes, which are small rectangular rice-cake pieces placed on a grilling mesh, grilled, and eaten, conventional problems included the interior rice cake suddenly swelling outward during heating and flowing downward onto the mesh. This dirtied the mesh, made the rice cakes difficult to lift off and eat, prevented uniform grilling of the whole cake and grilling many at once, and produced an undesirable finished appearance. To solve these problems, the invention adopts its stated configuration, using cuts to control (suppress) eruption caused by sudden swelling during grilling. It aims thereby to provide rice cakes that can be grilled uniformly without impairing appearance, are easy to eat and appetizing, and can in fact be enjoyed deliciously (Section 1(1)(b) above).

B. The defendant advertises the slits made in its cut rice cakes by displaying the following on the back of the exterior packaging of its products. [Ko 32-1 and 32-2]



Translation of the packaging text: Effects of “Paritto Slit” processing: (1) They grill up puffy and delicious. (2) They are also delicious when boiled. (3) They can also be split easily by hand.

C. The defendant also makes the following statements in its securities reports, etc. (Ko 77–79), and the Food Marketing Handbook contains the following statements (Otsu 219-1 to 219-9).

• ‘Overview of performance for the current fiscal year

In the packaged rice-cake division, we established production systems for the Paritto Slit type at all packaged rice-cake plants and, from September, 2004, added 700 g and 1 kg sizes to the existing 400 g size to expand sales. As a result, “Sato's Cut Rice Cakes Paritto Slit” performed steadily. However, owing to a shortage of glutinous rice caused by the poor 2003 harvest and the warm winter at the end of last year, sales declined by 3.8% year on year to JPY 12,978 million.’ [Ko 77: Securities Report (fiscal year: May 1, 2004–April 30, 2005; filed July 22, 2005)]

• ‘(1) Overview of performance for the current fiscal year

In the packaged rice-cake division, kagami-mochi sales grew as we expanded the lineup to respond to consumer purchasing trends, including “Sato's Satto Kagami Mochi,” requiring no assembly, and “Sato's Kagami Mochi with Cut Rice Cakes,” containing Paritto Slit-type cut rice cakes. In addition, “Sato's Cut Rice Cakes Paritto Slit” and “Sato's Round Rice Cakes Single Pack” performed steadily. As a result, packaged rice-cake sales increased by 0.5% year on year to JPY 13,045 million.’ [Ko 78: Securities Report (fiscal year: May 1, 2005–April 30, 2006; filed July 28, 2006)]

• ‘In the packaged rice-cake division, to further improve convenience and texture for consumers, we introduced “Paritto Slit,” which our company pioneered in the packaged rice-cake industry, into all cut-rice-cake types. We also introduced “Junjo Mochi” and “Value-Package Pounded Mochi” as products competing in the low-price range to stimulate in-store demand. However, nationwide warm-winter conditions depressed consumption, including demand for hot-pot dishes, and sales conditions during the peak year-end and New Year season remained severe. As a result, unit sales increased by 1.9% year on year, but sales value declined by 1.7% to JPY 12,819 million.’ [Ko 79: Securities Report (fiscal year: May 1, 2006–April 30, 2007; filed July 27, 2007)]

• ‘(1) Sato Foods ... launched “Paritto Slit” in 2003, with cuts allowing it to be divided into four by hand. It has gradually shifted from “Freshly Pounded Single Pack” and is putting substantial effort into this in 2004.’ ‘(2) Echigo Seika ... also saw steady performance for its “Echigo Nama Ichiban” cut rice cakes. In 2003 it launched “Fukkura Meijin,” with cuts in the sides of round rice cakes, which had been considered technically difficult, and has begun a slit-rice-cake battle with Sato Foods.’ [Otsu 219-1, second sheet]

• ‘In 2003 ... technology for putting cuts in rice cakes was developed, and rice cakes that brown even in a toaster oven without dirtying the appliance were commercialized and attracted attention. Leading manufacturers Sato Foods and Echigo Seika are increasing their focus on rice cakes with cuts.’ ‘In 2005, Sato Foods and Echigo Seika are increasing their focus on cut rice cakes with slits, and attention is being paid to whether these can become the mainstream in cut rice cakes.’ [Otsu 219-2, first sheet]

• ‘(1) Sato Foods launched “Sato's Cut Rice Cakes Paritto Slit,” processed with cuts, in 2004, and cut-rice-cake sales remained at the previous year's level ... . In 2005 it will increase its focus on “Sato's Cut Rice Cakes Paritto Slit” as a main product and expand sales channels. For kagami mochi ... it newly introduced “Sato's Kagami Mochi with Cut Rice Cakes,” containing “Sato's Cut Rice Cakes Paritto Slit,” ... seeking to recover from the previous year.’

‘(2) Echigo Seika ... in 2005 adopted cuts (“Fukkura Cut”) throughout its flagship “Echigo Nama Ichiban” line, promoting superior cooking characteristics and seeking to increase market share.’

‘Sato Foods and Echigo Seika are focusing on expanding sales of rice cakes with cuts, but many other companies are taking a wait-and-see approach. Depending on future trends in rice cakes with cuts, those with cuts are expected to become mainstream among retail cut rice cakes, and interest in them is increasing.’ [Otsu 219-2, second sheet]

• ‘(3) Kimura Foods, which focuses on commercial use, switched “Usagi Individually Packed Round Mochi” in 2008, following its cut rice cakes, to a slit-containing version made with specially cultivated rice ... . Because sales remained strong even after price revisions, the year ended with growth.’

‘The overall trend is dominated by products emphasizing convenience; slit-containing products that are easy to break and grill to an attractive appearance occupy the top three positions ... .’ [Otsu 219-6, second sheet]

• ‘Product development is progressing that emphasizes ease of eating and use, including best-before dates on individual packages and slits.’ [Otsu 219-7, first sheet]

• ‘(1) Sato Foods is advancing the switch from “Single Pack” to “Sato's Cut Rice Cakes Paritto Slit.” In 2009, promotion of the functionality of “Paritto Slit” captured demand, and the positive effect of the switch also helped performance exceed the previous year. In 2010 it is pursuing concentrated development of “Paritto Slit.” Although reduced demand caused by the extreme summer heat has had an impact, it plans to exceed the previous year's performance while promoting functionality and strengthening the brand.’ [Otsu 219-7, second sheet]

D. Considering comprehensively the facts in A through C above, particularly the significance of the invention, the content of the defendant's slit advertising, and the extent of improved performance from adding slits, as well as the facts that the patent was registered on April 18, 2008, and that the products subject to this damages claim are the defendant's products other than the representative products in the earlier case for which damages, etc. had already been sought, a 10% contribution rate for the patent relating to the invention is found appropriate in calculating damages under Article 102(2) of the Patent Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85042.pdf

Tokyo District Court, 2013 (Wa) 33070 [Agricultural-Produce Sorting Apparatus] <Hasegawa>

Original Ameblo publication: 2023-11-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12829877402.html

Tokyo District Court, 2013 (Wa) 33070 [Agricultural-Produce Sorting Apparatus] <Hasegawa>

<Damages> Rebuttal of the presumption under Patent Act, Article 102(2): Invention 1, 75%; Invention 2, 95%

(1) In the defendant's equipment, sorting categories vary as appropriate according to the accumulation state, reducing overflow compared with a configuration without this feature.

(2) Profits from equipment other than the inventions are also included.

(3) The respective inventions were not tender requirements.

(Extract from the court's reasoning)

<Grounds for rebuttal>

As to the proportion in which the respective inventions contributed to the defendant's above profits, for Invention 1 the defendant asserts 2.5% and the plaintiff 50%; for Inventions 2-1 and 2-2, the defendant asserts 0.3% for Type B equipment, 0.9% for Type D equipment, and 0.2% for Type F equipment, while the plaintiff asserts 30%. They argue that the presumption under Article 102(2) of the Patent Act is rebutted for the remaining portion.

Upon examination, according to Specification 1 (Ko 2), Invention 1 concerns an agricultural-produce sorting apparatus and has technical significance primarily in providing a return conveyor and devising its terminal portion; according to Specification 2 (Ko 4), Inventions 2-1 and 2-2 concern an internal-quality inspection apparatus and have technical significance primarily in providing multiple light sources and devising light-shielding means. On the other hand, as stated in Section 1(1) above, Type B through Type E equipment adopt a configuration in which sorting categories set on the pool conveyor vary as appropriate according to the accumulation state. As a result, the number of trays containing fruit or vegetables that overflow is found to decrease compared with a configuration without this feature, and to that extent the proportion in which Invention 1 contributed to the defendant's above profits is considered reduced.

According to the evidence cited below and the entire purport of the oral argument, the following facts are also established: (1) Type B through Type F equipment comprise, in addition to sorting equipment and internal-quality inspection apparatuses, receiving equipment (excluding Type D), packing equipment, carton-sealing and product-conveying equipment, carton-forming and empty-carton-conveying equipment, and other equipment, and the profits in B above include profits from their manufacture and installation (Otsu 38–41); (2) under the tender conditions for each installation site of Type B through Type F equipment (Ko 14–18), at least placing the return conveyor's return point at the position specified in Invention 1 and providing the multiple light-emitting sources specified in Inventions 2-1 and 2-2 in the internal-quality inspection apparatus were not mandatory requirements.

In view of the above technical significance and facts, circumstances are found that rebut, for part of the above profits, the presumption that they constitute the plaintiff's damage from patent infringement. It is appropriate to find that proportion to be 75% for Invention 1 and 95% for Inventions 2-1 and 2-2.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86137.pdf

[Article] Judicial Decisions on Infringement Warnings and Notification of False Facts Under the Unfair Competition Prevention Act (Patent Supplement, 2023; Professor Toshiya Kaneko)

Original Ameblo publication: 2023-11-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830068905.html

[Article] Judicial Decisions on Infringement Warnings and Notification of False Facts Under the Unfair Competition Prevention Act — Focusing on Recent Developments and Cases Concerning Unregistered IP (Patent Supplement, 2023; Professor Toshiya Kaneko)

Infringement complaints to platform operators such as Amazon

Tokyo District Court, 2016 (Wa) 12829 [CERAKOTE / complaint to Facebook]

⇒ Expression of a subjective perception, not notification of a fact.

IP High Court, 2018 (Ne) 10068 [Jolen Creme Bleach] (first instance: Tokyo District Court, 2016 (Wa) 15812) is a separate related case.

2018 (Wa) 22428

⇒ Violation of the Unfair Competition Prevention Act

* Among the recent decisions examined in the article, few denied unlawfulness or negligence.

https://jpaa-patent.info/patent/viewPdf/4168

[Article] Supplementing Unfair-Competition Protection Through Civil Code Tort Law (Patent Supplement, 2023; Professor Tatsuhiro Ueno)

Original Ameblo publication: 2023-11-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830137987.html

[Article] Supplementing Unfair-Competition Protection Through Civil Code Tort Law — The State of the Debate on Intellectual Property Law and Tort Law (Patent Supplement, 2023; Professor Tatsuhiro Ueno)

The Supreme Court’s North Korean Films judgment (December 8, 2011) concerned use of films not protected under the Copyright Act. The article reports that, among the subsequent decisions it examines, it found no case recognizing general tort liability where protection under copyright, unfair-competition law, or design rights was denied.

https://jpaa-patent.info/patent/viewPdf/4166

[U.S. Patents] November 6, 2023, CAFC <ACTELION v. MYLAN> — Interpretation of Numerical Limitations and Rounding

Original Ameblo publication: 2023-11-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830270100.html

[U.S. Patents] November 6, 2023, CAFC <ACTELION v. MYLAN>

For the claim language “a pH of 13 or higher,” the district court construed the “pH of 13” component, using rounding, to encompass 12.5–13.4. The words “or higher” remained part of the claim; 13.4 was not an upper limit. The district court had not addressed the extrinsic evidence, including textbooks.

⇒ The CAFC vacated the claim construction and the infringement judgment and remanded for consideration of the extrinsic evidence and its bearing on how a person skilled in the art would understand the significant digits.

* The use of rounding itself was not rejected!!

https://jpaa-patent.info/patent/viewPdf/3011

https://www.cafc.uscourts.gov/opinions-orders/22-1889.OPINION.11-6-2023_2217732.pdf

[Article] The Relationship Between ‘Confusion’ and ‘Business Interests’ Under Article 2(1)(i) of the Unfair Competition Prevention Act (Professor Hisayoshi Yokoyama)

Original Ameblo publication: 2023-11-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830400515.html

[Article] The Relationship Between ‘Confusion’ and ‘Business Interests’ Under Article 2(1)(i) of the Unfair Competition Prevention Act (Patent Supplement, 2023; Professor Hisayoshi Yokoyama)

‘Post-sale confusion’

The article argues that item (i) applies if confusion among persons other than the (direct) purchaser may unreasonably influence future choices of goods or services.

https://jpaa-patent.info/patent/viewPdf/4191

[Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2014 (Wa) 1397, the Shoe Last case

Original Ameblo publication: 2023-11-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830530025.html

[Unfair Competition Prevention Act / Trade Secrets] 2014 (Wa) 1397, the Shoe Last case

‘Because shoe leather is flexible, it is impossible ... to reproduce from leather shoes on the market a last of exactly the same shape and dimensions as that used to manufacture the shoes and obtain its design information.’ + No circumstances allowing acquisition without particular effort

⇒ The information was not publicly known

086520_hanrei.pdf (courts.go.jp)

[Design / Estoppel] Intellectual Property High Court, 2021 (Gyo-Ke) 10067 <Honda>

Original Ameblo publication: 2023-11-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830655860.html

[Design / Estoppel] Intellectual Property High Court, 2021 (Gyo-Ke) 10067 <Honda>

Whether grounds for rejection exist for a design-registration application is a matter the examiner must determine ex officio and is not subject to the binding effect of admissions.

In this case, the action to rescind the JPO decision concerned whether a right should be granted, and the applicant's change of position did not unfairly harm the interests of the administrative agency as defendant. The court therefore held that estoppel did not bar the argument.

⇒ The applicant was permitted to advance an argument about the article to which the applied-for design relates that differed from its argument before the JPO.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90849.pdf

[Trademark] Osaka High Court, 2021 (Ne) 2608, the Roller Sticker case — * The acts of removing or obliterating the registered trademark and related acts in this case do not, in themselves, constitute trademark infringement.

Original Ameblo publication: 2023-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830954072.html

[Trademark] Osaka High Court, 2021 (Ne) 2608, the Roller Sticker case

* The acts of removing or obliterating the registered trademark and related acts in this case do not, in themselves, constitute trademark infringement.

‘Removing and erasing a trademark ... in the distribution process ... and distributing the goods under one's own different sign ... does not create a likelihood of misidentification or confusion as to commercial origin ... and differs from the form of protection contemplated by the Trademark Act.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91175.pdf

[Copyright / Publication Right] Tokyo District Court, 2021 (Wa) 13720 <Kokubu>

Original Ameblo publication: 2023-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12830954149.html

[Copyright / Publication Right] 2021 (Wa) 13720 <Kokubu>

‘If creative expression is found in the common portions referred to above, the defendant ... created its cover, etc. as a separate work and can therefore be said to have adapted the plaintiff’s cover. ... In either event, the defendant’s cover, etc. cannot be found to have “reproduced ... without alteration” the plaintiff’s cover (Copyright Act, Article 80(1)(i)).’

⇒ No infringement of the publication right in the plaintiff's manga!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91733.pdf

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10157, the NUDE NAIL case <Kanno> <Agent of a foreign trademark owner>

Original Ameblo publication: 2023-12-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831091457.html

[Trademark] Intellectual Property High Court, 2019 (Gyo-Ke) 10157, the NUDE NAIL case <Kanno>

<Agent of a foreign trademark owner>

Five deliveries during the relevant period, totaling JPY 12.61 million.

Premised on an ongoing trading relationship.

The plaintiff sought to acquire a right to use the trademark.

⇒ Regardless of the existence of an agency agreement, etc., the plaintiff qualifies as an ‘agent’ under Article 53-2 of the Trademark Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91407.pdf

[Examination Handbook for Patent and Utility Model / Annex A] Addition of New Matter: Amendments Based on Drawings (8 Examples), p. 549

Original Ameblo publication: 2023-12-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831181576.html

[Examination Handbook for Patent and Utility Model / Annex A] Addition of New Matter: Amendments Based on Drawings (8 Examples), p. 549

The presence or absence of a component and positional relationships are relatively easy to perceive from drawings.

but

(1) Unclear whether the groove in the drawing is ‘for inserting a screwdriver’

(2) Contact is depicted, but it is unclear whether this means ‘light contact in a horizontal, non-depressed key state’

⇒ Amendment not permitted

https://www.jpo.go.jp/system/laws/rule/guideline/patent/handbook_shinsa/document/index/app_a.pdf

Osaka District Court, 2011 (Wa) 15499 [Lid and Container Equipped with the Lid]

Original Ameblo publication: 2023-12-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831314773.html

Osaka District Court, 2011 (Wa) 15499 [Lid and Container Equipped with the Lid]

<Damages> Article 102(2)

Approximately JPY 32.57 million awarded

Contribution rate 15% (85% reduction)

Alternative technologies: numerous containers can hold food and be heated

⇒ Only the plaintiff's product, the defendant's respective products, and the embodiment of the Otsu 30 invention integrally mold the flap portion and lid.

(Extract from the court's reasoning)

<Contribution rate>

The parties do not dispute that, in addition to the plaintiff's product and the defendant's respective products, numerous containers exist that can hold food and heat it. However, among those integrally molding the flap portion and lid, only the plaintiff's product, the defendant's respective products, and an embodiment of the Otsu 30 invention can be established.

The respective patented inventions have technical significance in producing the effect that ‘after cooking, moisture inside the container can be discharged through the opening. As a result, the container of the invention can suitably be used for cooking pasta, etc.’ (paragraph [0023]). Considering comprehensively these circumstances concerning the availability of substitutes, the technical significance of the respective patented inventions, and all other circumstances appearing in this case, a 15% contribution of the respective patented inventions to sales of the defendant's products is appropriate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83697.pdf

Osaka District Court, 2011 (Wa) 6878 [Method for Stabilizing the Coloration of a Colored Plaster Composition] <Damages> Article 102(2)

Original Ameblo publication: 2023-12-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831440848.html

Osaka District Court, 2011 (Wa) 6878 [Method for Stabilizing the Coloration of a Colored Plaster Composition]

<Damages> Article 102(2)

Approximately JPY 26.78 million awarded

<Grounds for rebutting the presumption> 60%

(1) Existence of competitors

(2) Features other than the invention: the defendant's catalog does not list the invention's ingredients or the accompanying uniformity and stability of coloration, prevention of uneven color, etc. as features

<Grounds for rebutting the presumption>

The invention has the effect of making the coloration of a colored plaster composition uniform and stable and preventing uneven color in the colored plaster coating formed when that composition is used. For a colored plaster composition used as a wall-coating material, this enhances usefulness and directly relates to commercial value, contributing to profits from sales of the defendant's product.

However, Patented Invention 1 is neither a product invention nor an invention of a method for producing a product, but a process invention other than a process for producing a product. Its contribution to profits from sales of the product must therefore be evaluated as low.

Features other than the invention: the website and catalog introducing the defendant's product did not list as product features the ingredients specified in the invention or the resulting effects of uniform and stable coloration or prevention of uneven color in the colored plaster coating formed when the product is used. Rather, while taking plaster's humidity-regulating function, etc. as a basis, the website and catalog emphasized features such as deodorizing through the inclusion of titanium oxide and antibacterial action through silver ions. These features also appear actually to have stimulated a certain amount of demand.

Existence of competitors

(Extract from the court's reasoning)

<Grounds for rebuttal>

Under Article 102(2) of the Patent Act, where a person infringing a patent right (or a contractually exclusive non-exclusive license) obtains profits from that infringement, the amount of those profits is presumed to be the amount of damage. However, part of that presumption is understood to be rebuttable depending on the degree to which working the patented invention contributed to those profits.

On this point, as also discussed in B above, Patented Invention 1 has the effect of making the coloration of a colored plaster composition uniform and stable and preventing uneven color in the colored plaster coating formed when that composition is used. For a colored plaster composition used as a wall-coating material, this enhances usefulness and directly relates to commercial value, and it certainly contributes to profits from sales of the defendant's Product 1.

However, Patented Invention 1 is neither a product invention nor an invention of a method for producing a product, but a process invention other than a process for producing a product. Its contribution to profits from sales of the product must therefore be evaluated as low.

The website (Ko 25) and catalog (Ko 26) introducing the defendant's Product 1 did not list as its features the ingredients specified in Patented Invention 1 or the accompanying effects of uniform and stable coloration or prevention of uneven color in the colored plaster coating formed when the product is used. Rather, while taking plaster's humidity-regulating function, etc. as a basis, the website and catalog emphasized features such as deodorizing through the inclusion of titanium oxide and antibacterial action through silver ions. These features also appear actually to have stimulated a certain amount of demand (Otsu 50–52).

Considering, in addition to the foregoing circumstances, the existence of competitors (Ko 33; Otsu 12 and 13), it is appropriate to find the presumption under Article 102(2) of the Patent Act rebutted to the extent of 60%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83546.pdf

Osaka District Court, 2009 (Wa) 10811 [Method and Apparatus for Manufacturing a Rotary Toothbrush] <Damages> Article 102(1)

Original Ameblo publication: 2023-12-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831575626.html

Osaka District Court, 2009 (Wa) 10811 [Method and Apparatus for Manufacturing a Rotary Toothbrush]

<Damages> Article 102(1)

Contribution rate 10% (90% reduction)

Circumstances preventing sales: 80%

<Circumstances preventing sales> Proviso to Article 102(1)

(1) Trading relationships with numerous retailers

(2) Advertising activities

(3) Price difference

<Contribution rate>

Merely advanced the manufacturing method on the premise of a product invention

<Circumstances preventing sales> Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its product

The defendant can be said to have achieved that sales volume by setting a suggested retail price of JPY 500, maintaining relationships with numerous retailers, and combining these with advertising activities involving substantial expenditure.

Sales of the plaintiff's product peaked in 2003 and 16, declined in 2005–18, and by the latter year the business was showing signs of reaching an impasse.

There are structural differences: the cylindrical brush is rotatably mounted in the plaintiff's product, whereas in the defendant's product it is fixed to the brush handle.

Price difference: the defendant's suggested retail price is JPY 500; the plaintiff's retail price is JPY 1,500–3,000, considerably high for a toothbrush.

<Contribution rate>

The greatest feature of the plaintiff's product is that a rotary brush formed by stacking numerous individual brush discs is rotatably attached to the handle member. The effects of this structure, including plaque removal and prevention or improvement of periodontal disease through gum massage, as well as the aesthetic appeal of its form, distinct from ordinary toothbrushes, can be said to stimulate demand among consumers.

⇒ What the defendant infringed, however, was a patent right for inventions of methods and apparatuses for efficiently manufacturing such rotary brushes and individual brush discs without skilled techniques, and

the method invention is positioned merely as advancing the manufacturing method on the premise of a product invention. ⇒ A contribution rate of 10% for the invention is appropriate.

(Extract from the court's reasoning)

Circumstances preventing sales

Over approximately four years from November 9, 2007, the defendant transferred ●●●●●●●●●●●●●●●●●●●●●● of its products. It can be said to have achieved that sales volume by setting a suggested retail price of JPY 500 (Ko 27-2 and 27-3), maintaining trading relationships with numerous retailers (Ko 33 and 34), and combining these with advertising activities involving substantial expenditure (Ko 9; Ko 27-1 to 27-3; entire purport of the oral argument).

By contrast, the plaintiff's product had been manufactured and sold by TC Dental, whose representative director is plaintiff P1, before plaintiff T World was established on November 9, 2007 and granted the contractually exclusive non-exclusive license at issue. From that date onward, only plaintiff T World manufactured and sold it. The combined sales volumes of the two companies were approximately as follows (Ko 55). (Passage omitted)

Namely, sales of the plaintiff's product peaked at approximately ●●● units in 2003 and approximately ●●● units in 2004, and by 2005–18 had already fallen to the ●●-unit range per year; in the latter year the business was showing signs of reaching an impasse (Ko 56). Moreover, since November 9, 2007, when the contractually exclusive non-exclusive license was granted (or, indeed, since July 6 of that year, when the patent right was registered), the plaintiff's product has not been sold in retail stores (Ko 56; entire purport of the oral argument). Although TC Dental had previously advertised it (Ko 23 and 53), there is insufficient evidence of prominent advertising such as television commercials or magazine placements after that time, apart from its own website (plaintiff T World itself admits that no advertising expenses were incurred for its product).

Although the plaintiff's and defendant's products both have cylindrical brushes, they differ structurally: the plaintiff's brush is rotatably mounted, whereas the defendant's is fixed to the handle (Ko 23–25, 27-1 to 27-3, 28, 31 and 32). Moreover, although specific sales volumes are unknown, similar products can be found both among toothbrushes with rotatably mounted cylindrical brush portions like the plaintiff's product and among toothbrushes with cylindrical brush portions fixed to the handle like the defendant's product (Otsu 56–68). It is therefore difficult to find that all customers would have purchased the plaintiff's product had the defendant's product not been sold.

In addition, the plaintiff's retail price was JPY 3,000 when TC Dental sold it and JPY 1,500 even under plaintiff T World, considerably high for a toothbrush. This point alone makes it doubtful whether the same number as the defendant's product could have been sold. Plaintiff P1 himself states that the plan was ‘●●●●●●●●●●●●●●●’ (Ko 56). Thus, insofar as the damages claim assumes a high price in calculating profit per unit of the plaintiff's product, it can be said that the plaintiff should accept a finding of a smaller number that could have been sold.

In view of the foregoing, since November 9, 2007, when plaintiff T World obtained the contractually exclusive non-exclusive license, even absent the defendant's infringement of that license, there were necessarily circumstances under which the plaintiff's product could not have achieved the same volume of ●●●●●●●● units as the defendant's product. It is appropriate to find the quantity deductible for these circumstances to be ●●●●●●●● units, equivalent to 80% of the defendant's transferred quantity of ●●●●●●●● units.

Contribution rate

In examining the contribution of the patented method invention to the plaintiff's profits from its product, as plaintiff T World itself emphasizes, the product's greatest feature is that a rotary brush formed by stacking numerous individual brush discs is rotatably attached to the handle member. The effects of that structure, including plaque removal and prevention or improvement of periodontal disease through gum massage, as well as the aesthetic appeal of its form, distinct from ordinary toothbrushes, can be said to stimulate

demand among consumers. However, what the defendant infringed here was the patent right for inventions of methods and apparatuses for efficiently manufacturing such rotary brushes and individual brush discs without skilled techniques; these do not directly concern the functions of the rotary brush or individual brush discs. The plaintiff's product itself is an embodiment of an invention for which plaintiff P1 separately applied for a patent (Japanese Patent Application 2000-83736; Exhibit Hei 17 contained in Otsu 45-1; the evidence does not establish whether a decision to grant was issued). The patented method invention at issue is positioned merely as advancing the manufacturing method on the premise of that product invention. The plaintiff also registered a design for the form of its product described above (Ko 47), and the registered design is expressly identified on the product's packaging (Ko 11). As stated above, while the packaging identifies another patent entitled ‘Roll Toothbrush’ (Ko 45), it does not identify the patent at issue.

Viewed in this way, the patented method invention can be said to make a certain contribution to profits from the plaintiff's product as technology for manufacturing the individual brush discs that constitute the rotary brush, the principal part of the product, ‘efficiently, without requiring a high degree of skill and with as few steps as possible’ compared with prior art (Ko 2). Nevertheless, its contribution must be regarded as considerably lower than the contribution of the plaintiff's product itself, namely its structural features, effects, and the aesthetic appeal of its form.

Accordingly, it is appropriate to find the contribution rate of the patented method invention to be 10%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83148.pdf

Osaka District Court, 2011 (Wa) 3850 [Flexible Plastic Container]

Original Ameblo publication: 2023-12-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831702139.html

Osaka District Court, 2011 (Wa) 3850 [Flexible Plastic Container]

<Damages> Article 102(1)

Approximately JPY 19.73 million awarded

Contribution rate 10% (90% reduction)

<Contribution rate>

The number of complaints concerning leaks and other problems referred to in the judgment was extremely small compared with annual sales volumes.

Even in the plaintiff's advertising, the effect of reducing pinhole risk is merely described under ‘Detailed Functional Improvements.’

<Circumstances preventing sales> Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its product

The parties do not dispute that, in the market for flexible plastic containers similar to the plaintiff's or defendant's product, the plaintiff's share is 30.4% and the defendant's is 28.6%.

The defendant's sales volume was within the plaintiff's capacity to work the invention, and no alternative technology for the invention has been proven.

<Contribution rate> The invention's contribution rate is 10%

No alternative technology has been proven.

Technical significance of the invention: protecting the ridge with reinforcing ribs serving particular functions and preventing pinholes.

⇒ However, compared with annual sales volumes of the plaintiff’s and defendant’s products, even the total number of complaints referred to in the judgment was extremely small.

Plaintiff's advertising: sales advertisements for its product devote a substantial proportion to the patented invention's effect of reducing pinhole risk, alongside foldability, lightness, and other measures improving container reliability. ⇒ Various factors other than pinhole risk are also considered; even the plaintiff's advertising describes the patented invention's pinhole-risk reduction under ‘Detailed Functional Improvements’ ... . Its contribution to sales should not be overestimated.

Defendant's advertising: the defendant sent customers a document entitled ‘Proposal for the Improved 20-Liter Product (20A).’ The contribution rate in the defendant's product is equivalent to that in the plaintiff's product.

(Extract from the court's reasoning)

Circumstances under the proviso to Article 102(1)

The parties do not dispute that, in the market for flexible plastic containers similar to the plaintiff's or defendant's product, the plaintiff's share is 30.4% and the defendant's is 28.6%.

However, as stated in (1) above, the defendant's sales volume is found to have been within the plaintiff's capacity to work the invention, etc.; moreover, as stated below, there is no allegation and proof sufficient to establish alternative technology for the patented invention.

Accordingly, it is appropriate to regard the defendant's product as having substituted for the plaintiff's product, which embodies the patented invention.

Contribution rate

In light of the following circumstances, a contribution rate of 10% for the patented invention is appropriate.

(1) Usefulness of the patented invention

A. Technical significance of the patented invention

(Passage omitted)

According to the foregoing, the essential feature of the patented invention is found to lie in protecting the ridge with reinforcing ribs serving those functions and preventing pinholes.

B. Availability of alternative technology

The defendant argues that the Otsu 1 invention and the invention described in Japanese Unexamined Patent Publication 1996-48364 (hereinafter the ‘Otsu 10 publication’; the invention is hereinafter the ‘Otsu 10 invention’) constitute alternative technologies for the patented invention. This argument cannot be accepted for the following reasons.

(Passage omitted)

Although the Otsu 10 invention can be said to solve a problem similar to that of the patented invention, there is insufficient evidence concerning its implementation or effects, so it is unclear whether it can substitute for the patented invention.

C. Effects of the patented invention

According to the evidence, of a total of ●●● complaints in fiscal 1995, before the plaintiff began manufacturing and selling its product in 1996, ●● concerned leakage from the folding-groove portion (Ko 26). By contrast, in fiscal 1999, ● complaints concerned leakage from the folding-groove portion, representing ●●●●% of total complaints (Ko 27-2).

These matters establish that the patented invention has a commensurate effect in solving the problem of preventing pinholes.

However, compared with annual sales volumes of the plaintiff's and defendant's products, the above number of complaints, even in total, is extremely small.

(2) Advertising by the plaintiff

According to the evidence (Ko 23-1 to 25-2), the plaintiff's sales advertising for its product devotes a substantial proportion to the patented invention's effect of reducing pinhole risk, alongside foldability, lightness, and other measures improving container reliability.

Flexible plastic folding containers themselves have a relatively simple structure, and the plaintiff has continued manufacturing and selling them for approximately forty-two years (Ko 28). The technical field is therefore considerably mature, and the patented invention is found to have commensurate value in differentiating the product from competitors under those circumstances.

On the other hand, as is clear from the content of the plaintiff's advertising, various factors other than pinhole risk are also considered when purchasing the plaintiff's or defendant's product. Even in the plaintiff's advertising, the patented invention's pinhole-risk reduction is described under ‘Detailed

Functional Improvements.’ In light of this and the discussion in (1)C above, the patented invention's contribution to sales should not be overestimated.

(3) Advertising by the defendant

According to the evidence (Ko 3), the defendant sent customers a document entitled ‘Proposal for the Improved 20-Liter Product (20A).’ The document reports an improvement from the defendant's existing product to the defendant's product having the configuration relating to the patented invention and encourages purchase.

This supports an inference that working the patented invention also contributed to sales of the defendant's product.

Even if, as stated in (3) above, various factors other than pinhole risk are considered when purchasing the plaintiff's or defendant's product, it is appropriate to regard the patented invention's contribution rate to sales of the defendant's product as equivalent to its contribution rate in the plaintiff's product.

(4) Changes in sales volumes of the defendant's product

According to Otsu 31 and 48, for the liquid container manufactured and sold under the product name ‘Baron Box,’ the defendant switched from its existing product to the product at issue and later switched back to its existing product. Sales volumes from June, 2008 to February, 2012 show no major change, but a gradual increase overall, and that trend appears unchanged even after sales of the product at issue ceased.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82662.pdf

Intellectual Property High Court, 2011 (Ne) 10002 [Rice Cake] <Iimura> <Damages> Article 102(2)

Original Ameblo publication: 2023-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831894367.html

Intellectual Property High Court, 2011 (Ne) 10002 [Rice Cake] <Iimura> <Damages> Article 102(2)

Approximately JPY 800 million awarded

Contribution rate 15% (85% rebutted)

<Contribution rate>

(1) Significance of the invention (appearance of grilled rice cakes and suppression of eruption caused by sudden swelling)

(2) Advertising for the defendant's products: displaying and advertising the ‘slits made in the cut rice cakes’

+ Value of the infringing portion, customer-attracting power, and consumers' motivation to select and purchase

(Extract from the court's reasoning) <Contribution rate>

As shown in the attached drawings of the defendant's products (perspective views), the defendant's products have cuts 13 formed in the long sides of the side peripheral surface 12, namely two opposing side faces. Like the invention, they are configured so that, during grilling, the portion above cut 13 rises relative to the portion below it and swells and deforms into a state in which the expanded contents are sandwiched between upper and lower grilled plate-like portions, like a monaka wafer sweet or sandwich, thereby suppressing outward eruption caused by swelling.

It is also found that the defendant (1) has sold the products under the name ‘Sato's Cut Rice Cakes Paritto Slit’ since around September, 2003, actively emphasizing in promotion and advertising that cuts in the upper, lower, and side faces of the rice cakes allow them to grill plumply; (2) from around 2005, packaged rice cakes with cuts became widely known among consumers, contributing to increased sales; and (3) from fiscal 2010, almost all its packaged rice cakes contained cuts. Taken together, these matters show that forming cuts, etc. on the side peripheral surface, which is the upright side face of a cut rice cake, and the resulting ability to grill well are connected to consumers' selection of the defendant's products (Attached Product Lists 1–5) and contribute considerably to increased sales (Ko 4, 21–26, 43, 51, 56-1 to 56-22, and 60–63; Otsu 152, 153 and 164–167).

Considering, as above, the value or importance of the infringing portion in the defendant's products (Attached Product Lists 1–5), customer-attracting power, consumers' motivation to select and purchase, etc., it is appropriate to find that the patent contributed 15% of the profits the defendant obtained from sales of those products (Attached Product Lists 1–5).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82175.pdf

[Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10063 <Miyasaka>, the VENTURE case — Composite marks

Original Ameblo publication: 2023-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831894769.html

[Trademark] Intellectual Property High Court, 2023 (Gyo-Ke) 10063 <Miyasaka>, the VENTURE case — Composite marks

Separation is permitted '... (1) ... (2) ... (3) where, in light of the appearance, etc. of the trademark, the mark as a whole has little structural unity, traders and consumers understand and apprehend it separately and recognize part of it as an abbreviation, etc., with the result that the component is considered to function independently as an indication of commercial origin.'

⇒ 'Not every separated component automatically becomes an essential portion ...'

⇒ '遊' (yū, meaning 'play') is the essential portion of the cited mark

⇒ Dissimilar to the applied-for mark VENTURE

★ As a test for whether a composite mark can be understood and apprehended separately, the court stated (3) as a general proposition in addition to the established (1) and (2)!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92548.pdf



Configuration of the registered trademark

Intellectual Property High Court, 2010 (Ne) 10032 and 2010 (Ne) 10041 [Solid Golf Ball] Damages, Article 102(1)

Original Ameblo publication: 2023-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12831955596.html

Intellectual Property High Court, 2010 (Ne) 10032 and 2010 (Ne) 10041 [Solid Golf Ball] <Damages> Article 102(1)

Approximately JPY 921.52 million awarded

Contribution rate 50%

The proportion remaining after deduction for circumstances preventing sales was 40% in the first-instance judgment. Taking the 50% contribution rate into account as well, this judgment applied a remaining proportion of 20% (an 80% deduction).

Proviso to Article 102(1)

Highly rated for high quality, high performance, and consistent quality

ZnPCTP costs account for 1.0–4.1% of the total

A specific chemical in the core ⇒ Does not necessarily translate directly into profits on the entire product.

<Contribution rate> <Circumstances preventing sales> Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its products

The defendant's golf-ball products are highly rated for their high quality, high performance, and consistent quality, and their usage rate is extremely high not only worldwide but also on Japanese tours.

The plaintiff's product catalog lists ‘core technology,’ ‘cover technology,’ and ‘dimple technology’ in parallel as golf-ball technologies. Under ‘mechanism of flight,’ it also lists spin, launch angle, and dimples alongside initial ball speed.

In the defendant's golf-ball products, zinc pentachlorothiophenolate (ZnPCTP) costs account for approximately 1.0–4.1% of total product costs. ⇒ The patent, characterized by using a specific chemical in the golf ball's core, does not necessarily translate directly into profits on the entire product (golf ball).

Golf balls are said to be bundles of patents, and the plaintiff's golf balls also use many patents besides this patent. ⇒ For golf balls, not only the core but also the cover and dimples are important; performance relating to spin, launch angle, dimples, etc. is important in addition to flight performance.

⇒ The patent's contribution rate is found to be 50%. As the proportion remaining after the deduction corresponding to the quantity attributable to ‘circumstances under which [the plaintiff] would have been unable to sell,’ taking the original judgment's 40% as the basis and also accounting for the patent's 50% contribution rate, the post-deduction proportion is found to be 20%.

(Extract from the court's reasoning) <Contribution rate and circumstances under the proviso to Article 102(1)>

a. Around 2005 (2005), Acushnet Company, the first-instance defendant's parent company, held approximately 49.6% of the U.S. golf-ball market by volume and approximately 60% by value. At the same time, the first-instance plaintiff held about 40% of the Japanese market, but its U.S. share was approximately 5.6% by volume and 4.8% by value.

b. The first-instance defendant's golf-ball products are highly rated for high quality, high performance, and consistent quality, and their usage rate is extremely high not only worldwide but also on Japanese tours.

Around 2003, golf magazines also prominently advertised that the first-instance defendant's golf balls were widely used in Europe and the United States and had a high winning percentage, etc.

c. Although a golf ball is a small rubber sphere, it is said to be a bundle of patents packed with cutting-edge science and technology.

d. The invention covered by this patent aims to provide a solid golf ball with further improved flight performance and is characterized by forming the core from a rubber composition containing a specific chemical.

e. A total of 233 golf-ball-related patents held by the first-instance plaintiff or its parent, Bridgestone Corporation, remained in force during the period from January, 2003 through February, 2006.

f. The first-instance plaintiff's ‘PRECEPT LADY,’ sold in the United States around February 2005 (2005), used at least six Japanese patents corresponding to U.S. patents (including the patent at issue). Its ‘PRECEPT MC LADY’ likewise practiced seven U.S. patents of the first-instance plaintiff.

g. The first-instance plaintiff's product catalog lists ‘core technology,’ ‘cover technology,’ and ‘dimple technology’ in parallel as golf-ball technologies.

Under ‘mechanism of flight,’ the same catalog also lists spin, launch angle, and dimples alongside initial ball speed.

h. In the first-instance defendant's golf-ball products, zinc pentachlorothiophenolate (ZnPCTP) costs account for approximately 1.0–4.1% of total product costs.

(c) Because this patent, characterized by using a specific chemical in the golf ball's core, does not necessarily translate directly into profits on the entire product (golf ball), its contribution rate will be considered in applying the proviso to Article 102(1) of the Patent Act.

As stated in (a) and (b) above, in Japan's golf-ball market from 2003 through 2007, the first-instance plaintiff had the largest share and the first-instance defendant the third-largest. Assuming a market excluding the first-instance defendant, the plaintiff's share would be slightly above approximately 40%. Meanwhile, in the United States around 2005 (2005), Acushnet Company held the largest golf-ball market share and was also extremely well known in Japan through advertising, etc.

As stated above, golf balls are said to be bundles of patents, and the first-instance plaintiff's golf balls use many patents besides this patent. The patent is characterized by forming the core from a rubber composition containing a specific chemical and aims at further improving flight performance.

For golf balls, not only the core but also the cover and dimples are important; performance relating to spin, launch angle, dimples, etc. is important in addition to flight performance.

Considering all these circumstances comprehensively, the patent's contribution rate is found to be 50%. In this case, as the proportion remaining after the deduction corresponding to the quantity attributable to ‘circumstances under which [the first-instance plaintiff] would have been unable to sell,’ it is appropriate to take the original judgment's 40% as the basis and, also considering the patent's 50% contribution rate, find the post-deduction proportion to be 20%.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82056.pdf

Intellectual Property High Court, 2010 (Ne) 10091 [Treatment Agent for Immobilizing ... Heavy Metals in Fly Ash] <Damages> Articles 102(1) and 102(3)

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832089491.html

Intellectual Property High Court, 2010 (Ne) 10091 [Treatment Agent for Immobilizing ... Heavy Metals in Fly Ash]

<Damages> Articles 102(1) and 102(3)

Approximately JPY 1.8 billion awarded

Circumstances preventing sales were assessed by reference to competitors present in fiscal 2003–18, with quantities calculated according to market share (Article 102(3): Period 1, before sales of the plaintiff’s product; Article 102(1): Periods 2 and 3, after sales began).

Proviso to Article 102(1)

Competitors

The argument concerning the defendant’s sales efforts, including its filing of a notification at a particular time, was rejected as a circumstance preventing the patentee from making the sales.

(Article 102(3): Period 1, before sales of the plaintiff's product; Article 102(1): Periods 2 and 3, after sales began) Proviso to Article 102(1): circumstances under which the plaintiff would have been unable to sell its product

Existence of competitors: suggests competitors existed in fiscal 2003–18. ⇒ Apportioned according to market share.

The evidence does not establish what significance the defendant's sales efforts, etc. (filing a notification at a particular time) had for the subsequent formation of the market for piperazine-based products among fly-ash heavy-metal immobilization agents.

The premise that the level of the plaintiff's average unit selling price is immediately reflected in tender prices is not necessarily correct.

(Extract from the court's reasoning)

(6) Application of the proviso to Article 102(1) of the Patent Act (circumstances preventing sales) in Periods 2 and 3

A. The underlying market size

(a) In this appeal, the first-instance defendant argues that, in calculating the quantity of the plaintiff's product that could have been sold absent sales of the defendant's product, the market for all fly-ash heavy-metal immobilization agents, including non-piperazine agents (Otsu 60, 61, 64, 94 and 108), should be used as the premise.

(b) However, non-piperazine fly-ash heavy-metal immobilization agents use active chemical substances different from those in piperazine-based agents, and therefore cannot in the first place be regarded as substitutes.

In addition, it is difficult to conclude, solely from the wording of tender specifications of some waste-treatment entities, as the first-instance defendant argues, that non-piperazine fly-ash heavy-metal immobilization agents may have been sold as substitutes for the defendant's product. This is also corroborated by the fact that many tender specifications (Ko 68; Otsu 96) list only piperazine-based fly-ash heavy-metal immobilization agents as eligible products (Ko 67-1).

Accordingly, the first-instance defendant's above argument cannot be accepted.

B. Existence of competitors

(a) Market size and market shares for piperazine-based fly-ash heavy-metal immobilization agents

(1) The first-instance defendant argues that, because competitors other than the first-instance plaintiff and defendant also manufacture and sell piperazine-based fly-ash heavy-metal immobilization agents, even assuming the defendant's product had not existed in the market, the plaintiff could not have sold the entirety of the defendant's sales volume. It argues that a market excluding the defendant's product should be assumed and that, of the defendant's sales volume, the quantity corresponding to competitors' shares in that market constitutes a quantity attributable to ‘circumstances under which [the plaintiff] would have been unable to sell.’

(2) Upon examination, Article 1 of both the former Chemical Substances Control Act and the Chemical Substances Control Act effective April 1, 2004 states that their purpose is to regulate as necessary the manufacture, etc. of new chemical substances to prevent environmental contamination by substances that may harm human health. Dipotassium piperazine-1,4-bis(carbodithioate) and potassium piperazine-1-carbodithioate were designated as designated chemical substances under Article 2(4) of the former Act (Ministry of Health, Labour and Welfare, Ministry of Economy, Trade and Industry, and Ministry of the Environment Joint Public Notice No. 1 of January 9, 2004; Otsu 55). Accordingly, before that date those substances were new chemical substances under Article 3 of the former Act, and thereafter they were designated chemical substances. Both substances also constitute Type II Monitoring Chemical Substances under Article 2(5) of the Chemical Substances Control Act.

Article 23(1) of both the former and the current Chemical Substances Control Acts requires persons manufacturing or importing designated chemical substances or Type II Monitoring Chemical Substances to notify the Minister of Economy, Trade and Industry annually of the quantities manufactured and imported. Article 45(ii) of the former Act prescribes a fine of no more than JPY 100,000 for violations, and Article 45(ii) of the current Act likewise prescribes a fine of no more than JPY 300,000. Article 23(2) of both Acts provides that the Minister shall annually publish the notified quantities manufactured and imported.

As above, the accuracy of the total manufacturing and import quantities of the respective substances published by the Minister under Article 23(2) of the former or current Act is secured by criminal penalties. Those totals should therefore be regarded as accurately reflecting the market size (sales volume) of those substances in Japan.

(3) Next, there is no material directly establishing the overall market size (sales volume) of piperazine-based fly-ash heavy-metal immobilization agents using those substances, and the first-instance defendant has not submitted particularly specific evidence of competitors other than the plaintiff and defendant in the market for piperazine-based heavy-metal immobilization agents. Meanwhile, a statement by an employee of the first-instance plaintiff (Ko 67-1) states that, from April, 2006 onward, the only piperazine-based fly-ash heavy-metal immobilization agents on the market were the plaintiff's and defendant's products.

Upon examination, the total manufacturing and import quantities of those substances published in Ministry of Economy, Trade and Industry notices are found to be 5,619 tonnes in fiscal 2003 (Ko 35-1), 7,773 tonnes in fiscal 2004 (Ko 4-1), 7,586 tonnes in fiscal 2005 (Ko 4-2), 10,434 tonnes in fiscal 2006 (Ko 35-2), 7,482 tonnes in fiscal 2007 (Otsu 54-1 and 54-2), 7,893 tonnes in fiscal 2008 (Otsu 54-1 and 54-2), and 7,023 tonnes in fiscal 2009 (Ko 50). No material is available to confirm the quantity for fiscal 2010, so an accurate figure cannot be determined; for calculation purposes, the most recent fiscal 2009 quantity will be substituted. The plaintiff's and defendant's products are manufactured and sold as aqueous solutions containing those substances at an average concentration of 38%. Dividing the total notified quantity of the substances by 0.38 therefore gives a provisional market size (sales volume) for piperazine-based fly-ash heavy-metal immobilization agents based solely on the published figures.

Calculating provisional annual market sizes (sales volumes) for piperazine-based fly-ash heavy-metal immobilization agents in Periods 2 and 3 by the above method gives the figures in Column C of Attached Table 3.

Using the defendant's sales volumes found in (5)B(a) above (Column B of Attached Table 3) and the plaintiff's sales volumes established by Table 4 of Expert Report A and Ko 64 (Column A of Attached Table 3), provisional annual market shares of the plaintiff's and defendant's products in Periods 2 and 3 are as shown in Column D of Attached Table 3. Their products account for the entire provisional market in fiscal 2007 and also show high shares of ● ●●●% to ●●●●% in fiscal 2008–22. By contrast, their combined share of the provisional market in fiscal 2006 is only ●●●●%.

(4) As above, the manufacturing and import quantities of the substances published by the Minister and the market size (sales volume) of piperazine-based heavy-metal immobilization agents do not necessarily coincide. Nevertheless, the plaintiff employee's statement that only the plaintiff's and defendant's products occupied the market is corroborated for fiscal 2007 by their occupation of the entire provisional market. For fiscal 2008, their combined provisional share is high and close to those for fiscal 2009 and 22; for fiscal 2009 and 22, the statement is also corroborated by many waste-treatment entities' tender specifications listing only the plaintiff's or defendant's product as eligible products (Ko 68). The statement is therefore credible insofar as it concerns fiscal 2007–22. For those fiscal years, in which the plaintiff's product objectively shows a high market share even on the provisional figures, it is appropriate to find that only the plaintiff's and defendant's products existed in the market for piperazine-based fly-ash heavy-metal immobilization agents.

For fiscal 2006, however, the waste-treatment entities' tender specifications supporting the statement all relate to fiscal 2009 and 22, years removed from fiscal 2006, and the combined share of the plaintiff's and defendant's products in the provisional market is only 75.2%. The statement that their products occupied the entire market therefore lacks sufficient corroboration. Rather, as explained in (2) above, the accuracy of the notified manufacturing and import quantities underlying the publication is secured by criminal penalties. The above provisional share of ●●●●% for fiscal 2006 shows a significant difference from the provisional shares for fiscal 2007 onward (●●●●%–●●●%) found in (3). In the absence of sufficient evidence that large quantities of the substances were used for purposes other than fly-ash heavy-metal immobilization agents, this difference should be regarded as sufficient to infer the existence of competitors in fiscal 2006.

Fiscal 2003–17, moreover, was a period in which three OEM companies existed as competitors in the market.

Accordingly, for fiscal 2003–18, absent other reliable evidence, when considering circumstances under which the first-instance plaintiff would have been unable to sell, the manufacturing and import quantities of those substances notified to the Minister, which approximately accurately reflect the market size for piperazine-based heavy-metal immobilization agents, must be treated as corresponding to that market size.

(5) Therefore, of the defendant's sales volumes in fiscal 2003–18, after excluding quantities considered to have been sold by competitors had the defendant's product not been sold, the quantity of the plaintiff's product that the first-instance plaintiff could have sold should appropriately be the defendant's sales volume (the fiscal 2003–18 portions of Column A of Attached Table 4) multiplied by the plaintiff's market share calculated above in the market for piperazine-based fly-ash heavy-metal immobilization agents excluding the defendant's product (the fiscal 2003–18 portions of Column B of Attached Table 4). The resulting quantities appear in the fiscal 2003–18 portions of Column F of Attached Table 4.

For fiscal 2007–22, by contrast, as stated above, only the plaintiff's and defendant's products are found to have existed in the market for piperazine-based fly-ash heavy-metal immobilization agents. The existence of competitors therefore cannot be found as a circumstance under which the first-instance plaintiff would have been unable to sell its product.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82109.pdf

Tokyo District Court, 2008 (Wa) 2944 [Normally Closed Flow-Control Valve] <Damages> Article 102(2)

Original Ameblo publication: 2023-12-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832384709.html

Tokyo District Court, 2008 (Wa) 2944 [Normally Closed Flow-Control Valve] <Damages> Article 102(2)

Approximately JPY 396.20 million awarded

Contribution rate 40% (60% reduction)

<Contribution and grounds for rebutting the presumption>

Alternative technology: pressure-type control devices and thermal-type flow-control devices fundamentally differ in their underlying approach to flow control; one is not an improved version of the other, and their characteristics each have advantages and disadvantages. Users therefore choose the method best suited to what is to be controlled, considering each device's features. As stated above, many features of the defendant's product that the defendant invokes could also have been accommodated by the plaintiff in a mass-flow controller if customers had requested similar specifications.

(Extract from the court's reasoning) <Contribution and grounds for rebutting the presumption>

... As above, pressure-type control devices and thermal-type flow-control devices fundamentally differ in their underlying approach to flow control; one is not an improved version of the other, and their characteristics each have advantages and disadvantages. Users can therefore be said to choose the method best suited to what is to be controlled, considering each device's features. As stated above, many features of the defendant's product that the defendant invokes are found to have been capable of accommodation by the plaintiff even in a mass-flow controller if customers had requested similar specifications.

(Passage omitted)

Considering comprehensively the circumstances found in Section 8 above, a 40% contribution of the invention to sales of the defendant's product is appropriate.

The defendant argues, by contrast, that (1) its product was jointly developed with its customer; (2) it has features absent from the plaintiff's product (flow control using a pressure sensor); and (3) the plaintiff had no sales history with that customer, which had previously purchased mass-flow controllers from companies other than the plaintiff. On these grounds, it argues that even absent infringement, there was no possibility that the plaintiff could have sold its product to the defendant's customer and that the plaintiff did not suffer damage equivalent to the profits from sales of the defendant's product. However, in light of the circumstances found in Section 8 above, it cannot necessarily be said that the defendant's product is superior to the plaintiff's, or that competitors' products are superior to the plaintiff's and the defendant's customer would have purchased a competitor's product if the defendant's product had not been sold. Such circumstances cannot be established. Accordingly, circumstances rebutting the presumption under Article 102(2) of the Patent Act are not found in this case.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81244.pdf

Osaka District Court, 2007 (Wa) 13513 [X-Ray Foreign-Matter Inspection Apparatus] <Damages> Article 102(2)

Original Ameblo publication: 2023-12-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832385120.html

Osaka District Court, 2007 (Wa) 13513 [X-Ray Foreign-Matter Inspection Apparatus] <Damages> Article 102(2)

Approximately JPY 371.50 million awarded

Contribution rate 20% (80% rebutted)

(1) An important function for maintainability, but an ancillary function.

(2) The defendant has the leading 48% share of the X-ray foreign-matter inspection apparatus market and a comprehensive support system.

The invention concerns the very support structure for the conveying mechanism and line sensor, important components of an X-ray foreign-matter inspection apparatus, and is indispensable to the overall structure of the defendant's product.

In its product pamphlet, the defendant emphasizes ‘cleanability,’ stating that the apparatus ‘can be easily disassembled and washed with water,’ in relation to easy maintenance, an effect of the patented invention.
⇒ The invention, which directly relates to the belt conveyor's cleanability, should be regarded as making a considerable contribution to sales of the defendant's product. However, the product's primary function is to inspect food for foreign matter using X-rays; although maintainability is important, it is only ancillary. The patented invention's contribution is therefore assessed within the limits of that ancillary function.

Defendant's sales capabilities: its leading 48% share in the X-ray foreign-matter inspection apparatus market and comprehensive support system contribute commensurately to sales of its product.

Competitor activities: the exclusivity of a patent right (Patent Act, Article 68) is a special legal effect, and unauthorized working by competitors does not diminish it.

Rather, because, as the defendant argues, competitors such as Anritsu, Nissin Electronics, and System Square practice the patented invention, the invention is found highly useful in X-ray foreign-matter inspection apparatuses, with no readily substitutable alternative technology.

(Extract from the court's reasoning)

(a) Position of the patented invention in the defendant's product

The patented invention concerns the very support structure for the conveying mechanism and line sensor, important components of an X-ray foreign-matter inspection apparatus, and is found indispensable to the overall structure of the defendant's product.

Regarding easy maintenance, an effect of the patented invention, the defendant's product pamphlets (Ko 5 and 15) emphasize ‘cleanability,’ stating that the apparatus ‘can be easily disassembled and washed with water.’ The defendant's product principally inspects food, and food-related machinery must always be kept hygienic, particularly conveyors carrying food. The defendant's instruction manual also recommends daily cleaning: ‘After finishing operation for the day, clean each part of the conveyor.’ Accordingly, the patented invention, which directly relates to the belt conveyor's cleanability, should be regarded as making a considerable contribution to sales of the defendant's product.

However, the defendant's product primarily functions to inspect food for foreign matter using X-rays; although maintainability is an important function, it is only ancillary.

The patented invention's contribution should therefore also be assessed within the limits of that ancillary function.

(b) Availability of alternative technology

The defendant argues that the configuration of the publicly used apparatus is an alternative technology to the patented invention. Admittedly, the technical idea of facilitating maintenance can also be perceived in that apparatus. However, its solution is to support the conveyor unit constituting the conveying mechanism with a member separate from the support member of the main body of the X-ray foreign-matter inspection apparatus, and then pull the unit forward, which differs greatly from the patented invention. Although in Otsu 6 and Otsu 13 the defendant shows cleaning without pulling the conveyor unit forward, the publicly used apparatus's instruction manual (Ko 9, p. 126) states that the conveyor unit is to be pulled out as part of the conveyor-cleaning procedure (despite being the seller of the publicly used apparatus, the defendant shows a maintenance procedure different from its manual). Thus, the means of solving the problem of easy maintenance in the publicly used apparatus should be regarded as pulling the conveyor unit forward. Because the apparatus adopts that structure, it requires correspondingly more work and must be regarded as inferior to the patented invention in maintainability.

Accordingly, although the publicly used apparatus has a configuration facilitating maintenance, it cannot be found to be an alternative technology readily substitutable for the patented invention.

(c) Defendant's technical capabilities

The defendant argues that its product sells because of technical elements other than the patented invention, specifically citing that the space below its conveyor is open and easy to clean.

However, the defendant's pamphlets (Ko 5 and 15) say nothing about that effect. The defendant also points out that the space below the plaintiff's product is not open, but according to the plaintiff's pamphlets (Ko 20, p. 2; Ko 21, p. 3), opening the inspection-chamber door also permits easy cleaning beneath the conveying mechanism in the plaintiff's product. Taking into account as well that daily cleaning is recommended for food-related X-ray foreign-matter inspection apparatuses, it is difficult to regard the open space below the defendant's conveyor as a major selling point.

The defendant also argues that its product sells because of ‘missing-item inspection accuracy,’ ‘durability,’ and ‘ease of handling,’ but there is insufficient evidence to establish this.

(d) Defendant's sales capabilities

The entire purport of the oral argument establishes that X-ray foreign-matter inspection apparatuses are used before or after computer scales, checkweighers, etc. on the same line; that sales capabilities for those peripheral devices led to opportunities to sell X-ray foreign-matter inspection apparatuses; that the defendant has the leading 48% share of the market; and that the defendant maintains a comprehensive support system. These facts are found to contribute commensurately to sales of its product.

The plaintiff argues on this point that the defendant was able to secure a position in the field of X-ray foreign-matter inspection apparatuses because the plaintiff and defendant cooperated closely and inseparably. However, whether the plaintiff contributed to establishing the defendant's sales network is basically unrelated to assessing the patented invention's contribution to sales of the defendant's product, and the argument cannot be accepted.

(e) Competitor activities

The defendant argues that competitors such as Anritsu practice the patented invention in the X-ray foreign-matter inspection apparatus market, and that the patented invention lacks deterrent force and therefore has no exclusive value.

However, the exclusivity of a patent right (Patent Act, Article 68) is a special effect granted by law, and unauthorized working by competitors does not diminish that legal effect.

Rather, because, as the defendant argues, competitors such as Anritsu, Nissin Electronics, and System Square practice the patented invention (the parties do not dispute this fact here, so it is taken as a premise), the invention is found highly useful in X-ray foreign-matter inspection apparatuses, with no readily substitutable alternative technology.

(f) As above, although the patented invention does not concern the primary function of an X-ray foreign-matter inspection apparatus, it is highly useful for maintainability, an important function for food-handling equipment, and no readily substitutable alternative technology is found. Considering also that the patented invention is structurally indispensable to the defendant's product, even accounting for the defendant's sales network's contribution to sales, a contribution rate of 20% for the patented invention is appropriate.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-38170.pdf

Tokyo District Court, 2003 (Wa) 19926 [Coagulant Composition for Tofu] <Damages> Article 102(1)

Original Ameblo publication: 2023-12-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832479061.html

Tokyo District Court, 2003 (Wa) 19926 [Coagulant Composition for Tofu] <Damages> Article 102(1)

Approximately JPY 152.29 million awarded

<Circumstances preventing sales> Proviso to Article 102(1): none

⇒ In light of the rapidly expanding demand for emulsified nigari products for tofu, etc., it cannot be said that the plaintiff's product and the defendant's respective products lack a complementary relationship.

(Extract from the court's reasoning)

The defendants argue, as circumstances under the proviso to Article 102(1) of the Patent Act, that (1) demand for their respective products arose from the products' own characteristics and the defendants' sales efforts, and (2) defendant Kawa Shoji supplies the respective products only through the sales channels of Hoshitaka Co., Ltd., to which the plaintiff ceased supplying. They therefore argue that the plaintiff's product and their products have no mutually complementary relationship.

However, even all the evidence in this case does not establish the circumstances concerning transactions between Hoshitaka Co., Ltd. and the plaintiff. In light of the fact that, since April, 1998, demand for emulsified nigari products for tofu has rapidly expanded among major mass-production tofu manufacturers (Ko 8-1 and 8-2), etc., it cannot be said that the plaintiff's product and the defendants' respective products lack a complementary relationship. Nor is there other sufficient evidence of facts supporting the defendants' assertions, which therefore cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9931.pdf

[Trademark] Tokyo District Court, 2022 (Wa) 18610 <Kokubu>

Original Ameblo publication: 2023-12-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832606903.html

[Trademark] Tokyo District Court, 2022 (Wa) 18610 <Kokubu>

If the bankruptcy trustee of Onkyo Home Entertainment sells the remaining inventory bearing the Pioneer mark after the agreed six-month period following termination of the license agreement has expired, those sales constitute trademark infringement.

The Supreme Court's Fred Perry judgment concerns unlawfulness of parallel imports. This case concerns unlawfulness of acts by the former licensee itself and is factually different.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92167.pdf

[Trademark] Intellectual Property High Court, 2016 (Gyo-Ke) 10164 and 2017 (Gyo-Ke) 10169

Original Ameblo publication: 2023-12-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12832797762.html

[Trademark] Intellectual Property High Court, 2016 (Gyo-Ke) 10164

Trademark at issue: ゲンコツメンチ (Genkotsu Menchi)

Cited mark: ゲンコツ (Genkotsu)

⇒ Dissimilar; cannot be separated.

The word menchi is not particularly widespread as a noun meaning menchi-katsu (minced-meat cutlet).

[Trademark] Intellectual Property High Court, 2017 (Gyo-Ke) 10169

Trademark at issue: ゲンコツコロッケ (Genkotsu Korokke)

Cited mark: ゲンコツ (Genkotsu)

⇒ Similar; separable. The korokke (‘croquette’) portion has low distinctiveness.

Intellectual Property High Court, 2021 (Gyo-Ke) 10097 [Golf Swing Monitoring System] <Otaka>

Original Ameblo publication: 2023-12-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833126467.html

Intellectual Property High Court, 2021 (Gyo-Ke) 10097 [Golf Swing Monitoring System] <Otaka>

* General principles for amendments increasing the number of claims

An amendment increasing the number of claims is itself permitted ‘if a new post-amendment claim limits the invention-specifying features of a particular corresponding pre-amendment claim’!!

* In this case, deleting the configuration did not constitute a narrowing amendment

★ For amendments increasing the number of claims, see Tokugikon No. 307

https://www.tokugikon.jp/gikonshi/307/307hanketsu.pdf

Tokyo District Court, 2022 (Wa) 5905 [Composition for Promoting Increased Subcutaneous Tissue] <Shibata>

Original Ameblo publication: 2023-12-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833126611.html

Tokyo District Court, 2022 (Wa) 5905 [Composition for Promoting Increased Subcutaneous Tissue] <Shibata>

The defendant maintained that the drugs were administered separately. The court found insufficient evidence that the defendant had compounded and manufactured a preparation containing the drugs together and administered that preparation to the patient.

⇒ No literal satisfaction of the claim (no allegation of indirect infringement)

Related cases: Tokyo District Court, 2011 (Wa) 19435, and Osaka District Court, 2011 (Wa) 7576 [Pioglitazone]

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92235.pdf

Intellectual Property High Court, 2018 (Gyo-Ke) 10146 [Pachinko Machine] <Otaka>

Original Ameblo publication: 2023-12-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833126637.html

Intellectual Property High Court, 2018 (Gyo-Ke) 10146 [Pachinko Machine] <Otaka>

* ‘A predetermined number of game balls’ was construed as, in principle, multiple balls

⇒ No effect on the outcome

‘The claimed invention and the invention according to Claim 1 ... differ only in configuration G ... . Therefore ... “a predetermined number of game balls” in the claimed invention is also construed in the same way as ... in claim 1.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88767.pdf

[Design] Intellectual Property High Court, 2023 (Gyo-Ke) 10001 <Shoji> — Ease of creation denied

Original Ameblo publication: 2023-12-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833247790.html

[Design] Intellectual Property High Court, 2023 (Gyo-Ke) 10001 <Shoji> — Ease of creation denied

‘The shapes of the upper end, opening end, and bottom face of the main body, and the shape of the handle of the design at issue ... are neither changes achievable by commonplace techniques, minor modifications, nor a mere aggregation. Novelty of conception or originality cannot be denied in their forming a coherent, unified aesthetic with the overall substantially inverted truncated-cone shape, whose left and right edges, viewed from the front and side, spread outward toward the top like a V. The design at issue cannot be said to be easily creatable from the above designs, and there is no error in the JPO decision.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92129.pdf

Intellectual Property High Court, 2022 (Gyo-Ke) 10125 <Hibiku Shimizu>, Disclaimer Claims and Correction Requirements

Original Ameblo publication: 2023-12-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833371802.html

Intellectual Property High Court, 2022 (Gyo-Ke) 10125 [Composition Containing 2,3-Dichloro-1,1,1-Trifluoropropane, 2-Chloro-1,1,1-Trifluoropropene, 2-Chloro-1,1,1,2-Tetrafluoropropane, or 2,3,3,3-Tetrafluoropropene] <Hibiku Shimizu>

Disclaimer Claims and Correction Requirements

(1) Excluding only the portion identical to an earlier-filed invention or prior art is not a correction requirement.

(2) The court found that the correction excluded a portion likely to be assessed as substantially identical to prior art relied on for grounds of invalidity based on lack of novelty and inventive step.

⇒ An impact on correction requirements?

(1) was held for the first time!!

Assessment of the holding in (2) may stir controversy ...

(Extract from the court's reasoning)

... When correcting the claims, ... there is no requirement to exclude only the portion identical to an earlier-filed invention or only the portion identical to prior art publicly known before the patent application. Where a correction is made ‘within the scope of matters described in the specification, claims, or drawings,’ that is, where it introduces no new technical matter in relation to the original technical matters, it is difficult to envisage unforeseen harm to third parties from the correction. It should therefore be said to be inappropriate to add requirements of the kind asserted by the defendant when interpreting the correction requirements of that paragraph.

The defendant also argues that the content of a corrected invention cannot be freely defined in the form of a disclaimer claim. The correction at issue ... followed an advance notice of a trial decision finding invalidity grounds of lack of novelty and inventive step based on Ko 4. However, ... Ko 4 states ... ‘This concerns an advantageous method of directly preparing ... hydrofluorocarbons from a halocarbon mixture containing HCFC-225cb. ... The method is performed without converting a substantial quantity of that HCFC-225cb into other compounds’ ([0012]) and ‘A preferred mixture according to the invention is a mixture containing the compound HCFC-225cb. In another preferred embodiment, the mixture consists essentially of approximately 1 to approximately 99 weight percent HCFC-225cb ...’ ([0015]). In light of those passages, the correction can be said to seek to exclude the portion likely to be assessed as substantially identical to the invention described in Ko 4. It therefore cannot be said to freely define the corrected invention's content independently of the prior-art invention described in Ko 4.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92409.pdf

[Unfair Competition Prevention Act, Article 2(1)(iii)] Tokyo District Court, 2017 (Wa) 21145 <Sato>

Original Ameblo publication: 2023-12-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833494414.html

[Unfair Competition Prevention Act, Article 2(1)(iii)] Tokyo District Court, 2017 (Wa) 21145 <Sato>

* ‘Goods’ under the Unfair Competition Prevention Act include intangible things

The plaintiff's software has economic value separate from the tablet and can independently be traded ... ; it can therefore be called ‘goods,’ and ... the screen's shape, patterns, colors, etc. may constitute ‘configuration.’

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88101.pdf

[Article / Europe] Intermediate Generalization — A Special EPC Patent Procedure

Original Ameblo publication: 2023-12-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12833680537.html

[Article / Europe] Intermediate Generalization — A Special EPC Patent Procedure (Patent, Vol. 72, No. 13, 2019; Christian Köster)

<Permitted examples>

T2297/16

The Board found no reason to consider the 10% concentration of N-acetyl glucosamine closely associated with the other technical features or linked to a particular property of the cream composition.

T1396/13

They are not inseparably linked.

https://jpaa-patent.info/patent/viewPdf/3454

[Article / Foreign Jurisdictions] Selection Inventions at the EPO (Patent, Vol. 73, No. 14, 2020; Charles Renney and Eleanor Maciver)

Original Ameblo publication: 2023-12-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834008813.html

[Article / Foreign Jurisdictions] Selection Inventions at the EPO (Patent, Vol. 73, No. 14, 2020; Charles Renney and Eleanor Maciver)

For selection inventions at the EPO, a combination obtained by selections from two or more lists of a certain length may be novel where that combination is not specifically disclosed in the prior art (the two-list principle). This does not mean that every finding of novelty requires selection from at least two lists.

The article generally envisages three or more elements for a list “of a certain length.” This is not a fixed numerical threshold; the assessment is case-specific.

The article explains that, when selecting from three or more lists, even two elements may be considered sufficiently long (citing T686/99).

https://jpaa-patent.info/patent/viewPdf/3722

Intellectual Property High Court, 2015 (Gyo-Ke) 10190 [Method for Reducing Environmental Pollutants in Oils or Fats] <Tsuruoka>

Original Ameblo publication: 2023-12-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834137552.html

Intellectual Property High Court, 2015 (Gyo-Ke) 10190 [Method for Reducing Environmental Pollutants in Oils or Fats] <Tsuruoka>

* Replacing some steps of the cited invention with well-known technology would leave two of its three problems unsolved.

⇒ There is a reason not to make the proposed substitution!!

★ For a patentee, it is strategically advantageous to argue that the primary reference solves multiple problems!!

(Extract from the court's reasoning)

The Ko 1 ... invention ... requires, to solve the problems in D(1) and D(3), ‘performing selective transesterification using lipase to generate an oil composition containing fatty-acid esters,’ followed by molecular distillation to obtain a residual glyceride fraction substantially free of undesired saturated and monounsaturated fatty acids. Replacing this step with ‘externally adding a volatile working fluid to the oil composition’ followed by molecular distillation might solve the problem in ... D(2), but could not solve the problems in ... D(1) and D(3). Thus, adopting in the Ko 1 ... invention the well-known configuration of ‘externally adding a volatile working fluid to the oil composition’ in place of ‘performing selective transesterification using lipase to generate an oil composition containing fatty-acid esters’ would mean deliberately replacing a configuration essential to solving the invention's problems with another that cannot solve them. A person skilled in the art has no motivation to make such a replacement; rather, there is a reason not to make that substitution ... .

The Ko 1 ... invention ... should be regarded as premised on solving the problems in D(1) through D(3) even without ... optional, additional steps, and for that purpose the configuration of ‘performing selective transesterification using lipase to generate an oil composition containing fatty-acid esters’ is indispensable ... . Even considering the existence of subsequent steps does not alter the above ... determination ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86533.pdf

Intellectual Property High Court, 2005 (Gyo-Ke) 10717 [... Siloxane ...] <Tsukahara>

Original Ameblo publication: 2023-12-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834261339.html

Intellectual Property High Court, 2005 (Gyo-Ke) 10717 [... Siloxane ...] <Tsukahara>

* Planarization is essential in the primary reference, but the secondary reference is unsuitable for it.

⇒ There is a reason not to make the proposed substitution!!

‘The overcoat layer of Cited Invention 1b must be capable of substantially planarizing the uneven surface of the light-scattering portion, but Cited Invention 3 ... is unsuitable for planarization ... .’

(Extract from the court's reasoning)

... The overcoat layer of Cited Invention 1b must be capable of substantially planarizing the uneven surface of the light-scattering portion. However, there is insufficient evidence that the siloxane of Cited Invention 3 has characteristics suitable for planarization, including its formation method and film thickness; rather, ... it appears unsuitable for planarization. Accordingly, even though both Cited Invention 1b and Cited Invention 3 have light-emitting portions (the organic EL element in 1b and the laminated structure in 3) covered by coating layers (the overcoat layer in 1b and the siloxane in 3), and even though both belong to the same technical field of organic light-emitting elements, those facts alone do not logically establish that a person skilled in the art could readily use the siloxane of Cited Invention 3 in place of the overcoat layer of Cited Invention 1b.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33644.pdf

Tokyo High Court, 2003 (Gyo-Ke) 405 [Substituted 1,3-Oxathiolanes with Antiviral Activity] <Sato>

Original Ameblo publication: 2023-12-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834554514.html

Tokyo High Court, 2003 (Gyo-Ke) 405 [Substituted 1,3-Oxathiolanes with Antiviral Activity] <Sato>

‘Even if cross-resistance is likely ... there is strong motivation to conduct experiments to confirm the drug's efficacy ... and simply performing the experiments readily reveals whether it exhibits cross-resistance.’

⇒ Inventive step denied

Obvious to try

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10075.pdf

Intellectual Property High Court, 2008 (Gyo-Ke) 10366 [Gastritis Treatment Agent] <Iimura>

Original Ameblo publication: 2023-12-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834554708.html

Intellectual Property High Court, 2008 (Gyo-Ke) 10366 [Gastritis Treatment Agent] <Iimura>

* Criteria for assessing inventive step of second-medical-use inventions

* Post-filing literature and opinion letters contradicting the alleged obstacles were also examined as evidence of common general technical knowledge at the filing date!!

⇒ Inventive step denied

'... Post-filing literature and opinion letters ... also contain the view that ... ; throughout the period before and after filing, there was no established view that gastric ulcers and gastritis differ in their pathology and mechanisms of onset ... .'

(Extract from the court's reasoning)

[Claim] A therapeutic agent for gastritis caused by reflux of bile acids into the stomach, comprising ... as an active ingredient

For an invention concerning use of a substance, it goes without saying that whether a newly discovered property (use) could readily have been conceived by a person skilled in the art should be determined on the basis of publicly known technology and common general technical knowledge in the invention's field. In this case, where efficacy as a 'gastric-ulcer treatment agent' was known before filing, whether a person skilled in the art could readily conceive the technical idea that it also has efficacy as a 'gastritis treatment agent' should be determined by comprehensively considering (1) whether gastric ulcers and gastritis differ in pathology and mechanisms of onset; (2) whether gastric-ulcer and gastritis treatment agents differ in mechanisms of action; (3) comparison and examination of other drugs effective for both gastric ulcers and gastritis; and (4) whether factors discourage applying the compound to gastritis treatment, etc. ...

At the time of filing ... acute gastric mucosal lesions appear to have begun being identified as a cause of acute gastritis, but attacks on normal mucosa through gastric-juice irritation were also identified for gastric ulcers. It cannot be found that their pathologies or mechanisms of onset were recognized as clearly distinct. Post-filing literature and opinion letters show changes in gastritis classification after the discovery of H. pylori, but regarding the relationship between gastric ulcers and gastritis, some take the view that gastric ulcers are advanced gastritis (Otsu 8), while others, such as the plaintiff's opinion letter, take the view that they differ in their mechanisms of onset (Ko 52). It should therefore be said that, throughout the period before and after filing, there was no established view that gastric ulcers and gastritis differ in pathology and mechanisms of onset. Accordingly, it is difficult to find that, at the filing date, persons skilled in the art recognized gastric ulcers and gastritis as different in pathology and mechanisms of onset and their therapeutic agents as different in mechanisms of action.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-38010.pdf

<New YouTube Video> [Patents] IP Strategy That Serves Business (Publicly Releasable Extracts from a Five-Hour Paid Lecture)

Original Ameblo publication: 2023-12-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834565399.html

<New YouTube Video> [Patents] IP Strategy That Serves Business (Publicly Releasable Extracts from a Five-Hour Paid Lecture / Two Hours)

★ More than half of the material was cut because it was unsuitable for general release, so there are places where the speech jumps. Thank you for your understanding.

https://www.youtube.com/watch?v=jXGvy82Ihvg

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8. Other Techniques to Maximize Patent-Application Value (A Wide Variety of Small Techniques)

(1) Reasons for rejection and amendments to claim wording: devising prosecution responses!!

(2) Utilizing dependent claims: claim differentiation

(3) Functional claims: worth considering as independent claims in every case!!

(4) Subcombination claims: among the cases discussed in the lecture, no infringement claim was unsuccessful because of a difference in intended application

(5) Specifying ‘use’ and ‘manner of use’: among the cases discussed in the lecture, only one case in which a difference in the specified use led to an unsuccessful infringement claim

(6) Disclaimer claims: inventive step upheld by excluding an essential element of the primary reference!!

(7) Numerical-limitation and parameter inventions: paired with a new ‘problem’!!

(8) Incorporating effects into claims: the ultimate technique when obviousness of the configuration cannot be avoided

(9) Manufacturing-method inventions

(10) Using separate applications

(11) Terms expressing degree

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Intellectual Property High Court, 2013 (Gyo-Ke) 10209 [Agent for Suppressing Vascular Intimal Thickening] <Shimizu>

Original Ameblo publication: 2023-12-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834656128.html

Intellectual Property High Court, 2013 (Gyo-Ke) 10209 [Agent for Suppressing Vascular Intimal Thickening] <Shimizu>

* The claim describes an ‘agent’ having specified effects, rather than directly specifying its use as an ‘agent for suppressing vascular intimal thickening’!!

(Incorporating effects into the claim)

[Author’s comment] ⇒ It is a use invention in the sense of ingestion into the human body, but might its technical scope not be limited to pharmaceuticals?

‘In particular, the ACE-inhibitory activity of IPP and VPP is considerably lower than that of the above ACE inhibitors ... ; therefore, selecting ... them for testing is not readily conceivable ... .’

(Extract from the court's reasoning)

[Claim 1] An agent comprising ... Ile Pro Pro and/or Val Pro Pro as an active ingredient and having at least one of the actions of improving vascular endothelial function and suppressing vascular intimal thickening

At the priority date, although there were examples in which ACE inhibitors exhibited an action improving vascular endothelial contraction and dilation or suppressing vascular intimal thickening, it could not be said that ACE inhibitors generally possessed at least one of those actions. Persons skilled in the art are found generally to have understood that whether individual ACE inhibitors actually had those actions could only be known by confirming them through separate experiments. ... IPP and VPP differ greatly in properties and structure from the above ACE inhibitors, and, in particular, their ACE-inhibitory activity can be said to be considerably lower. Selecting IPP and/or VPP for testing is therefore not readily conceivable ... .

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84454.pdf

Image Retrieval Notes

Figures 1 and 2 in Article 66 have been restored at their original positions from another publication of the same article. The packaging illustration in Article 133 has been restored from the judgment published by the court. The article text and existing illustrations have been retained.

Article ID: 12820114434

Figure 1: included in the article

Article ID: 12820114434

Figure 2: included in the article

Hideki Takaishi Article Collection

January–June 2024

English Edition

167 articles

Complete English translations of the revised Ameblo articles

In chronological order of the original Ameblo publication date

Confirmed errors in wording, legal descriptions, and translations have been corrected. Unless otherwise stated, descriptions of legal rules, outlooks, and statistics reflect the time when each original article was published.

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02 2024-01-01 Happy New Year January 1, 2024

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04 2024-01-04 Tokyo District Court, 2014 (Wa) No. 7643 [Retrofit Sliding Door Device] <Shoji>

05 2024-01-04 [Trademarks / Damages] Tokyo District Court, 2020 (Wa) Nos. 23616 and 23627 <Nakashima>

06 2024-01-04 IP High Court, 2023 (Ne) No. 10030 <Claim for Registration of Transfer of Patent Rights> ⇒ Plaintiff loses

07 2024-01-06 Tokyo District Court, 2005 (Wa) No. 1599 [Rekeyable Pin Tumbler Lock] <Ichikawa>

08 2024-01-06 [Unfair Competition Prevention Act / Trade Secret Infringement Offense / Criminal] Nagoya District Court, 2017 (Wa) No. 427

09 2024-01-09 Osaka District Court, 2017 (Wa) No. 4178 <Takemiya> [Belt for a Shoe Press] Public use ⇒ Lack of novelty

10 2024-01-10 <IP LAB> Attorney Hideki Takaishi's Patent Channel ② — Inventive Step of Parameter Inventions

11 2024-01-10 <IP LAB ③> Limits on Abstracting a “Secondary” Cited Invention (Inventive Step)

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18 2024-01-15 [U.S. Patents] Enplas Display v. Seoul Semiconductor, 909 F.3d 398 (CAFC, November 2018)

19 2024-01-16 [U.S. Patents] Power Integrations v. Fairchild, 843 F.3d 1315 (CAFC, December 2016)

20 2024-01-17 [U.S. Patents] Power Integrations v. Fairchild (CAFC, December 2016)

21 2024-01-18 [United States] Takeda v. West-Ward, 785 F.3d 625 (CAFC 2015)

22 2024-01-19 [United States] 2010 CAFC (633 F.3d 1042) AstraZeneca v. Apotex

23 2024-01-21 [United States] 1998 CAFC (152 F.3d 1342) Johns Hopkins University v. Cellpro

24 2024-01-21 [United States] 2003 CAFC (316 F.3d 1348) Warner v. Apotex

25 2024-01-22 [United States] 2003 CAFC (324 F.3d 1322) Allergan v. Alcon

26 2024-01-22 [New YouTube Video] [Patents] Inventive Step of Parameter Inventions (30 minutes from the two-hour 2023 JAFBIC lecture)

27 2024-01-23 [United States] Induced Infringement — Cases Finding Willful Blindness

28 2024-01-24 [Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2016 (Wa) No. 648

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32 2024-01-28 [Unfair Competition Prevention Act / Trade Secrets] Osaka High Court, 2017 (Ne) No. 442

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39 2024-02-06 [Article] Shared Data with Limited Access and AI (2023, Izumi Hayashi)

40 2024-02-07 IP High Court, 2023 (Gyo-Ke) No. 10014 [Navigation Device] <Shoji> * Addition of claim language held to constitute a substantive change

41 2024-02-12 [Contract / Patent Act Article 73(2)] Tokyo District Court, 2019 (Wa) No. 3141 <Tanaka>

42 2024-02-12 IP High Court, 2023 (Gyo-Ke) No. 10059 [Prescription with an Entry for the Quantity Held by the Patient] <Shoji> Matter of human convention ⇒ Not an invention

43 2024-02-12 [Article] Dwango IP High Court Grand Panel Judgment (Patent, December 2023 issue, Hideki Takaishi)

44 2024-02-12 [Trademark] Tokyo District Court, 2021 (Wa) No. 10991 <Kokubu> ⇒ Similar trademarks

45 2024-02-12 [Trademark] IP High Court, 2015 (Gyo-Ke) No. 10086 <Otaka> “ハイガード” (HIGUARD) case

46 2024-02-13 [Trademark] IP High Court, 2018 (Gyo-Ke) No. 10103 <Tsuruoka> Mark used: “Buromaga”

47 2024-02-14 [Trademark] Use in a Trial for Cancellation for Non-Use: Must It Be Trademark Use?

48 2024-02-15 [Trademark] IP High Court, 2022 (Gyo-Ke) No. 10087 “EMPIRE STEAK HOUSE” case <Kanno>

49 2024-02-16 [Foreign] Korean Supreme Court, March 31, 2022 (2018Hu10923): Inventive Step of Crystal-Form Inventions

50 2024-02-19 IP High Court, 2022 (Gyo-Ke) No. 10131 [Heat Exchanger Using a Thermally Conductive Knitted Wire Fabric] <Honda>

51 2024-02-19 Osaka District Court, 2020 (Wa) No. 4913 [Electric Impact Tightening Tool] <Takemiya>

52 2024-02-19 IP High Court, 2005 (Gyo-Ke) No. 10223 [Acidic Oil-in-Water Emulsified Seasoning] <Sato>

53 2024-02-24 [Korea] Supreme Court Judgment of December 30, 2021, 2017 Hu 1304

54 2024-02-24 [United States] <Federal District Court> Sonos v. Google LLC (N.D. Cal. 2023)

55 2024-02-24 IP High Court, 2022 (Gyo-Ke) No. 10109 [Anti-Glare Film] <Miyasaka>

56 2024-02-25 [Article / Foreign] Antibody Patents in Europe (Chizai Kanri, Vol. 73, No. 6, 2023, Naho Fujimoto)

57 2024-02-26 Patent Attorneys Association Members’ Website ★ Patent Committee Reports: Essential Information for Modern Patent Practice!!

58 2024-02-27 IP High Court, 2022 (Ne) No. 10008 [Information Provision Device] <Otaka>

59 2024-02-28 IP High Court, 2022 (Ne) No. 10078 [Display Device Supportable with One Hand] <Kanno>

60 2024-02-29 IP High Court, 2021 (Ne) No. 10094 [… Work Gloves] <Kanno>

61 2024-03-03 IP High Court, 2023 (Gyo-Ke) No. 10046 [Liquid Cleansing Agent for Removing Keratin Plugs] <Miyasaka>

62 2024-03-03 [Trademark] Composite Word Marks (Components Cannot Be Considered Separately ⇒ Similar in Two Cases; Dissimilar Even Assuming Separate Consideration in One Case)

63 2024-03-04 [Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) No. 33583 <Kokubu> “Resin Delivery Box” case

64 2024-03-05 [Article] Operational Guidelines Clarified for the “NHK-Fintiv Rule” Governing IPR Institution (Yoshinari Kishimoto …)

65 2024-03-06 [Article] Consideration of Whether Experimental Results Certificates May Be Taken into Account against Grounds for Revocation Based on Disclosure-Requirement Violations (Chizai Kanri, Vol. 73, No. 12, 2023)

66 2024-03-07 [Article] A Study of Overlapping Protection by Design Rights and Trademark Rights (Eri Murakami, Tokyo Zokei University Research Bulletin 24)

67 2024-03-08 [Article] Use Inventions in China (Chizai Kanri, Vol. 73, No. 12, 2023, Ding Wenyun / Wang Weidong)

68 2024-03-09 [Article] Recent U.S. Appeal Decisions Concerning 35 U.S.C. § 112 in Patent Applications by Japanese Companies (2023)

69 2024-03-10 [Article] Extraterritorial Application of U.S. Patent Law (Patent 2023, Vol. 76, No. 13, Aya Tatsuno (龍野文))

70 2024-03-11 [Article] Invention Disclosure Forms for Improving Patent Specification Quality (Katsuyuki Ishibashi, Chizai Kanri, Vol. 73, 2023)

71 2024-03-12 <Damages> Whether Patent Act Article 102(2) and (3) May Be Applied Cumulatively

72 2024-03-13 [U.S. Patents] Caltech v. Broadcom, 25 F.4th 976 (2022)

73 2024-03-14 [U.S. Patents] 2003 CAFC (340 F.3d 1367) Bayer v. Housey

74 2024-03-15 [U.S. Patents] Centillion v. Qwest 631 F.3d 1279 (Fed. Cir. 2011)

75 2024-03-16 [United States] No Standing Where an IPR Petitioner Appealing a PTAB Decision Has No Injury in Fact

76 2024-03-18 [United States] Section 103 Nonobviousness Requirement; Consideration of New Arguments in an IPR Petitioner's Reply Brief Improper

77 2024-03-18 [United States] U.S. Supreme Court Decision on Issue Preclusion (B&B Hardware v. Hargis Ind)

78 2024-03-19 [United States] Standard of Review for Claim Construction on Appeal: Supreme Court and Remand Decision, Teva v. Sandoz 2015

79 2024-03-20 [Copyright] "TRIPP TRAPP" Case: Standard for Copyrightability, Tokyo District Court, 2021 (Wa) No. 31529

80 2024-03-21 [United States] Ironburg v. Valve (CAFC, April 3, 2023)

81 2024-03-22 IP High Court, 2023 (Gyo-Ko) No. 10001 <Miyasaka> = First Instance, Tokyo District Court, 2022 (Gyo-U) No. 382 <Sugiura>

82 2024-03-23 [Trademark] IP High Court, 2023 (Gyo-Ke) No. 10030 <Hibiku Shimizu>

83 2024-03-24 [Trademark] IP High Court, 2021 (Gyo-Ke) No. 10100 <Otaka> "Scrum Master": No Distinctiveness (Trial Decision Rescinded)

84 2024-03-25 IP High Court, 2017 (Ne) No. 10043 [Electronic Program Guide with Digital Storage] <Mori> ⇒ No Indirect Infringement

85 2024-03-27 Tokyo District Court, 2016 (Wa) No. 37954 [Electronic Program Guide with Digital Storage] <Okinaka>

86 2024-03-28 Tokyo District Court, 2020 (Wa) No. 27972 [Lighting Device] <Shibata>

87 2024-03-30 IP High Court, 2021 (Gyo-Ke) No. 10082 [Electrically Insulated Cable] <Shoji>

88 2024-04-01 Osaka District Court, 2021 (Wa) No. 10032 [Chip-Type Fuse] <Takemiya>

89 2024-04-02 IP High Court, 2023 (Ne) No. 10041 [Training Equipment] <Hibiku Shimizu>

90 2024-04-03 [Trademark] IP High Court, 2023 (Gyo-Ke) No. 10067 <Honda> 5252byO!Oi

91 2024-04-06 [Trademark] Tokyo District Court, 2021 (Wa) No. 22287 <Sugiura> "Birkin, Kelly" Trademarks

92 2024-04-06 [Trademark] Tokyo District Court, 2021 (Wa) No. 13895 <Nakashima>

93 2024-04-06 [Trademark] Tokyo District Court, 2022 (Wa) No. 19876 <Sugiura> "Gendai no Riron" case

94 2024-04-08 [Trial and Appeal Practitioners Study Group 2023] (Mechanical) "Inventive Step of Numerically Limited Inventions" (The Subgroup in Which Takaishi Participated)

95 2024-04-10 [Trial and Appeal Practitioners Study Group 2023] (Chemistry 1) "New Matter" "Support Requirement for Parameter Inventions in the Food Field"

96 2024-04-11 [Trial and Appeal Practitioners Study Group 2023] (Chemistry 2) "Support Requirement" "Novelty of Use Inventions"

97 2024-04-14 [Trial and Appeal Practitioners Study Group 2023] (Electrical) Inventive Step of Software-Related Inventions

98 2024-04-15 [Trial and Appeal Practitioners Study Group 2023] (Design) "Articles" "Scope of Knowledge and Materials of a Person Skilled in the Art in Determining Ease of Creation"

99 2024-04-17 [Trial and Appeal Practitioners Study Group 2023] (Trademark) "Trademark Act Article 3(1)(iii): Distinctiveness" "Similarity of Composite Marks"

100 2024-04-19 IP High Court, 2021 (Gyo-Ke) No. 10033 [Construction Method Using Short Interior Corner Members] <Kanno> Correction of an Error in the Specification Permitted

101 2024-04-20 IP High Court, 2022 (Gyo-Ke) No. 10081 [Golf Club Shaft] <Honda>

102 2024-04-22 IP High Court, 2022 (Gyo-Ke) No. 10112 [Control System for Fee-Charging Automatic Machines] <Honda>

103 2024-04-22 IP High Court, 2018 (Gyo-Ke) No. 10100 [Transdermal Absorption Preparation] <Tsuruoka> * Correction of Errors in the Detailed Description Allowed

104 2024-04-23 [Article] Prior Use Rights as Seen through Case Law: Focusing on the Burden of Allegation and Proof (Makiko Takabe)

105 2024-04-24 Osaka District Court, 2017 (Wa) No. 1390 [Lamp] * Prior Use Right Recognized for a Numerically Limited Invention

106 2024-04-25 [Article] Product Configuration and Functionality (2023, Professor Masaharu Miyawaki)

107 2024-04-26 [Design] IP High Court, 2023 (Gyo-Ke) No. 10008 (Shoji) * Violation of Joint-Application Requirement (Plaintiff Employee's Creatorship) Rejected

108 2024-04-30 I Have Been Recognized by Best Lawyers in the Field of Patent Law!! April 30, 2024

109 2024-04-30 [Unfair Competition Prevention Act] Major Cases, 2018–2020 <METI> * An Excellent Overview Table!!

110 2024-04-30 [Unfair Competition Prevention Act] Tokyo District Court, 2022 (Wa) No. 4104 <Nakashima> Does Not Qualify as an "Indication of Goods or Business"!

111 2024-04-30 [Article] Degree of Similarity in Determining Confusion (2023, Shunji Sato)

112 2024-04-30 [Article] Civil Code Tort Law as a Supplement to Unfair Competition Law (2023, Professor Tatsuhiro Ueno)

113 2024-05-01 Tokyo District Court, 2017 (Wa) No. 22010 <Yamada> = Appeal, IP High Court, 2020 (Ne) No. 10038 <Otaka> […Air-Conditioned Clothing]

114 2024-05-02 [United States] K-Fee System v. Nespresso (CAFC, December 2023)

115 2024-05-04 "Prior Use Rights: A Great Debate on the Main Issues" (Tamura, Iseki, Takabe, Sato, Kajinami, Morita)

116 2024-05-04 IP High Court, 2021 (Ne) No. 10061 Hirano Tecseed, PI v. Kaneka ⇒ No Interest in Bringing Suit (Action for a Declaration of Non-Liability)

117 2024-05-05 Tokyo District Court, 2020 (Wa) No. 8642 [PCSK9]

118 2024-05-06 IP High Court, 2022 (Gyo-Ke) No. 10082 [Antibodies Relating to PIVKA-II] <Shoji> ⇒ Clarity Requirement Satisfied

119 2024-05-07 [Statistics] Trends in Numbers of Patent Invalidation Trials and Oppositions: Invalidation Decisions (Including Partial Invalidation) Just under 20%

120 2024-05-08 [Design] IP High Court, 2023 (Gyo-Ke) No. 10066 <Miyasaka> "Roof Tile" Case ⇒ Similar (No Novelty)

121 2024-05-09 [Unfair Competition Prevention Act] Osaka High Court, 2022 (Ne) No. 2081 <Morisaki>

122 2024-05-10 [Trademark] IP High Court, 2023 (Gyo-Ke) No. 10030 "Kuruntto Maegami Curler" <Hibiku Shimizu> ⇒ No Distinctiveness (Falls under Trademark Act Article 3(1)(iii))

123 2024-05-11 [Design] Tokyo District Court, 2022 (Wa) No. 17015 [Lidded Tray for Steam Cooking] <Shibata>

124 2024-05-12 [Patents] I Have Comprehensively Explained the Case Law on "Addition of New Matter"

125 2024-05-13 IP High Court, 2021 (Gyo-Ke) No. 10133 [Method for Manufacturing a Laminated Rotor Core] <Honda>

126 2024-05-14 I Got a Commemorative Plaque!!

127 2024-05-15 [Trademark] IP High Court, 2023 (Gyo-Ke) No. 10141 "Chizai Jitsumu Online" <Miyasaka> ⇒ No Distinctiveness

128 2024-05-16 [Right of Publicity] Tokyo District Court, 2023 (Wa) No. 70056 <Nakashima> * Infringement of the Right of Publicity Established

129 2024-05-17 IP High Court, 2013 (Gyo-Ke) No. 10089 [Total Parenteral Nutrition Infusion Preparation in a Two-Chamber Container] <Misao Shimizu>

130 2024-05-18 [Unfair Competition Prevention Act Article 2(1)(i) / Criminal] Nagoya District Court, December 16, 2022 <Checkered Pattern (Demon Slayer)>

131 2024-05-19 Tokyo District Court, 2018 (Wa) No. 28931 [Laser Processing Apparatus] <Shibata> ⇒ Article 102(2) Inapplicable, Article 102(1) Applicable

132 2024-05-20 [Unfair Competition Prevention Act Article 2(1)(iii)] Tokyo District Court, 2021 (Wa) No. 25324 <Shibata> ⇒ Substantially Identical Configurations; Configuration Imitation Found!!

133 2024-05-21 [Article] Monosodium Glutamate Case / Tokyo District Court, September 24, 2020 (2016 (Wa) No. 25436) (Yuki Hirai, Patent, September 2021 issue)

134 2024-05-22 [Article] Trademark Rights and Territoriality (Yoshiyuki Tamura, Patent, December 2023 Issue)

135 2024-05-23 [U.S. Patents] Amgen v. Chugai (1991 CAFC) 927 F.2d 1200

136 2024-05-24 [U.S. Patents] Conopco v. May Dept. (1994, CAFC) 46 F.3d 1556

137 2024-05-28 IP High Court, 2023 (Gyo-Ke) No. 10009 [Wastepaper Processing Apparatus] <Hibiku Shimizu>

138 2024-05-28 [U.S. Patents] Par v. Hospira (2020, CAFC) * Literal Infringement Affirmed on Appeal; Equivalents Addressed in the Alternative Below

139 2024-05-28 [U.S. Patents] Cohesive v. Waters (2008, CAFC): Numerical Range Construed Broadly!

140 2024-05-28 [U.S. Patents] Ortho-McNeil v. Caraco (2007, CAFC)

141 2024-05-29 [United States] Cordis v. Boston Scientific (2009, CAFC)

142 2024-05-30 [United States] Weber v. Provisur (2024, CAFC)

143 2024-05-31 IP High Court, 2023 (Gyo-Ke) No. 10011 [Device for Remote Operation of a Mobile Terminal] <Miyasaka>

144 2024-06-02 [U.S. Patents] Dyfan v. Target (CAFC, March 2022): MPF in Software Patents

145 2024-06-02 [Copyright] Osaka High Court, 2023 (Ne) No. 1384: Product Photograph of Vocabulary Cards — Copyrightability Recognized Contrary to the Court Below!!

146 2024-06-03 IP High Court, 2022 (Gyo-Ke) No. 10099 [Laser Processing Apparatus] <Honda>

147 2024-06-05 [Contract] IP High Court, 2020 (Ne) No. 10016 <Takabe>

148 2024-06-06 IP High Court, 2013 (Gyo-Ke) No. 10228 [Method for Producing a Photocatalyst] * Agreement Concerning Technical Guidance and Ownership of Rights

149 2024-06-06 IP High Court, 2021 (Ne) No. 10086 [Lamp] <Honda> ≒ First Instance, Osaka District Court, 2017 (Wa) No. 1390: Prior Use Right Established

150 2024-06-08 [Culpa in Contrahendo] Tokyo District Court, 1996 (Wa) No. 20909

151 2024-06-10 IP High Court, 2022 (Gyo-Ke) No. 10097 [Aminosilane] <Honda>

152 2024-06-11 Osaka District Court, 2019 (Wa) No. 5620 [… Power Generation Control System] <Takemiya>

153 2024-06-12 Osaka District Court, 2021 (Wa) No. 4920 [Functional Water] <Takemiya> * Intention behind Numerical Values of Products in Public Use Not at Issue

154 2024-06-13 [United States] LG v. Immervision (CAFC, July 11, 2022)

155 2024-06-14 [United States] Salazar v. AT&T Mobility LLC (CAFC, April 5, 2023)

156 2024-06-15 [United States] Arbutus v. ModernaTX (CAFC, April 2023)

157 2024-06-16 [Book] “The Strongest IP Management That Strategy Consultants Do Not Know” (Rikikazu Hayashi, Takahiro Shibuya) “An Offensive Open IP Strategy”

158 2024-06-17 IP High Court, 2022 (Gyo-Ke) No. 10003 [Method for Preventing Adhesion of Marine Organisms] <Kanno>

159 2024-06-18 [Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2015 (Wa) No. 11753

160 2024-06-19 [Article] Relationship between Prior Art from Simultaneous Worldwide Publication and Time Differences, and the Grace Period (Patent, May 2023 issue, Janice Logan et al.)

161 2024-06-20 [Article] Consumer Surveys for Proving Requirements under the Unfair Competition Prevention Act (2023, Yuriko Inoue)

162 2024-06-21 [Article] [India] Positive Judgments on Pre-Grant Amendments (Akiko Yamaguchi, Chizai Kanri 2024)

163 2024-06-22 [Patents] Joint Ownership of Patent Rights and Unilateral Granting of Non-Exclusive Licenses (Comparison of Countries)

164 2024-06-24 [Article] “Determining Unreasonableness” in Providing Reasonable Benefits under Employee Invention Rules (Tatsuro Fujita, Chizai Kanri, Vol. 74, No. 1, 2024)

165 2024-06-24 Tokyo District Court, 2013 (Wa) No. 21383 <Shimasue>: Enforcement of Declared-Essential Patents, Abuse of Rights, and Notification of False Facts

166 2024-06-26 Osaka District Court, 2022 (Wa) No. 9521 [Thermoplastic Resin Composition]: Numerical Limitation — Rounding Argument Rejected, No Equivalence

167 2024-06-28 [Unfair Competition Prevention Act] Tokyo District Court, 2022 (Wa) No. 14148 <Sugiura> ⇒ No Breach of Duty to Clarify the Specific Manner of Conduct

I came to the office after reading that 14.3% of entrepreneurs work on New Year's Day, but… I was the first person to enter the building.

Original Ameblo publication: 2024-01-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834862911.html

I came to the office after reading that 14.3% of entrepreneurs work on New Year's Day, but… at 1:30 p.m. I was the first person to enter the building 😅 (The building management office was staffed. Thank you for your hard work.) I will start working on my manuscript for the journal Patent.





Happy New Year January 1, 2024

Original Ameblo publication: 2024-01-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834863078.html

Happy New Year. In 2023, I somehow managed to achieve the goals I set at the beginning of the year.

This, too, was the result of the good opportunities and connections that all of you gave me. Thank you so much for your support.

In 2024, in addition to professional achievements, scholarly articles, and daily posts, as in the previous year, my goal is to make exercise a habit!

I will stay healthy in both body and mind and contribute to the smooth functioning of patent practice in Japan!!

Tokyo District Court, 2018 (Wa) No. 28930 [Laser Processing Apparatus] <Nakashima>

Original Ameblo publication: 2024-01-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12834863205.html

Tokyo District Court, 2018 (Wa) No. 28930 [Laser Processing Apparatus] <Nakashima>

“Disposition of the judgment… 3. The defendant shall pay the plaintiff 1,506,978,762 yen and the respective sums stated in the attached schedule of delay damages. … 6. This judgment may be provisionally enforced, limited to paragraphs 1 through 3, if the plaintiff provides security of 1 billion yen.”

The court also discussed whether to grant a declaration of provisional enforceability!!

092186_hanrei.pdf (courts.go.jp)

Tokyo District Court, 2014 (Wa) No. 7643 [Retrofit Sliding Door Device] <Shoji>

Original Ameblo publication: 2024-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835209578.html

Tokyo District Court, 2014 (Wa) No. 7643 [Retrofit Sliding Door Device] <Shoji>

*Because 20% of the defendant's products were non-infringing, sales were taken as 80% in calculating the damages presumed under Article 102(2).

⇒ This can be cited as a case in which, where only some of multiple defendant products infringed the patent, damages were calculated according to that proportion.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86669.pdf

[Trademarks / Damages] Tokyo District Court, 2020 (Wa) Nos. 23616 and 23627 <Nakashima>

Original Ameblo publication: 2024-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835209734.html

[Trademarks / Damages] Tokyo District Court, 2020 (Wa) Nos. 23616 and 23627 <Nakashima>

*The royalty rate doubled after the provisional disposition order!!

“10% before the provisional disposition order… after that order… 20%, taking into account the malicious nature of the infringement, namely that sales of the defendant's products continued after the order.”

The written confirmation was prepared after the application for a provisional disposition.

⇒ Negligence was not negated.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91729.pdf

IP High Court, 2023 (Ne) No. 10030 <Claim for Registration of Transfer of Patent Rights> ⇛ Plaintiff loses

Original Ameblo publication: 2024-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835209850.html

2023 (Ne) No. 10030 <Claim for Registration of Transfer of Patent Rights>

⇒ Plaintiff loses

After leaving employment, A filed a patent application in the name of a company A had founded.

At the time of completion of the inventions alleged by the appellant (around May 2018), the former company's work rules provided for transfer of the rights at the company's request in return for payment of an amount determined through consultation; no agreement providing for original vesting of the rights in the company was established.

⇒ The later employee-invention regulations providing for original vesting were alleged to apply retroactively. The court held, however, that even if the regulations had been validly adopted, they could not change the original ownership of rights to obtain patents that had already arisen.

*Would there also be no negligence even if a damages claim were brought!?

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92161.pdf

Tokyo District Court, 2005 (Wa) No. 1599 [Rekeyable Pin Tumbler Lock] <Ichikawa>

Original Ameblo publication: 2024-01-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835536271.html

Tokyo District Court, 2005 (Wa) No. 1599 [Rekeyable Pin Tumbler Lock] <Ichikawa>

*The proportion of infringing products in which the conversion under-pin and ball were not separated was set at 25% to calculate the three defendants' profits forming the basis for the damages assessment under Article 102(2).

“…taking the proportion of the defendant's products that were not separated as 25%… calculate the amount of profit… Formula: 28,854,463 ÷ 0.40 ÷ 0.3333 × 0.25 = …”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-35166.pdf

[Unfair Competition Prevention Act / Trade Secret Infringement Offense / Criminal] Nagoya District Court, 2017 (Wa) No. 427

Original Ameblo publication: 2024-01-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835536632.html

[Unfair Competition Prevention Act / Trade Secret Infringement Offense / Criminal] Nagoya District Court, 2017 (Wa) No. 427

The defendant was a former employee of Aichi Steel and founded MagneDesign.

⇒ Acquitted (the prosecutor abandoned an appeal)

The defendant's explanation to a third party was excessively abstracted and generalized, amounting only to a combination of commonplace methods.

⇒ The non-public-knowledge requirement was not met (intent was also negated).

(Excerpt from the court's reasoning)

“Although the information that the two defendants explained to e at the meeting in question concerned a process for aligning amorphous wires on a substrate, there are substantial differences in important parts of the process from the structure of the wire-alignment apparatus owned by b and the process for aligning amorphous wires on a substrate using that apparatus. Moreover, in the portions of that information corresponding to the process asserted by the prosecutor, the measures for arranging wires precisely on a substrate in light of the characteristics of amorphous wire had been stripped away. The information was excessively abstracted and generalized and, even when viewed as a single integrated sequence of operations, amounted merely to selecting and combining commonplace methods. It cannot be said that it was not generally known or could not readily be learned. Thus it cannot be said to satisfy the non-public-knowledge requirement among the three requirements for a trade secret (management as a secret, usefulness, and non-public knowledge). Accordingly, it cannot be said that the two defendants disclosed b's trade secrets at the meeting in question.

Furthermore, even if one were to adopt the view that the two defendants' conduct objectively constituted disclosure of a trade secret (this assumption does not represent this court's view), the possibility remains that the two defendants believed that the information they explained to e at the meeting did not constitute b's trade secrets. In light of this and the fact that there were reasonable grounds for that belief, the two defendants cannot be held liable for an intentional offense.

Accordingly, both defendants are acquitted.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91195.pdf

Osaka District Court, 2017 (Wa) No. 4178 <Takemiya> [Belt for a Shoe Press] Public use ⇛ Lack of novelty

Original Ameblo publication: 2024-01-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12835874853.html

Judgment of January 31, 2023: Osaka District Court, 2017 (Wa) No. 4178 <Takemiya> [Belt for a Shoe Press]

It was possible to focus on the curing agent contained in a product that had been publicly used.

⇒ No novelty

Is this the same benchmark as “it could have been learned by disassembling and analyzing it by ordinary methods” (2015 (Gyo-Ke) No. 10069, [Rod-Shaped Light] <Shitara>)?

⇒ An important judgment to watch, sharing an approach with the IP High Court judgment on prior-use rights, 2017 (Ne) No. 10090 <Presiding Judge Takabe>!!

For Invention 2 in this case, the surface roughness (Ra) of the drainage-groove walls in the defendant's product must fall within the numerical range along the entire length of the grooves!

⇒ Claim limitation not satisfied

★ According to this judgment, “literally” requires that the drainage-groove walls fall within the numerical range along the entire length of the grooves, and language permitting exceptions is needed in the claim wording or the specification…

(Excerpt from the court's reasoning)

The plaintiff argues that even if Belt B was delivered to Nippon Paper, it cannot be said that it would have been possible to identify the presence of DMTDA as a curing agent in Belt B's outer peripheral surface. The plaintiff points out that it is impossible to determine from the physical belt itself how many layers constitute the belt, and so forth; that because the polyurethane constituting the belt consists of various chemicals, it cannot be said that an analysis focusing on the curing agent contained in the polyurethane forming the outer peripheral surface would have been performed; and that, at the time, there were an extremely large number of candidate substances for a curing agent, and even a person skilled in the art did not know that the use of Ethacure 300 could suppress cracking, so it is wholly implausible that someone would have focused on DMTDA as the curing agent, gone out of their way to obtain it, and sent it to an analytical laboratory as a sample with a request for analysis. However, … Belt B was delivered to Nippon Paper and placed in a condition in which it could freely be analyzed and the like. In addition to the fact that its structure and other features could be identified through analysis and the like…, before the filing of Patent 1 in this case, Ethacure 300 had attracted attention and had been put into practical use as a curing agent for urethane. Even if the mass spectrum of DMTDA had not been registered in an analytical laboratory's library…, it can be said that there was a probability that Ethacure 300 would have been sent to an analytical laboratory as a sample with a request for analysis. It is therefore found that a person skilled in the art could have learned the content of Publicly Worked Invention B. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91743.pdf

<IP LAB> Attorney Hideki Takaishi's Patent Channel ② — Inventive Step of Parameter Inventions

Original Ameblo publication: 2024-01-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836020741.html

<IP LAB> Attorney Hideki Takaishi's Patent Channel ②

Inventive Step of Parameter Inventions

Unlike the Examination Guidelines, courts tend to treat a parameter and its range as matters defining the invention and to recognize an inventive step unless their obviousness is demonstrated. As discussed in detail below, where a new parameter is related to solving the invention's problem, obviousness is more likely to be denied (and inventive step affirmed). Viewed from another perspective, where the invention's problem, effects, or technical significance are not described in the specification, or are unrelated to the parameter, the parameter is more likely to be regarded as a matter of design choice. In that sense, the relationship between the parameter and the invention's problem, effects, and technical significance is the central issue.

https://www.takaishihideki.com/_files/ugd/324a18_ed5f0d7975c342ecb2530c6041d32cc5.pdf

https://www.youtube.com/watch?v=MnJC0emQ7Ho

1. Correlation between the invention's problem and the parameter, and inventive step (general principles)

Where there is a correlation between solving the invention's problem and the parameter in question, technical significance is recognized in the parameter. If the correlation is one-to-one, the parameter can be said to have high technical significance. On the other hand, if the relationship is one-to-n, or is an indirect, weak correlation, its technical significance is lower and inventive step tends to be harder to establish (obviousness is more readily found). In other words, although the proposition to be assessed in determining inventive step is the obviousness of the parameter and its range, the tendency is to evaluate the technical significance of the parameter itself according to the degree of correlation with the invention's problem, and to apply a different threshold for obviousness accordingly.

Accordingly, how the invention's problem is identified is one of the most important issues in an inventive-step assessment and can determine the outcome. The Pyrimidine Grand Panel judgment established the principle (in the context of the support requirement) that the assessment should be based on the description in the specification. The Examination Guidelines take the same approach, allowing reference to external evidence as an exception where an amendment or divisional application has shifted the problem from the one described in the specification.

2. Conditions under which a parameter invention satisfies inventive step

Where numerical values are the only difference between a parameter invention and the cited reference, numerous court decisions have found inventive step if both ① and ② below are satisfied. (In other words, it depends on how the invention's problem is framed.)

① There is a correlation between solving the invention's problem and the parameter (throughout the entire numerical range).

② The invention's problem is neither publicly known nor obvious.

OR

Even if the invention's problem is publicly known or obvious, focusing on the parameter as a factor contributing to the solution of that problem is neither publicly known nor obvious.

⇒ Conversely, where ① the invention's problem cannot be read from the specification in question and cannot be identified, or ② the parameter and the invention's problem (operation and effects) are not correlated (there is no description in the specification), or, even if they are correlated, the parameter was publicly known or could have been focused on, numerous court decisions have held the numerical values themselves to be a matter of design choice, etc. (*This category corresponds to “qualitatively different effects” in the Examination Guidelines.) Very few court decisions have affirmed inventive step by finding critical significance in the numerical range, effects that are of the same kind but remarkable, or unforeseeable remarkable effects.

Examples of decisions denying novelty or inventive step where the setting of a parameter was treated as a matter of design choice or a similar matter, and the parameter and the invention's problem (operation and effects) were not correlated (or no such correlation was described in the specification), include IP High Court, 2021 (Gyo-Ke) No. 10096, [Light Source] <Presiding Judge Honda>; IP High Court, 2021 (Gyo-Ke) No. 10135, [Vectors Containing Stuffer/Filler Polynucleotide Sequences] <Presiding Judge Kanno> (lack of novelty of Claim 30); and 2010 (Gyo-Ke) No. 10296, [Petrolatum-Based Nasal Ointment] <Presiding Judge Takizawa> (= 2006 (Gyo-Ke) No. 10132, 2005 (Gyo-Ke) No. 10665, 2005 (Gyo-Ke) No. 10754, and 2005 (Gyo-Ke) No. 10189). Outside parameter inventions, examples include IP High Court, 2022 (Gyo-Ke) No. 10111, [Beltline Molding for a Vehicle Door] <Presiding Judge Honda>.

There are also decisions recognizing inventive step on the ground that it was not obvious in which direction, or by how much, to change a parameter (2020 (Gyo-Ke) No. 10044 <Presiding Judge Otaka>, 2019 (Gyo-Ke) No. 10011 <Presiding Judge Takabe>, 2015 (Gyo-Ke) No. 10206 <Presiding Judge Takabe>, etc.). However, these are exceptional, and one should not rely on them.

⇒ Regarding “unforeseeable remarkable effects,” apart from the facts of the Supreme Court's Doxepin judgment (2018 (Gyo-Hi) No. 69), there are extremely few court decisions in which an invention with an obvious configuration was nevertheless found inventive because of its effects.

Considering that JPO trial/appeal decisions finding inventive step based on unforeseeable remarkable effects are liable to be overturned by the IP High Court, it is preferable to argue a difference in the problem, rather than the effects, from the JPO trial/appeal stage. (*Naturally, it is a different matter where an originator pharmaceutical manufacturer seeks a decision upholding validity in connection with patent linkage.)

3. Where multiple parameters are correlated with solving the invention's problem

Where the primary reference has multiple parameters, if the issue is whether changing only one of them would have been obvious, it is necessary to demonstrate the rationale for being able to change that one parameter alone.

(1) An example in which it was not possible to change only one parameter in the primary reference (inventive step affirmed) is IP High Court, 2022 (Gyo-Ke) No. 10029, [Antiglare Film] <Presiding Judge Shoji>.

(2) An example in which it was possible to change only one parameter in the primary reference (inventive step denied) is Tokyo District Court, 2015 (Wa) No. 1025, [Low-Extract Beer-Taste Beverage with Adjusted pH] <Presiding Judge Hasegawa>.

End

2021 (Gyo-Ke) No. 10096 <Honda>	Light Source *Numerical limitation for which there are no example data ⇒ No technical	…(Difference) With respect to the “light conversion layer,” the invention in this case “contains a scattering agent,” and “the scattering agent is contained in an amount of 10% by weight or less relative to the total weight of the light conversion layer,” whereas in the cited invention it is unclear whether there is a “scattering agent.” …	Loss / No ★

	significance ⇒ Matter of design choice	…Regarding the configuration in which "a scattering agent is contained in an amount of 10% by weight or less relative to the total weight of the light conversion layer" …The specification of the application contains only statements such as "may be contained in an amount of 10% by weight or less"…, "it is preferable that it be contained in an amount of 10% by weight or less, and more preferable that it be contained in an amount of 1% by weight or more and 5% by weight or less"…, and "preferably 10% by weight or less." … Moreover, … the maximum content percentage described in the examples is only 6% by weight…, and the specification contains no description whatsoever of experimental results where that content percentage exceeds 10% by weight…. In view of the foregoing, it must be said that there is no particular critical significance in setting the scattering-agent content at 10% by weight or less relative to the total weight of the light conversion layer. In addition, … the color coordinates of white light can be adjusted by adjusting the content ratio of the scattering agent, red quantum-dot material, and green quantum-dot material in the light conversion layer. Paragraph [0137] of the specification also indicates that the luminance and other properties of white light can be adjusted by adjusting the scattering-agent content. Taking into account as well the statement in paragraph [0116] of Well-Known Document 1 that "[i]n one preferred embodiment, the concentration range of the scatterer is 0.1 to 10% by weight," a person skilled in the art could appropriately design the scattering-agent content relative to the total weight of the light conversion layer according to the desired characteristics of the white light obtained through that layer.	
2021 (Gyo-Ke) No. 10135 <Kanno>	Vectors Containing Stuffer/Filler Polynucleotide Sequences *Numerical limitation with insufficient example data ⇒ Identical technical significance ⇒ The numerical limitation is not a substantive difference!! ⇒ No novelty	[Claim 1] …a recombinant vector plasmid in which said first inactive filler or stuffer polynucleotide sequence has a length of 7.0 to 10.0 Kb. There is no technical significance in the filler or stuffer polynucleotide sequence of the vector plasmid having a length within the particular range of "7.0 to 10.0 Kb." … In the cited invention as well, the stuffer sequence is modified so that the backbone exceeds the packaging capacity of AAV. The combined length of the transgene (4297 nt (approximately 4.297 Kb)) and the length of the stuffer sequence contained in this backbone (the backbone being 6980 bp (approximately 6.980 Kb)) can be understood to exceed at least the packaging capacity of 4.7 Kb. Thus the claimed invention… and the cited invention are identical in their technical significance, and making the filler or stuffer polynucleotide sequence of the vector plasmid a length within the particular range of "7.0 to 10.0 Kb" in the claimed invention… cannot be regarded as a substantive difference. … It cannot immediately be found that the amount of residual DNA contained in the AAV particles of the claimed invention… is even less than 2.69 ± 0.69 pg/10^9 vg; nor, even if the amount of residual DNA is reduced, can it immediately be found that the reduction results from increasing the length of the oversized backbone….	Loss / No ★
2015 (Gyo-Ke) No. 10206 <Takabe>	Base Fabric for Airbags *There was motivation to move the numerical value	Difference 1B: Dynamic air permeability. In Invention 1 in this case it is "1300 mm/s or less," whereas in the cited invention it is "1498 mm/s." Difference 1C: Pullout resistance of the constituent yarns. In Invention 3 in this case it is "146–200 N/cm/cm," whereas in	Win / Yes ★★★

	of the publicly worked product toward the value of the invention in this case. ⇒ However, because it was unclear how far the value needed to be changed to solve the invention's problem, the value in the invention was not obvious.	Cited Invention 1 it is “53 N/cm/cm.” <JPO trial decision (conclusion: inventive step affirmed; upheld)> Even if the problem is well known, the Exhibit Ko 1 Invention is an “existing product” that has been optimized for its function, so a corresponding motivation is considered necessary to make a change. In the Exhibit Ko 1 Invention, there is no motivation to change the boiling-water shrinkage rate, single-filament fineness of the constituent yarns, pullout resistance of the constituent yarns, and cover factor, which affect dynamic air permeability, within the ranges specified in Invention 1 in this case to the point of bringing dynamic air permeability into the specific range of “1300 mm/s or less.” Nor is there evidence showing that this is possible. <This judgment> (b) Increasing the cover factor …It can be said that, at the priority date in this case, a person skilled in the art would have tried increasing the cover factor of Cited Invention 1 above 2131 to reduce yarn slippage at the seam boundary when the airbag inflates and deploys, and to reduce post-loading dynamic air permeability. However, on the evidence in this case, the relationship between the degree of increase in the cover factor and the degree of decrease in post-loading dynamic air permeability is unclear. Nor is there any indication that common general technical knowledge on this point existed at the priority date. Therefore, it is unclear how much the cover factor of 2131 in Cited Invention 1 should be increased to reduce its post-loading dynamic air permeability from 1498 mm/s… to 1300 mm/s or less. It is conceivable that it would be necessary to increase it beyond the upper limit of 2100–2500, the numerical range of the cover factor stated in Invention 1 in this case to be more preferable “from the perspective of achieving both deployment performance and productivity.” … Moreover, because the cover factor is calculated from the warp/weft average total fineness and the warp/weft average weave density of the constituent yarns…, a change in cover factor can also be said to affect the total fineness of the constituent yarns. … (c) Increasing the pullout resistance of the constituent yarns …It can be said that, at the priority date in this case, a person skilled in the art had motivation to increase the pullout resistance of the constituent yarns in Cited Invention 1 to reduce yarn slippage at the seam boundary when the airbag inflates and deploys and to reduce post-loading dynamic air permeability. However, on the evidence in this case, it is unclear how much the warp/weft average pullout resistance of the constituent yarns in Cited Invention 1, 53 N/cm/cm, would have to be increased to reduce its post-loading dynamic air permeability from 1498 mm/s… to 1300 mm/s or less. It is also unclear whether increasing it to 200 N/cm/cm, the upper limit of that average value in Invention 1 in this case, at which “local stress concentration in the constituent yarns no longer occurs and airbag rupture is not caused,”… would suffice. It is conceivable that an increase beyond that upper limit would be necessary.	

2010 (Gyo-Ke) No. 10296 <Takizawa>	Petrolatum-Based Nasal Ointment *Because the technical significance of the numerical limitation is not described in the specification, inventive step is denied even without a direct suggestion.	[Claim 1] A nasal ointment for the prevention of inhalation-allergic reactions… characterized by having a viscosity of 8 mm²/s (100°C) or more according to DIN 51 562. The cited reference… admittedly contains no direct suggestion to focus on the viscosity of the mixture of saturated hydrocarbons in relation to preventing inhalation-allergic reactions. However, the specification of the application itself contains no description establishing that the numerical value of 8 mm²/s has special technical significance for the viscosity of the saturated-hydrocarbon mixture. Nor does it describe the technical significance of focusing on viscosity among the various physical properties of petrolatum (density, solidification point, viscosity, cone penetration (a kind of viscosity…), average carbon number, and distribution of hydrocarbon carbon numbers). It therefore cannot be said that the specification discloses the technical significance of the viscosity or its numerical value of 8 mm²/s. … The claimed invention does not go beyond the prior art in which viscosity was not defined by a numerical range, and it cannot be said that the claimed invention has remarkable operation and effects by adjusting the viscosity of the mixture of saturated hydrocarbons. Thus, given that the specification describes neither the technical significance of focusing on viscosity nor the technical significance of specifying a viscosity of 8 mm²/s or more, even if the cited reference does not directly suggest preventing allergic reactions by adjusting the viscosity of the mixture of saturated hydrocarbons, inventive step cannot be recognized on the basis of the matters defining the claimed invention.	Loss No △
2022 (Gyo-Ke) No. 10111 <Honda>	Beltline Molding for a Vehicle Door *No description of technical significance in the specification. No effect on operation and effects ⇒ Matter of design choice	The specification in this case contains no description of the technical significance of the stepped portion extending “substantially horizontally” inward from the lower part of the vertical flange. … Whether the stepped portion extends “substantially horizontally” or “slightly downward” has no influence on the operation and effects of the invention. It therefore cannot be found that there is any technical significance in having the stepped portion extend “substantially horizontally.” Nor, in Exhibit Ko 1 Invention 1, can any technical significance be found in the stepped portion extending “slightly downward” from the lower part of the vertical flange toward the vertically movable window glass (inward). Configuring the stepped portion that extends “slightly downward” in Exhibit Ko 1 Invention 1 to extend “substantially horizontally” should be regarded as nothing more than a matter of design choice that a person skilled in the art could make as appropriate.	Loss / No ○
2020 (Gyo-Ke) No. 10044 <Otaka>	Lipid-Containing Composition *Although the numerical value itself was stated in the publication, there was no suggestion to limit it to that value or less. ⇒ No motivation *It was possible to	[Claim 19] …a lipid-containing formulation in which the dose of ω-6 fatty acids is 40 g or less. The defendant argues as follows: ① Publication 5 states that fat intake has increased to 40 g per day and indicates recognition of this as a problem. The Publication 5 Invention is based on the technical concept of taking ω-6 and ω-3 fatty acids in a balanced manner on the premise of curbing excessive lipid (fat) intake. Therefore, it is only natural to keep ω-6 fatty acids, which are a subset of unsaturated fatty acids that in turn form part of lipids, below a certain level, and there is strong motivation to specify a value of 40 g or less, 40 g being recognized as excessive intake of lipids as a whole. ② Moreover, daily lipid intake also comes from foods other than the drink composition of the Publication 5	Win Yes ★★★

	focus on the parameter and numerical value, but… motivation to make it “that value or less” was denied.	Invention, so setting an upper limit of 40 g of ω-6 fatty acids per day or per serving is a technical matter that a person skilled in the art could readily accomplish. Accordingly, a person skilled in the art could easily have arrived at the configuration of the claimed invention relating to Difference 2 in the Publication 5 Invention. However, … Publication 5 states: “The Japanese diet has recently become increasingly Westernized, with a substantial increase in opportunities to eat meat-centered meals. Fat intake has increased to 40 g per day. The types of diseases have changed accordingly, with increases in cardiovascular diseases such as hypertension and heart disease, and in breast cancer and colorectal cancer, thus also becoming Westernized and constituting a major social problem.” This is immediately followed by statements including: “However, as research progressed, it became apparent that this was caused by an imbalance in the intake of the types of unsaturated fatty acids constituting fats.” In light of this, the natural understanding is that the passage neither states that the increase in “fat intake” to “40 g per day” is itself a problem nor suggests that this should be improved. …	
2019 (Gyo-Ke) No. 10010 (Related case: No. 10011, discussed separately above) <Takabe>	Engineering of Systems, Methods, and Optimized Guide Compositions for Sequence Manipulation *Identification of the invention in an earlier application (The same exercise as for inventive step) ⇒ 2013 (Gyo-Ke) No. 10199 and 1999 (Gyo-Ke) No. 285 apply the same standard. *The patent applicant pointed out inconsistencies in the experimental data in the earlier application's specification and argued that the system of the earlier invention could not solve the problem of the claimed invention, but this argument was not accepted.	…Even in the absence of a specific description in the specification and other documents of the earlier application, the earlier invention may be identified by taking into account the common general technical knowledge of a person skilled in the art when understanding that invention. On the other hand, an invention that is abstract, or whose technical content is still insufficiently disclosed even after considering that knowledge, does not constitute an “invention” for this purpose and does not have the effect of excluding a later application under that Article. The degree of disclosure of technical content required here should be regarded as sufficient if the description enables a person skilled in the art to understand that the earlier invention is presented there and that it can be carried out. … Examples 1–3 of Cited Invention 1 describe in detail the methods of producing each of the vectors (i)–(iii) of Cited Invention 1. Example 4 also expressly describes a specific test method for confirming that the donor sequence (GFP gene) has been incorporated into or near the target sequence. Furthermore, … the experimental results in Example 4 can be understood to show that the combination of an RNA-guided endonuclease containing a nuclear localization signal, guide RNA, and a donor polynucleotide is incorporated into a eukaryotic cell and that double-strand cleavage and repair occur at the target site. The experimental results in Example 5 are not understood to impede that understanding. In addition, the vector system containing the vectors (i)–(iii) above has the technical means necessary for appropriate transcription, translation, nuclear translocation, and so forth in a eukaryotic cell, as well as the technical means necessary for appropriate modification of the target sequence in such a cell. Therefore, as already explained, it can be understood that even when constituted as a vector system, it has the function of cleaving and modifying the target sequence in a eukaryotic cell. Accordingly, Cited Reference 1 contains a description sufficient for a person skilled in the art to understand that the earlier invention is presented there and can be carried out. … It is therefore appropriate to find that technology had been disclosed to an	Loss / No △

		extent sufficient to exclude a later application.	
2022 (Gyo-Ke) No. 10029 <Shoji>	Antiglare Film *Where two parameters are interrelated, the court denied that there was a suggestion to adjust only one parameter of the primary cited invention independently of the other parameter.	[Claim 1] An antiglare film… having a haze value in a range of 60% or more and 95% or less, and an internal haze value in a range of 0.5% or more and 8.0% or less. Difference 1-1 / The "antiglare layer" of Invention 1 in this case has "an internal haze value in a range of 0.5% or more and 8.0% or less," whereas the "internal haze value" of the cited invention is unknown. … Cited Reference 2… describes expressing the degree of unevenness (the surface-diffusion element) more specifically by defining surface haze…. Since the surface haze value defines the shape of the unevenness, which is technically inseparable from sparkle, the description in Cited Reference 2 cannot be understood as suggesting adjustment of sparkle independently of the surface haze value. … Although Well-Known Document A1 also states that "the internal haze is preferably 5–30%," it also states that "the surface haze is preferably 20–50%." … It therefore does not suggest adjusting sparkle independently of the surface haze value.	Win Yes ★
2015 (Wa) No. 1025 <Hasegawa>	Low-Extract Beer-Taste Beverage with Adjusted pH *If the parameters are unrelated, it is permissible to extract and identify only the specific parameter constituting the difference from the publicly worked invention!! *The problem of the publicly worked product was identified from consumer evaluations. ⇒ Inventive step denied Cf. 2012 (Gyo-Ke) No. 10275	The plaintiff argues that the technical concept of the invention in this case lies in discovering a relationship between the respective numerical ranges of total extract, pH, and carbohydrate content and the effects of providing a satisfying drinking sensation and appropriate acidity. Because Publicly Worked Invention 1 does not disclose such a technical concept, the plaintiff argues that it is impermissible to identify Publicly Worked Invention 1 by extracting only total extract, pH, and carbohydrate content from the numerous analysis items for All-Free, and that differences should be identified by treating total extract, pH, and carbohydrate content as a single integrated configuration. … Although the claims of the invention in this case limit the numerical ranges of total extract, pH, and carbohydrate content, it is sufficient that each respective value fall within its range; no particular correlation among them is specified. Moreover, the detailed description of the invention in the specification contains no statements such as what pH range is desirable when total extract is 0.5% by weight and what pH range is desirable when it is 2.0% by weight. In short, it is sufficient that total extract, pH, and carbohydrate content each fall within their respective numerical ranges. … Among the numerous analysis items for Publicly Worked Invention 1 shown in Appendices 1-1 to 1-3, the analysis results for components and the like other than total extract, pH, and carbohydrates need not be considered when examining inventive step of the invention in this case. … When identifying differences from Publicly Worked Invention 1 as a premise for assessing inventive step, it is sufficient to examine the respective numerical values of total extract, pH, and carbohydrates. …	Loss No ★

<IP LAB ③> Limits on Abstracting a “Secondary” Cited Invention (Inventive Step)

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<IP LAB ③>

Limits on Abstracting a “Secondary” Cited Invention (Inventive Step)

Taking as our starting point the IP High Court's judgment in 2022 (Gyo-Ke) No. 10009, [Gas Fire-Extinguishing Equipment] <Presiding Judge Otaka>, which overturned an opposition decision that had excessively abstracted (generalized) a secondary reference by disregarding the structure on which it was premised, this article considers the “limits on abstracting a ‘secondary’ cited invention” in inventive-step assessments and introduces relevant court decisions.

The Pyrimidine Grand Panel judgment (IP High Court, Grand Panel, 2016 (Gyo-Ke) No. 10182) held: “Where an invention asserted as a cited invention is an ‘invention described in a publication,’ and a compound is described in that publication in the form of a general formula having an enormous number of alternatives, it is appropriate to find that, unless there are circumstances warranting affirmative or preferential selection of the technical idea relating to a particular alternative, a specific technical idea relating to that particular alternative cannot be extracted and cannot be identified as a cited invention. The same reasoning applies when identifying a secondary cited invention from a publication where there is another ‘invention described in a publication’ under paragraph (1), item (iii) of that Article corresponding to the differences between the claimed invention and the primary cited invention (hereinafter a ‘secondary cited invention’), and it is being assessed whether the claimed invention could easily have been made by applying the secondary cited invention to the primary cited invention. Therefore, where the secondary cited invention is an ‘invention described in a publication,’ and a compound is described in that publication in the form of a general formula having an enormous number of alternatives, it is appropriate to find that, unless there are circumstances warranting affirmative or preferential selection of the specific technical idea relating to a particular alternative, that specific technical idea cannot be extracted and cannot be identified as a secondary cited invention.” Thus it described what is combined with the primary reference in an inventive-step assessment as “another ‘invention described in a publication’ under paragraph (1), item (iii) of that Article corresponding to the differences between the claimed invention and the primary cited invention (hereinafter a ‘secondary cited invention’).”

The IP High Court judgment in 2022 (Gyo-Ke) No. 10009, [Gas Fire-Extinguishing Equipment] <Presiding Judge Otaka>, refers to the secondary reference as the “Exhibit Ko 2 technical matters” (as many judgments do). However, it is understood to have held that cherry-picking part of a “coherent technical idea” from a secondary reference (generalizing it) is erroneous. Thus, whether the secondary reference is called the “Exhibit Ko 2 technical matters” or the “Exhibit Ko 2 Invention,” the judgment is consistent with the Pyrimidine Grand Panel judgment. Indeed, many decisions have held that not only a primary reference but also a secondary reference must constitute a “coherent technical idea” (the group of decisions marked ★ below); conversely, there are no decisions expressly stating that a secondary reference need not be a “coherent technical idea.”

Accordingly, a petitioner for a patent invalidation trial should be careful about abstracting or generalizing what is disclosed in primary and secondary references. Conversely, it is preferable for a publicly known document not to contain specific descriptions unnecessary for comparison with the invention in question. Where a publicly known document contains multiple descriptions at different levels of abstraction, it is desirable to present technical matters at an appropriate level of abstraction that do not include specific

technical matters that would constitute differences in a comparison with the invention. In that sense, one should always consider whether to use an example in the publicly known document or a general description in it as the cited reference, and at which level of abstraction the disclosure should be cited. (For example, as discussed below, IP High Court, 2022 (Ne) No. 10008 and 2021 (Gyo-Ke) No. 10027, [Information Providing Device] <Presiding Judge Otaka>, illustrate a case in which the outcome of the novelty and inventive-step assessments differed depending on which level of abstraction of the disclosure in the publicly known document was used as the reference.)

In connection with this issue, the following two decisions are important examples in which the court overturned the assessment of the level of abstraction of the invention identified from a cited document and set aside the JPO decision (details follow below).

IP High Court, 2016 (Gyo-Ke) No. 10061 <Presiding Judge Tsuruoka>, held that the cited invention was not limited to the examples described in the cited document and revoked the JPO decision that had affirmed inventive step on the basis of an erroneous identification of the differences.

IP High Court, 2017 (Gyo-Ke) No. 10062 <Presiding Judge Takabe>, affirmed inventive step on the ground that the cited invention was defined by a configuration different from that of the invention in question.

In IP High Court, 2022 (Gyo-Ke) No. 10009, [Gas Fire-Extinguishing Equipment] <Presiding Judge Otaka>, too, the finding that the Exhibit Ko 2 technical matters were “premised on the use of a rupture disk” was decisive, and the reasoning for the case in which a rupture disk was not used was rejected. The level of abstraction of the cited reference is an important issue in novelty and inventive-step assessments.

The author also addresses this important issue of limits on abstracting a cited invention in the following video, “All Issues Concerning Inventive Step.”

https://www.youtube.com/watch?v=HEU-zc-jOXI&t=636s

[Introduction to Related Decisions (Limits on Abstracting a “Secondary” Cited Invention)]

(1) Decisions holding that a secondary reference, too, must be a “coherent technical idea” (★)

IP High Court, 2020 (Gyo-Ke) No. 10066, [Biaxial Hinge] <Presiding Judge Mori> — No motivation to extract only part of the secondary cited invention and apply it to the primary cited invention.

(Excerpt from the court's reasoning)

…They are functionally interlinked and integrally configured…. There is no motivation to extract only supporting piece 511 and supporting piece 512 from the integrally configured members described above and apply the configuration of having a pair of supporting pieces to the Exhibit Ko 2 Invention…. …The Exhibit Ko 2 Invention includes a member corresponding to the stopper mechanism of the Exhibit Ko 1 Invention… and has selective rotation-restriction means…. The integrally configured members of the Exhibit Ko 1 Invention described above include a stopper mechanism and selective rotation-restriction means, so there is also no motivation to apply those integrally configured members of the Exhibit Ko 1 Invention to the Exhibit Ko 2 Invention….

IP High Court, 2019 (Gyo-Ke) No. 10041, [Wound Dressing] <Presiding Judge Kanno> — No motivation to extract only part of the secondary cited invention and apply it to the primary cited invention.

(Excerpt from the court's reasoning)

…The invention described in Exhibit Ko 4 has a structure integrating a first layer with numerous holes that form an appropriate retention space between the wound surface and the second layer, retain an appropriate amount of exudate on the wound surface, and prevent the exudate from spreading in the in-plane direction; a second layer that is a sheet material with initial water-pressure resistance; and a sheet material capable of absorbing and retaining water (a third layer). Because its technical significance lies in maintaining a moist wound surface through this structure, there is no motivation to extract only the first layer of the invention

described in Exhibit Ko 4 and apply it to the Exhibit Ko 1 Invention. …The three functions of Common General Technical Knowledge 1 asserted by the plaintiff are merely described in the three patent documents above concerning wound dressings having those functions. Disregarding the specific configurations of the wound dressings, those individual descriptions in the patent documents are insufficient to establish that, for wound dressings generally, it was common general technical knowledge to provide the functions of Common General Technical Knowledge 1 in order to perform moist wound healing effectively.

IP High Court, 2013 (Ne) No. 10025 <Presiding Judge Shimizu> — Excessive generalization of the secondary cited invention was rejected. ⇒ The first-instance judgment, Osaka District Court, 2011 (Wa) No. 11104, had denied inventive step based on the same primary and secondary references.

(Excerpt from the court's reasoning)

Exhibit Otsu 7 does not disclose a configuration in which “side walls” and “inner contact pieces” are connected in that order along the four sides of a “box bottom,” and the “side walls” nearer the four sides are “notched by a length equal to the width of the support posts.” It cannot be said to have been easy for a person skilled in the art to extract, from the Exhibit Ko 2 Invention in which part of an outer side plate farther from the box bottom is notched, a generalized technical idea of notching only part of a side plate, whether inner or outer, and apply it to the inner side plate folded inward in the Exhibit Otsu 13 Invention. The view that this would have been obvious must be regarded as precisely “hindsight” based on knowledge of the configuration of the invention in this case.

IP High Court (Grand Panel), 2016 (Gyo-Ke) No. 10182, [Pyrimidine Derivatives] — A secondary reference, too, must be an “invention” (= a specific technical idea).

(Excerpt from the court's reasoning)

…In assessing inventive step, an invention under any of the items of paragraph (1) of that Article to be compared with the claimed invention (hereinafter the “primary cited invention,” and collectively with the “secondary cited invention” discussed below, the “cited inventions”) is ordinarily selected from those in a technical field related to the claimed invention and within the scope of what a person skilled in that field would consider. An “invention described in a publication” under paragraph (1), item (iii) of that Article must form the basis for determining whether a person skilled in the art could easily have made the claimed invention on the basis of the state of the art at the time of filing, and must therefore be a specific technical idea that can be extracted from the description in that publication. Where a compound is described in the publication in the form of a general formula having an enormous number of alternatives, a person skilled in the art cannot extract from that description the specific technical idea relating to a particular alternative unless there are circumstances warranting affirmative or preferential selection of that specific technical idea. Accordingly, where the invention asserted as a cited invention is an “invention described in a publication,” and a compound is described in the publication in the form of a general formula having an enormous number of alternatives, the specific technical idea relating to a particular alternative cannot be extracted and cannot be identified as a cited invention unless there are circumstances warranting affirmative or preferential selection of the technical idea relating to that alternative….

The same reasoning applies when identifying a secondary cited invention from a publication where there is another “invention described in a publication” under paragraph (1), item (iii) of that Article corresponding to the differences between the claimed invention and the primary cited invention (hereinafter the “secondary cited invention”), and it is being assessed whether the claimed invention could easily have been made by applying the secondary cited invention to the primary cited invention. Thus, where the secondary cited invention is an “invention described in a publication,” and a compound is described in that publication in the form of a general formula having an enormous number of alternatives, the specific technical idea relating to a particular alternative cannot be extracted and cannot be identified as a secondary cited invention unless there are circumstances warranting affirmative or preferential selection of that specific technical idea…. …

Exhibit Ko 2… describes "−NR4R5" as an alternative for substituent R3 at the 2-position of the pyrimidine ring in the "particularly preferred compounds" among compounds represented by general formula (I), and describes a "methyl group" and an "alkylsulfonyl group" as alternatives for R4 and R5. However, there are an extremely large number of alternatives for R3 in the "particularly preferred compounds" described in Exhibit Ko 2, numbering at least more than 20 million…. Choosing "−NR4R5" as R3, with R4 and R5 being "methyl" and "alkylsulfonyl," is one of more than 20 million alternatives. Moreover, Exhibit Ko 2 describes not only "particularly preferred compounds" but also "particularly especially preferred compounds," and "−NR4R5" is not listed as an alternative for R3 in the latter. Furthermore, Exhibit Ko 2… describes Example 8 (R3 is methyl), Example 15 (R3 is phenyl), and Example 23 (R3 is phenyl) as examples of compounds in which X and A in general formula (I) have the same structures as in the Exhibit Ko 1 Invention, but does not describe any example selecting "−NR4R5" as R3. Accordingly, even if an alkylsulfonyl group is described in Exhibit Ko 2, a person skilled in the art cannot find in that description circumstances warranting affirmative or preferential selection of "−NR4R5" as R3 in… general formula (I). Having selected "−NR4R5," it is also difficult to find circumstances warranting the further selection of "methyl" and "alkylsulfonyl" as R4 and R5.

Therefore, Exhibit Ko 2 cannot be evaluated as permitting extraction of a technical idea of making the group at the 2-position of the pyrimidine ring "−N(CH3)(SO2R′)." It cannot be said that Exhibit Ko 2 describes the configuration relating to Difference (1-i), and the configuration of the invention in this case relating to Difference (1-i) cannot be obtained by combining the Exhibit Ko 2 Invention with the Exhibit Ko 1 Invention. …

(2) Decisions setting aside a JPO decision by overturning the level of abstraction of the cited invention identified from the cited document

IP High Court, 2016 (Gyo-Ke) No. 10061 <Presiding Judge Tsuruoka>, held that the cited invention was not limited to the examples described in the cited document and revoked the JPO decision that had affirmed inventive step on the basis of an erroneous identification of the differences.

(Excerpt from the court's reasoning)

…Publication 1 shows, as an example, a configuration in which multiple fixed wireless units are provided in respective predetermined rooms of a facility…. However, no particular technical relationship can be found between limiting the installation locations of the multiple fixed wireless units to "each room of a facility" and the means of solving the problem. It is also found that the problem of the Publication 1 Invention can be solved and its operation and effects achieved without such a limitation. It is therefore inappropriate to limit that invention to the technical content of the example described above. (The example merely illustrates one embodiment of the invention; this does not mean that implementation in other forms cannot be read from Publication 1.) Accordingly, it is also inappropriate to limit Cited Invention A… to that technical content, and comparison with Corrected Invention 1 in this case should be made against Cited Invention A identified as including, but not being limited to, "each room of a facility" as the installation locations of the multiple fixed wireless units. …

If Difference 1′ is identified as above, and assuming that the configuration relating to that difference (a configuration in which multiple activation-signal transmitters are installed on one side and the other side of an entrance/exit to detect the position of a moving object) was well known when the patent application was filed, Cited Invention A and that well-known technology would be found to belong to related technical fields and share a common problem in that both aim to detect the position of a moving object. Moreover, because Cited Invention A does not specify (limit) the installation locations of the multiple fixed wireless units, there would be no particular circumstances constituting a factor inhibiting application of the well-known technology….

IP High Court, 2017 (Gyo-Ke) No. 10062 <Presiding Judge Takabe>, affirmed inventive step on the ground that the cited invention was defined by a configuration different from that of the invention in question.

(Excerpt from the court's reasoning)

…The cited reference is found to describe an invention (…) consisting of "…". Thus the finding in the decision in this case that one electrode of the SiC MOSFET and one electrode of the SiC Schottky diode were both unknown must be regarded as erroneous. …

Furthermore, the cited reference contains no description or suggestion that, when the combination of IGBT 4 and diode 5 is replaced by a combination of a SiC MOSFET and a Schottky barrier diode, operation should differ before and after replacement.

Moreover, Cited Invention A… is an invention addressing the problem of… and aiming to… (…). Achieving that objective is unrelated to changing the type of SiC MOSFET or the connection direction of the Schottky barrier diode connected in parallel. Therefore, it cannot be said that a person skilled in the art would be motivated, in Cited Invention A, to change "one electrode of said PN-junction diode" and "one electrode of said Schottky barrier diode" from cathode electrodes to anode electrodes in order to achieve that objective. Accordingly, it cannot be found that a person skilled in the art could easily have arrived at the configuration of Invention 1 in this case relating to Difference 1′.

(3) Introduction to 2022 (Ne) No. 10008 and 2021 (Gyo-Ke) No. 10027, [Information Providing Device] <Presiding Judge Otaka>

A case in which patentability assessments differed in IP High Court judgments handed down on the same day by the same division (an infringement appeal and an action to revoke a JPO decision), involving the same patent and the same cited document. ⇒ The logic of an invalidity defense can be changed flexibly!!

The infringement appeal (2022 (Ne) No. 10008) and the action to revoke the JPO decision (2021 (Gyo-Ke) No. 10027) share the following points.

The "information providing device" of the invention in this case means a single device.

The "learning/life support system 1" in the cited document consists of multiple elements (devices): ① a learning/life support server 2 connected via network N, and ② user terminals 3 used by multiple course participants and students.

<Analytical framework and conclusion of the judgment in the action to revoke the JPO decision (2021 (Gyo-Ke) No. 10027)> — Claim dismissed

(On the premise of the comparison made at the JPO trial stage) the "learning/life support system 1" in the cited document consists of multiple devices and therefore does not correspond to the "information providing device" of the invention in this case. The difference is not obvious. ⇒ Inventive step affirmed

<Analytical framework and conclusion of the infringement appeal judgment (2022 (Ne) No. 10008)> — Appeal dismissed

Only "server 2" within the "learning/life support system 1" in the cited document was compared as corresponding to the "information providing device" of the invention in this case. Both are single devices, and under this comparison this becomes a common feature. ⇒ No novelty

<IP LAB ④> “One-Line Descriptions and Identification of Cited Inventions” (Novelty and Inventive Step)

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<IP LAB ④>

“One-Line Descriptions and Identification of Cited Inventions” (Novelty and Inventive Step)

A primary reference described in a publicly known document and used to deny novelty or inventive step must be an “invention” (Patent Act, Article 29(1)(iii)). (According to the Pyrimidine Grand Panel judgment (IP High Court, 2016 (Gyo-Ke) Nos. 10182 and 10184), a secondary reference must also be an “invention,” but even among JPO decisions and judgments following that Grand Panel judgment, many refer to a secondary reference as “matters” rather than an “invention.”)

Accordingly, at least a primary reference based on documentary prior art must be an “invention.” Even if it need not satisfy the enablement requirement of Article 36(4) of the Patent Act, a person skilled in the art must be able to understand it as an “invention” under Article 29(1), and a so-called one-line description is not recognized as a cited invention. (One could presumably obtain a patent even if an “Anywhere Door” were described in a cited document. There is a decision holding that, even if a cited invention has not been completed as an invention, it is eligible as a cited invention if a person skilled in the art can understand it as an invention (Tokyo High Court, 2000 (Gyo-Ke) No. 315).)

This article considers Tokyo District Court, 2022 (Wa) No. 9716, [5-Aminolevulinic Acid Phosphate], and introduces decisions on the issue of “one-line descriptions and identification of cited inventions” in novelty and inventive-step assessments. In that case, the particular phosphate became capable of being manufactured as a result of the patent application, and the claim limitations were therefore satisfied. However, before the filing date, a person skilled in the art could not manufacture it without thought or trial and error. Thus, although the name of that particular phosphate appeared in a publicly known document, it was not recognized as a cited invention, and novelty and inventive step were affirmed (the patentee prevailed).

(Note) The judgment found the claim limitations satisfied on the ground that each of the defendant's products contains the 5-aminolevulinic acid phosphate of the invention itself, and held that the compound achieves the effects of the invention even if it is not isolated and even if its concentration in the product is not high (judgment, pp. 12–13). The judgment does not treat the compound's having become producible through the disclosure in the patent specification as a reason for satisfaction of the claim limitations.

The author has also released the following three videos on the important issue of identifying cited inventions, which are introduced here.

① All Issues Concerning Inventive Step

https://www.youtube.com/watch?v=HEU-zc-jOXI&t=636s

② <Identification of Cited Inventions> Can a cited invention be read from drawings in a patent publication? (Shape, relative size, positional relationships, dimensions, arrangement, direction, existence)

https://www.youtube.com/watch?v=Ew49FtfJVwE

③ Statements in a specification that “various modifications are possible without departing from the spirit of the invention” and inventive-step assessments

https://www.youtube.com/watch?v=m9qsrCbhOI4&t=183s

Tokyo District Court, 2022 (Wa) No. 9716, [5-Aminolevulinic Acid Phosphate] <Presiding Judge Shibata> *Inventive step affirmed (claim limitations also satisfied; patentee wins)

“…It cannot be said that Documents Otsu 16 through Otsu 18 disclose a technique for obtaining 5-aminolevulinic acid itself. In addition, … the cited reference in this case also states that ‘5-ALA is… an extremely chemically unstable substance’ and ‘only an acidic aqueous solution of 5-ALA HCl is shown to be sufficiently stable’ ([0007]). Taking into account that these matters were common general technical knowledge at the priority date in this case, it cannot be found that a technique for obtaining 5-aminolevulinic acid itself was well known at that time.

On this point, the plaintiff argues that, in manufacturing 5-aminolevulinic acid phosphate, 5-ALA need not have been isolated as a substance and may be present mixed with medium components and the like in a fermentation broth. However, at the priority date in this case, a method of adding an acid or base to a mixed solution containing various components cannot be found to have been common general technical knowledge as a method of manufacturing a salt as a compound. Therefore, it cannot be said that a person skilled in the art encountering the cited reference at that time could, without exercising creative abilities such as thought or trial and error, have discovered, as a method of manufacturing the compound 5-aminolevulinic acid phosphate, a method of adding phosphoric acid to a fermentation broth in which 5-aminolevulinic acid was present mixed with medium components and the like (or adding that fermentation broth to a phosphoric acid solution). Moreover, … as is clear from the statement in Document Otsu 17 that the medium contains yeast extract, tryptone, and the like, a fermentation broth mixed with medium components and the like contains various ions as impurities. Even if phosphoric acid is added to such a fermentation broth, this cannot be evaluated as manufacture of the compound 5-aminolevulinic acid phosphate by a neutralization reaction between equimolar quantities of acid and base…. …There are no other circumstances indicating that a person skilled in the art at the priority date could have discovered a method of manufacturing or otherwise obtaining 5-ALA phosphate. …

In light of the foregoing, it cannot be said that a person skilled in the art encountering the cited reference at the priority date could, on the basis of common general technical knowledge at that date, have discovered a method of manufacturing or otherwise obtaining 5-ALA phosphate without exercising creative abilities such as thought or trial and error. Accordingly, 5-ALA phosphate cannot be identified as a cited invention from the cited reference in this case.”

(*“5-ALA phosphate” = “5-aminolevulinic acid phosphate”)

At the beginning of its novelty assessment, this judgment states that “[i]t cannot be found that a technique for obtaining 5-aminolevulinic acid itself was well known at the priority date in this case,” which might prompt a hasty assumption that it conflicts with the finding that the claim limitations are satisfied. However, reading further into the novelty reasoning, the judgment states that “this cannot be evaluated as manufacture of the compound 5-aminolevulinic acid phosphate.” It recognized novelty and inventive step

because, at the priority date, a person skilled in the art could not manufacture the novel compound of the invention without trial and error.

In this case, the substance's name (5-aminolevulinic acid phosphate, the invention in question) was described in the cited document. Nevertheless, the disclosure in that document was not recognized, or its eligibility as a cited invention was denied, because a person skilled in the art at the priority date could not carry it out without trial and error.

Not only this judgment but many decisions hold that, for disclosure of a cited invention to be recognized in a cited document, a person skilled in the art must be able to carry out the configuration and other features of the invention without trial and error, based on the disclosure in the cited document and common general technical knowledge. Applied to this case, at a minimum a person skilled in the art would have needed to be able to manufacture ‘5-aminolevulinic acid phosphate’ as part of a mixture without trial and error.

However, under the state of the art at the priority date, it was difficult not only to isolate it, but also to manufacture 5-aminolevulinic acid ‘phosphate’ even as part of a mixture. That is why novelty and inventive step were recognized despite the substance's name appearing in the cited document. One should always bear in mind the possible rebuttal that, as in this case, even if the compound of the invention is mentioned by name in a publicly known document, a person skilled in the art could not manufacture it without trial and error under the state of the art at the priority date.

Thus, there is no contradiction between this judgment's findings on satisfaction of the claim limitations and invalidity. Under the state of the art at the filing date (priority date), a person skilled in the art could not manufacture the compound of the invention without trial and error. However, because the disclosure of the patent specification made it possible for a person skilled in the art at the time of infringement to manufacture the compound without trial and error (otherwise there would be an enablement or support issue), the claim limitations were held to be satisfied.

This situation has something in common with the relationship between the third and fourth requirements of the doctrine of equivalents, in that they use different reference dates. The third requirement asks whether a person skilled in the art could easily have conceived of replacing the claimed configuration with the configuration of the accused product or process at the time of its manufacture or use. The fourth requirement, by contrast, requires that the accused product or process was neither identical to the publicly known technology at the filing date nor easily deducible from it by a person skilled in the art at that date. This can encompass cases where subsequent technological developments make substitution easy, but a change in ease between filing and manufacture is not itself a necessary condition for equivalence.

However, according to the general approach adopted by many decisions, including this one, even if a compound's name appears in a publicly known document, novelty and inventive step are not immediately denied unless it can be proven that, under the state of the art at the filing date (priority date), a person skilled in the art could manufacture the compound without trial and error. The first person to succeed in manufacturing a particular compound as part of a mixture would therefore be granted a patent even without isolating it, and could enforce that right against those who work a mixture containing the compound after filing. In an invention such as this one, 5-aminolevulinic acid was known, the new substance was obtained by making it into a ‘phosphate,’ and the compound ‘5-aminolevulinic acid phosphate’ itself was expressly mentioned in a publicly known document. Where the technical significance of the invention lies in being the first to manufacture the ‘phosphate,’ there is room for debate as to whether granting a patent as a product invention, rather than a manufacturing-process invention, strikes the proper balance, and whether it is appropriate to allow enforcement against an alleged infringer who manufactures or otherwise deals with a mixture containing that compound by a method other than the manufacturing method actually invented by the inventor.

(Note) Article 66(1) of the Patent Act provides that a patent right becomes effective upon registration of its establishment. Accordingly, a patent right can be enforced only after registration.

There are also cases such as IP High Court, 2007 (Gyo-Ke) No. 10378, [Crystalline Azithromycin Dihydrate], discussed below. Although it was argued that an identical product had existed before filing, the court rejected the asserted lack of novelty because a person skilled in the art at the priority date could not identify that product from the cited document and reproducibility of the described manufacturing method was not established. The court did not decide whether the product in the cited document was in fact identical to the invention. Nevertheless, if the substance was not actually new and the inventor was merely the first to notice it, there is room for debate in relation to the public domain: does granting a patent as a product invention strike the proper balance, and is it appropriate to permit enforcement against an alleged infringer who continues to manufacture and sell the prior art (= a product that in fact contained the substance, though nobody had noticed it)?

<Introduction to Related Decisions>

Tokyo High Court, 1996 (Gyo-Ke) No. 136, [Novel Peptide] — Decision of refusal ⇒ JPO decision revoked (*Ineligible as a cited invention)

“Generally, for a compound to be recognized as described in a cited reference, the compound must actually be made available. Merely showing a chemical structural formula or manufacturing method and demonstrating theoretical manufacturability is insufficient; it must be possible to confirm the compound in practice. The cited reference does not disclose a method of manufacturing the motilin derivative (the motilin of the application) that is…, nor does it state a melting point or any other grounds demonstrating that it was actually manufactured.”

IP High Court, 2009 (Gyo-Ke) No. 10180, [Process for Preparing 4-Amino-1-Hydroxybutylidene-1,1-Bisphosphonic Acid or Its Salts and Certain Salts of Said Acid] — Decision of refusal ⇒ JPO decision revoked (*Ineligible as a cited invention)

*Enablement is required for ‘eligibility as a cited invention.’ (2004 (Gyo-Ke) No. 259 and 2012 (Gyo-Ke) No. 10134 take the same approach.)

⇒ A case denying eligibility as a cited invention to a one-line description in a collection of academic conference abstracts.

*The experimental certificate relies on knowledge that was not common general technical knowledge at the priority date.

“The… trihydrate in this case is a novel chemical substance. Although Document Ko 7 states the chemical formula of an organic compound equivalent to this trihydrate, it neither describes nor suggests a manufacturing method. …These points are also acknowledged by the JPO decision.

The first issue in such a case is therefore whether Document Ko 7 constitutes a ‘publication’ under Article 29(1)(iii) of the Patent Act, which is a prerequisite to applying Article 29(2). Article 29(1) provides that a patent may not be granted for an ‘invention described in a publication distributed… prior to the filing of the patent application’ under item (iii). To say that a ‘product invention’ is described in such a ‘publication,’ it goes without saying that the configuration of that product invention must be disclosed in the publication. Furthermore, given that an invention is a creation of a technical idea (see Article 2(1) of the Act), the invention's technical idea must be disclosed to an extent enabling a person skilled in the art who encounters that publication to implement it on the basis of common general technical knowledge at the filing date, without exercising creative abilities such as thought or trial and error. Particularly where the product is a novel chemical substance, it is often difficult to discover a method of manufacturing or otherwise obtaining it. Thus, generally, to say that its technical idea is disclosed in a publication requires not merely disclosure of the substance's configuration but also a description sufficient to understand its manufacturing method. If the publication does not contain a description sufficient to understand the manufacturing method, it is necessary that a person skilled in the art who encounters it be able to discover a method of manufacturing

or otherwise obtaining the substance, based on common general technical knowledge at the filing date, without exercising creative abilities such as thought or trial and error….

In this case, … Document Ko 7 cannot be said to contain a description sufficient to understand the manufacturing method. Accordingly, under the assessment standard… above, for Document Ko 7 to constitute a 'publication' under Article 29(1)(iii) of the Patent Act, a person skilled in the art encountering Document Ko 7 must be able to discover a method of manufacturing or otherwise obtaining the trihydrate in this case, based on common general technical knowledge at the filing date, without exercising creative abilities such as thought or trial and error…. …In this case, such common general technical knowledge cannot be found to have existed at the time of the application…."

IP High Court, 2007 (Gyo-Ke) No. 10120, [Crystalline Azithromycin Dihydrate] <Presiding Judge Tanaka>

*A case denying eligibility as a cited invention to a one-line description.

"…Article 29(1) of the Patent Act provides that a patent may not be granted for an 'invention described in a publication distributed… prior to the filing of the patent application' under item (iii). To say that a 'product invention' is described in such a 'publication,' … the invention's technical idea must be disclosed to an extent enabling a person skilled in the art who encounters the publication to implement that technical idea easily, without special thought. Where the product is, for example, a novel chemical substance, it is generally often difficult to discover a method of manufacturing or otherwise obtaining it. Thus, to say that its technical idea is disclosed in a publication may require a description sufficient to understand its manufacturing method."

IP High Court, 2007 (Gyo-Ke) No. 10378, [Crystalline Azithromycin Dihydrate] <Presiding Judge Tanaka>

*In applying Article 29(1)(iii) of the Patent Act to a novel substance, the issue is whether it could be understood at the priority date that a product identical to the invention was described in the cited document, not whether a product identical to the invention existed before the priority date.

*This case also rejected replication experiments based on the cited document.

*There are many cases in which novelty was assessed through replication experiments.

E.g., 1995 (Gyo-Ke) No. 205, the 'Ethylene Polymer' case (see 'Novelty of Inventions Defined by Physical Properties,' Intellectual Property Management, April 2010 issue).

= 2007 (Gyo-Ke) No. 10120, 'Crystalline Azithromycin Dihydrate' (inventive step over crystalline azithromycin monohydrate)

"[Claim 1] Crystalline azithromycin dihydrate

(1) Article 29(1) of the Patent Act provides that a patent may not be granted for an 'invention described in a publication distributed… prior to the filing of the patent application' under item (iii). To say that a 'product invention' is described in such a 'publication,' first, the configuration of that product invention must be disclosed in the publication. Moreover, given that an invention is a creation of a technical idea (see Article 2(1) of the Act), disclosure of the product invention's configuration alone is insufficient; the invention's technical idea must be disclosed to an extent enabling a person skilled in the art who encounters the 'publication' to implement it easily without special thought. This requirement—that the technical idea be disclosed to an extent enabling a person skilled in the art to implement it easily without special thought—does not differ at all depending on whether the 'product invention' described in the 'publication' is an invention of a novel chemical substance or of a known chemical substance. However, in the case of a known chemical substance, a person skilled in the art can often understand how to obtain it from descriptions in prior-art documents, common general technical knowledge, and the like, even if the 'publication' itself does not describe a manufacturing or other acquisition method. By contrast, for novel

chemical substances it is generally often difficult to discover a manufacturing or other acquisition method. Therefore, it can be said that, in many cases, a description sufficient to understand the manufacturing method is required to say that the technical idea is disclosed in the 'publication.' This is why the required content of the description for a substance to be regarded as described in a 'publication' (particularly whether a manufacturing method must be described) is sometimes explained as differing between novel and known chemical substances.

…In this case, even if the substance known as azithromycin itself was publicly known, a structure in which two water molecules maintain particular positional relationships to one azithromycin molecule through intermolecular forces, forming a dihydrate crystal structure, was not publicly known at least before distribution of Exhibit Ko 2…. It is therefore clear that whether azithromycin dihydrate is described in Exhibit Ko 2 cannot be assessed in the same way as for an ordinary known chemical substance (that is, on the assumption that, even if Exhibit Ko 2 itself does not describe a method of manufacturing or otherwise obtaining azithromycin dihydrate, a person skilled in the art could understand how to obtain it from prior-art documents, common general technical knowledge, and the like). In this sense, azithromycin dihydrate must be treated as a novel chemical substance.

…The Tokyo High Court judgment of October 1, 1991 cited by the plaintiff upheld a JPO finding that, where (R,S) α-cyano-3-phenoxybenzyl alcohol, a racemic compound (racemate) consisting of a pair of optical isomers (enantiomers), is disclosed in a cited reference, the invention of (S) α-cyano-3-phenoxybenzyl alcohol, one of the pair of optical isomers forming that racemate, should be regarded as described in the same reference. However, that assessment was based on the fact that it was common general technical knowledge among persons skilled in the art that various methods of racemic resolution (optical resolution) had been practiced before the patent application for that invention. It therefore cannot be said to hold that a publication never needs to describe the manufacturing method of a product for a product invention to fall under Article 29(1)(iii) of the Patent Act.

(2) As explained in (1) above, to say that a 'product invention' is described in a 'publication' under Article 29(1)(iii) of the Patent Act, before requiring disclosure of the invention's technical idea in the publication, it is first necessary that the product invention's configuration be disclosed. …It is clear that Exhibit Ko 2 contains no express statement that the resulting crystal (Crystal A) is azithromycin dihydrate, or even that it is a hydrate of azithromycin. Nor are the physical-property data stated as 'crystallographic data' such that their description alone makes it easy to recognize Crystal A as azithromycin dihydrate. On the contrary, according to the entire purport of the oral argument, the molecular formula 'C38H72O12N2' and molecular weight 748 (Mr = 748 g/mol) stated at the beginning of the 'crystallographic data' section both relate to anhydrous azithromycin….

…The plaintiff argues that Crystal A described in Exhibit Ko 2 is identified as azithromycin dihydrate because its lattice constants match the values stated in Exhibits Ko 3 and Ko 4 as the lattice constants of azithromycin dihydrate. However, whether Exhibit Ko 2 can be said to disclose the 'configuration of azithromycin dihydrate' concerns whether Exhibit Ko 2 constitutes a publication under Article 29(1)(iii) of the Patent Act. Under that paragraph, for Exhibit Ko 2 to constitute such a publication, it must have been easy to recognize Crystal A described in Exhibit Ko 2 as crystalline azithromycin dihydrate based on the common general technical knowledge or state of the art of a person skilled in the art before filing (…before the priority date in this case…)…. Yet Exhibit Ko 3… and Exhibit Ko 4… were both publications distributed after the priority date in this case…. Accordingly, the knowledge described in those publications does not form part of the common general technical knowledge or state of the art at that priority date. Even if consulting those publications enables a person skilled in the art to recognize easily that Crystal A described in Exhibit Ko 2 is crystalline azithromycin dihydrate, Exhibit Ko 2 cannot be regarded as a publication under Article 29(1)(iii) in relation to the patent application in this case.

The plaintiff argues that Exhibits Ko 3 and Ko 4 are used only to confirm the fact that Crystal A described in Exhibit Ko 2 is a dihydrate, and therefore it is immaterial that Exhibits Ko 3 and Ko 4 themselves were distributed after the priority date. However, as explained above, for Exhibit Ko 2 to constitute a publication under Article 29(1)(iii) of the Patent Act, it must have been easy to recognize Crystal A described there as crystalline azithromycin dihydrate based on the common general technical knowledge or state of the art of a person skilled in the art before…the priority date. Where it is only by relying on common general technical knowledge or the state of the art after the priority date that Crystal A described in Exhibit Ko 2 is first understood to have been crystalline azithromycin dihydrate, Exhibit Ko 2 cannot be regarded as a publication under that item. Furthermore, Exhibits Ko 3 and Ko 4, publications other than Exhibit Ko 2, are relevant only in that the knowledge they describe might form part of the common general technical knowledge or state of the art. Since they were distributed after the priority date and their knowledge does not form part of the common general technical knowledge or state of the art at that date, they cannot affect the assessment of whether Exhibit Ko 2 constitutes a publication under that item in relation to the patent application in this case.

The plaintiff also argues that, in applying Article 29(1)(iii) of the Patent Act, the issue is whether a product identical to the invention existed before the priority date and that this fact is not affected by consulting publications distributed after the priority date. However, application of that item concerns whether, before the priority date, it could be understood that a product identical to the invention was described in Exhibit Ko 2; it does not concern whether a product identical to the invention existed before that date. …

…Neither the replication experiment in Exhibit Ko 7 nor that in Exhibit Ko 17 can be recognized as a replication of the manufacturing method for Crystal A described in Exhibit Ko 2. Nor is there other evidence sufficient to find that, based on common general technical knowledge or the state of the art of a person skilled in the art at the priority date, Crystal A could actually be manufactured from the description of its manufacturing method in Exhibit Ko 2 (that the manufacturing method for Crystal A in Exhibit Ko 2 could be replicated). …It also cannot be found that, at the priority date, Exhibit Ko 2 identified the product azithromycin dihydrate itself through its manufacturing method."

IP High Court, 2010 (Gyo-Ke) No. 10029, […B-Lymphoblastoid Cell Line]

*The cell line described in the cited document was unobtainable. ⇒ Not described

"Before the priority date of the application, Dr. A (and the joint researchers) are found to have had no intention of complying with third-party requests for provision of the L612 cell line. As a result, the L612 cell line was not available to third parties. The JPO decision's finding that 'the L612 cell line described in Cited References 1 and 2 may be presumed to have been in a condition in which it could be provided if a third party requested provision' is erroneous, and that error may affect the conclusion of the decision…."

IP High Court, 2005 (Gyo-Ke) No. 10445, [Nonaqueous Electrolyte Secondary Battery]

*In identifying the cited invention, the court found that the one-line description merely listed a possible battery structure without disclosing its specific configuration, and therefore did not disclose the relevant cited invention.

Cf. 2010 (Gyo-Ke) No. 10324

"…The plaintiff argues… that, based on the statement in Exhibit Ko 1 that '…examples of battery structures include… a cylindrical battery formed by winding a positive electrode, a negative electrode, and, if further required, a separator into a roll,' Exhibit Ko 1 describes the structure of a spiral-wound secondary battery in which strip-shaped positive- and negative-electrode current collectors are laminated with a separator between them and wound many times. The plaintiff argues that this should therefore have been identified as a common feature of the invention in this case and the Exhibit Ko 1 Invention, and that the JPO decision erred in overlooking it and identifying it as Difference (b)…. …

However, an ‘invention described in a publication’ (Patent Act, Article 29(2) and (1)(iii)) that must be identified as a premise for assessing inventive step means an invention understood from matters described in the publication and matters equivalent to those described. ‘Matters equivalent to those described’ means matters that a person skilled in the art (a person having ordinary knowledge in the technical field to which the invention pertains) can derive from matters expressly described in the publication by taking into account common general technical knowledge at the filing date.

Applying this to Exhibit Ko 1, the above passage cited by the plaintiff appears at the end of the section ‘Means and Operation for Solving the Problems’ in the detailed description of the invention. As is clear from the phrases ‘if further required,’ ‘the battery structure is not particularly limited, but,’ and ‘examples include,’ it merely exemplifies battery structures or forms applicable when working the secondary-battery invention described in the claims and cannot be recognized as disclosing a specific embodiment. In other words, even if Exhibit Ko 1 can be said to disclose a cylindrical battery using as its active material the composite oxide and the like described in its claims, it contains no description whatsoever suggesting the specific form of the electrodes in such a cylindrical battery (whether they are long strips rather than short rectangular pieces, whether other forms are possible, etc.) or the specific manner of forming the active material (whether it is formed on both sides, the respective thickness ranges of the positive and negative electrodes, the relationship between the ratio and sum of their thicknesses, etc.). Moreover, even considering all the evidence in this case, it cannot be found that, at the filing date, it was common general technical knowledge to make the electrodes strip-shaped, apply active material to both sides, or set film thickness within a certain range in a cylindrical battery using the composite oxide and the like described in the claims of Exhibit Ko 1 as the active material. Therefore, even taking common general technical knowledge into account, Exhibit Ko 1 cannot be regarded as describing a secondary battery with the configuration… that the plaintiff says should be identified as a common feature of the invention in this case and the Exhibit Ko 1 Invention (strip-shaped positive- and negative-electrode current collectors forming a spiral-wound body). …”

IP High Court, 2012 (Gyo-Ke) No. 10233, [Antibacterial Glass]

*A case denying eligibility as a cited invention to a one-line description.

“…The defendant argues that Cited Reference 1 discloses borosilicate glass, relying on the statement in its detailed description that ‘the soluble glass used in the present invention is at least one type selected from borosilicate and phosphate types’ (paragraph [0006]). However, … since Claim 1 of Cited Reference 1 limits the soluble glass to phosphate glass, the above passage cannot be found to disclose borosilicate glass…. Cited Reference 1 cites Document Otsu 1 as prior art preceding it…, and that document describes both borosilicate glass and phosphate glass as water-soluble glass. However, on the basis of that context, it is unreasonable to understand the ‘soluble glass’ of the Cited Reference 1 Invention, which limits soluble glass to phosphate glass, as including both borosilicate glass and phosphate glass, and that argument cannot be accepted.”

<IP LAB ⑤> “Disclaimer Claims” and “Inventive Step”

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<IP LAB ⑤>

“Disclaimer Claims” and “Inventive Step”

1. Relationship between addition of new matter through a “disclaimer claim” and inventive-step assessment

IP High Court, 2021 (Gyo-Ke) No. 10151, the “Vessel” case, is the fourth court decision recognizing inventive step through a disclaimer claim, but more than 1,000 disclaimer claims are granted annually in examination and trials/appeals at the JPO.[i]

Like the previous three decisions recognizing “inventive step” through “disclaimer claims,” 2021 (Gyo-Ke) No. 10151 reasoned, in affirming inventive step, that there was an inhibiting factor against excluding the particular configuration in relation to the problem of the primary cited invention.

On the other hand, like numerous other decisions, 2021 (Gyo-Ke) No. 10151 held, when finding that the correction requirements were satisfied because no new matter was added, that the correction by means of a disclaimer claim did not change the operation and effects of the invention in this case.

Thus, “disclaimer claims” contain a twist: when assessing addition of new matter, the relationship to the problem of the invention in question is at issue, whereas when assessing inventive step, the relationship to the problem of the cited invention is at issue. Some have said this is too convenient for right holders.[ii]

Nevertheless, this may be only a minor twist compared with the major twist in current practice whereby, in an inventive-step assessment, a difference between the problem of the invention and that of the cited invention is a reason to affirm inventive step, while in assessing satisfaction of the claim limitations in infringement litigation, it is not asked whether the accused product or method addresses the problem of the invention.[iii]

The author has released a YouTube video titled “Using Disclaimer Claims” on this important issue of “disclaimer claims and inventive step,” which is introduced here. (It does not include decisions issued after the video was made, but the explanation in the video remains the same as of 2023.)

https://www.youtube.com/watch?v=MCoshkBBcRo

2. Assessment of new matter in “disclaimer claims” (different approaches to enlarged prior-application effect and inventive step)

I have the impression that the assessment of new matter in “disclaimer claims” is applied more strictly when an amendment/correction is made to overcome lack of inventive step than when it is made to avoid the enlarged prior-application exclusion. Below I quote the application of the standards in four decisions.

2021 (Gyo-Ke) No. 10151, the “Vessel” case, found that “‘flood-prevention rooms’ are permitted to have a tank function, and thus there are ‘flood-prevention rooms’ that also serve as tanks and those that do not.” It thereby presented substantive reasoning beyond the formal proposition that the effects of the invention are not changed and no new effects are achieved.

2021 (Gyo-Ke) No. 10111, the [Laser Processing Apparatus] case, likewise found that “it would be unnatural deliberately not to depict ‘grooves’ while depicting ‘planned cutting lines,’” thereby presenting substantive reasoning beyond the formal proposition that the effects of the invention are not changed and no new effects are achieved.

In 2018 (Ne) No. 10006, [Method of Operating a System (Capcom v. Koei)], addition of new matter was not a disputed issue.

The first judgment in 2017 (Gyo-Ke) No. 10032, [Method of Manufacturing a Conductive Material (Silver Flakes)], also held: “It cannot be said that the specification, claims, or drawings attached to the application contain no express description that the ‘fusion’ in Corrected Invention 10 in this case arises from ‘locally oxidizing part of said silver particles.’ Therefore… it does not constitute addition of new matter.”

This has something in common with the approach explained in the European Patent Office's guidelines below: a double standard under which the assessment framework for new matter itself is strict for disclaimer claims used to establish inventive step.

“G 1/03: An ‘undisclosed disclaimer’ is permitted only in the following three situations:

1. To restore novelty over prior art under EPC Article 54(3) (corresponding to documents under Article 29bis of the Japanese Patent Act).

2. To restore novelty over accidental prior art.

3. To exclude subject matter that is excluded from patentability for non-technical reasons (for example, treatment methods).

However, it is not permitted in the following situations:

(1) Where it is intended to exclude embodiments that cannot be carried out or to remedy insufficient enablement.

(2) Where it is relevant to inventive step.

(3) Where it also restores novelty over prior art other than earlier-filed, unpublished applications (EPC Article 54(3)) or accidentally anticipating prior art.

(4) Where it removes more subject matter than necessary (G 1/03, G 2/03).” (Quoted from European GW)

[Introduction to Related Decisions (Four Court Decisions and One JPO Decision Recognizing Inventive Step Through Disclaimer Claims)]

≪Decisions Favorable to Right Holders≫

If one excludes the portion relating to the primary reference's principle for solving its problem or its essential part, inventive step can also be recognized!!

● 2021 (Gyo-Ke) No. 10151, “Vessel” <Presiding Judge Shoji>

*Inventive step was recognized by excluding a configuration constituting, or underlying, the primary cited invention's principle for solving its problem, on the logic that there was an inhibiting factor against removing that configuration from the primary cited invention. Specifically, replacing a tank in the primary cited invention that functioned as a ‘flood-prevention room’ with a ‘flood-prevention room’ having no tank function would require new space to accommodate a tank and would prevent the location previously available for tank use from being used as a tank. On those grounds, an inhibiting factor was found and inventive step was recognized.

(Excerpt from the court's reasoning) …The ‘aft trimming tank (ballast water tank)’ of the Exhibit Ko 6 Invention inherently has a tank function. It faces the side wall and is a room with a watertight structure that prevents flooding of the ‘room’ in which it is provided even if that side wall is damaged and flooded. It therefore also constitutes a ‘flood-prevention room’ and is found to be a flood-prevention room that also functions as a tank. However, there is no evidence suggesting that a ‘flood-prevention room’ that also serves as a tank should be constituted separately as a tank and a ‘flood-prevention room’ that does not also serve as a tank. Nor is there evidence suggesting that, at the location of a tank originally designed to perform a tank function and understood also to perform a ‘flood-prevention room’ function, a ‘flood-prevention room’ with no tank function should be placed while a separate tank is placed elsewhere. Therefore, in the Exhibit Ko 6 Invention, no motivation can be found to constitute the ‘aft trimming tank

(ballast water tank)’ separately as a tank and a non-tank ‘flood-prevention room,’ or to replace it with a void serving as a ‘flood-prevention room.’

Furthermore, if a tank and a ‘flood-prevention room’ with no tank function are constituted separately, and a tank originally designed to perform a tank function and understood also to perform a ‘flood-prevention room’ function is replaced with a ‘flood-prevention room’ having no tank function, new space will be required to accommodate a tank, and a location that could previously be used as a tank will no longer be available for tank use. This impairs freedom of design, and there is therefore an inhibiting factor against doing so. Accordingly, it cannot be found that a person skilled in the art could easily have conceived of replacing the ‘aft trimming tank (ballast water tank)’ in the Exhibit Ko 6 Invention with a void serving as a ‘flood-prevention room’ and placing the ‘aft trimming tank (ballast water tank)’ in the room behind it.

● 2021 (Gyo-Ke) No. 10111, [Laser Processing Apparatus] <Presiding Judge Kanno>

*The absence of grooves was discerned from drawings in the specification, and correction by a disclaimer claim was allowed.

(Excerpt from the court's reasoning) …Figures 1 and 3 in the specification and other documents are plan views depicting planned cutting lines on workpiece 1. Neither Figure 2, a cross-section along line II–II in Figure 1, nor Figure 4, a cross-section along line IV–IV in Figure 3, shows any grooves being formed. … Figures 1–4 depict ‘planned cutting lines’ but do not depict ‘grooves.’ If the invention before correction had been premised on the existence of ‘grooves,’ it would have been unnatural deliberately not to depict ‘grooves’ while depicting ‘planned cutting lines.’

…It is inconceivable that a person skilled in the art encountering Document Ko 11 would disregard, from substrate 201, groove portions 203 that create the internal stress used to cut the semiconductor wafer. There is not only no motivation to make a modification adopting, as the workpiece, substrate 201 without grooves along the break line and forming a processing-altered portion inside substrate 201 whose surface has no grooves; rather, there is an inhibiting factor against such modification….

● 2018 (Ne) No. 10006, [Method of Operating a System (Capcom v. Koei)] <Presiding Judge Tsuruoka>

*(Unlike the first-instance judgment,) inventive step was recognized through a ‘disclaimer claim’!! ⇒ Because this is substantively a difference in configuration, the assessment is not unusual.

(Excerpt from the court's reasoning) …If a storage medium incapable of saving ‘character’ and ‘play achievement’ information is adopted, the ‘character’ and ‘play achievement’ information from the earlier game will not be stored on that medium. It is clear that this would make it impossible to implement Publicly Known Invention 1 in this case, namely, ‘playing a later game with a character from an earlier game’ and ‘operating an extended game program in the later game when the earlier character's level is 16 or higher.’ Therefore, … in Publicly Known Invention 1 there is no motivation to change the storage medium to a ‘storage medium (excluding, however, a storage medium capable of storing save data)’ that cannot save game characters or play achievements, and there is an inhibiting factor against adopting such a storage medium.

● 2017 (Gyo-Ke) No. 10032, [Method of Manufacturing a Conductive Material (Silver Flakes)] <Presiding Judge Takabe> — First judgment

*Inventive step was recognized through a ‘disclaimer claim’!! ⇒ The second judgment (Otaka) reached the same conclusion on grounds of binding effect.

(Excerpt from the court's reasoning) …The manufacturing method of Cited Invention 1 differs from the method in Corrected Invention 9 in this case of ‘obtaining a conductive material in which said silver particles fuse at mutually adjacent portions (excluding, however, cases in which the silver flakes fuse only at their ends), and having voids thereby generated.’ …Cited Reference 1 merely discloses a method of sintering silver flakes only at their ends so that the ends fuse. It does not suggest to a person skilled in the

art that selecting the firing atmosphere or other conditions yields a conductive material in which the portions of the silver particles that fuse are portions other than their ends and cases of fusion only at their ends are excluded….

● <JPO> Correction Trial 2017-390031

[Claim 1] …an antibody or antibody derivative (excluding, however, antibody clone AHIX-5041, manufactured by Haematologic Technologies, and antibody clone HIX-1, manufactured by SIGMA-ALDRICH)

⇒ It would not have been obvious to a person skilled in the art to create an antibody that 'increases procoagulant activity' based on the two excluded publicly worked inventions (antibodies).

(Excerpt from the JPO decision) "…No evidence has been presented sufficient to find that these two antibodies were known even to 'increase procoagulant activity.' Furthermore, there is no evidence showing that, at the priority date in this case, it was known that an 'antibody or antibody derivative against factor IX or factor IXa' 'increases procoagulant activity.' Therefore, creating an antibody that 'increases procoagulant activity' based on these two antibodies would not have been obvious to a person skilled in the art, and the invention of corrected Claim 1 has inventive step…." ⇒ Inventive step affirmed

≪Decisions Unfavorable to Right Holders≫

● 2014 (Gyo-Ke) No. 10204, [Transdermal Absorption Preparation] <Presiding Judge Ishii>

*Because the portion excluded by the disclaimer claim was not clear as a product, the correction was held not to constitute a restriction of the scope of claims, and the correction requirements were not satisfied. = 2016 (Gyo-Ke) No. 10160 involving the same parties

[i] Hidenori Yorozu, 'Yorozu Intellectual Property Consulting Blog,' March 14, 2022 article 'Disclaimer Claims' https://yorozuipsc.com/blog/4130957

[ii] Intellectual Property Practice Online, 'Such Convenient "Disclaimer Claims"' (patent attorney Kenji Tanaka)

https://www.youtube.com/watch?v=1QfcGA-Nh2E

[iii] Hideki Takaishi, 'Why Does the "Problem of the Invention in Question" Affect the Inventive-Step Assessment?' (Intellectual Property Practice Information Lab., published September 12, 2023; updated September 16, 2023) https://chizai-jj-lab.com/2023/09/12/0912/

[U.S. Patents] September 2023 CAFC — Apple v. Corephotonics

Original Ameblo publication: 2024-01-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836138009.html

[U.S. Patents] September 2023 CAFC — Apple v. Corephotonics

The indefinite article ‘a’ in the claim language was construed to mean ‘one or more.’ (a point of view)

Where multiple embodiments are disclosed in the specification, that contributes to construing the claim language as meaning ‘one or more.’

https://www.cafc.uscourts.gov/opinions-orders/22-1350.OPINION.9-11-2023_2188207.pdf

[Article] Article 38-2 of the Patent Act (Mamoru Suzuki, Intellectual Property Management, Vol. 73, No. 8, 2023)

Original Ameblo publication: 2024-01-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836257818.html

[Article] Article 38-2 of the Patent Act (Mamoru Suzuki, Intellectual Property Management, Vol. 73, No. 8, 2023)

Introduced by the 2015 amendment.

A filing date can be secured even without claims.

Unlike a U.S. provisional application, the application itself is examined and must satisfy the disclosure requirements. However, the two are the same insofar as disclosure from the original filing is needed to claim priority.

395d2af9ca5a4aa9b2214f98f4911b7e.pdf (ksilawpat.jp)

[U.S. Patents] Cleveland v. True Health, 859 F.3d 1352

Original Ameblo publication: 2024-01-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836523845.html

[U.S. Patents] Cleveland Clinic Found v. True Health Diagnostics, 859 F.3d 1352 (CAFC, June 16, 2017)

Treatment-method patent

Test results were reported to physicians.

The test reports did not constitute the provision of material or apparatus ⇒ Contributory-infringement claim dismissed

Failure to allege specific facts showing specific intent and action to induce patent infringement ⇒ Induced-infringement claim dismissed

https://www.supremecourt.gov/DocketPDF/17/17-997/20700/20171117152103851_Exhibit%20A.PDF

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜１＞誘印者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋＜２＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
2018.11 CAFC (909 F.3d 398) Enplas Display v. Seoul Semiconductor	米国外でレンズ販売⇒照明装置に係る米国特許の誘引侵害成立。271(b) 被疑侵害者の世界市場シェアが５０％を有しており、被疑侵害者の顧客が米国でも最終製品（テレビ）を販売していることを知っていた以上、「specific intent to induce infringement」を認めた。	★
2015.05 CAFC (785 F.3d 625) Takeda v. West-Ward Pharm ⇒誘引侵害不成立 271(b)	被疑侵害者（製薬メーカー）が被疑侵害医薬品の侵害用途を知っていたとしても、そのラベルが曖昧で（vague）、必然的に医師が特許発明の用途で処方するわけではない場合には、誘引侵害の意図は認められない。271(b) Arthrocare v. Smith&Nephew 406 F.3d 1365 (Fed. Cir. 2005)事件では、ラベルが特許権侵害を「必然的に導く（necessarily lead)」ものであったから、事案が異なる。（一般論はその後も同じ。Sanofi v. Watson 875 F.3d 636 (Fed. Cir. 2017))	★
2010.11 CAFC (633 F.3d 1042) AstraZeneca v. Apotex	特許発明は１日１回の処方。被告が承認を得たラベルには１日２回の処方と記載されていたが、喘息が安定したら服用量を徐々に減らすことが推奨されていた。被告医薬品は濃度 0.25mg と 0.5mg しかなかった。医師や患者がラベルの推奨通り服用量を減らすと１日１回服用する者も現れる。⇒治療方法の特許発明の誘引侵害成立。271(b) ⇒一定割合の直接侵害者を「necessarily lead」すれば足り、100%侵害用途で使われることは要件でない。何%で誘引侵害？	★
1998.08 CAFC (152 F.3d 1342) Johns Hopkins University v. Cellpro	医療機器の宣伝・広告で、誘引侵害成立。271(b) ⇒特許発明を知りながら、被告機器を使えば特許発明の純化率を実現できると唱っていた。 ≒CAFC 2020.10 Glaxosmithkline v. Teva（ラベルに特許用途が明記されていなかったが、同等品であると記載されていた。） ＝日本の知財高判平成 17 年(ネ)第 10125 号【シロスタゾール事件（職務発明の対価請求訴訟）】＜佐藤＞	○
2003.01 CAFC（316 F.3d 1348) Warner-Lambert v. Apotex	存続期間満了後の OFF-LABEL USE⇒271(e)(2)不成立（※物が同一である医薬品特有の判決か？） ＜傍論＞特許発明用途の OFF-LABEL USE に 2.1%（5000 万ドル）使われても、誘引侵害不成立。271(b) ⇒特に、製品に非侵害用途が相当程度ある場合、被告がその製品の一部のユーザーが特許を侵害している可能性があることを実際に知っていたとしても、侵害を誘引する意図（intent）を推論することはできない。gabapentinのように、ある製品に多くの用途があり、侵害する用途に用いられる製品販売が46件に1件以下である場合は、直接的な証拠がない限り、Apotex社の意図（intent）を推論することも推論しないこともできない。	★ ★ ★
2003.03 CAFC（324 F.3d 1322） Allergan v. Alcon	特許発明とは別用途の OFF-LABEL USE⇒271(e)(2)不成立（※特許発明は緑内障。被疑侵害者の商品は眼圧低下。） Warner-Lambert の先例に基づき、FDA に特許発明の用途で承認を求めていないことから、被告 Alcon 有利な略式判決。（多数意見は 271(b)の誘引侵害を検討していない。271(e)(2)をクリアしても、ANDA 承認後 271(b)が更に争われる。）	△

(Note) Regarding the entry “inducement established, 271(b)” in the first row of the figure above (Power Integrations v. Fairchild Semiconductor), the CAFC vacated the jury’s inducement verdict under 35 U.S.C. § 271(b) and remanded because the jury instructions were erroneous (see the table below).

(Editor's transcription and correction of the figure above)

U.S. inducement decisions

Case	Holding and comparison	Note
2016.12 CAFC, 843 F.3d 1315 Power Integrations v. Fairchild Semiconductor	Inducement requires successful communication from the inducer to the direct infringer and affirmative conduct that leads to direct infringement; merely allowing infringement to occur is insufficient. Evidence of a U.S. technical support center, assistance in locating U.S. distributors, and indemnification against U.S. patent infringement claims could support a finding of intent to induce infringement in the U.S. market. The CAFC nevertheless vacated the inducement verdict under 35 U.S.C. § 271(b) and remanded because the jury instructions were erroneous.	★

Case	Holding and comparison	Note
2018.11 CAFC, 909 F.3d 398 Enplas Display Device v. Seoul Semiconductor	The court upheld induced infringement under § 271(b) involving lighting devices in the United States that incorporated lenses sold abroad. The evidence included an approximately 50% worldwide market share, knowledge that customers sold the finished televisions in the United States, prior joint development with the patentee, notice identifying infringing products found in the United States, and product specifications recommending infringing configurations to customers. Taken together, the evidence supported a finding of specific intent to induce infringement.	★
2015.05 CAFC, 785 F.3d 625 Takeda Pharmaceuticals v. West-Ward Pharmaceutical	At the preliminary injunction stage, the court affirmed denial of relief because Takeda had not shown a likelihood of success on induced infringement. Knowledge of an infringing use does not necessarily establish intent where ambiguous labeling does not necessarily lead physicians to prescribe the drug for the patented use. The court distinguished the instructions and other evidence in ArthroCare v. Smith & Nephew, 406 F.3d 1365 (Fed. Cir. 2005). (The general rule has remained the same since; see Sanofi v. Watson, 875 F.3d 636 (Fed. Cir. 2017).)	★
2010.11 CAFC, 633 F.3d 1042 AstraZeneca v. Apotex	The patent concerned once-daily inhalation. The approved label specified twice-daily administration but also directed gradual reduction to the lowest effective dose once asthma was stable. The product was available only in strengths of 0.25 mg and 0.5 mg per 2 mL vial. Following the titration instructions would necessarily lead some patients to once-daily administration. The CAFC affirmed a preliminary injunction based on a likelihood of success on induced infringement. ⇒ It suffices that a certain proportion of direct infringers are "necessarily led" to infringe; use for the infringing purpose in 100% of cases is not required. At what percentage is inducement established?	★
1998.08 CAFC, 152 F.3d 1342 Johns Hopkins University v. CellPro	The court upheld induced infringement under § 271(b) based on promotion and advertising of a medical device, including statements, made with knowledge of the patent, that the device could achieve the patented purity level. Comparison: the 2020 GlaxoSmithKline v. Teva opinion was replaced by the 2021 panel rehearing opinion. The latter sustained the jury's finding that the partial label still included a patented use and that the carve-out was incomplete, considering the label's specific language together with promotional statements of equivalence to the brand-name drug and other evidence in sustaining the inducement verdict. ≈ Japan: IP High Court, 2005 (Ne) No. 10125 [Cilostazol case (action for compensation for an employee invention)] <Sato>	○
2003.01 CAFC, 316 F.3d 1348 Warner-Lambert v. Apotex	The patents covering the compound and its approved use for epilepsy had expired, while a patent on a different, unapproved use for neurodegenerative diseases remained in force. Because the ANDA sought approval for an unpatented, approved use, the court found no infringement under § 271(e)(2). (* Is this a ruling specific to pharmaceuticals involving the same product?) In dicta, the court explained that the plaintiff's asserted 2.1% rate of off-label use for the patented indication (estimated by the plaintiff at $50 million) did not by itself establish intent to induce infringement under § 271(b). Where substantial noninfringing uses existed and fewer than one in 46 sales were for an infringing use, knowledge that some users might infringe was insufficient. On the record before it, the court could neither infer nor reject an inference of intent from that proportion alone without direct evidence.	★ ★ ★
2003.03 CAFC, 324 F.3d 1322 Allergan v. Alcon	The approved use was reduction of intraocular pressure; the patented, unapproved use was optic-nerve protection or neuroprotection. Applying Warner-Lambert, the court held that § 271(e)(2) was not infringed because Alcon did not seek FDA approval for the patented use. The majority did not decide liability for inducement under § 271(b). The absence of § 271(e)(2) liability from filing the ANDA does not rule out a later § 271(b) claim based on actual post-approval conduct.	△

[Article / United States] Trends in U.S. Induced-Infringement Decisions and Points to Note in Practice (Intellectual Property Management, November 2023)

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[Article / United States] Trends in U.S. Induced-Infringement Decisions and Points to Note in Practice (Intellectual Property Management, Vol. 73, No. 11, 2023)

Communication between the inducer and direct infringer + affirmative conduct are required.

In Takeda v. West-Ward, the labeling and other evidence did not establish an intent to induce use for the patented indication, and the likelihood of success on the merits of induced infringement required for a preliminary injunction was not established.

Sales of components outside the United States can constitute induced infringement of a U.S. patent.

Willful blindness

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2311

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜１＞誘印者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋ ＜２＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
2018.11 CAFC (909 F.3d 398) Enplas Display v. Seoul Semiconductor	米国外でレンズ販売⇒照明装置に係る米国特許の誘引侵害成立。271(b) 被疑侵害者の世界市場シェアが５０％を有しており、被疑侵害者の顧客が米国でも最終製品（テレビ）を販売していることを知っていた以上、「specific intent to induce infringement」を認めた。	★
2015.05 CAFC (785 F.3d 625) Takeda v. West-Ward Pharm ⇒誘引侵害不成立 271(b)	被疑侵害者（製薬メーカー）が被疑侵害医薬品の侵害用途を知っていたとしても、そのラベルが曖昧で（vague）、必然的に医師が特許発明の用途で処方するわけではない場合には、誘引侵害の意図は認められない。271(b) Arthrocare v. Smith&Nephew 406 F.3d 1365 (Fed. Cir. 2005)事件では、ラベルが特許権侵害を「必然的に導く（necessarily lead)」ものであったから、事案が異なる。（一般論はその後も同じ。Sanofi v. Watson 875 F.3d 636 (Fed. Cir. 2017))	★
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1998.08 CAFC (152 F.3d 1342) Johns Hopkins University v. Cellpro	医療機器の宣伝・広告で、誘引侵害成立。271(b) ⇒特許発明を知りながら、被告機器を使えば特許発明の純化率を実現できると唱っていた。 ≒CAFC 2020.10 Glaxosmithkline v. Teva（ラベルに特許用途が明記されていなかったが、同等品であると記載されていた。） ＝日本の知財高判平成 17 年(ネ)第 10125 号【シロスタゾール事件（職務発明の対価請求訴訟）】＜佐藤＞	○
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[U.S. Patents] Enplas Display v. Seoul Semiconductor, 909 F.3d 398 (CAFC, November 2018)

Original Ameblo publication: 2024-01-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836652957.html

[U.S. Patents] Enplas Display v. Seoul Semiconductor, 909 F.3d 398 (CAFC, November 2018)

Lenses sold outside the United States

⇒ Induced infringement of a U.S. patent concerning a lighting device established

The alleged infringer had a 50% global market share and knew that its customers also sold the finished products in the United States. Evidence that it supplied customers with product specifications recommending infringing configurations also supported the finding.

⇒ Specific intent found!!

https://law.justia.com/cases/federal/appellate-courts/cafc/16-2599/16-2599-2018-11-19.html

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜１＞誘印者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋＜２＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
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[U.S. Patents] Power Integrations v. Fairchild, 843 F.3d 1315 (CAFC, December 2016)

Original Ameblo publication: 2024-01-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836775574.html

[U.S. Patents] Power Integrations v. Fairchild, 843 F.3d 1315 (CAFC, December 2016)

For induced infringement to be established,

① Successful communication between the inducer and the direct infringer is required

+

② Mere inaction in allowing patent infringement to continue is insufficient; an affirmative act affecting the acts of practicing the invention is required.

https://www.cafc.uscourts.gov/opinions-orders/15-1329.opinion.12-8-2016.1.pdf

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[U.S. Patents] Power Integrations v. Fairchild (CAFC, December 2016)

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12836900393.html

[U.S. Patents] Power Integrations v. Fairchild (CAFC, December 2016)

① Established a technical support center in the United States.

② Enabled customers to find U.S. distributors.

③ Indemnified customers against claims of U.S. patent infringement in its standard terms.

⇒ Sales activities targeting the U.S. market were evidence from which intent to induce infringement could be found. However, the induced-infringement verdict was vacated because of an erroneous jury instruction, and the case was remanded.

https://patentlyo.com/patent/2016/12/integrations-fairchild-semiconductor.html

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜１＞誘印者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋ ＜２＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
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[United States] Takeda v. West-Ward, 785 F.3d 625 (CAFC 2015)

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[United States] Takeda v. West-Ward, 785 F.3d 625 (CAFC 2015)

In this case, the labeling and other evidence did not establish an intent to induce use for the patented indication, and the likelihood of success on the merits of induced infringement required for a preliminary injunction was not established.

Cf. The Arthrocare case (CAFC 2005) involved 'necessarily lead.'

https://www.finnegan.com/a/web/2896/2G4ikc/15-1139-05-06-15.pdf

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Original Ameblo publication: 2024-01-19

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[United States] 2010 CAFC (633 F.3d 1042) AstraZeneca v. Apotex

Preliminary injunction affirmed based on a likelihood of success on induced infringement (treatment method)

Cf. Takeda v. West-Ward, 785 F.3d 625 (CAFC 2015)

The patented invention called for once-daily dosing.

The defendant's label stated twice daily, but recommended gradual dose reduction.

The defendant’s drug was available in only two strengths: 0.25 mg and 0.5 mg per 2 mL vial.

If physicians or patients reduced the dose administered by inhalation in accordance with the label’s recommendation, some patients would receive the drug by inhalation once daily.

https://www.cafc.uscourts.gov/opinions-orders/09-1381-1424.pdf

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[United States] 1998 CAFC (152 F.3d 1342) Johns Hopkins University v. Cellpro

Induced infringement established through promotion and advertising of a medical device.

Knowing of the patented invention, the defendant claimed that use of its device could achieve the purity level of the patented invention.

≈ CAFC 2021, GlaxoSmithKline v. Teva (panel rehearing decision: the attempted carve-out was incomplete, leaving a patented use on the label; the court sustained the inducement verdict based on the label and promotional materials, including statements of equivalence).

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[United States] 2003 CAFC (316 F.3d 1348) Warner-Lambert v. Apotex

Section 271(e)(2) infringement not established

+

<Obiter dictum> The court held that, even assuming the plaintiff's estimate that use for the patented indication accounted for 2.1% and represented $50 million in sales was correct, that circumstance alone was insufficient to establish induced infringement for a drug that also had noninfringing uses, as in this case.

*Fewer than one in 46 sales were for the infringing use.

The determination concerned the evidence in this case and did not generally exclude proof of intent to induce infringement by circumstantial evidence.

https://www.law.uh.edu/faculty/gvetter3/fcplc/CaseFiles/2003/PDF/Warner-Lambert%20v.%20Apotex,%2002-1073%20(Fed.%20Cir.%20Jan%202003).pdf

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[United States] 2003 CAFC (324 F.3d 1322) Allergan v. Alcon

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[United States] 2003 CAFC (324 F.3d 1322) Allergan v. Alcon

The approved use was lowering intraocular pressure, whereas the patented uses—optic-nerve protection and neural protection—were unapproved uses (OFF-LABEL USE).

⇒ Section 271(e)(2) infringement not established

Binding precedential effect of Warner-Lambert

*The majority opinion does not examine induced infringement under § 271(b).

Even after clearing § 271(e)(2), § 271(b) may be further disputed after ANDA approval.

https://law.justia.com/cases/federal/appellate-courts/F3/324/1322/577219/

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜1＞誘印者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋＜2＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
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[New YouTube Video] [Patents] Inventive Step of Parameter Inventions (30 minutes from the two-hour 2023 JAFBIC lecture)

Original Ameblo publication: 2024-01-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12837589112.html

[New YouTube Video]

[Patents] Inventive Step of Parameter Inventions (30 minutes from the two-hour 2023 JAFBIC lecture)

The correlation between the problem and the parameter is the dividing line.

Together with the key court decisions,

I explain in depth how to construct the logic.

*An approach applicable beyond numerical limitations / parameter inventions

⇒ An examination by category of what becomes a ‘matter of design choice’!!

https://www.youtube.com/watch?v=xqcalGBpzmk&t=1s

[United States] Induced Infringement — Cases Finding Willful Blindness

Original Ameblo publication: 2024-01-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12837683662.html

[United States] Induced Infringement — Cases Finding Willful Blindness

Supreme Court: Global-Tech

⇒ Did not tell the opinion provider that the product had been copied.

Smith & Nephew v. Arthrex, 502 F. App'x 945 (CAFC 2013)

⇒ Did not compare against the patent.

Global Traffic v. Morgan, 620 F. App'x 895 (CAFC 2015)

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2015.05 CAFC, 785 F.3d 625 Takeda Pharmaceuticals v. West-Ward Pharmaceutical	At the preliminary injunction stage, the court affirmed denial of relief because Takeda had not shown a likelihood of success on induced infringement. Knowledge of an infringing use does not necessarily establish intent where ambiguous labeling does not necessarily lead physicians to prescribe the drug for the patented use. The court distinguished the instructions and other evidence in ArthroCare v. Smith & Nephew, 406 F.3d 1365 (Fed. Cir. 2005). (The general rule has remained the same since; see Sanofi v. Watson, 875 F.3d 636 (Fed. Cir. 2017).)	★
2010.11 CAFC, 633 F.3d 1042 AstraZeneca v. Apotex	The patent concerned once-daily inhalation. The approved label specified twice-daily administration but also directed gradual reduction to the lowest effective dose once asthma was stable. The product was available only in strengths of 0.25 mg and 0.5 mg per 2 mL vial. Following the titration instructions would necessarily lead some patients to once-daily administration. The CAFC affirmed a preliminary injunction based on a likelihood of success on induced infringement. ⇒ It suffices that a certain proportion of direct infringers are "necessarily led" to infringe; use for the infringing purpose in 100% of cases is not required. At what percentage is inducement established?	★
1998.08 CAFC, 152 F.3d 1342 Johns Hopkins University v. CellPro	The court upheld induced infringement under § 271(b) based on promotion and advertising of a medical device, including statements, made with knowledge of the patent, that the device could achieve the patented purity level. Comparison: the 2020 GlaxoSmithKline v. Teva opinion was replaced by the 2021 panel rehearing opinion. The latter sustained the jury's finding that the partial label still included a patented use and that the carve-out was incomplete, considering the label's specific language together with promotional statements of equivalence to the brand-name drug and other evidence in sustaining the inducement verdict. ≈ Japan: IP High Court, 2005 (Ne) No. 10125 [Cilostazol case (action for compensation for an employee invention)] <Sato>	○
2003.01 CAFC, 316 F.3d 1348 Warner-Lambert v. Apotex	The patents covering the compound and its approved use for epilepsy had expired, while a patent on a different, unapproved use for neurodegenerative diseases remained in force. Because the ANDA sought approval for an unpatented, approved use, the court found no infringement under § 271(e)(2). (* Is this a ruling specific to pharmaceuticals involving the same product?) In dicta, the court explained that the plaintiff's asserted 2.1% rate of off-label use for the patented indication (estimated by the plaintiff at $50 million) did not by itself establish intent to induce infringement under § 271(b). Where substantial noninfringing uses existed and fewer than one in 46 sales were for an infringing use, knowledge that some users might infringe was insufficient. On the record before it, the court could neither infer nor reject an inference of intent from that proportion alone without direct evidence.	★ ★ ★
2003.03 CAFC, 324 F.3d 1322 Allergan v. Alcon	The approved use was reduction of intraocular pressure; the patented, unapproved use was optic-nerve protection or neuroprotection. Applying Warner-Lambert, the court held that § 271(e)(2) was not infringed because Alcon did not seek FDA approval for the patented use. The majority did not decide liability for inducement under § 271(b). The absence of § 271(e)(2) liability from filing the ANDA does not rule out a later § 271(b) claim based on actual post-approval conduct.	△

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2016 (Wa) No. 648

Original Ameblo publication: 2024-01-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12837798528.html

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2016 (Wa) No. 648

‘In addition to normative management… such as prohibiting disclosure of customer information in the work rules…, given the importance of customer information to a placement-sales business…, employees, too, could readily understand… that it was subject to management as a secret.’

⇒ Requirement that the information be managed as a secret satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87795.pdf

[Unfair Competition Prevention Act / Trade Secrets] IP High Court, 2019 (Ne) No. 10044 <Otaka>= Tokyo District Court, 2017 (Wa) No. 29604 <Yamada>

Original Ameblo publication: 2024-01-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12837926295.html

[Unfair Competition Prevention Act / Trade Secrets] 2019 (Ne) No. 10044 <Otaka>

= Tokyo District Court, 2017 (Wa) No. 29604 <Yamada>

‘Under its confidentiality regulations, it treated all equipment at the electrical steel sheet plant, including the technical information in question,… as highly confidential… and made efforts to manage secrecy, including requiring the defendant to submit a written confidentiality undertaking….’

⇒ Requirement that the information be managed as a secret satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89431.pdf

[Unfair Competition Prevention Act / Trade Secrets] IP High Court, 2017 (Ne) No. 10031 <Mori>

Original Ameblo publication: 2024-01-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838055350.html

[Unfair Competition Prevention Act / Trade Secrets] IP High Court, 2017 (Ne) No. 10031 <Mori>

‘Design information embodied in wooden shoe lasts’ — Work rules + written undertakings + strict management so employees ordinarily could not handle it.

⇒ Requirement that the information be managed as a secret satisfied

‘Business partner subcontractor information’ — Work rules only; the contents of the trade secrets were not made visible on paper or another medium.

⇒ Requirement that the information be managed as a secret not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87425.pdf

[New YouTube Video] The Support Requirement (A Shortened Version of the December 20, 2023 IP LAB Lecture)

Original Ameblo publication: 2024-01-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838172641.html

[New YouTube Video] The Support Requirement (Reading through the manuscript for Patent Case Law, 4th Edition): an edited, shortened version of the lecture held at IP LAB on December 20, 2023

A comprehensive review of decisions addressing the support requirement, with their key points.

From older cases to the latest, all in this one video!!

*A recording of the Q&A session is also included at the end of the video.

https://www.youtube.com/watch?time_continue=3212&v=AxqzQ1V1BWY&embeds_referring_euri=https%3A%2F%2Ftwitter.com%2F&source_ve_path=MzY4NDIsMjM4NTE&feature=emb_title

[Unfair Competition Prevention Act / Trade Secrets] Osaka High Court, 2017 (Ne) No. 442

Original Ameblo publication: 2024-01-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838304376.html

[Unfair Competition Prevention Act / Trade Secrets] Osaka High Court, 2017 (Ne) No. 442

First instance: Osaka District Court, 2015 (Wa) No. 7288

Separate case also recognizing management as a secret: Osaka District Court, 2013 (Wa) No. 12149

In 2015 (Wa) No. 7288, the court found that employees could recognize the information as business information that must not be divulged to others.

Although it was not kept in a locked cabinet despite awareness that it should have been…

⇒ Requirement that the information be managed as a secret satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87039.pdf

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2016 (Wa) No. 5649

Original Ameblo publication: 2024-01-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838434437.html

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2016 (Wa) No. 5649

‘The work rules did not identify the secrets covered, nor can defendant P1 himself be found to have been aware that the drawing data in question were secret; there were no other… measures… enabling recognition that they were trade secrets.’

⇒ Although the defendant was a director, the requirement that the information be managed as a secret was not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88649.pdf

[Contract (Patent Warranty)] Osaka District Court, 2020 (Wa) No. 7001

Original Ameblo publication: 2024-01-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838571868.html

[Contract (Patent Warranty)] Osaka District Court, 2020 (Wa) No. 7001

The special agreement in this case: '…in the event of a conflict, the defendant shall handle and resolve the matter at its own expense and responsibility, and shall not cause loss to the plaintiff company.'

⇒ Because the information needed to make counterarguments was shared, there was no breach of the duty to respond.

⇒ The plaintiff company's decision to abandon the sales business after its business partners terminated their dealings was ultimately held to reflect the plaintiff company's own business judgment.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92075.pdf

[Statistical Data] Percentage of Patent Rights Remaining in Force

Original Ameblo publication: 2024-01-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838692023.html

[Statistical Data] Percentage of Patent Rights Remaining in Force

The percentages are 70% eight years after registration, 64% at nine years, 57% at ten years, 45% at eleven years, and 35% at twelve years.

(Note) The years are counted from registration. Because the patent term ends 20 years from the filing date (Article 67(1) of the Patent Act), patents expire before 20 years have passed from registration.

With annual fees gradually increasing, the trend is as expected.

This can inform decisions on pruning a patent portfolio.

https://www.e-stat.go.jp/stat-search/file-download?fileKind=2&statInfId=000040077880

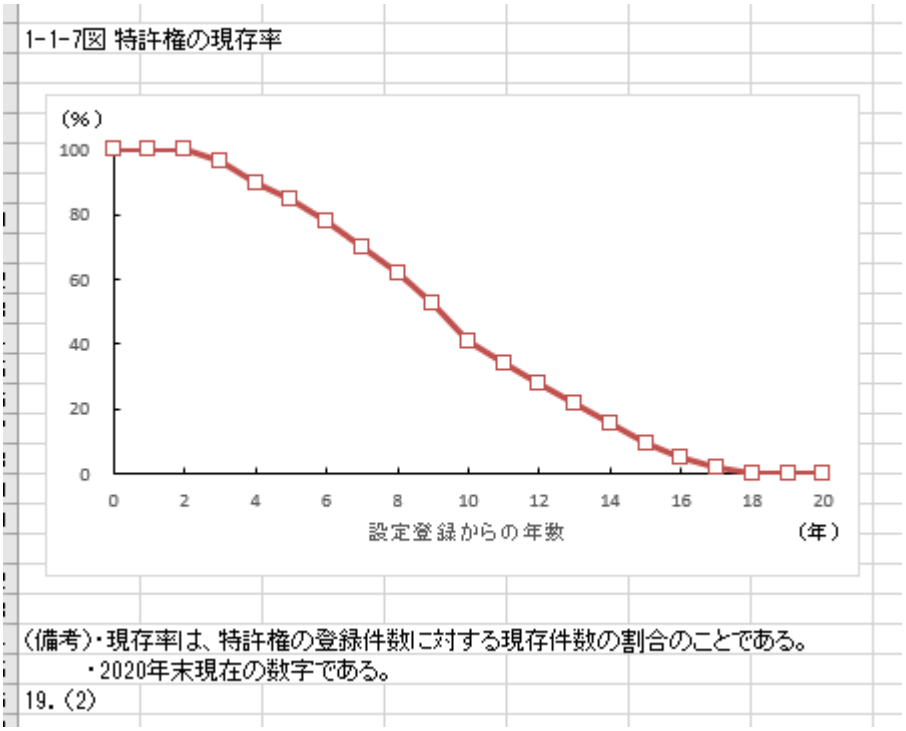


Figure 1-1-7. Percentage of patents remaining in force

Vertical axis: percentage (%), from 0 to 100. Horizontal axis: number of years since registration (years), from 0 to 20.

(Note) The percentage remaining in force is the ratio of the number of patents currently in force to the number of registrations. The figures are as of the end of 2020.

[Statistics] Statistics on Patent Infringement Litigation (Tokyo and Osaka District Courts, 2014–2022)

Original Ameblo publication: 2024-02-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838830485.html

[Statistics] Statistics on Patent Infringement Litigation (Tokyo and Osaka District Courts, 2014–2022)

① Of the 745 cases disposed of by judgment or settlement, 154 resulted in judgments granting relief, including partial relief, representing approximately 21%. Among the 519 judgments alone, the proportion granting relief was approximately 30%. The 154 judgments granting relief and 181 settlements containing payment or other performance obligations totaled 335 cases, approximately 45% of all judgments and settlements.

③ Only 20% of settlements involved neither an injunction nor monetary relief

④ 35 judgments awarding 100 million yen or more

⑤ 29 settlements providing payment of 100 million yen or more

⑥ Where the invalidity defense was adjudicated, the invalidity rate was 50%

https://www.ip.courts.go.jp/vc-files/ip/2023/2022_sintoukei_H26-r4.pdf

[Editorial note] The numbering follows the figure numbers in the source statistics. ① is the sum of ② (content of judgments) and ③ (content of settlements).

[Article] Relationship between “Confusion” and “Business Interests” under Article 2(1)(i) of the Unfair Competition Prevention Act (2023, Hisayoshi Yokoyama)

Original Ameblo publication: 2024-02-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12838968451.html

[Article] Relationship between ‘Confusion’ and ‘Business Interests’ under Article 2(1)(i) of the Unfair Competition Prevention Act (2023, Professor Hisayoshi Yokoyama)

Post-sale confusion — Item (i) applies if there is a risk of an unreasonable effect on future choices of goods and the like.

E.g., the direct acquirer knows it is counterfeit, but confusion arises with a subsequent acquirer.

https://www.jstage.jst.go.jp/article/patentsp/76/29/76_43/_pdf/-char/ja

[Article] Legal Protection of Know-How and Trade Secrets as Seen through Court Decisions and Other Sources — Civil Remedies and Criminal Penalties (2023, Hideaki Togawa)

Original Ameblo publication: 2024-02-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12839369111.html

[Article] Legal Protection of Know-How and Trade Secrets as Seen through Court Decisions and Other Sources — Civil Remedies and Criminal Penalties (2023, Hideaki Togawa)

For ‘technical information,’ intentional disclosure by former employees predominates.

If reverse engineering is expensive and time-consuming, the information does not lose its non-public character.

According to the article, an injunction against taking employment with a competitor, sought under Article 3(2) of the Unfair Competition Prevention Act, appears not to be available as a matter of interpretation, given the nature of the right to seek an injunction (the article cites the Alumina Long Fiber Trade Secret case, Osaka District Court, October 19, 2017, as an example). As for concluding a confidentiality agreement expressly imposing a non-compete obligation upon retirement, the article notes that this is debated in relation to the constitutional “freedom to choose one’s occupation.”

https://www.jstage.jst.go.jp/article/patentsp/76/29/76_107/_pdf/-char/ja

[Article] Shared Data with Limited Access and AI (2023, Izumi Hayashi)

Original Ameblo publication: 2024-02-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12839506662.html

[Article] Shared Data with Limited Access and AI (2023, Izumi Hayashi)

‘…Guidelines’ revised in May, 2022

‘As a business’ — Satisfied if in the course of, or as part of, conducting business

‘Provision’ — Intention alone is sufficient

‘Substantial accumulation’ — Investment may also be considered.

‘(Excluding information managed as secret)’ — This only means that protection under the two systems does not apply cumulatively.

https://www.jstage.jst.go.jp/article/patentsp/76/29/76_131/_pdf/-char/ja

IP High Court, 2023 (Gyo-Ke) No. 10014 [Navigation Device] <Shoji> * Addition of claim language held to constitute a substantive change

Original Ameblo publication: 2024-02-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12839638977.html

2023 (Gyo-Ke) No. 10014 [Navigation Device] <Shoji>

* Adding language to the claim was held to constitute a substantive change!!

By adding the words “of candidate points,” the correction removes the “restriction” on the “points” for which location information can be obtained and … can be said to delete part of the matters defining the invention.

(Excerpt from the judgment)

(2) Whether the matters corrected substantially change the scope of the claims

A. Article 126(6) of the Patent Act is intended to prevent unforeseen disadvantages to third parties that could arise if an invention excluded from the scope of the claims before correction were to be included within the scope after correction. Accordingly, whether a correction “substantially enlarges or changes the scope of the claims” within the meaning of that provision should be determined by reference to the meaning of the claims before and after correction, and whether an enlargement or change is “substantial” should be decided from the standpoint of whether the correction would cause unforeseen disadvantages to third parties.

B. Interpretation of the terminology in the specification

Applying this to the present case, both before and after the correction, according to the language of the claims for the invention of claim 1, the candidate points displayed as symbols on the map screen are “candidate points” after extraction by the candidate-extraction means, whereas the location information that can be obtained by the location-information acquisition means concerns “points”; the “points” for which it can be obtained are restricted to the “locations” corresponding to the symbols.

Terminology in a specification must be used in its ordinary meaning and consistently throughout the specification and claims (Article 24 of the Regulations under the Patent Act; Note 8 to Form No. 29). From this standpoint, the meaning of the terms in the present specification is examined below.

First, “point” in the specification is understood to mean any place within the geographical area displayed on the map screen, including places not displayed as symbols, in view of the statements “set points such as waypoints” (paragraphs [0003] and [0004]), “this conventional navigation device obtains location information for a desired point from the map screen displayed on the display device” (paragraph [0005]), “obtains location information for the target location by designating a point with a cursor on the map screen” (paragraph [0030]), “even on a large-scale map screen, an unnecessary point will not be set by mistake” (paragraph [0040]), and “location information cannot be obtained for points other than those corresponding to symbols on the map screen” (paragraph [0042]).

Next, “location” in the specification is used to refer to a “point’s geographical position on Earth,” as in the statements “when candidate points are displayed in a list and the user selects a candidate point from among them, the user cannot confirm the location of the candidate point on the map” (paragraph [0003]) and “when symbols are displayed in this way, while they remain displayed, the points for which location information can be obtained are restricted to locations corresponding to the symbols, and location information can no longer be obtained for other locations” (paragraph [0007]). It is also used to refer to the

“vehicle’s current position,” as in “the vehicle’s current location and the destination” (paragraph [0002]) and “measure the vehicle’s location using artificial satellites” (paragraph [0024]). In either case, it is understood to refer to their geographical positions on Earth.

Further, “location information” in the specification is understood to mean information representing a location in the real world, rather than a location on the map screen (screen coordinates), as is clear from the statements “the storage unit 41 [stores] current-location information output from the current-location detection unit 11” (paragraph [0029]) and “in step S101 of Fig. 5, a map screen is displayed on the display device 51; in step S102, location information for the destination is obtained through destination-setting processing; in the subsequent step S103, a route search is performed on the basis of the location information for the current location and destination; and in step S104, the searched route is displayed on the map screen. At this time, for example, as shown in Fig. 8, a cursor c indicating the current location o and a mark indicating the destination p are displayed on the map screen together with multiple candidate routes. The user then selects the desired route R1 as appropriate” (paragraph [0032]). Where this refers to location information for points, it clearly includes the destination, in light of the foregoing statement “on the basis of the location information for the current location and destination” (paragraph [0032]).

C. Meaning of the invention of claim 1 before the correction

On the basis of the meanings of the above terms, the meaning of the invention of claim 1 before the correction is examined.

The [Means for Solving the Problem] section of the detailed description of the invention in the specification states: “The invention of claim 1, which solves the above problem, … when location information for a target point is obtained from the map screen of the display means, narrows down candidate points using the candidate-extraction means and displays the extracted candidate points as symbols on the map screen. When symbols are displayed in this way, while they remain displayed, the points for which location information can be obtained are restricted to locations corresponding to the symbols, and location information can no longer be obtained for other locations” (paragraph [0007]). The statement in paragraph [0007] that “the points for which location information can be obtained are restricted to locations corresponding to the symbols, and location information can no longer be obtained for other locations” is understood to have the same meaning as the claim 1 language “restrict the points for which location information can be obtained by the location-information acquisition means to locations corresponding to the symbols.” As for its meaning, given that “point” in the specification means any place within the geographical area displayed on the map screen, including places not displayed as symbols, the location-information acquisition means could previously obtain location information for any such point displayed on the map screen, but, while symbols are displayed as candidate points on the display screen, the locations for which information representing a real-world location can be obtained are restricted to those corresponding to the symbols, so location information for other points displayed on the screen can no longer be obtained.

Thus, in the invention of claim 1 before correction, while candidate points are displayed as symbols, the points for which location information can be obtained are limited to locations corresponding to those symbols, and location information for other points cannot be obtained. This is also clear from the [Effects of the Invention] section of the detailed description, which states: “According to the invention of claim 1, the candidate-extraction means narrows down candidate points and displays the narrowed-down candidate points as symbols on the map screen, and, while those symbols are displayed, restricts the points for which location information can be obtained to locations corresponding to the symbols; therefore, desired location information can be obtained from the map screen simply by selecting a displayed symbol” (paragraph [0015]), thus limiting the points for which location information can be obtained while symbols are displayed to the locations where symbols are displayed. Furthermore, as stated in (1)B above, the invention provides a navigation device capable of obtaining desired location information from a map screen without

requiring the user to perform complicated operations. This interpretation is also consistent with the specification's statements that, for that purpose, the device "comprises location-information acquisition means 46 for obtaining location information for a target location by designating a point with a cursor on the map screen" (paragraph [0030]); "is configured so that symbols indicating candidate points remain even when the map is displayed at a large scale at which symbols other than candidate points disappear, thereby improving convenience" (paragraph [0038]); "when setting a waypoint, acquisition of location information is restricted for locations other than those corresponding to symbols, so that an unnecessary point will not be set by mistake even on a large-scale map screen" (paragraph [0040]); and "although location information cannot be obtained for points other than those corresponding to symbols on the map screen, the location-information selection cursor may also be made incapable of moving anywhere other than candidate points (symbols), rather than merely preventing acquisition" (paragraph [0042]).

D. Meaning of the invention of claim 1 after the correction

In contrast, the invention of claim 1 after correction provides that "while the candidate points are displayed as symbols," "the points for which location information of candidate points can be obtained are restricted to locations corresponding to the symbols." As stated in B above, according to the claim language, the candidate points after extraction by the candidate-extraction means are displayed as symbols on the map screen. Therefore, "locations corresponding to the symbols" means the geographical positions on Earth of the candidate points displayed as symbols on the map screen, and this means the same thing as "points for which location information of candidate points can be obtained" on the map screen. Consequently, in claim 1 after correction, no "restriction" whatsoever is imposed on the points for which location information can be obtained.

In addition, as stated in B above, the location-information acquisition means obtains location information for points, not for candidate points. Thus claim 1 after correction leaves unclear whether, while candidate points are displayed as symbols, the location-information acquisition means can obtain location information for points that are arbitrary places displayed on the map screen other than candidate points.

In other words, by adding the words "of candidate points," the invention of claim 1 after correction removes the "restriction" on the "points" for which location information can be obtained and makes the range within which location information can be obtained unclear. It renders meaningless the claim language "while the candidate points are displayed as symbols on the map screen of the display means, restrict the points for which location information can be obtained by the location-information acquisition means to locations corresponding to the symbols" (Element G), and can be said to delete part of the matters defining the invention.

E. Comparison between the invention of claim 1 before correction and the invention of claim 1 after correction

Accordingly, Correction 1 changes the invention of claim 1 from one in which, as stated in claim 1 before correction, the points for which location information can be obtained are limited to locations corresponding to symbols and location information for other points cannot be obtained, to one that removes the "restriction" on the points for which location information can be obtained, makes the range of acquisition of location information unclear, and deletes part of the matters defining the invention. This change alters the scope of the claims; it is not a narrowing change, nor can it be said to have the purpose of "clarifying an ambiguous statement." It clearly causes unforeseen disadvantages to third parties who relied on the wording of claim 1 before correction.

Therefore, Correction 1 is found substantially to change the scope of the claims and must be held not to satisfy the requirements of Article 126(6) of the Patent Act. There is no error in the trial decision's conclusion to the same effect.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92616.pdf

[Contract / Patent Act Article 73(2)] Tokyo District Court, 2019 (Wa) No. 3141 <Tanaka>

Original Ameblo publication: 2024-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840272429.html

[Contract / Patent Act Article 73(2)] Tokyo District Court, 2019 (Wa) No. 3141 <Tanaka>

The contract stated that the patent right belongs to the plaintiff,

but after the defendant filed the application, the right was jointly owned.

⇒ After the collaboration ended, the claim for transfer of the ownership share was denied.

(Reason) The contract also terminated when the collaboration ended.

* Would it have been better to stipulate that the right “belongs exclusively to the plaintiff”?

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90235.pdf

IP High Court, 2023 (Gyo-Ke) No. 10059 [Prescription with an Entry for the Quantity Held by the Patient] <Shoji> Matter of human convention ⇒ Not an invention

Original Ameblo publication: 2024-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840272565.html

2023 (Gyo-Ke) No. 10059 [Prescription with an Entry for the Quantity Held by the Patient] <Shoji>

* Matter of human convention ⇒ Does not qualify as an invention

(The specification did not mention an “electronic prescription” or a “PC program.”)

(Excerpt from the judgment)

Among the matters in the claimed invention, the items to be entered on a “prescription” are prescribed by Article 21 of the Regulations for Enforcement of the Medical Practitioners’ Act. Thus the entries for “quantity, usage and dosage” are understood as rules based on laws and regulations, that is, human-made arrangements. Accordingly, the “number of days of administration” entered as “quantity, usage and dosage” is also a human-made arrangement. In the claimed invention, providing an entry for the “quantity held by the patient” under the “number of days of administration” on a prescription is likewise merely a human-made arrangement specifying what a physician is to enter on the prescription, and cannot be said to utilize a law of nature. Moreover, the claimed invention specifies methods for calculating … the administration period excluding the amount corresponding to the medicines held by the patient, but each calculation method is a human-made arrangement specifying how a physician calculates the administration period when prescribing and administering medicines to a patient, and cannot be said to utilize a law of nature. … The specification, etc. contains no statement or suggestion whatsoever that the “prescription” is an “electronic prescription,” nor any statement or suggestion whatsoever concerning a “PC program.” Accordingly, the plaintiff’s arguments concerning an “electronic prescription” and a “PC program” are unrelated to the claimed invention. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92588.pdf

[Article] Dwango IP High Court Grand Panel Judgment (Patent, December 2023 issue, Hideki Takaishi)

Original Ameblo publication: 2024-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840272817.html

[Article] Dwango IP High Court Grand Panel Judgment (Patent, December 2023 issue, Hideki Takaishi)

Extending “provision of a program” to “transfer of tangible goods”

(2) Related trademark cases

(2-1) Online-shop server located outside Japan

(2-2) Export of tangible goods from a foreign country to Japan

(3) Patents … important cases

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(1) General discussion

(2) Related trademark cases

(2-1) Cases involving online-shop servers located outside Japan

(2-2) Cases involving the export of tangible goods from a foreign country to Japan

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(3) Control theory (HOYA case, U.S. AKAMAI remand, CAFC en banc) (single-actor direct infringement)

(4) Joint infringement

(5) Instigation and assistance

https://jpaa-patent.info/patent/viewPdf/4344

[Trademark] Tokyo District Court, 2021 (Wa) No. 10991 <Kokubu> ⇒ Similar trademarks

Original Ameblo publication: 2024-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840273000.html

[Trademark] Tokyo District Court, 2021 (Wa) No. 10991 <Kokubu> ⇒ Similar trademarks

① No pronunciation

② Identical concept

A woman lying on a beach mat floating on water

③ Similar appearance

(In addition to ②,) both depict a woman in a bikini wearing black sunglasses and shoes, with her legs bent back below the knees and her head facing the back of the picture.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92422.pdf

商標権目録

登録番号	商標登録第５８２００２４号
出願日	平成２７年（２０１５年）７月２８日
登録日	平成２８年（２０１６年）１月１５日
商品の区分	第２５類
指定商品	「被服、ガーター、靴下止め、ズボンつり、バンド、ベルト、履物、仮装用衣服、運動用特殊衣服、運動用特殊靴」
登録商標	



被告イラスト目録



[Trademark] IP High Court, 2015 (Gyo-Ke) No. 10086 <Otaka> — The “ハイガード” (HIGUARD) case

Original Ameblo publication: 2024-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840273164.html

[Trademark] 2015 (Gyo-Ke) No. 10086 <Otaka>

Mark used: “ハイガード”

Registered mark: “ハイガード” and “HIGUARD” on two lines

The registered mark gives rise to the same concept as the katakana “ハイガード” (= “high-level defense” OR “a high degree of protection of things”).

⇒ Considered identical under generally accepted social norms

* Two-line presentation where the upper and lower lines have the same “concept”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85357.pdf

（本件商標）



[Trademark] IP High Court, 2018 (Gyo-Ke) No. 10103 <Tsuruoka> Mark used: “Buromaga”

Original Ameblo publication: 2024-02-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840411839.html

[Trademark] 2018 (Gyo-Ke) No. 10103 <Tsuruoka>

Mark used: “Buromaga”

Registered mark: katakana + English on two lines

“BlogMaga” on the lower line of the registered mark is pronounced “Burogu Maga,” differently from the upper line. Both are coined words and have no concept.

⇒ Not considered identical under generally accepted social norms

⇒ Cancellation for non-use

* Two-line presentation where the upper and lower lines have the same “pronunciation”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88220.pdf

登録商標

ブロマガ

BlogMaga

[Trademark] Use in a Trial for Cancellation for Non-Use: Must It Be Trademark Use?

Original Ameblo publication: 2024-02-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840542430.html

[Trademark] Use in a Trial for Cancellation for Non-Use: Must It Be Trademark Use?

* View that it is required

2021 (Gyo-Ke) No. 10076, Chihon Shugi <Honda>

* View that it is not required

Tokyo High Court, February 28, 1991, POLA

2016 (Gyo-Ke) No. 10086, LE MANS <Takabe>

2014 (Gyo-Ke) No. 10234, Eye Light (アイライト) <Takabe>

2015 (Gyo-Ke) No. 10032, European <Takabe>, found trademark use.

[Trademark] IP High Court, 2022 (Gyo-Ke) No. 10087 “EMPIRE STEAK HOUSE” case <Kanno>

Original Ameblo publication: 2024-02-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840672026.html

[Trademark] 2022 (Gyo-Ke) No. 10087 “EMPIRE STEAK HOUSE” case <Kanno>

⇒ Separate consideration of components is possible

⇒ Similar to the cited mark “EMPIRE”

The verbal portion does not give the impression of being buried in the figurative portion.

+

There are spaces between the words, so it is perceived as three words.

“EMPIRE” has a strong function of distinguishing one’s services from those of others, while “STEAK HOUSE” has a weak one.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91732.pdf

本願商標

商標の構成



[Foreign] Korean Supreme Court, March 31, 2022 (2018Hu10923): Inventive Step of Crystal-Form Inventions

Original Ameblo publication: 2024-02-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12840800818.html

[Foreign] Korean Supreme Court, March 31, 2022 (2018Hu10923): Inventive Step of Crystal-Form Inventions

Previously, a remarkable effect or an effect different in nature was required.

⇒ The court held that, in addition to ④ advantageous effects,

① whether crystalline polymorphism was expected,

② motivation to arrive at the particular claimed crystal form, and

③ whether it falls within the scope examined in routine polymorph screening

should be considered in making the determination.

https://www.jetro.go.jp/ext_images/world/asia/kr/ip/pdf/han_2022.pdf

IP High Court, 2022 (Gyo-Ke) No. 10131 [Heat Exchanger Using a Thermally Conductive Knitted Wire Fabric] <Honda>

Original Ameblo publication: 2024-02-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841202853.html

2022 (Gyo-Ke) No. 10131 [Heat Exchanger Using a Thermally Conductive Knitted Wire Fabric] <Honda>

Elements D and F merely claim effects necessarily produced by configurations A, B and C.

⇒ No inventive step

* For an effect recited in a claim to constitute a matter defining the invention, it must define the invention. Adding an effect necessarily produced by the configuration does not contribute to novelty or inventive step.

(Excerpt from the judgment)

Since a person skilled in the art could easily have conceived of providing the cited invention with configurations A through C of the claimed invention, the cited invention would, as a consequence, naturally also be provided with configurations D and F of the claimed invention. … Configuration D specifies an operation realized by having configurations A through C. Because the “device requiring heat dissipation or heat absorption” in configuration C does not specify what members it includes as physical components, whatever components are contained within the cited invention’s “heat pipe 4 having a heat-generating portion” do not affect the identification of common features and differences between the claimed invention and the cited invention concerning configuration C, or the determination of obviousness, and do not affect the determination concerning configuration D either. … Since configuration F does not specify a basis for comparison, “rapidly conducting the generated heat over the shortest distance to the largest heat-dissipating surface” in configuration F is a function possessed by a device having configurations A through C, and is not an operation specified by comparison with some criterion. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92501.pdf

Osaka District Court, 2020 (Wa) No. 4913 [Electric Impact Tightening Tool] <Takemiya>

Original Ameblo publication: 2024-02-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841203377.html

Osaka District Court, 2020 (Wa) No. 4913 [Electric Impact Tightening Tool] <Takemiya>

* Cumulative application of paragraphs (2) and (3) denied: competing products were found not to satisfy the claim elements.

“Looking at the competing products … none is found to employ an outer-rotor electric motor … the plaintiff cannot be said to have lost an opportunity to grant a license … with respect to the rebutted portion.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92070.pdf

[Claim 1] … An electric impact tightening tool characterized in that the electric motor … is an outer-rotor electric motor.

(Excerpt from the judgment)

The portion for which the presumption is rebutted on the ground of the existence of competing products in the market is based on the probability that, even if the infringing products had not been sold, competing products other than those of the infringer and the patentee would have been sold. For the portion for which the presumption is rebutted because of the probability of competing products being sold, the plaintiff patentee does not stand in a relationship of granting a license to the defendant; therefore, it cannot be found that the plaintiff could have granted a license to the defendant. Moreover, looking at the competing products in this case, although all have performance and the like similar to the effects of the corrected invention, none is found to employ an outer-rotor electric motor, and they are found to have mechanisms different from the configuration of the corrected invention. From this standpoint as well, the plaintiff cannot be said to have lost an opportunity to grant a license with respect to that rebutted portion. … In this case, paragraph (3) of Article 102 of the Patent Act cannot be applied to the portion for which the presumption under paragraph (2) of that Article is rebutted.

IP High Court, 2005 (Gyo-Ke) No. 10223 [Acidic Oil-in-Water Emulsified Seasoning] <Sato>

Original Ameblo publication: 2024-02-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841203804.html

2005 (Gyo-Ke) No. 10223 [Acidic Oil-in-Water Emulsified Seasoning] <Sato>

* A case recognizing inventive step in view of an unpredictable synergistic effect

"Using them together … compared with using one of them … produces a synergistic effect … of making oil-phase separation less likely. … Also taking into account that a person skilled in the art could not predict the synergistic effect …" the invention was not obvious.

(Excerpt from the judgment)

Invention 1 is found to produce the effect of making oil-phase separation less likely when subjected to heat treatment in the form of baking or frying, by using phospholipase A-treated egg yolk together with octenyl succinate starch, as compared with using either phospholipase A-treated egg yolk or octenyl succinate starch alone. According to (c) above, it can be inferred that when only one of phospholipase A-treated egg yolk and octenyl succinate starch is used, oil-phase separation occurs and shape retention is lost upon baking even if its content is increased. Accordingly, the above effect of Invention 1 should be recognized as a synergistic effect arising from the combined use of phospholipase A-treated egg yolk and octenyl succinate starch. …

… Also taking into account that the synergistic effect could not be predicted by a person skilled in the art from the disclosures of Publications 1 and 2, it cannot be said that a person skilled in the art could easily have conceived of incorporating octenyl succinate starch in accordance with the teaching of Publication 2, instead of the starch, dextrin or gums that Publication 1 states may be incorporated into the cited invention as necessary. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-32956.pdf

[Korea] Supreme Court Judgment of December 30, 2021, 2017 Hu 1304

Original Ameblo publication: 2024-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841843999.html

[Korea] Supreme Court Judgment of December 30, 2021, 2017 Hu 1304

Where the manufacturing method disclosed in an earlier paper “necessarily” results in the configuration of the patented invention, inherent disclosure is recognized and novelty is denied.

“Probability” is insufficient.

Materials dating after the filing date may be used as evidence to ascertain inherent properties.

https://www.jetro.go.jp/ext_images/world/asia/kr/ip/pdf/han_2022.pdf

[United States] <Federal District Court> Sonos v. Google LLC (N.D. Cal. 2023)

Original Ameblo publication: 2024-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841844322.html

[United States] <Federal District Court> Sonos v. Google LLC (N.D. Cal. Oct. 6, 2023)

Sonos claimed, in a continuation application, an invention that read on Google's products

⇒ The jury awarded $32.5 million

However, the judge held the patent unenforceable, finding it unfair to amend claims after seeing a competing product. (The lengthy period during which the application had been pending also had a major influence.)

⇒ Google restored the functionality

★ If this judgment is upheld by the CAFC, it will likely fundamentally overturn patent divisional-application strategies.

★ The thinking is akin to the Chinese Supreme People's Court's restrictions on the timing of divisional applications.

★ According to a comment I received after posting, Brazil apparently follows the same practice as China.

https://patentlyo.com/patent/2024/02/redefining-continuation-strategy.html

[2026 editorial update] On August 28, 2025, the Federal Circuit reversed the invalidity judgments for lack of written description and the findings of unenforceability for prosecution laches concerning U.S. Patent Nos. 10,469,966 and 10,848,885. It affirmed the obviousness-based invalidity judgment concerning the asserted claims of U.S. Patent No. 10,779,033. The statement above beginning "If this judgment is upheld" reflects the perspective at the time of the 2024 post, not the later appellate outcome.

IP High Court, 2022 (Gyo-Ke) No. 10109 [Anti-Glare Film] <Miyasaka>

Original Ameblo publication: 2024-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841844520.html

2022 (Gyo-Ke) No. 10109 [Anti-Glare Film] <Miyasaka>

1. Clarity requirement satisfied

There is no particular difficulty in taking several photographs to determine the F-number that produces the highest contrast.

Even if the size of the photographic subject varies individually, using the apparatus described in the specification and adjusting it according to the described method naturally determines the shooting distance for each subject.

2. Support requirement satisfied

“By varying the haze value, the clarity of a transmitted image can also be adjusted. … To improve anti-glare performance while suppressing sparkle, it is sufficient not only to reduce the surface irregularities of the anti-glare layer … but also to increase the slope of the irregularities … to make them steeper and increase their number ([0078]).”

3. Enablement requirement satisfied

In response to the defendant’s argument, the court held that “the shape of the irregular structure formed by condensation of fine particles is understood to be similar to the shape of the above droplet-phase structure resulting from the progress of aggregation in spinodal decomposition; therefore, reference can be made to the irregular structure of the first embodiment.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92560.pdf

[Article / Foreign] Antibody Patents in Europe (Chizai Kanri, Vol. 73, No. 6, 2023, Naho Fujimoto)

Original Ameblo publication: 2024-02-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12841968141.html

[Article / Foreign] Antibody Patents in Europe (Chizai Kanri, Vol. 73, No. 6, 2023, Naho Fujimoto)

Inventive step in Europe: effects are important

The question is whether it is credible that the effect is obtained over the full scope.

⇒ If the effect is not recognized, the problem becomes “providing an alternative,” and the invention is regarded as obvious.

Even structural claims face difficulty establishing inventive step merely because their sequences differ.

Amgen’s invention was also found to lack inventive step.

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2306

Patent Attorneys Association Members' Website ★ Patent Committee Reports: Essential Information for Modern Patent Practice!!

Original Ameblo publication: 2024-02-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842108769.html

Patent Attorneys Association Members' Website ★ Patent Committee Reports: Essential Information for Modern Patent Practice!!

① Disclaimer claims and inventive step: research on "trial decisions"

⇒ The same as court decisions

② Indirect infringement: reassessing systems and methods that do not produce a product!!

The most recent 10 years

Success rate under items (i) and (iv): 83% (30 cases)

* However, some cases were captured under items (ii) and (v)

Success rate under items (ii) and (v): 47% (9 cases)

* Few cases reject the "indispensability requirement"!!

令和３年（行ケ）第10150号＜東海林＞ =令和３年（行ケ）第10151号＜東海林＞	船舶 ＊「除くクレーム」で本件発明の作用効果が変わらない。 ⇒新たな技術的事項の導入に当たらない ⇒訂正要件○ ⇒進歩性も○!!	…「浸水防止部屋」は、タンクの機能を備えることが 許容されるから、「浸水防止部屋」には、タンクの機能を兼ねるものと、タンクの機能を兼ねないものがあるものと認められる。本件明細書等には、浸水防止部屋としてタンクの機能を兼ねるもののみが記載されていると解すべき理由はないから、本件明細書等には、タンクの機能を兼ねる「浸水防止部屋」とともに、タンクの機能を兼ねない「浸水防止部屋」が記載されていると認められる。そして、タンクの機能を兼ねる「浸水防止部屋」を備える発明と、タンクの機能を兼ねない「浸水防止部屋」を備える発明は、いずれも本件明細書等に記載された発明であったから、…特許請求の範囲の請求項１の「浸水防止部屋」がタンクの機能を兼ねない「浸水防止部屋（ただし、タンクを除く。）」に訂正されて、タンクの機能を兼ねる「浸水防止部屋」を備える発明が除かれても、新たな技術的事項を導入しないことは明らかである。なお、本件訂正により、本件訂正後の発明が、側壁における隔壁の近傍が損傷を受けても、浸水防止部屋が浸水するだけで、複数の部屋に跨って浸水することはなく、船損傷時における複数の部屋への浸水を防止することができると共に、複数の部屋の大型化を抑制して設計の自由度を拡大することができるという本件発明の効果を奏することなく、新たな効果を奏する発明となると解すべき理由はない。そのため、本件訂正によって発明の作用効果が変わることによって新たな技術的事項が導入されたと解する余地もない。	勝有★
令和４年（行ケ）第10030号＜菅野＞	ポリエステル樹脂組成物の積層体 ＊「除くクレーム」は発明の課題に影響が及ばなければ、新たな技術的事項の導入に当たらない。 ⇒訂正要件○（訂正後の進歩性判断せず）	…被告は、本件訂正事項２のような「除くクレーム」とする訂正は、第三者に明細書等の記載に関して誤解を与える可能性があり、不測の不利益を及ぼす蓋然性が高いものというべきである旨主張する。しかし、被告主張のような懸念が仮にあったとしても、それは、訂正後の請求項につき、明確性要件やサポート要件等の適合性を巡って検討されるべき問題というべきであるから、いずれにしても、本件事案において、この点をもって直ちに訂正を認めない理由とすることは相当でない。… …訂正…によって「該積層体上に無機酸化物の蒸着膜が設けられ、その蒸着膜上にガスバリア性塗布膜が設けられてなるもの」を除外することにより、新たな技術的事項が導入されるわけではなく、新規事項が追加されるものではない。本件発明の課題は、バイオマスエチレングリコールを用いたカーボンニュートラルなポリエステルを含む樹脂組成物からなる層を有する積層体を提供することであって、従来の化石燃料から得られる原料から製造された積層体と機械的特性等の物性面で遜色ないポリエステル樹脂フィルムの積層体を提供すること（【０００８】）であるが、上記除外によってこの技術的課題に何らかの影響が及ぶものではない。	勝有○
令和４年（行ケ）第10125号＜清水響＞	２，３－ジクロロ－１，１，１－トリフルオロプロパン，２－クロロ－１，１，１－トリフルオロプロペン，２－クロロ－１，１，１，２－テトラフルオロプロパンまたは２，３，３，３－テトラフルオロプロペンを含む組成物 ＊先行技術と同一である部分のみを除くことは訂正要件ではない。 ＊進歩性欠如の先行技術と実質的に同一と評価される蓋然性がある部分を除いたと認定した。⇒影響あり?	…特許請求の範囲を訂正するときは、…先願発明と同一である部分のみを除外することや、当該特許出願前に公知であった先行技術と同一である部分のみを除外することは要件とされていない。そして、訂正が、「明細書、特許請求の範囲又は図面に記載した事項の範囲内において」行われた場合、すなわち、当初技術的事項との関係において、新たな技術的事項を導入しないものであるときは、当該訂正によって第三者に不測の損害をおよぼすとは考え難いから、同項に規定する訂正要件の解釈として、被告が主張するような要件を加重することは相当ではないというべきである。 また、被告は、除くクレームの形式で自由に訂正発明の内容を規定することは許されない旨主張しているところ、本件訂正は…甲４による新規性欠如及び進歩性欠如の無効理由がある旨の審決の予告を受けてされた訂正であるが、…甲４には…「ＨＣＦＣ－２２５ｃｂを含むハロカーボン混合物から…ヒドロフルオロカーボンを直接的に調製する有利な方法に関する。…この方法は相当量の該ＨＣＦＣ－２２５ｃｂを他の化合物へ転化することなく行われる。」（【００１２】）、「本発明による好ましい混合物とは、化合物ＨＣＦＣ－２２５ｃｂを含む混合物である。他の好ましい態様において、混合物は本質的に約１～約９９重量パーセントのＨＣＦＣ－２２５ｃｂ…とから成る」（【００１５】）との記載があり、同各記載を踏まえると、本件訂正は、甲４に記載された発明と実質的に同一であると評価される蓋然性がある部分を除外しようとするものといえるから、本件訂正は先行技術である甲４に記載された発明とは無関係に、自由に訂正発明の内容を規定するものとはいえない。	勝有△

English translation of the case table

2021 (Gyo-Ke) Nos. 10150 and 10151 <Shoji>. Ship. The operation and effects of the invention do not change through a disclaimer. ⇒ No introduction of new technical matter. ⇒ Correction requirements satisfied. ⇒ Inventive step also affirmed!! Outcome: wins ★.

…An "anti-flooding compartment" is permitted to have a tank function; therefore, "anti-flooding compartments" are understood to include those that also have a tank function and those that do not. There is no reason to understand the specification and other documents as describing only those anti-flooding compartments that also

have a tank function. The specification and other documents are therefore found to describe both anti-flooding compartments that also have a tank function and anti-flooding compartments that do not. Thus, an invention having an anti-flooding compartment that also has a tank function and an invention having one that does not are both inventions described in the specification and other documents. …Even if the anti-flooding compartment in claim 1 is amended to read "an anti-flooding compartment that does not also have a tank function (excluding a tank)" and inventions having an anti-flooding compartment that also has a tank function are excluded, it is clear that no new technical matter is introduced. Moreover, there is no reason to understand the corrected invention as a different invention producing a new effect instead of the effects of the invention in question: even if an adjacent partition wall is damaged, only the anti-flooding compartment is flooded, without flooding across multiple compartments; flooding of multiple compartments when the ship is damaged can be prevented; and an increase in the size of multiple compartments can be restrained, increasing freedom of design. Accordingly, there is no room to understand the correction as introducing new technical matter through a change in the operation or effects of the invention.

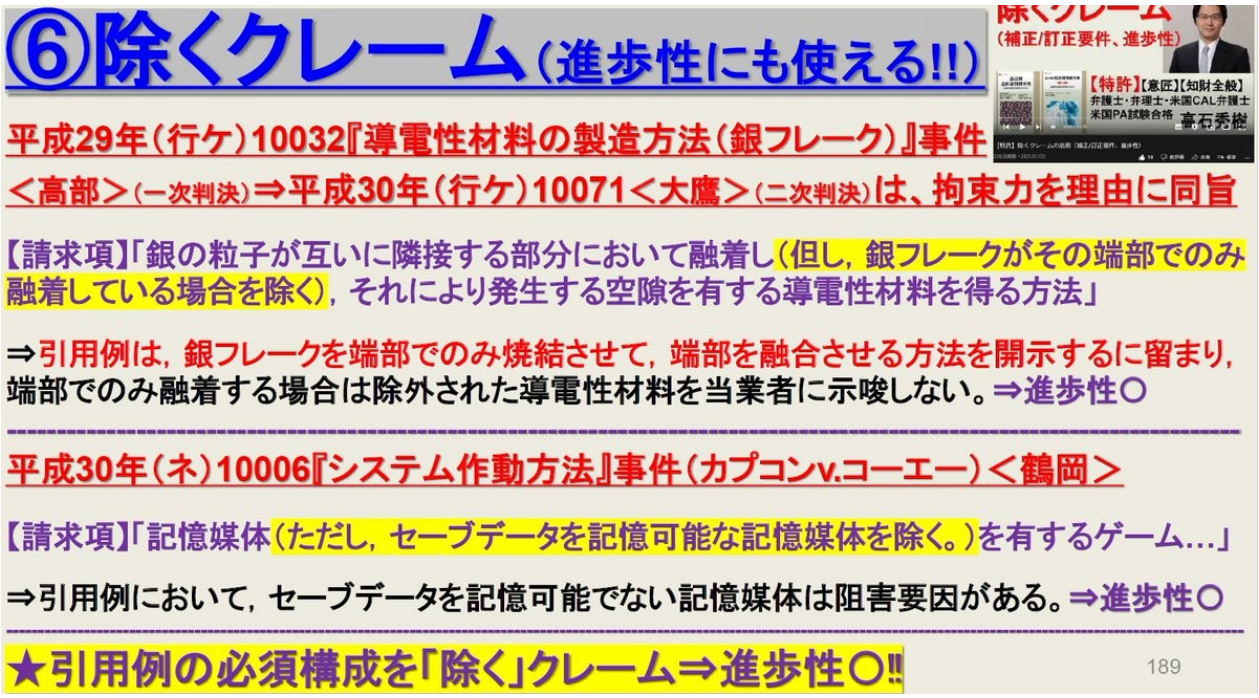
2022 (Gyo-Ke) No. 10030 <Kanno>. Laminate of a polyester resin composition. Unless a disclaimer affects the problem addressed by the invention, it does not introduce new technical matter. ⇒ Correction requirements satisfied (the inventive step of the corrected invention is also affirmed). Outcome: wins ○.

…The defendant argues that a correction employing a disclaimer, such as correction item 2, should be recognized only where there is a high likelihood of causing third parties to misunderstand the description in the specification and other documents or of causing unexpected disadvantage. However, even assuming a concept of the kind asserted by the defendant, it is a matter to be considered through the clarity and support requirements for the corrected claims. In any event, it cannot be a reason for refusing the correction in this case merely on that ground. …By excluding through the correction "a laminate in which an inorganic-oxide deposited film is provided on the laminate and a gas-barrier coating film is provided on that deposited film," new technical matter is not introduced; nor is any new matter added. The problem of the invention is to provide a laminate having a layer made of a resin composition containing a polyester having a furandicarboxylic acid component as a main acid component, in which the mechanical properties and other physical properties of the laminate manufactured from raw materials obtainable from later biomass raw materials are suitable for a polyester resin film laminate, compared with a laminate manufactured from raw materials obtainable from conventional fossil raw materials ([0008]). The foregoing exclusion has no influence on this technical problem.

2022 (Gyo-Ke) No. 10125 <Shimizu>. Composition comprising 2,3-dichloro-1,1,1-trifluoropropane; 2-chloro-1,1,1-trifluoropropene; 2-chloro-1,1,1,2-tetrafluoropropane; or 2,3,3,3-tetrafluoropropene. Exclusion only of a portion identical to the prior art is not a correction requirement. A portion having a high likelihood of being evaluated as substantially identical to the prior art relied on for lack of inventive step was excluded. ← Influence? Outcome: wins ★.

…Correction of the claims … is not subject to a requirement that only a portion identical to the prior invention, or only a portion identical to prior art publicly known before the patent application, be excluded. Furthermore, where a correction is made within the matters described in the specification, claims, or drawings, so long as it introduces no new technical matter in relation to the technical matters in question, it is difficult to consider that the correction causes unexpected disadvantage to third parties. It is therefore inappropriate to impose additional requirements of the kind asserted by the defendant as an interpretation of the correction requirements prescribed by that provision. …The defendant also argues that it is impermissible to specify the content of the corrected invention freely in the form of a disclaimer. However, the correction was made following a preliminary trial decision finding grounds of invalidity for lack of novelty and inventive step based on Exhibit Ko 4. …Exhibit Ko 4 states … "a method useful for preparing heptafluoropropane directly from a chlorofluorocarbon mixture containing HCFC-225cb. …This method is performed without converting a considerable amount of HCFC-225cb into other compounds." ([0012]), and "a preferred mixture according to the invention is a mixture containing the compound HCFC-225cb. In another preferred embodiment, the mixture consists essentially of about 1 to about 99 weight percent HCFC-225cb…" ([0015]). In light of those statements, the correction seeks to exclude a portion having a high likelihood of being evaluated as substantially identical to the invention described

in Exhibit Ko 4. The correction is therefore not an attempt to specify freely the content of the corrected invention without relation to the invention described in Exhibit Ko 4 as prior art.



English translation of slide 189

6. Disclaimers (usable for inventive step as well!!)

2017 (Gyo-Ke) No. 10032, [Method of Manufacturing an Electrically Conductive Material (Silver Flakes)] <Takabe> (first judgment) ⇒ 2018 (Gyo-Ke) No. 10071 <Otaka> (second judgment) reached the same result on the ground of the binding effect.

[Claim] “A method of obtaining an electrically conductive material having voids produced by silver particles being fused at portions adjacent to each other (excluding the case in which the silver flakes are fused only at their end portions).”

⇒ The cited reference merely discloses a method of sintering silver flakes only at their end portions and fusing the end portions; it does not suggest to a person skilled in the art an electrically conductive material from which cases of fusion only at the end portions are excluded. ⇒ Inventive step affirmed.

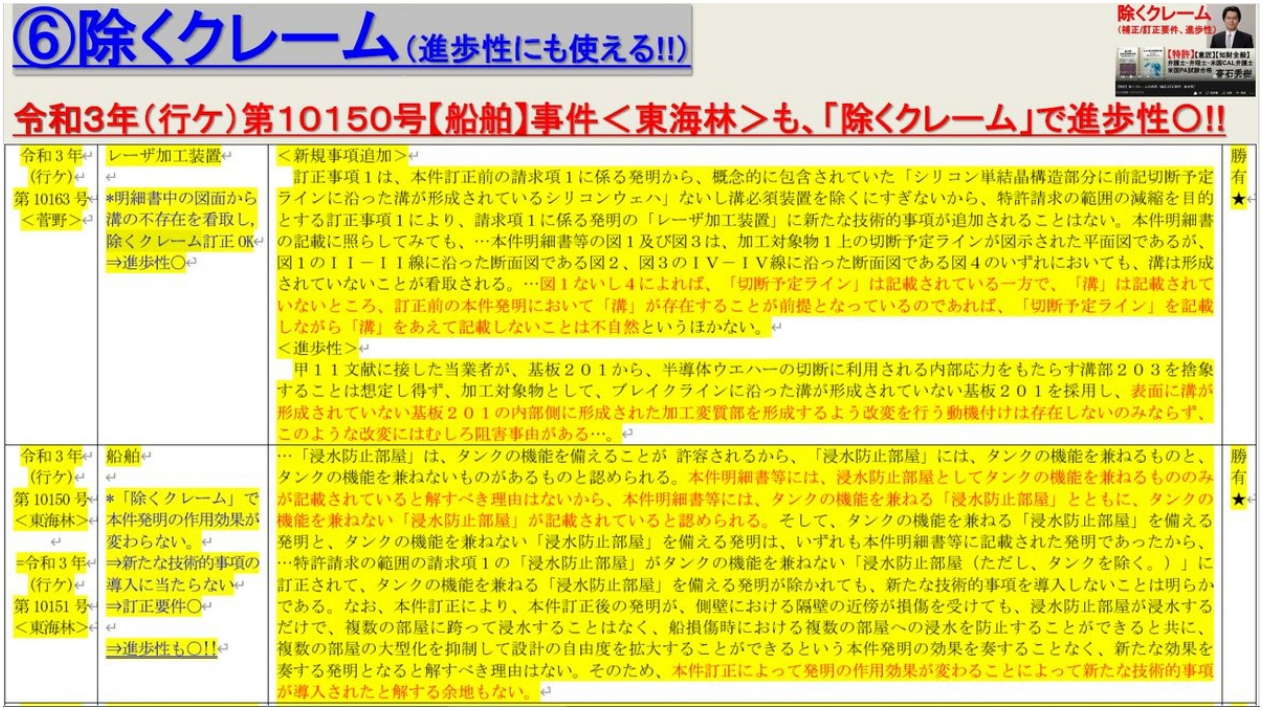
2018 (Ne) No. 10006, [System Operation Method] (Capcom v. Koei) <Tsuruoka>.

[Claim] “A game having a storage medium (excluding a storage medium capable of storing save data)…”

⇒ In the cited reference, there is a factor discouraging a storage medium incapable of storing save data. ⇒ Inventive step affirmed.

★ A disclaimer excluding an essential configuration of the cited reference ⇒ Inventive step affirmed!!

Inset: Disclaimers (amendment/correction requirements; inventive step). Patents [Designs] [Intellectual property generally]. Attorney-at-law, Patent Attorney; former CAFC law clerk; former USPTO examination training participant. Hideki Takaishi.



English translation of the additional disclaimer slide

6. Disclaimers (usable for inventive step as well!!)

2021 (Gyo-Ke) No. 10150, [Ship] <Shoji>, also: inventive step affirmed through a disclaimer!!

2021 (Gyo-Ke) No. 10163 <Shimizu>. Laser Processing Apparatus. Absence of a groove is read from the drawings in the specification, and correction by disclaimer is accepted. ⇒ Inventive step affirmed. Outcome: wins ★.

<Addition of new matter> Correction item 1 merely excludes from the invention of claim 1 before correction, to reduce the scope of the claim, a silicon wafer having grooves formed along scheduled cutting lines in a silicon single-crystal structure portion, or an apparatus requiring grooves, which had conceptually been included. The correction therefore introduces no new technical matter into the “laser processing apparatus” of claim 1. In light of the description in the specification and other documents, … Figures 1 and 3 are plan views showing scheduled cutting lines on workpiece 1. In Figure 2, a sectional view taken along line II–II in Figure 1, and Figure 4, a sectional view taken along line IV–IV in Figure 3, the absence of a groove can be read. …According to Figures 1 through 4, “scheduled cutting lines” are described, while “grooves” are not. If the existence of “grooves” had been assumed in the invention before correction, it would be rather unnatural to describe “scheduled cutting lines” without also describing “grooves.”

<Inventive step> A person skilled in the art encountering Exhibit Ko 11 could not conceive of removing groove portion 203, which relieves internal stress used to cut a semiconductor wafer, from substrate 201. There is not only no motivation to adopt, as the workpiece, a substrate 201 without a groove along the break line and modify it to form a modified processing layer inside substrate 201 whose surface has no groove, but also a clear factor discouraging such a modification.

2021 (Gyo-Ke) Nos. 10150 and 10151 <Shoji>. Ship. The operation and effects of the invention do not change through a disclaimer. ⇒ No introduction of new technical matter. ⇒ Correction requirements satisfied. ⇒ Inventive step also affirmed!! Outcome: wins ★.

…An “anti-flooding compartment” is permitted to have a tank function; therefore, “anti-flooding compartments” are understood to include those that also have a tank function and those that do not. There is no reason to understand the specification and other documents as describing only those anti-flooding compartments that also have a tank function. The specification and other documents are therefore found to describe both anti-flooding compartments that also have a tank function and anti-flooding compartments that do not. Thus, an invention having an anti-flooding compartment that also has a tank function and an invention having one that does not are

both inventions described in the specification and other documents. …Even if the anti-flooding compartment in claim 1 is amended to read “an anti-flooding compartment that does not also have a tank function (excluding a tank)” and inventions having an anti-flooding compartment that also has a tank function are excluded, it is clear that no new technical matter is introduced. Moreover, there is no reason to understand the corrected invention as a different invention producing a new effect instead of the effects of the invention in question: even if an adjacent partition wall is damaged, only the anti-flooding compartment is flooded, without flooding across multiple compartments; flooding of multiple compartments when the ship is damaged can be prevented; and an increase in the size of multiple compartments can be restrained, increasing freedom of design. Accordingly, there is no room to understand the correction as introducing new technical matter through a change in the operation or effects of the invention.

Inset: Disclaimers (amendment/correction requirements; inventive step). Patents [Designs] [Intellectual property generally]. Attorney-at-law, Patent Attorney; former CAFC law clerk; former USPTO examination training participant. Hideki Takaishi.

(Editor's transcription and correction of the figure above)

⑥ Disclaimer claims (also useful in the inventive-step analysis)

2021 (Gyo-Ke) No. 10150, “Vessel” (Presiding Judge Shoji), also upheld inventive step for a claim containing a disclaimer.

Case	Summary and translated excerpts
2021 (Gyo-Ke) No. 10111 Laser Processing Apparatus Presiding Judge Kanno Favorable ★	The drawings disclosed the absence of grooves, supporting correction by a disclaimer. Inventive step was also upheld. [Addition of new matter — translation of excerpts] “Correction 1 merely excludes a ‘silicon wafer having grooves along the planned cutting lines in the silicon single-crystal structure portion,’ or an apparatus requiring grooves, that was conceptually encompassed by the invention of Claim 1 before correction. Consequently, Correction 1, which restricts the scope of the claims, adds no new technical matter to the ‘laser processing apparatus’ of Claim 1. … Figures 1 and 3 in the specification and other documents are plan views showing planned cutting lines on workpiece 1. Both Figure 2, a cross section along line II–II in Figure 1, and Figure 4, a cross section along line IV–IV in Figure 3, show that no grooves are present. … Figures 1–4 depict ‘planned cutting lines’ but do not depict ‘grooves.’ If the invention before correction had presupposed the existence of grooves, it would be unnatural deliberately to omit grooves while depicting the planned cutting lines.” [Inventive step — translation of excerpt] “It is inconceivable that a person skilled in the art encountering Document Ko 11 would disregard groove portions 203 in substrate 201, which create the internal stress used to cut the semiconductor wafer. There is not only no motivation to make a modification in which substrate 201 without grooves along the break line is adopted as the workpiece and a processing-altered portion is formed inside that substrate, whose surface has no grooves; rather, there is an inhibiting factor against such a modification….”
2021 (Gyo-Ke) Nos. 10150 and 10151 Vessel Presiding Judge Shoji Favorable ★	The disclaimer did not change the invention’s operation or effects or introduce new technical matter. The correction requirements were satisfied and inventive step was upheld. [New matter and effects — translation of excerpts from No. 10151] “…Because a ‘flood-prevention room’ is permitted to have a tank function, such rooms are found to include both those that also function as tanks and those that do not. There is no reason to interpret the specification and other documents as describing only flood-prevention rooms that also function as tanks. Accordingly, the specification and other documents are found to describe both ‘flood-prevention rooms’ that also function as tanks and ‘flood-prevention rooms’ that do not. Both an invention having a ‘flood-prevention room’ that also functions as a tank and an invention having a ‘flood-prevention room’ that does not were disclosed in the specification and other documents. Therefore, even if Correction 1 amends the ‘flood-prevention room’ in Claim 1 to a ‘flood-prevention room (excluding tanks)’ that does not also function as a tank, thereby excluding the invention having a ‘flood-prevention room’ that also functions as a tank, it is clear that no new technical matter is introduced. Moreover, there is no reason to interpret the correction as resulting in an invention that

Case	Summary and translated excerpts
	achieves a new effect without achieving the effects of the invention in this case: even if the sidewall near a bulkhead is damaged, only the flood-prevention room is flooded and flooding does not extend across multiple rooms, thereby preventing flooding of multiple rooms when the vessel is damaged, while also increasing freedom of design by limiting the enlargement of multiple rooms. Consequently, there is no basis for interpreting the correction as introducing new technical matter through a change in the invention’s operation or effects.”

IP High Court, 2022 (Ne) No. 10008 [Information Provision Device] <Otaka>

Original Ameblo publication: 2024-02-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842238055.html

2022 (Ne) No. 10008 [Information Provision Device] <Otaka>

* A “patentee’s correction-based rejoinder to an invalidity defense” was asserted in the appeal after the conclusion of written preparatory proceedings. ⇒ Dismissed as untimely

Given the chronology in which the original judgment finding a lack of novelty followed a trial decision maintaining the patent, a correction-based rejoinder to an invalidity defense should have been asserted in the alternative for claim 1 or 5.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91603.pdf

IP High Court, 2022 (Ne) No. 10078 [Display Device Supportable with One Hand] <Kanno>

Original Ameblo publication: 2024-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842365112.html

2022 (Ne) No. 10078 [Display Device Supportable with One Hand] <Kanno>

* In the court below, the patentee asserted correction-based rejoinders to invalidity defenses based on the second and third corrections.

⇒ It asserted a correction-based rejoinder to an invalidity defense based on the fourth correction "in the statement of reasons for appeal," but the court stated that, in light of the course of proceedings, it should ordinarily be dismissed as untimely.

(However, the court ruled on it because a rebuttal had been submitted.)

(Excerpt from the judgment)

Examining the course of proceedings in the court below, in response to the invalidity defense asserting that the patent lacked novelty and inventive step (Defendant's First Preparatory Brief), raised at the first preparatory-proceedings date (November 18, 2019), the appellant submitted Plaintiff's Second Preparatory Brief concerning a rejoinder based on the second correction by the third preparatory-proceedings date (July 27, 2020). In conjunction with the request for correction in the patent invalidation trial, it then submitted Plaintiff's Fifth Preparatory Brief dated March 3, 2021, and Plaintiff's Sixth Preparatory Brief dated May 27 of that year, setting out a rejoinder based on the third correction. (These briefs, including correction documents, were presented at the fourth preparatory-proceedings date (December 16, 2021).) The original judgment held that neither the rejoinder based on the second correction nor that based on the third correction satisfied the correction requirements and that the patent should be invalidated in a patent invalidation trial. The appellant then added an assertion of a rejoinder based on the fourth correction in its statement of reasons for appeal. In view of this course of proceedings in the court below, the fourth correction constitutes an untimely submitted means of attack or defense, and the appellant was grossly negligent in submitting it late, so dismissal would ordinarily be unavoidable. However, the appellee has submitted rebuttal arguments concerning the rejoinder based on the fourth correction, including that the fourth correction does not satisfy the correction requirements. To this extent, it cannot be said that this would delay the conclusion of the litigation, so the court will examine it below.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91824.pdf

Related case: Intellectual Property High Court, 2021 (Gyo-Ke) No. 10037, [Display Device Capable of Being Supported with One Hand]
Judgment date: February 2, 2022
The following is an excerpt from the court's reasoning on the admissibility of the correction in that action seeking revocation of a trial decision.

… It is clear that the intermediate left-right open-position fixing means in configuration e, which "fixes" two display panels "with a stopper" at any angle within a range of approximately 120 degrees to approximately 170 degrees, is a means for "temporary fixation," whereas the arbitrary-angle holding means in configuration C, which "holds" the two display panels "by frictional force," is a means for "semi-fixation." It can naturally be understood that these are separate means employing different fixing means. … There is no basis for narrowly interpreting "an arbitrary angle" in relation to the arbitrary-angle holding means as meaning an angle within the range of approximately 120 degrees to approximately 170 degrees

…; in accordance with its ordinary meaning, it should be understood to include the range from 0 degrees to 360 degrees. … Such a configuration is not described in the specification before correction. …

IP High Court, 2021 (Ne) No. 10094 [… Work Gloves] <Kanno>

Original Ameblo publication: 2024-02-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842496801.html

2021 (Ne) No. 10094 [… Work Gloves] <Kanno>

* In the court below, the patentee asserted a “correction-based rejoinder to an invalidity defense” after the court disclosed its provisional view that the patent was invalid; it was dismissed as untimely.

⇒ “In the statement of reasons for appeal,” it asserted the “correction-based rejoinder to an invalidity defense” dismissed below, but it was again dismissed as untimely.

Cf. The exact opposite of 2016 (Ne) No. 10100 <Takabe>!!

★ There is still no judgment dismissing as untimely a “new” argument raised on appeal “in the statement of reasons for appeal”!!

(Excerpt from the judgment)

In its statement of reasons for appeal, the appellant asserted that it would correct the invention (a correction-based rejoinder to an invalidity defense), but this court dismissed that argument as an untimely means of attack or defense. The reason is that, according to the case record, this rejoinder based on correction was raised after the court below disclosed its provisional view that the patent was invalid and was therefore dismissed below as an untimely means of attack or defense. No circumstances can be found that prevented its being raised at an appropriate time in the court below. Accordingly, the above argument in this appeal is clearly untimely, the appellant was at least grossly negligent in this respect, and permitting this means of attack or defense would clearly delay the conclusion of this litigation considerably.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91303.pdf

IP High Court, 2023 (Gyo-Ke) No. 10046 [Liquid Cleansing Agent for Removing Keratin Plugs] <Miyasaka>

Original Ameblo publication: 2024-03-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842951645.html

2023 (Gyo-Ke) No. 10046 [Liquid Cleansing Agent for Removing Keratin Plugs] <Miyasaka>

* Disclaimer claim concerning a numerical range ⇒ No inventive step

"The limitation 'excluding those having 0 to 10 vol%' in the disclaimer configuration … means nothing other than … the range 'greater than 10 vol%' …"

⇒ No inventive step

* This interpretation differs from 2022 (Gyo-Ke) No. 10125 <Hibiku Shimizu>!!

* The infringement action, 2022 (Ne) No. 10029 <Otaka> = first instance, Tokyo District Court, 2020 (Wa) No. 22071 <Kokubu>, found a violation of the support requirement.

https://www.youtube.com/watch?v=hMHc8iJvPTQ&t=1s

[Trademark] Composite Word Marks (Components Cannot Be Considered Separately ⇒ Similar in Two Cases; Dissimilar Even Assuming Separate Consideration in One Case)

Original Ameblo publication: 2024-03-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12842951821.html

[Trademark] Composite Word Marks

★ Components cannot be considered separately ⇒ Similar in two cases

2010 (Gyo-Ke) No. 10332 <Nakano>

“天下米” (Tenka Mai) v. “天下” (Tenka)

2010 (Gyo-Ke) No. 10215 <Iimura>

“ハーブヨーグルトン” (Herb Yogurton) v. “ヨーグルトン” (Yogurton)

★ Even assuming separate consideration of the component ⇒ Dissimilar in one case

2011 (Gyo-Ke) No. 10135 <Iimura>

“スーパー / みらべる” (Super / Miraberu) v. “MIRABELL / ミラベル” (MIRABELL / Miraberu)

https://www.jpaa.or.jp/old/activity/publication/patent/patent-library/patent-lib/201605/jpaapatent201605_080-093.pdf

[Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) No. 33583 <Kokubu> “Resin Delivery Box” case

Original Ameblo publication: 2024-03-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843032720.html

[Unfair Competition Prevention Act / Trade Secrets] Tokyo District Court, 2018 (Wa) No. 33583 <Kokubu>

“Resin Delivery Box” case

Although no password was set, a confidentiality agreement had been concluded between the plaintiff and defendant, and a defendant employee who received other data without a confidentiality marking acted on the premise that it was confidential (requesting permission to disclose it to another company).

⇒ Secrecy-management requirement satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91398.pdf

[Article] Operational Guidelines Clarified for the “NHK-Fintiv Rule” Governing IPR Institution (Yoshinari Kishimoto …)

Original Ameblo publication: 2024-03-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843162379.html

[Article] Operational Guidelines Clarified for the “NHK-Fintiv Rule” Governing IPR Institution (Yoshinari Kishimoto, Chizai Kanri, Vol. 73, No. 12, 2023)

The PTAB can exercise discretion to deny institution when the trial date is near.

The Supreme Court did not decide whether this was appropriate (denying certiorari).

Discretionary denials have been declining since peaking in the first half of 2021.

Review is instituted where the likelihood of invalidity is very high.

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2312

[Article] Consideration of Whether Experimental Results Certificates May Be Taken into Account against Grounds for Revocation Based on Disclosure-Requirement Violations (Chizai Kanri, Vol. 73, No. 12, 2023)

Original Ameblo publication: 2024-03-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843296777.html

[Article] Consideration of Whether Experimental Results Certificates May Be Taken into Account against Grounds for Revocation Based on Disclosure-Requirement Violations (Chizai Kanri, Vol. 73, No. 12, 2023)

Number of opposition cases in which experimental results certificates submitted by the patentee were taken into account

Article 29: 51/62 (82%)

Article 36: 56/63 (89%)

All seven Article 36 cases in which they were not taken into account resulted in revocation decisions

Insufficient because the claims were too broad: four cases; insufficient experimental conditions: three cases

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2312

[Article] A Study of Overlapping Protection by Design Rights and Trademark Rights (Eri Murakami, Tokyo Zokei University Research Bulletin 24)

Original Ameblo publication: 2024-03-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843431805.html

[Article] A Study of Overlapping Protection by Design Rights and Trademark Rights (Eri Murakami, Tokyo Zokei University Research Bulletin 24)

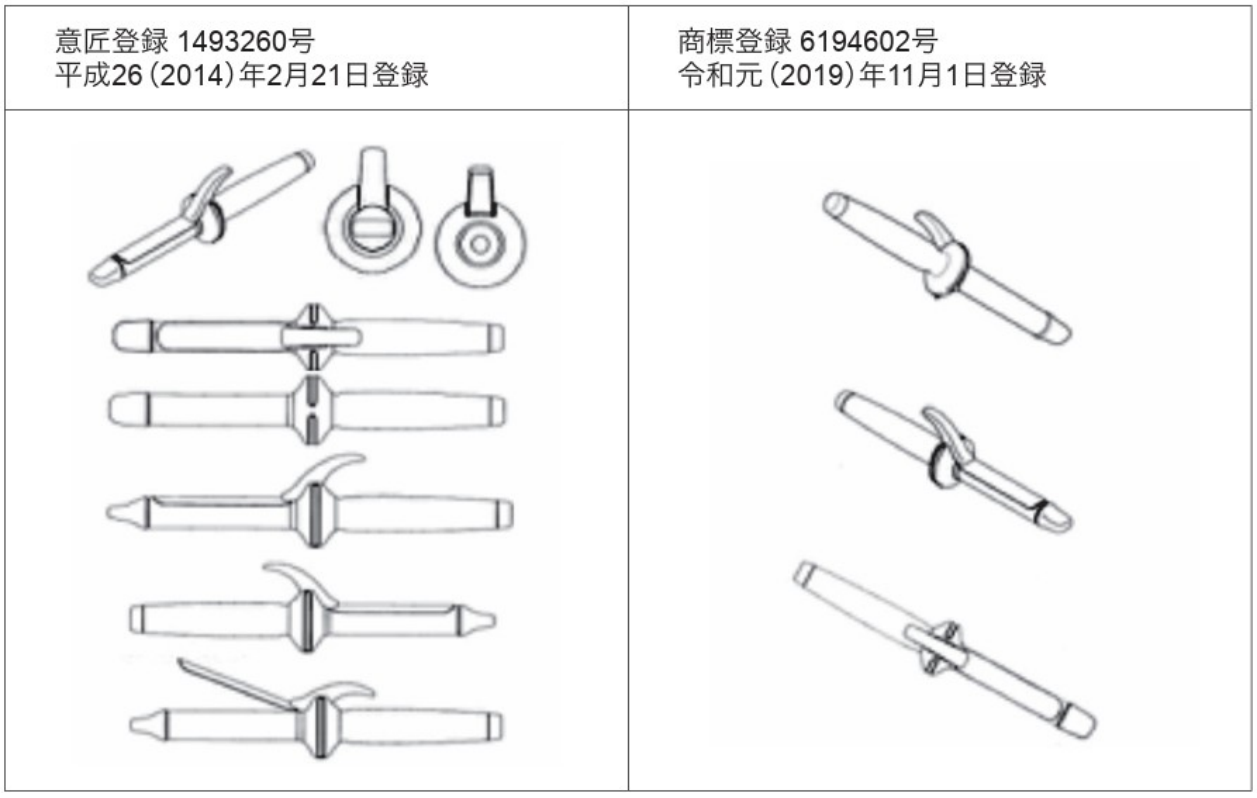
＊ Examples in which design and trademark rights were obtained at around the same time

① Hair iron (three-dimensional trademark)

② Woven fabric (two-dimensional pattern)

⇒ Obtain a design registration designating woven fabric as the article, and pursue infringement claims against the manufacture, importation, etc. of the fabric used as a raw material.

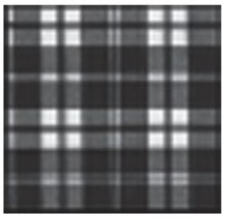
google.co.jp/url?sa=t&rct=j&q&esrc=s&source=web&cd&ved=2ahUKEwjxiNv59uCEAxXzZ_UHHadyCtoQFnoECBAQAQ&url=https%3A%2F%2Fzokei.repo.nii.ac.jp%2Frecord%2F137%2Ffiles%2F24-06murakami.pdf&usg=AOvVaw0LCM1-M2uJXFMKfYJB5cZ7&opi=89978449&fbclid=IwAR0KXIs17Iv1A0MLnlCHYZx-vEtY9jtUm8h3hwCq-xK2ThFlkCSKaljDnG4



English translation of the registration captions

Left: Design Registration No. 1493260. Registered on February 21, 2014 (2014).

Right: Trademark Registration No. 6194602. Registered on November 1, 2019 (2019).

	意匠登録 1235826号 平成17（2005）年2月25日登録 ＊登録商標に色彩あり	商標登録 4954194号 平成18（2006）年5月19日登録 ＊登録商標に色彩あり
II		

English translation of the registration captions (II)

Left: Design Registration No. 1235826. Registered on February 25, 2005 (2005). *The registered trademark is in color.

Right: Trademark Registration No. 4954194. Registered on May 19, 2006 (2006). *The registered trademark is in color.

[Article] Use Inventions in China (Chizai Kanri, Vol. 73, No. 12, 2023, Ding Wenyun / Wang Weidong)

Original Ameblo publication: 2024-03-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843551531.html

[Article] Use Inventions in China (Chizai Kanri, Vol. 73, No. 12, 2023, Ding Wenyun / Wang Weidong)

Use inventions in China are expressed as “use of …” or “application of …”

A limitation “for …” does not contribute to novelty if it merely describes an intended use or manner of use.

For example, a “hook for a crane” and a “hook for fishing” have different structures, so novelty is recognized.

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2312

[Article] Recent U.S. Appeal Decisions Concerning 35 U.S.C. § 112 in Patent Applications by Japanese Companies (2023)

Original Ameblo publication: 2024-03-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843742562.html

[Article] Recent U.S. Appeal Decisions Concerning 35 U.S.C. § 112 in Patent Applications by Japanese Companies (Patent, Vol. 76, No. 4, 2023, Shintaro Yamada)

Rejections by USPTO examiners ⇒ Reversed on appeal <Most recent five years>

Written-description requirement: 22/59

Enablement requirement: 12/23

Definiteness requirement: 15/54

⇒ Dependence on the particle-size measurement method does not immediately make a claim indefinite.

https://jpaa-patent.info/patent/viewPdf/4171

[Article] Extraterritorial Application of U.S. Patent Law (Patent 2023, Vol. 76, No. 13, Aya Tatsuno (龍野 文))

Original Ameblo publication: 2024-03-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843841664.html

[Article] Extraterritorial Application of U.S. Patent Law (Patent 2023, Vol. 76, No. 13, Aya Tatsuno (龍野文))

Delivery of products outside the United States

Pricing + contract negotiations in the United States: § 271(a) liability denied (Halo decision)

Activities in the United States can also lead to § 271(a) liability (Caltech decision)

Section 271(f) does not apply to method patents

Section 271(f)(2) concerns only acts within the United States

https://jpaa-patent.info/patent/viewPdf/4328

[Article] Invention Disclosure Forms for Improving Patent Specification Quality (Katsuyuki Ishibashi, Chizai Kanri, Vol. 73, 2023)

Original Ameblo publication: 2024-03-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12843940032.html

[Article] Invention Disclosure Forms for Improving Patent Specification Quality (Katsuyuki Ishibashi, Chizai Kanri, Vol. 73, No. 7, 2023)

Provide material (text and specific examples / data) concerning the principle for solving the problem in the invention disclosure form. Provide modifications as well, regardless of whether the company plans to adopt them.

⇒ A patent firm cannot create material out of nothing!!

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2307

<Damages> Whether Patent Act Article 102(2) and (3) May Be Applied Cumulatively

Original Ameblo publication: 2024-03-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844070008.html

<Damages> Whether Patent Act Article 102(2) and (3) May Be Applied Cumulatively

Portion exceeding working capacity: Yes, 2020 (Ne) No. 10024

Non-identity of markets: Yes, 2020 (Ne) No. 10024

Existence of competing products: No, Osaka District Court, 2020 (Wa) No. 4913 (Yes in JPO materials)

Infringer’s sales efforts: Yes, 2018 (Ne) No. 10034

Performance of infringing products: No, Osaka District Court, 2020 (Wa) No. 4913; 2018 (Ne) No. 10034

Patented invention worked only in part of the infringing product: No, 2020 (Ne) No. 10024

https://www.takaishihideki.com/_files/ugd/324a18_7c43370f2fed4ec5809c5d5f8933212e.pdf

[U.S. Patents] Caltech v. Broadcom, 25 F.4th 976 (2022)

Original Ameblo publication: 2024-03-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844196643.html

[U.S. Patents] Caltech v. Broadcom, 25 F.4th 976 (Fed. Cir. 2022)

Much of the sales activity took place within the United States: even if delivery occurs abroad, the transaction can constitute a domestic sale.

Halo v. Pulse, 831 F.3d 1369 (Fed. Cir. 2016), does not categorically hold that design wins arising from a sales cycle cannot constitute domestic transactions.

https://www.aoyamapat.gr.jp/news/3207

[U.S. Patents] 2003 CAFC (340 F.3d 1367) Bayer v. Housey

Original Ameblo publication: 2024-03-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844326330.html

[U.S. Patents] 2003 CAFC (340 F.3d 1367) Bayer v. Housey

Products under 35 U.S.C. § 271(g) are limited to “physical goods.”

⇒ It does not extend to importing into the United States “information” obtained by using a screening method (a method that does not produce a product).

* This can be considered in parallel with Japanese patents for manufacturing methods.

https://www.youtube.com/watch?v=0Inc-wqmOe8

[U.S. Patents] Centillion v. Qwest 631 F.3d 1279 (Fed. Cir. 2011)

Original Ameblo publication: 2024-03-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844450335.html

[U.S. Patents] Centillion v. Qwest 631 F.3d 1279 (Fed. Cir. 2011)

* “Making” a system under § 271(a) requires combining all the claim elements, but the court held that the user, not Qwest, did so.

This differs from the IP High Court Grand Panel judgment, 2022 (Ne) No. 10046.

It is the same as the first-instance judgment, Tokyo District Court, 2019 (Wa) No. 25152 <Presiding Judge Kokubu>.

⇒ This U.S. CAFC decision is also 13 years old, so a different conclusion might be reached today, with the advancement of the networked society.

https://patent-law.hatenablog.com/entry/2022/10/02/151755

[United States] No Standing Where an IPR Petitioner Appealing a PTAB Decision Has No Injury in Fact

Original Ameblo publication: 2024-03-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844630544.html

[United States] Introduction to a CAFC Decision Dismissing an Appeal for Lack of Standing Where an IPR Petitioner Appealing a Patent Trial and Appeal Board (PTAB) Decision in Inter Partes Review (IPR) to the CAFC Had No Injury in Fact

IPR brought by a petitioner developing a product

⇒ PTAB upheld some of the claims

⇒ CAFC dismissed the appeal because there was no injury in fact

Would the same apply to a PAE?

https://www.jpaa.or.jp/cms/wp-content/uploads/2019/08/JTEKTvGKN_final20190808.pdf

[United States] Section 103 Nonobviousness Requirement; Consideration of New Arguments in an IPR Petitioner’s Reply Brief Improper

Original Ameblo publication: 2024-03-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844827439.html

[United States] Introduction to a CAFC Decision Clarifying the Nonobviousness Requirement of Section 103 and Holding It Improper to Consider New Arguments in an IPR Petitioner’s Reply Brief and Other Submissions

Both “motivation to combine references” and a “reasonable expectation of success” must be proved!!

New arguments in a Reply Brief will not do!!

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/Biosystems-v.-Illumina.pdf

[United States] U.S. Supreme Court Decision on Issue Preclusion (B&B Hardware v. Hargis Ind)

Original Ameblo publication: 2024-03-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844834285.html

[United States] U.S. Supreme Court Decision of March 24, 2015, on Issue Preclusion (B&B Hardware v. Hargis Ind)

Provided the general requirements of issue preclusion are satisfied, a TTAB decision has issue-preclusive effect where the trademark usages considered by the TTAB are materially the same as those at issue in court.

However, cases satisfying the general requirements of issue preclusion are limited.

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/2_S.C.BB20150714.pdf

[United States] Standard of Review for Claim Construction on Appeal: Supreme Court and Remand Decision, Teva v. Sandoz 2015

Original Ameblo publication: 2024-03-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12844963381.html

[United States] Supreme Court and CAFC Remand Decisions Concerning the Standard of Review for Claim Construction on Appeal: Teva v. Sandoz (2015)

On remand, the CAFC examined the issue under the standard in Nautilus, 134 S. Ct. 2120 (2014), considering the prosecution history as to whether a person skilled in the art would consider it reasonably certain that “molecular weight” in the claims referred to Mp.

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/7_TEVAv.Sandoz.pdf

[Copyright] “TRIPP TRAPP” Case: Standard for Copyrightability, Tokyo District Court, 2021 (Wa) No. 31529

Original Ameblo publication: 2024-03-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845120352.html

[Copyright] “TRIPP TRAPP” Case: Standard for Copyrightability

Tokyo District Court, 2021 (Wa) No. 31529 <Nakashima>

“Where, separately from the function associated with its practical purpose, it possesses creativity such that it is independently an object of artistic appreciation in itself”

⇒ No infringement (neither reproduction nor adaptation), without examining copyrightability

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92439.pdf

IP High Court, 2014 (Ne) No. 10063 <Misao Shimizu>

“Whether the creator’s individuality is expressed”

⇒ Copyrightability recognized; no infringement (“The appellee’s products cannot be said to be similar to the portions of the appellant’s products for which copyrightability is recognized.”)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85044.pdf

原告製品目録

製品名：　　ＴＲＩＰＰ　ＴＲＡＰＰ

（日本語表記：トリップトラップ）

カラー：　　ナチュラル、ブラック、ホワイト、ホワイトウォッシュ、ウォールナットブラウン、ウォームレッド、ストームグレー、ヘイジーグレー、モスグリーン、ソフトミント、セレーヌピンク、サンフラワーイエロー

形態：　　下図のとおり。



被告製品目録

1　被告製品１

製品名：　　Ｃｈｏｉｃｅ　Ｋｉｄｓ

カラー：　　ナチュラル、ウォールナット、アイボリー、ホワイト、レッド

形態：　　下図のとおり。



[United States] Ironburg v. Valve (CAFC, April 3, 2023)

Original Ameblo publication: 2024-03-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845216529.html

[United States] Ironburg v. Valve (CAFC, April 3, 2023)

For IPR estoppel—which, after a final written decision in an IPR, bars assertion in court or the ITC of invalidity grounds raised or reasonably available in that IPR—the test is whether a skilled searcher exercising reasonable diligence could reasonably have been expected to discover the grounds. The patent owner asserting estoppel bears the burden of proof.

+ Invalidity grounds on which review was not instituted became subject to IPR estoppel.

⇒ Invalidity arguments based on grounds included in the petition but not instituted were barred. For grounds not included in the petition and discovered later, however, the estoppel ruling was vacated and remanded because the district court had incorrectly placed the burden of proof on the patent challenger.

[Cases & Trends] Latest U.S. CAFC Decision: Standard and Burden of Proof in Applying IPR Estoppel | NGB Corporation

IP High Court, 2023 (Gyo-Ko) No. 10001 <Miyasaka> = First Instance, Tokyo District Court, 2022 (Gyo-U) No. 382 <Sugiura>

Original Ameblo publication: 2024-03-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845343834.html

IP High Court, 2023 (Gyo-Ko) No. 10001 <Miyasaka> = First Instance, Tokyo District Court, 2022 (Gyo-U) No. 382 <Sugiura>

＊A divisional application was filed within 30 days from service of the certified copy of the decision to grant a patent (Patent Act Article 44(1)(ii)), but the patent fees had been paid and the patent registered before the divisional application was filed.

⇒The disposition dismissing the divisional application because the filer was no longer a “patent applicant” was held lawful.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92405.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) No. 10030 <Hibiku Shimizu>

Original Ameblo publication: 2024-03-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845531025.html

[Trademark] 2023 (Gyo-Ke) No. 10030 <Hibiku Shimizu>

“Kuruntto Maegami Curler” (“Curling Bangs Curler”): no distinctiveness (trial decision rescinded)

When used in relation to hair, including bangs, the word “kurunto” is ordinarily used to indicate “the state of (hair) being curved into a round shape.” … It indicates “the state of (bangs) being curved into a round shape.” …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92351.pdf

[Trademark] IP High Court, 2021 (Gyo-Ke) No. 10100 <Otaka> “Scrum Master”: No Distinctiveness (Trial Decision Rescinded)

Original Ameblo publication: 2024-03-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845627399.html

[Trademark] 2021 (Gyo-Ke) No. 10100 <Otaka> “Scrum Master”: No Distinctiveness (Trial Decision Rescinded)

(Excerpt from the judgment)

… The extent of actual use or whether it is well known is not at issue. … It also gives rise to concepts such as a person who has learned “Scrum,” one of the methods of agile software development, or a person proficient in “Scrum.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91256.pdf

IP High Court, 2017 (Ne) No. 10043 [Electronic Program Guide with Digital Storage] <Mori> ⇛ No Indirect Infringement

Original Ameblo publication: 2024-03-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12845724255.html

2017 (Ne) No. 10043 [Electronic Program Guide with Digital Storage] <Mori>

⇒ No indirect infringement

* “Indispensability” requirement not satisfied

“The distinctive technical means not found in the prior art lies in the interactive television program guide system incorporating … a digital storage device. … The accused products … do not incorporate one. …”

(Excerpt from the judgment)

The invention is intended to provide an interactive television program guide system with a digital storage device in order to offer users advanced functions unavailable with a stand-alone analog storage device. The distinctive technical means not found in the prior art should be understood to lie in the interactive television program guide system having, that is, incorporating, a digital storage device. Accordingly, because the accused products do not incorporate a digital storage device, they cannot be said to be “indispensable for solving the problem” by means of the invention.

* “Article used for production” requirement not satisfied

“… Recording becomes possible only by connecting an external USB hard disk… to the accused products, so there is no room to incorporate digital storage into the accused products. …”

(Excerpt from the judgment)

The accused liquid-crystal television products merely receive broadcasts and none itself has a memory portion (digital storage) capable of recording. Recording destinations are external USB hard disks or Toshiba recorders compatible with REGZA Link; only by connecting these to the accused products can programs received by the accused products be recorded onto the above hard disks or the like. Accordingly, there is no room to incorporate digital storage into the accused products. Thus the accused products cannot be called “articles used for production” of an interactive television guide system having user television equipment that includes a digital storage device.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87430.pdf

Tokyo District Court, 2016 (Wa) No. 37954 [Electronic Program Guide with Digital Storage] <Okinaka>

Original Ameblo publication: 2024-03-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846010046.html

Tokyo District Court, 2016 (Wa) No. 37954 [Electronic Program Guide with Digital Storage] <Okinaka>

Estoppel in interpretation of the wording!

= Tokyo District Court, 2012 (Wa) No. 16103 <Hasegawa>

To argue inventive step, the applicant asserted a temporal sequence in which, unlike the cited reference, “a program is stored before program data is stored.”

[Claim 1] (Element D) A system comprising means for digitally storing a plurality of program data in the digital storage device (31), using the interactive television program guide, in response to the digital storage of the plurality of programs, each of the plurality of program data being associated with one of the plurality of programs, and … .

(Excerpt from the judgment)

United, the applicant for the patent, argued to the JPO during prosecution that, in the invention, unlike the invention described in “Cited Reference 3” …, “a program is stored before program data is stored,” for the purpose of showing that the invention differed from the invention in that reference and possessed inventive step. The JPO is understood to have granted the patent on the basis that the invention differed from the invention in “Cited Reference 3” and was not obvious from it, taking United’s above arguments into account as well. Accordingly, the temporal sequence between storage of programs and storage of program data in Element D of the invention should be interpreted, in accordance with United’s above argument, as “a program is stored before program data is stored.” The plaintiff, which succeeded to the position of the patent applicant, is not permitted to make an argument in this litigation inconsistent with the above argument of the patent applicant, as doing so would violate the principle of estoppel. … Since the accused products are not found to have the temporal sequence in which “a program is stored (recorded) before program data is stored,” they do not satisfy Element D.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86498.pdf

Tokyo District Court, 2020 (Wa) No. 27972 [Lighting Device] <Shibata>

Original Ameblo publication: 2024-03-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846102586.html

Tokyo District Court, 2020 (Wa) No. 27972 [Lighting Device] <Shibata>

* The extent of each lens portion cannot be identified

⇒ Claim elements not satisfied

(Excerpt from the judgment)

According to the claims and specification, the diffusion lens of each invention has multiple lens portions, each with an identifiable position and shape, and it is possible to ascertain, for each lens portion, the radius of curvature in the direction in which the LEDs are arranged side by side and the radius of curvature in the direction perpendicular to that direction.

The claims and specification also establish that each invention has the technical significance of producing the effects described in 1(2) above for an invention having such lens portions in a diffusion lens. … Given the shapes of the LSDs used in the accused products, the extent of each “lens portion” referred to in “multiple lens portions” and “each lens portion” … of the inventions cannot be identified in any accused product. Thus the accused products cannot be said to have “each lens portion” as referred to in the inventions, and the radius of curvature in the direction in which the LEDs are arranged side by side and that in the perpendicular direction cannot be ascertained for each lens portion. Nor can the accused products be said to satisfy the configurations … concerning the radii of curvature of the inventions.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91871.pdf

IP High Court, 2021 (Gyo-Ke) No. 10082 [Electrically Insulated Cable] <Shoji>

Original Ameblo publication: 2024-03-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846335663.html

2021 (Gyo-Ke) No. 10082 [Electrically Insulated Cable] <Shoji>

* Although the problem is common, the cited invention has already solved it by other means.

⇒ No motivation to further combine a secondary reference

= 2007 (Gyo-Ke) No. 10238

= 2012 (Gyo-Ke) No. 10328

= 2016 (Gyo-Ke) No. 10103

= 2017 (Gyo-Ke) No. 10013

"In the cited invention … the problem common to the claimed invention has already been solved by means different from those of the claimed invention … there is no need … to wrap both wire cores with a tape member, thereby placing the tape member between both wire cores and the sheath. …"

(Excerpt from the judgment)

The claimed invention concerns the ease of removing a coating layer to expose a core wire. Conventional cables with powder applied to the outer peripheral surface of the core material had the problem that the powder scattered into the surroundings when the core material was removed, reducing workability. The invention has technical significance in seeking to solve this problem by providing, between the core wire and coating layer, a tape member arranged in a state wrapped around the core wire, thereby allowing the core wire and coating layer to be separated easily by removing the tape member. On the other hand, … one of the problems addressed by the cited invention is facilitating removal of the wire cores, and in that respect it shares a problem with the claimed invention. However, it seeks to solve that problem by a configuration in which only the outer peripheries of the power-supply and signal wire cores are covered with a sheath, so its means for solving the problem differ from those of the claimed invention. In this way, the cited invention has already solved the problem common to the claimed invention by different means. It must therefore be said that there is no need, in addition to those problem-solving means, to wrap both wire cores with a tape member, thereby placing the tape member between the wire cores and the sheath. If such a configuration were added to the cited invention, removing the wire cores would require not merely removing the sheath but also removing the tape member, which would instead impair workability and detract from the effects of the cited invention. Moreover, Publication Ko 1 contains no statement suggesting any technical significance in wrapping both wire cores with a tape member even at the expense of the effects of the cited invention.

★ On this issue,

Cases favorable to patentees include:

• 2016 (Gyo-Ke) No. 10103 <Takabe>, Wire Gripper

• 2017 (Gyo-Ke) No. 10013 <Takabe>, Method for Producing Dried Noodles

• 2021 (Gyo-Ke) No. 10082 <Shoji>, Electrically Insulated Cable

• 2022 (Gyo-Ke) No. 10003 <Kanno>, Method for Preventing Adhesion of Marine Organisms

Cases unfavorable to patentees include:

• 2010 (Gyo-Ke) No. 10328 <Takizawa>, Safety Shield Assembly

* Combining multiple means for similar purposes and providing them redundantly was held obvious

• 2015 (Gyo-Ke) No. 10114 <Takabe>, Tire

* A person skilled in the art would also try other solutions in order to solve the primary reference’s problem completely

• 2016 (Gyo-Ke) No. 10039 <Shimizu>, Medical Multi-Chamber Container

* Even if a secondary reference solves the cited invention’s problem, the motivation to solve it by another method is not lost

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91207.pdf

Osaka District Court, 2021 (Wa) No. 10032 [Chip-Type Fuse] <Takemiya>

Original Ameblo publication: 2024-04-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846653463.html

Osaka District Court, 2021 (Wa) No. 10032 [Chip-Type Fuse] <Takemiya>

* The case became a battle of experiments, and identical function and effect were not established.

⇒ Second requirement of the doctrine of equivalents not satisfied

The experiments did not themselves compare the respective functions and effects of the accused product's "sealed space" and the invention's "arc-extinguishing material portion" …; their results contradicted the defendant's … test report … .

* The court also stated the general proposition that equivalence can be established even when part of a claim element is missing. (★ In Tokyo District Court, 2012 (Wa) No. 31523 <Hasegawa>, equivalence was found for Product A, which lacked part of a claim element!!)

(Excerpt from the judgment)

The plaintiff submits as evidence experimental reports, etc. … to show that the "sealed space 26 formed by bonding with adhesive" in configuration c of the accused product has the same function and effect (arc extinguishing) as the "arc-extinguishing material portion" in Element C of the invention. These reports compare the duration of arc discharges in products having the same structure as the accused product when the fuse-element portion has a sealed structure, when it has an unsealed structure, or when a terminal-integrated fuse element is removed and mounted on a board for interruption testing. The results indicate that the duration in the sealed structure was one-half to one-third that in the unsealed structure or the like. However, these experiments do not themselves compare the respective functions and effects of the accused product's "sealed space" and the invention's "arc-extinguishing material portion." In addition, according to the test report … submitted as evidence by the defendant, the durations of arc discharges were recorded for the accused product, a fuse comprising the accused product with an arc-extinguishing material portion added, and the fuse element of the accused product alone, and the accused product had the longest duration. With respect to the respective arc-discharge durations of the accused product and the fuse element, these results contradict the experimental reports … submitted by the plaintiff. Accordingly, the above evidence submitted by the plaintiff and other circumstances do not sufficiently establish that configuration c of the accused product has the same function and effect as Element C of the invention. At least the second requirement therefore cannot be said to be satisfied.

Even where the product or other subject matter lacks part of a claim element of the patented invention, infringement under the doctrine of equivalents is understood to be possible if that part is not an essential part of the patented invention and the other requirements for equivalence described above are met. In response, the defendant argues that applying the doctrine of equivalents where part of a claim element is missing impermissibly asserts an enlargement of the claims. However, there is no reasonable basis for distinguishing a case in which part of a claim element is replaced with another configuration from one in which part of a claim element is missing. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92171.pdf

IP High Court, 2023 (Ne) No. 10041 [Training Equipment] <Hibiku Shimizu>

Original Ameblo publication: 2024-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846760261.html

2023 (Ne) No. 10041 [Training Equipment] <Hibiku Shimizu>

The court rejected the identification of the bar alone, extracted from the apparatus described in Exhibit Ko 7, as an independent cited invention, and also denied that removal of the weight-supporting portion would have been obvious.

"… Bar 10 alone … cannot be identified as an independent cited invention; the cited invention … includes not only bar 10 but also the weight-supporting portion … in determining inventive step … the question is whether removing the weight-supporting portion would have been obvious."

(Excerpt from the judgment)

… In this case, bar 10 alone (the Ko 7 invention) cannot be identified as an independent cited invention. Rather, it is appropriate to identify the Ko 7 invention (defendant), which comprises not only bar 10 but also the weight-supporting portion, as the cited invention. Therefore, in determining the inventive step of the inventions using the invention described in Publication Ko 7 as the cited invention …, the question is whether it would have been obvious to remove the weight-supporting portion from that Ko 7 invention (defendant). Bar 10 in the Ko 7 invention (defendant) is one of the members constituting that invention and is inseparable from the weight-supporting portion. Thus bar 10 alone cannot be regarded as the ring-shaped apparatus asserted by the plaintiff. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92504.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) No. 10067 <Honda> 5252byO!Oi

Original Ameblo publication: 2024-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12846874803.html

[Trademark] 2023 (Gyo-Ke) No. 10067 <Honda>

Mark at issue: 5252byO!Oi

⇒ O!Oi is the dominant portion

Cited mark: OIOI (Marui)

“The dominant portion, which is reasonably similar in pronunciation and mutually confusable in appearance … when used for the designated goods of the mark at issue, the possibility that traders and consumers will mistake the source of the two cannot be denied …”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92567.pdf

登録商標：

5252byO!Oi

引　用　商　標　目　録

１　登録第１３１８６０３号商標（甲１５。以下「引用商標１」という。）

商標の構成：

OIOI

登録出願日：昭和４８年１１月１４日

設定登録日：昭和５３年１月１０日

書換登録日：平成２０年６月２５日

[Trademark] Tokyo District Court, 2021 (Wa) No. 22287 <Sugiura> “Birkin, Kelly” Trademarks

Original Ameblo publication: 2024-04-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847333484.html

[Trademark] Tokyo District Court, 2021 (Wa) No. 22287 <Sugiura>

“Birkin, Kelly” trademarks

“In light of the fact that some of Plaintiff’s Product 1 sold in the secondhand market are priced considerably lower than new products … and the absence of sufficient evidence to establish that purchasers in ordinary transactions invariably check for an engraved mark or a zippered pocket before purchasing …, the possibility of confusion as to the source of Defendant’s Product 1 cannot be ruled out.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91965.pdf

[Trademark] Tokyo District Court, 2021 (Wa) No. 13895 <Nakashima>

Original Ameblo publication: 2024-04-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847333789.html

[Trademark] Tokyo District Court, 2021 (Wa) No. 13895 <Nakashima>

No violation of Trademark Act Article 4(1)(i)

“Although the mark at issue and the Swiss national flag have in common a broad cross inside them, they are found to differ in that the Swiss national flag is square, has no white outer border, and is bright red apart from the internal cross.”

⇒ Dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92147.pdf

1　控訴人標章１



2　控訴人標章２



1　控訴人標章１



2　控訴人標章２



登録商標



[Trademark] Tokyo District Court, 2022 (Wa) No. 19876 <Sugiura> “Gendai no Riron” case

Original Ameblo publication: 2024-04-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847333913.html

[Trademark] Tokyo District Court, 2022 (Wa) No. 19876 <Sugiura> “Gendai no Riron” case

In 2016, when the trademark application was filed, it was widespread practice for the same person to publish magazines and other publications with identical content in paper and electronic editions.

⇒ “Electronic publications” (Class 9) and “printed matter” (Class 16) are similar goods

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92397.pdf

[Trial and Appeal Practitioners Study Group 2023] (Mechanical) “Inventive Step of Numerically Limited Inventions” (The Subgroup in Which Takaishi Participated)

Original Ameblo publication: 2024-04-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847567252.html

[Trial and Appeal Practitioners Study Group 2023] Case 1 (Mechanical) “Inventive Step of Numerically Limited Inventions” (The Subgroup in Which Takaishi Participated)

① Where the technical significance of a numerical limitation (its function and effect as means for solving the problem of the claimed invention) is low, inventive step is likely to be denied (as a design matter, etc.).

② Where the technical significance of a numerical limitation is high, the motivation to apply a numerical limitation from a secondary reference to the primary cited invention becomes an issue.

⇒ To establish inventive step, the most important thing is to state in the specification what functions and effects are produced by setting the numerical range of the limitation as means for solving the problem of the claimed invention.

Case 7 (Mechanical) “Inventive Step of Numerically Limited Inventions”

2021 (Gyo-Ke) No. 10091, “Adhesive Tape” case

The differences concerning the four numerical limitations all have low technical significance.

The specification describes general effects of the numerical limitations, but not their mechanisms, and the preferred numerical ranges are broad.

⇒ Design matters; no inventive step

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

[Trial and Appeal Practitioners Study Group 2023] (Chemistry 1) “New Matter” “Support Requirement for Parameter Inventions in the Food Field”

Original Ameblo publication: 2024-04-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847828499.html

[Trial and Appeal Practitioners Study Group 2023] Case 2 (Chemistry 1)

“New Matter”

Given the present situation in which “disclaimer claims” can be used freely, not only to secure novelty, it is difficult to restrict them on the basis of new matter.

⇒ The support requirement should be used to check whether the invention after the exclusion produces a common effect as a whole and can solve the problem

Cf. 2022 (Gyo-Ke) No. 10125

[Trial and Appeal Practitioners Study Group 2023] Case 8 (Chemistry 1)

“Support Requirement for Parameter Inventions in the Food Field”

2016 (Gyo-Ke) No. 10147, “Tomato-Containing Beverage” case

• Align the experimental conditions

• Mention factors other than the matters defining the invention that influence its problem and effects.

• For sensory evaluation, ensure objectivity by establishing a basis for comparison.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

[Trial and Appeal Practitioners Study Group 2023] (Chemistry 2) “Support Requirement” “Novelty of Use Inventions”

Original Ameblo publication: 2024-04-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12847983100.html

[Trial and Appeal Practitioners Study Group 2023] Case 3 (Chemistry 2) “Support Requirement”

No participant objected to the proposition that the basic approach to the support requirement for numerically limited inventions is the same as for inventions other than numerically limited inventions, and that the standard of the Grand Panel (Polarizing Film) applies.

⇒ If the technical meaning can be understood, limited specific examples are sufficient.

[Trial and Appeal Practitioners Study Group 2023] Case 9 (Chemistry 2) “Novelty of Use Inventions”

2021 (Gyo-Ke) No. 10066

The judgment rejected an “unknown attribute” and a “new use” because a person skilled in the art would recognize that the pathological condition, purpose and effect, and operation did not differ from those of the Ko 1 invention.

Another court decision recognizing patentability of a use invention is difficult to distinguish from the public domain.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

[Trial and Appeal Practitioners Study Group 2023] (Electrical) Inventive Step of Software-Related Inventions

Original Ameblo publication: 2024-04-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12848331171.html

[Trial and Appeal Practitioners Study Group 2023] Case 4 (Electrical)

“Assessment of Inventive Step in Software-Related Inventions, Focusing Particularly on Functionally Expressed Features of Information and Information Processing”

In the software field, warning letters are frequently sent. Even warnings based on abstract claims exert a “deterrent effect,” for example by being flagged in due diligence and causing investment to be abandoned.

[Trial and Appeal Practitioners Study Group 2023] Case 10 (Electrical)

“Treatment of Commercial Practices and the Like in Software-Related Inventions”

2021 (Gyo-Ke) No. 10116

The primary cited invention is in the “gaming” field

⇒ “Commercial practices” in the product-sales and marketing industries cannot be applied without motivation.

⇒ For an invention of a business system, a modification taking cross-industry commercial practices into account is a design matter.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

[Trial and Appeal Practitioners Study Group 2023] (Design) “Articles” “Scope of Knowledge and Materials of a Person Skilled in the Art in Determining Ease of Creation”

Original Ameblo publication: 2024-04-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12848429963.html

[Trial and Appeal Practitioners Study Group 2023] Case 5 (Design) Identification of the “Article to Which a Design Pertains”

In determining similarity of “articles to which designs pertain,” similarity may be recognized broadly where common uses and functions create a possibility of similarity in form.

The “consumer” in Design Act Article 24(2) is the person whose perspective determines the points of attention and weighting of evaluations concerning the form of the design, rather than the article.

[Trial and Appeal Practitioners Study Group 2023] Case 11 (Design) “Scope of Knowledge and Materials of a Person Skilled in the Art in Determining Ease of Creation”

2021 (Gyo-Ke) No. 10158

It is appropriate to premise the analysis on circumstances in which a person skilled in the art of the article to which the design pertains would “naturally encounter” the material

The part of the holding that transferring a motif is easy where the function is identical can vary with individual circumstances.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

[Trial and Appeal Practitioners Study Group 2023] (Trademark) “Trademark Act Article 3(1)(iii): Distinctiveness” “Similarity of Composite Marks”

Original Ameblo publication: 2024-04-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12848686359.html

[Trial and Appeal Practitioners Study Group 2023] Case 6 (Trademark) “Trademark Act Article 3(1)(iii): Distinctiveness”

If a mark is generally recognized as describing the quality of services, “including in the future,” it lacks distinctiveness

For example, where the content of goods or services can be imagined from a word or concept used as a particular quality indication in another goods or services field sharing some consumers.

[Trial and Appeal Practitioners Study Group 2023] Case 12 (Trademark) “Similarity of Composite Marks”

Approaches to applying the legal standards of the Supreme Court decisions to individual cases

The general rule is to consider a composite mark as a whole

⇒ There can be various perspectives for determining unity, so it is important to reach a reasoned determination based on a legal standard appropriate to the case

* All the other points merely present opinions of some committee members

https://www.jpo.go.jp/resources/shingikai/kenkyukai/document/sinposei_kentoukai/2023_houkokusyo_youyaku.pdf

IP High Court, 2021 (Gyo-Ke) No. 10033 [Construction Method Using Short Interior Corner Members] <Kanno> Correction of an Error in the Specification Permitted

Original Ameblo publication: 2024-04-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12848944205.html

2021 (Gyo-Ke) No. 10033 [Construction Method Using Short Interior Corner Members] <Kanno>

* Correction of an error in the specification was allowed

Before the correction … the two terms “joining” and “connecting” were used for the same stage, so the correction can be said to unify the terminology and constitutes correction of an error.

(Excerpt from the judgment)

(1) Whether the correction constitutes correction of an error …

Before the correction, “joining” was used in claim 1 and paragraph [0022] of the pre-correction specification for the third step, which is the construction stage, whereas paragraph [0025] of that specification stated, with respect to the construction stage, “at this time, the end faces of the first and second short interior corner members 21-1 and 21-2 are connected without cutting … .” Since the two terms “joining” and “connecting” were used for the same stage, the correction can be said to unify the terminology and constitutes correction of an error. …

(2) Whether the correction constitutes clarification of an ambiguous statement …

Before the correction, the work at the same construction stage was described as “joining” in claim 1 and “connecting” in paragraph [0025] of the pre-correction specification, so the correction constitutes clarification of an ambiguous statement.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90805.pdf

IP High Court, 2022 (Gyo-Ke) No. 10081 [Golf Club Shaft] <Honda>

Original Ameblo publication: 2024-04-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849120132.html

2022 (Gyo-Ke) No. 10081 [Golf Club Shaft] <Honda>

Torque ($1.6 \leq Tq \leq 4.0$)

Ratio of total bias-layer weight to the combined total weight of the bias and straight layers ($0.5 \leq B / (B + S) \leq 0.8$)

Ratio of small-diameter-side bias-layer weight to total bias-layer weight ($0.05 \leq A / B \leq 0.12$)

Ratio of small-diameter-side bias-layer weight to large-diameter-side bias-layer weight ($1.0 \leq A / C \leq 1.8$)

The court examined separately the upper and lower limits of these four numerical ranges (eight boundary values in total), and held that “a person skilled in the art at the filing date could not have recognized that the problem of the invention could be solved…”.

Tq is the torque of the shaft (°); B is the total weight of the bias layers (g); S is the total weight of the straight layers (g); A is the weight of the small-diameter-side bias layer (g); and C is the weight of the large-diameter-side bias layer (g).

⇒ Support requirement not satisfied

(Excerpt from the judgment)

It is appropriate to find that the problem addressed by the inventions is “to provide a golf club shaft made of fiber-reinforced resin with high torsional rigidity (a low-torque fiber-reinforced resin golf club shaft), which has high swing stability and excellent stability in both flight distance and direction regardless of the player’s swing speed or ability” (hereinafter “the problem”). …

The feature of setting the shaft torque at 4.0° or less cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, in light of the common general technical knowledge at that time, that the problem could be solved. …

The feature of setting the shaft torque at 1.6° or more cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, in light of the common general technical knowledge at that time, that the problem could be solved. …

The feature of setting the total weight of the bias layers at 50% or more of the sum of the total weight of the bias layers and the total weight of the straight layers cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, in light of the common general technical knowledge at that time, that the problem could be solved. …

The feature of setting the total weight of the straight layers at 20% or more of the sum of the total weight of the bias layers and the total weight of the straight layers cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, from the detailed description of the invention in the specification, that the problem could be solved. …

The feature of setting the weight of the small-diameter-side bias layer at 180% or less of the weight of the large-diameter-side bias layer cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, from the detailed description of the invention in the specification, that the problem could be solved. …

The feature of setting the weight of the small-diameter-side bias layer at 100% or more of the weight of the large-diameter-side bias layer cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, from the detailed description of the invention in the specification, that the problem could be solved. …

The feature of setting the weight of the small-diameter-side bias layer at 12% or less of the total weight of the bias layers cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, from the detailed description of the invention in the specification, that the problem could be solved. …

The feature of setting the weight of the small-diameter-side bias layer at 5% or more of the total weight of the bias layers cannot be said to fall within a range in which a person skilled in the art at the filing date could recognize, from the detailed description of the invention in the specification, that the problem could be solved.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92205.pdf

IP High Court, 2022 (Gyo-Ke) No. 10112 [Control System for Fee-Charging Automatic Machines] <Honda>

Original Ameblo publication: 2024-04-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849321194.html

2022 (Gyo-Ke) No. 10112 [Control System for Fee-Charging Automatic Machines] <Honda>

"Since the problem can be solved provided that … is possible, individual factors such as the types of input signals and the determination method, which are details of the means for solving the problem …, were encompassed by that configuration in the original specification, etc. …"

⇒ No addition of new matter

(Excerpt from the judgment)

… Like Invention 1 before the amendment, amended Invention 1 can solve the problem provided that a device having an IC card reader/writer unit and a communications unit can "output information indicating whether or not [the machine] is operating" to a management server, irrespective of the types of input signals or the specific method for determining "operating" or "not operating." Thus individual factors such as the types of input signals and the determination method, which are details of the "monitor and transmit" and "output information" configurations constituting the means for solving the problem, can be said to have been encompassed by those configurations in the original specification, etc. Even if amended Invention 1 comes to include types of input signals or determination methods not exemplified in the original specification, etc., this does not add a new technical matter to the technical matters derived from the original specification, etc. as a whole.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92460.pdf

IP High Court, 2018 (Gyo-Ke) No. 10100 [Transdermal Absorption Preparation] <Tsuruoka> * Correction of Errors in the Detailed Description Allowed

Original Ameblo publication: 2024-04-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849321437.html

2018 (Gyo-Ke) No. 10100 [Transdermal Absorption Preparation] <Tsuruoka>

* Correction of errors in the detailed description of the invention was allowed. (Slightly more lenient than for claim language?)

There is no evidence sufficient to establish that “hinai” and “hifunai” are medical terms with different concepts … and it is inconceivable that “hinai” was used in the corrected passage to express such a different concept.

(Excerpt from the judgment)

Correction 12 changes “hinai” to “hifunai” in paragraph [0003] of the specification. It is clear from the context that the passage explains, as background art, inserting microneedles, particularly self-dissolving microneedles, into the “skin” (“hifu”). Considering also that all other occurrences in paragraph [0003] use the term “hifu,” it is appropriate to understand “hinai,” the term corrected, as having omitted the character “fu” from “hifu” and as properly having been intended to read “hifunai” (“within the skin”). Accordingly, Correction 12 satisfies the requirements for correction as correction of an error. In response, the plaintiff argues that “hinai” is a medical term expressing a concept different from “hifunai” and that “hinai,” expressing that different concept, was also used in the corrected passage. However, there is no evidence sufficient to establish that “hinai” and “hifunai” are medical terms with different concepts. At least in the corrected passage of paragraph [0003], it is inconceivable that “hinai” was used to express such a different concept, as already explained. Accordingly, the trial decision allowing Correction 12 is appropriate in its conclusion and should be held lawful. …

Correction 16 changes “the surface and dermis of the skin” to “the epidermis and dermis of the skin” in paragraph [0077] of the specification. That passage explains the solubility of the target substance in the skin in relation to surfactants used as absorption enhancers. The invention is, in the first place, a transdermal absorption preparation having a base and a target substance, used by insertion into skin consisting of epidermis and dermis. It is therefore clear that the solubility of the target substance is relevant in “the epidermis and dermis of the skin,” not “the surface and dermis of the skin.” Taking into account also that paragraph [0030], which should be regarded as corresponding to paragraph [0077], uses the term “the epidermis or dermis of the skin” …, it is appropriate to understand “surface,” the term corrected, as having been written in error where “epidermis” should have been written. Accordingly, Correction 16 satisfies the requirements for correction as correction of an error.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88401.pdf

[Article] Prior Use Rights as Seen through Case Law: Focusing on the Burden of Allegation and Proof (Makiko Takabe)

Original Ameblo publication: 2024-04-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849453247.html

[Article] Prior Use Rights as Seen through Case Law: Focusing on the Burden of Allegation and Proof (Makiko Takabe)

2017 (Ne) No. 10090 <Presiding Judge Takabe>

⇒ Some case commentaries say that the prior user must recognize the technical significance of the numerical value (concerning moisture content), but the judgment did not intend to require such recognition and did not so hold.

https://jpaa-patent.info/patent/viewPdf/4366

Osaka District Court, 2017 (Wa) No. 1390 [Lamp] * Prior Use Right Recognized for a Numerically Limited Invention

Original Ameblo publication: 2024-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849582464.html

Osaka District Court, 2017 (Wa) No. 1390 [Lamp] * Prior Use Right Recognized for a Numerically Limited Invention

No change over time.

The 403W invention has y = 15.7 mm and x = 11.7 mm, and thus the configuration y = 1.34x.

⇒ While maintaining its function, it is possible to modify the design to a numerical range satisfying the relationship between x and y specified by the inventions.

https://www.lawlibrary.jp/pdf/z18817009-00-111652435_tkc.pdf

[Article] Product Configuration and Functionality (2023, Professor Masaharu Miyawaki)

Original Ameblo publication: 2024-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849706108.html

[Article] Product Configuration and Functionality (2023, Professor Masaharu Miyawaki)

<United States> Deliberately adopting a particular configuration despite its having no functional advantage is considered a strong circumstance against functionality.

Where there is a patent, status as an indication of goods or business should be denied unless alternatives are available that satisfy the claims while being dissimilar to the plaintiff’s configuration.

https://www.jstage.jst.go.jp/article/patentsp/76/29/76_79/_pdf

[Design] IP High Court, 2023 (Gyo-Ke) No. 10008 (Shoji) * Violation of Joint-Application Requirement (Plaintiff Employee’s Creatorship) Rejected

Original Ameblo publication: 2024-04-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12849832079.html

[Design] 2023 (Gyo-Ke) No. 10008 (Shoji)

* Violation of the joint-application requirement (plaintiff employee’s creatorship) rejected

“To qualify as a creator of a design … one must have actually participated in creating its aesthetic appearance, that is, actually have been involved in the act of creating the aesthetic appearance, particularly in completing the distinctive portions differing from those of previous designs.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92226.pdf

I Have Been Recognized by Best Lawyers in the Field of Patent Law!! April 30, 2024

Original Ameblo publication: 2024-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850338724.html

I have been recognized by Best Lawyers in the field of patent law!!

I am grateful to those who recommended me, and intend to work even harder so as not to disappoint their expectations.

2024.4.30

https://www.bestlawyers.com/search?q=hideki+takaishi&sort=relevancy

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Practice Areas

Patent Law

[Unfair Competition Prevention Act] Major Cases, 2018–2020 <METI> * An Excellent Overview Table!!

Original Ameblo publication: 2024-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850338898.html

[Unfair Competition Prevention Act] Major Cases, 2018–2020 <METI> * An Excellent Overview Table!!

Acts causing confusion through well-known indications (civil)

Misappropriation of famous indications (civil)

Provision of products imitating another product’s configuration (civil)

Trade secret infringement (civil) (criminal)

Provision of devices circumventing technological restriction measures (civil)

Misleading representations (criminal)

Acts injuring business reputation (civil)

Bribery of foreign public officials (criminal)

https://www.meti.go.jp/shingikai/sankoshin/chiteki_zaisan/fusei_kyoso/pdf/011_s03_00.pdf

[Unfair Competition Prevention Act] Tokyo District Court, 2022 (Wa) No. 4104 <Nakashima> Does Not Qualify as an “Indication of Goods or Business”!

Original Ameblo publication: 2024-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850339290.html

[Unfair Competition Prevention Act] Tokyo District Court, 2022 (Wa) No. 4104 <Nakashima>

Gas valves sold exclusively for more than 20 years

In the circumstances of this case, transactions do not focus on their shape.

⇒ Does not qualify as an “indication of goods or business”!

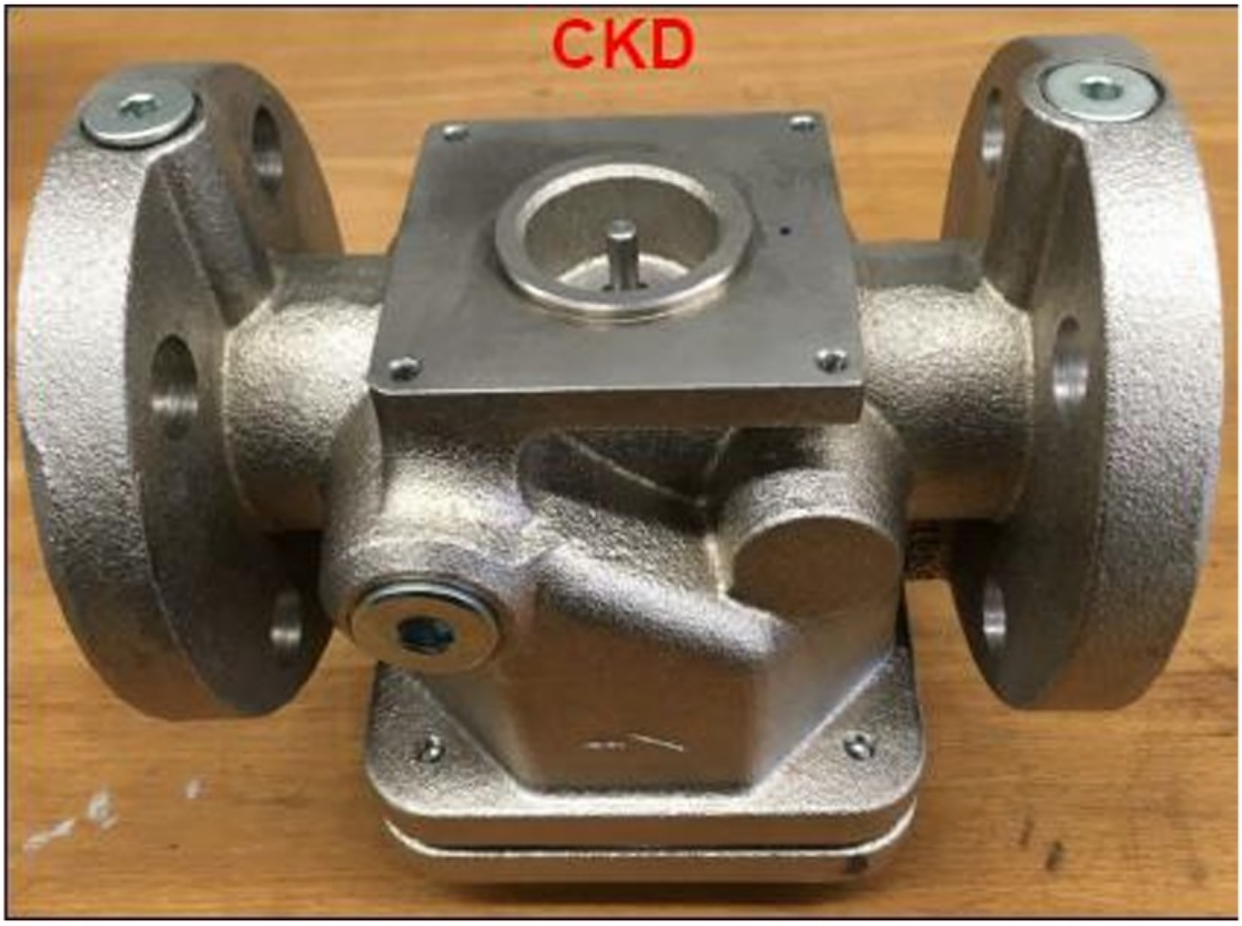
Even if a product configuration has secondary meaning, it does not qualify as an indication of goods or business under Article 2(1)(i) of the Unfair Competition Prevention Act if it does not serve to indicate origin in the relevant transactions.

091854_hanrei.pdf (courts.go.jp)

写真１（ＧＲＶ－２）



写真２



ガスの流れ

[Article] Degree of Similarity in Determining Confusion (2023, Shunji Sato)

Original Ameblo publication: 2024-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850339446.html

[Article] Degree of Similarity in Determining Confusion (2023, Shunji Sato)

The comparison table for Trademark Act Article 4(1)(x), (xi), and (xv) is extremely useful!!

The U.S. Polaroid and DuPont tests also need to be checked!!

Most cases applying item (xv) (likelihood of confusion with goods or services pertaining to another person’s business) fall into the category where the marks are identical / similar but the goods or services are dissimilar

https://jpaa-patent.info/patent/viewPdf/4255

[Article] Civil Code Tort Law as a Supplement to Unfair Competition Law (2023, Professor Tatsuhiro Ueno)

Original Ameblo publication: 2024-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850339567.html

[Article] Civil Code Tort Law as a Supplement to Unfair Competition Law (2023, Professor Tatsuhiro Ueno)

Since the Supreme Court’s North Korea decision, no court decision has recognized a tort where protection is unavailable under intellectual property law.

⇒ One possible view is that situations requiring legal protection, such as imitation of product configurations, domains, and shared data with limited access, have been addressed through legislation.

https://jpaa-patent.info/patent/viewPdf/4166

Tokyo District Court, 2017 (Wa) No. 22010 <Yamada> = Appeal, IP High Court, 2020 (Ne) No. 10038 <Otaka> [… Air-Conditioned Clothing]

Original Ameblo publication: 2024-05-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850474762.html

Tokyo District Court, 2017 (Wa) No. 22010 <Yamada> = Appeal, 2020 (Ne) No. 10038 <Otaka> [… Air-Conditioned Clothing]

<Indirect infringement> "Only" requirement satisfied

"A mode of use involving no harness-type safety belt at all is not contemplated as an economic, commercial or practical use"

<Prior use right> Denied

A prototype was tried on within the company, but it was unclear whether immediate working was possible

(Excerpt from the judgment)

<Indirect infringement>

The defendant's air-conditioned clothing catalog states that "garment only" products are "garments only for use as a spare while washing or for people who already own fans, batteries, etc." Products 3 and 6 are described as "air-conditioned clothing exclusively for wearers of full-harness safety belts. The lanyard can be brought out through the back. Of course, air will not escape. …" In view of these descriptions and other circumstances, Products 3 and 6 should be found to be sold for wearing harness-type safety belts. A mode of use involving no harness-type safety belt at all cannot be regarded as an economic, commercial or practical use; therefore, they should be found to be used only for manufacturing the accused products, which are articles embodying the registered utility model.

<Prior use right>

Even though a hand-drawn diagram of the configuration of air-conditioned clothing compatible with a full harness was prepared, a prototype was made, and it was tried on within the company, it is not necessarily clear that the defendants were in a position to work it immediately. … The defendants began manufacturing and selling the accused products in May, 2016, more than a year after the prototype was made and tried on in March and April, 2015. In light of this as well, at the filing date, at least, it cannot be said that the defendants' intention to work immediately the business relating to the accused products embodying the device had been expressed in an objectively recognizable manner and to an objectively recognizable extent. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89683.pdf

[United States] K-Fee System v. Nespresso (CAFC, December 2023)

Original Ameblo publication: 2024-05-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850604781.html

[United States] K-Fee System v. Nespresso (CAFC, December 2023)

<Issue> Can “bit code” satisfy the claim term “bar code”?

The court below construed the term narrowly on the basis of the patentee’s arguments concerning the corresponding EP patent and found it not satisfied.

⇒ Taking the patentee’s EPO arguments into account, the CAFC nevertheless rejected the narrow construction and remanded to the court below.

https://www.cafc.uscourts.gov/opinions-orders/22-2042.OPINION.12-26-2023_2244064.pdf

“Prior Use Rights: A Great Debate on the Main Issues” (Tamura, Iseki, Takabe, Sato, Kajinami, Morita)

Original Ameblo publication: 2024-05-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850931826.html

“Prior Use Rights: A Great Debate on the Main Issues” (Tamura, Iseki, Takabe, Sato, Kajinami, Morita, Patent Supplement 2024)

Except for patent attorney Morita (p. 89), the participants appear to interpret “the invention” in Patent Act Article 79 differently from an “invention” publicly worked.

⇒ If the concept of “invention” under the Patent Act is not uniform, what about the “invention” being worked?

* Must an “invention” publicly worked also be managed??

https://www.jstage.jst.go.jp/article/patentsp/77/30/77_167/_pdf

IP High Court, 2021 (Ne) No. 10061 Hirano Tecseed, PI v. Kaneka ⇛ No Interest in Bringing Suit (Action for a Declaration of Non-Liability)

Original Ameblo publication: 2024-05-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850932078.html

2021 (Ne) No. 10061 <Shoji> Hirano Tecseed, PI v. Kaneka

“Only the manufacture and sale of machinery by the first-instance plaintiff falls within the scope of the license agreement”

For resin film manufactured using machinery sold under license, no obligation on the patentee not to enforce its patent rights was recognized under the contract at issue.

Separately, there was no interest in bringing the claim for a declaration of non-existence of the obligation (action for a declaration of non-liability)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92503.pdf

Tokyo District Court, 2020 (Wa) No. 8642 [PCSK9]

Original Ameblo publication: 2024-05-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12850981052.html

Tokyo District Court, 2020 (Wa) No. 8642 [PCSK9]

(Patentee’s argument)

Although EGFa-mimic antibodies could not be obtained at the filing date, it is not required to provide means for solving a problem that did not exist at the time of filing.

(Judgment)

The specification does not disclose “the configuration of means for solving … a problem to be solved in the future,” so the support and enablement requirements are violated

* The support and enablement requirements also become an issue when something unknown at the filing date but falling within the claims is discovered after filing.

⇒ This is an unavoidable problem, but can it be addressed through a disclaimer claim?

(The judgment has not been published, so this is unclear, but since it was an infringement action, the accused product may have been an “EGFa-mimic antibody.”)

(Note) The statement in parentheses above reflects the explanation in the original article as of May 5, 2024.

* Curiously, under the doctrine of equivalents, infringement can be asserted against things that became known after the filing date; although the fourth requirement applies, support and enablement are not questioned with respect to the equivalent.

I have doubts about this point and consider this judgment to have exposed that contradiction. In other words, if the original claim language did not encompass “EGFa-mimic antibodies,” there would be room to assert the doctrine of equivalents against them; yet if it does encompass them, this results in a violation of the support and enablement requirements.

(Even if the claim were narrowed now by a disclaimer, would the fifth requirement bar equivalence? Or, since there are many cases in which equivalence was allowed despite narrowing to avoid support- or enablement-requirement violations, might there still be a chance?)

IP High Court, 2022 (Gyo-Ke) No. 10082 [Antibodies Relating to PIVKA-II] <Shoji> ⇛ Clarity Requirement Satisfied

Original Ameblo publication: 2024-05-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851115255.html

2022 (Gyo-Ke) No. 10082 [Antibodies Relating to PIVKA-II] <Shoji>

⇒ Clarity requirement satisfied

(The support and enablement requirements and inventive step were also upheld, and the challenge under the extended prior-application rule was rejected.)

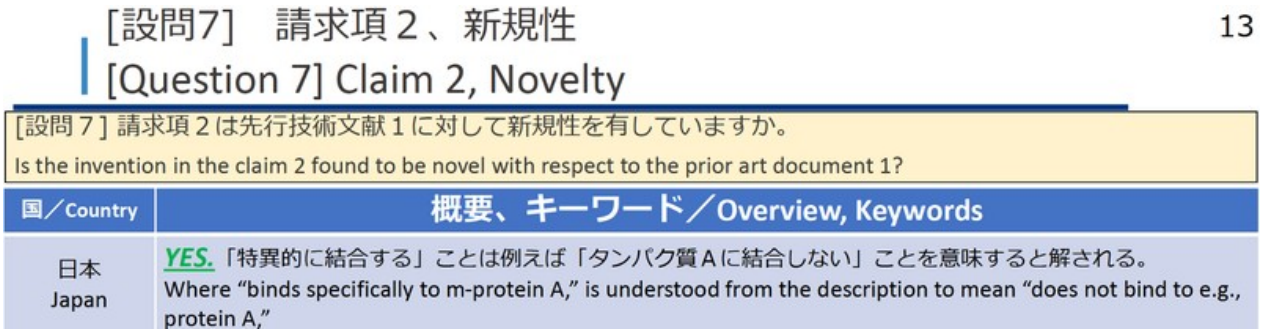
A person skilled in the art would understand “specifically recognizes and binds to PIVKA-II” to mean that the binding protein’s reactivity varies depending on the presence or absence of a specific structural site containing Glu at position 6 and/or 7 of PIVKA-II.

The claim language “specifically recognizes and binds to PIVKA-II” was construed as “an antibody having higher affinity for PIVKA-II, a variant of normal prothrombin, than for normal prothrombin.”

Cf. Page 13 of the 2023 Judicial Symposium on Intellectual Property: this differs from Japan’s interpretation of “specifically binds” as “for example, does not bind to others”!?

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92709.pdf

https://www.jpo.go.jp/news/kokusai/seminar/document/chizaishihou-2023/5-03.pdf



[設問7] 請求項２、新規性 13

[Question 7] Claim 2, Novelty

[設問７] 請求項２は先行技術文献１に対して新規性を有していますか。

Is the invention in the claim 2 found to be novel with respect to the prior art document 1?

国／Country	概要、キーワード／Overview, Keywords
日本 Japan	YES.「特異的に結合する」ことは例えば「タンパク質Ａに結合しない」ことを意味すると解される。 Where “binds specifically to m-protein A,” is understood from the description to mean “does not bind to e.g., protein A,”

[Statistics] Trends in Numbers of Patent Invalidation Trials and Oppositions: Invalidation Decisions (Including Partial Invalidation) Just under 20%

Original Ameblo publication: 2024-05-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851247423.html

[Statistics] Trends in Numbers of Patent Invalidation Trials and Oppositions

From 2018 through 2022, the annual number of requests for patent invalidation trials ranged from 97 to 159, with an annual average of 119.2.

Of the 626 final dispositions by the Trial and Appeal Department shown in the table for that period, 106 granted the request, including partial grants, representing approximately 16.9%.

For that period, 159 final dispositions involved withdrawal or abandonment, representing approximately 25.4%. In 2022 alone, 41 of the 115 final dispositions involved withdrawal or abandonment, representing approximately 35.7%.

⇒ Only cases linked to infringement litigation remain, and they are withdrawn upon settlement.

From 2018 through 2022, the annual number of patent oppositions, counted by patent right, ranged from 1,029 to 1,322, with an annual average of 1,151.8.

Of the 5,555 final dispositions by the Trial and Appeal Department shown in the table for that period, counted by patent right, 628 were revocation decisions, including partial revocation, representing approximately 11.3%.

* Reasonable, given that correction requests are made?

https://www.jpo.go.jp/resources/report/nenji/2023/index.html

(3) 無効審判

	特許			
	請求件数	審判部最終処分件数		
		請求成立（含一部成立）	請求不成立（含却下）	取下・放棄
2013年	247	43	139	29
2014年	215	37	106	41
2015年	231	39	144	36
2016年	140	56	125	42
2017年	161	35	108	24
2018年	159	19	84	22
2019年	113	26	102	34
2020年	121	28	60	24
2021年	106	17	57	38
2022年	97	16	58	41

(3) Invalidation trials — Patents

The last three columns show final dispositions by the Trial and Appeal Department.

Year	Requests	Requests granted (including partial grants)	Requests rejected (including dismissals)	Withdrawal / abandonment
2013	247	43	139	29
2014	215	37	106	41
2015	231	39	144	36
2016	140	56	125	42
2017	161	35	108	24
2018	159	19	84	22
2019	113	26	102	34
2020	121	28	60	24
2021	106	17	57	38
2022	97	16	58	41

(7) 異議申立て

	特許			
	申立件数	審判部最終処分件数		
		取消決定（含一部取消）	維持決定（含却下）	取下・放棄
2015年	364 (389)	0 (0)	5 (5)	0 (0)
2016年	1,214 (1,334)	55 (59)	645 (680)	7 (8)
2017年	1,251 (1,371)	128 (146)	1,085 (1,182)	1 (2)
2018年	1,075 (1,172)	150 (165)	1,006 (1,095)	4 (5)
2019年	1,073 (1,164)	140 (161)	896 (971)	4 (6)
2020年	1,029 (1,127)	139 (166)	874 (939)	1 (1)
2021年	1,260 (1,398)	104 (114)	961 (1,044)	1 (4)
2022年	1,322 (1,446)	95 (109)	1,178 (1,300)	2 (3)

注：2015年の件数については、2015年4月1日以降に申立てられた件数である。
また、（ ）外の数字は権利単位、（ ）内の数字は申立単位の件数である。

(7) Oppositions — Patents

The last three columns show final dispositions by the Trial and Appeal Department.

Note: Figures for 2015 concern oppositions filed on or after April 1, 2015. Numbers outside parentheses are counted by patent right; numbers in parentheses are counted by opposition.

Year	Oppositions filed	Revocation (including partial revocation)	Maintenance (including dismissal)	Withdrawal / abandonment
2015	364 (389)	0 (0)	5 (5)	0 (0)
2016	1,214 (1,334)	55 (59)	645 (680)	7 (8)
2017	1,251 (1,371)	128 (146)	1,085 (1,182)	1 (2)
2018	1,075 (1,172)	150 (165)	1,006 (1,095)	4 (5)
2019	1,073 (1,164)	140 (161)	896 (971)	4 (6)

Year	Oppositions filed	Revocation (including partial revocation)	Maintenance (including dismissal)	Withdrawal / abandonment
2020	1,029 (1,127)	139 (166)	874 (939)	1 (1)
2021	1,260 (1,398)	104 (114)	961 (1,044)	1 (4)
2022	1,322 (1,446)	95 (109)	1,178 (1,300)	2 (3)

[Design] IP High Court, 2023 (Gyo-Ke) No. 10066 <Miyasaka> “Roof Tile” Case ⇛ Similar (No Novelty)

Original Ameblo publication: 2024-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851367146.html

[Design] 2023 (Gyo-Ke) No. 10066 <Miyasaka> “Roof Tile” case

⇒ Similar (no novelty)

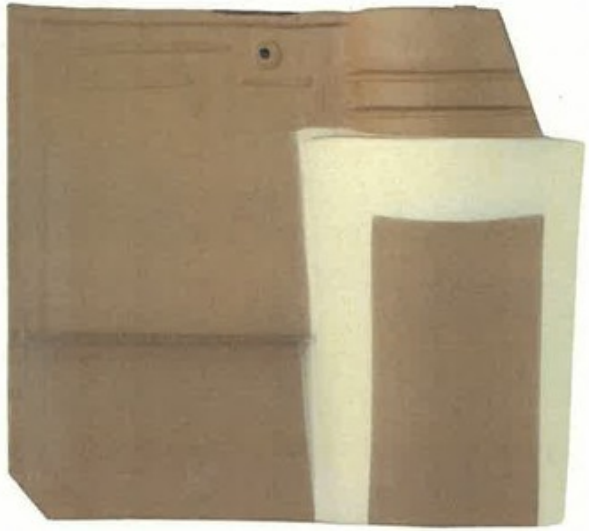
“… Ultimately, the appearance after installation that satisfies the client is considered the most important. Accordingly, configurations that cannot be perceived from the installed state of the roof tiles have a relatively small influence on the determination of design similarity. …”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92650.pdf

別紙　本件登録意匠と引用意匠の対比

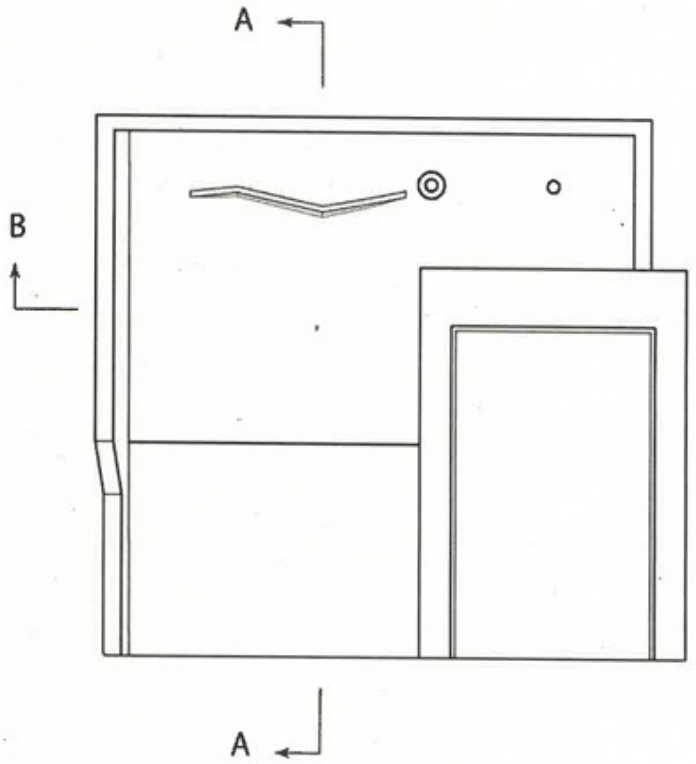
＜本件登録意匠＞

正面図　←　【平面図】



＜引用意匠＞

正面図



[Unfair Competition Prevention Act] Osaka High Court, 2022 (Ne) No. 2081 <Morisaki>

Original Ameblo publication: 2024-05-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851525538.html

[Unfair Competition Prevention Act] Osaka High Court, 2022 (Ne) No. 2081 <Morisaki>

Even if consumers distinguish types such as stick floats and conical floats by their product configurations, they do not select “floats” on the basis of minute differences in configuration. For a float’s product configuration to have “special distinctiveness,” it “must have an unusual configuration far removed from other floats.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92074.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) No. 10030 “Kuruntto Maegami Curler” <Hibiku Shimizu> ⇛ No Distinctiveness (Falls under Trademark Act Article 3(1)(iii))

Original Ameblo publication: 2024-05-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851617918.html

[Trademark] 2023 (Gyo-Ke) No. 10030 “Kuruntto Maegami Curler” <Hibiku Shimizu>

⇒ No distinctiveness (falls under Trademark Act Article 3(1)(iii))

(Excerpt from the judgment)

It is appropriate to find that the word “kuruntto” in the mark, placed immediately before “maegami” (“bangs”), … is ordinarily perceived by the consumers and others concerned as indicating “the state of (bangs) being curved into a round shape.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92351.pdf

[Design] Tokyo District Court, 2022 (Wa) No. 17015 [Lidded Tray for Steam Cooking] <Shibata>

Original Ameblo publication: 2024-05-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851811067.html

[Design] Tokyo District Court, 2022 (Wa) No. 17015 [Lidded Tray for Steam Cooking] <Shibata>

“The specific configurations, such as the specific shape, including curvature, of each portion of the lid on the premise of a circular dome shape, and the specific shape of the handle on the premise that a handle exists at the top of the lid”

There are marked differences in the dominant portions.

⇒ Dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92639.pdf

別紙対比図面



[Patents] I Have Comprehensively Explained the Case Law on “Addition of New Matter”

Original Ameblo publication: 2024-05-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12851877254.html

[Patents] “Addition of New Matter”

I have comprehensively explained the case law on addition of new matter.

This is an edited version of the April 10, 2024 “Chizai LAB” mini-lecture.

Please obtain the presentation materials using the link in the description.

https://www.youtube.com/watch?v=cYifFclB3is

IP High Court, 2021 (Gyo-Ke) No. 10133 [Method for Manufacturing a Laminated Rotor Core] <Honda>

Original Ameblo publication: 2024-05-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852003522.html

2021 (Gyo-Ke) No. 10133 [Method for Manufacturing a Laminated Rotor Core] <Honda>

* Even though it was examined in depth in the original application's specification, it was held not to be "essential" to the invention.

⇒ Not an addition of new matter.

"… Even if … is particularly highlighted and examined in depth in the problems to be solved by the invention and elsewhere in the specification of the earliest parent application … the invention described in that specification, etc. is not … limited to one including that configuration. …"

(Excerpt from the judgment)

… The plaintiff … argues, among other things, that the invention described in the specification, etc. necessarily requires a configuration having a relief space. However, even if matters concerning the configuration having a crimped portion and relief space are particularly highlighted and examined in depth in the problems to be solved by the invention and elsewhere in the specification of the earliest parent application, this does not immediately limit the invention described in that specification, etc. to one including that configuration. … Accordingly, Invention 1 is found to have been described in the original application's specification, etc. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91427.pdf

I Got a Commemorative Plaque!!

Original Ameblo publication: 2024-05-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852189445.html

I got a commemorative plaque ‼️



[Trademark] IP High Court, 2023 (Gyo-Ke) No. 10141 “Chizai Jitsumu Online” <Miyasaka> ⇛ No Distinctiveness

Original Ameblo publication: 2024-05-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852270768.html

[Trademark] 2023 (Gyo-Ke) No. 10141 “Chizai Jitsumu Online” <Miyasaka>

Classes 9, 41 and 45 ⇒ No distinctiveness

<Applicant’s arguments>

① None of the more than 40,000 intellectual-property professionals use the mark

② Merely indirectly indicates characteristics of the goods and services

③ A coined word

④ The examples of use cited in the trial decision also indicate source

⑤ Like a periodical’s title, it indicates source as well as content

<Excerpts from the judgment>

① The trademark applicant’s argument that “none of the more than 40,000 intellectual-property professionals use the mark”

⇒ In view of the meanings of “chizai jitsumu” (“intellectual property practice”) and “online” and the general circumstances of marks with “online” appended at the end, the applied-for mark is found to be perceived as indicating the quality of goods or services. Although evidence of third-party use could further support this finding, the absence of third-party use does not affect it.

② The trademark applicant’s argument that it “merely indirectly indicates characteristics of the goods and services”

③ The trademark applicant’s argument that it is “a coined word”

⇒ Consumers perceive the applied-for mark as meaning “something providing information on intellectual property practice online.” Even if there is some breadth in its content, it is still understood as indicating the quality of goods or services and cannot be called a coined word without a definite meaning.

④ The trademark applicant’s argument that “the examples of use cited in the trial decision also indicate source”

⇒ Except for examples in which the words before “online” themselves function as source identifiers, the examples in Appendix 2 are not found to be used in a manner that is perceived as a source identifier by the addition of “online.” The social media post in Exhibit Ko 3 concerning “Jinja Bukkaku Online” (“Shrines and Temples Online”) in Example 16 does not affect this finding.

⑤ The trademark applicant’s argument that “like a periodical’s title, it indicates source as well as content”

⇒ Periodicals such as newspapers and magazines, unlike books authored by individuals, are mainly edited and published continuously by particular newspaper companies or publishers. Their content varies by newspaper company or publisher (including publication of articles with little connection to the title). They thus have trading circumstances different from other goods: even where a title indicates quality or content, it can serve as a source identifier. (The June 16, 1932, judgment of the Great Court of Cassation cited by the plaintiffs is understood to have the same purport.)

Apart from electronic periodicals that are digitized versions of such periodicals, there is insufficient evidence to find that the designated goods and services of the application have the same trading circumstances as periodicals.

For example, designated services ⑩ and ⑪ involve providing videos and the like online. Internet video-posting and sharing services, represented by YouTube, generally allow anyone to post videos easily. Therefore, limitations such as “concerning intellectual property” and “different content provided periodically or successively on each occasion” do not establish trading circumstances equivalent to those of periodicals such as newspapers and magazines.

The plaintiffs refer to discussions of broadcast program titles in the revision of the Trademark Examination Guidelines and argue that goods and services concerning “programs” for which it is clear that “different content is provided periodically or successively on each occasion” are equivalent to periodicals. However, online provision of videos and the like includes diverse content and characteristics. Even considering the current situation in which some “broadcast programs” are also provided online, the trading circumstances cannot be found equivalent to those of broadcast programs themselves.

Further, among periodically issued electronic publications concerning intellectual property (designated goods ⑤), those corresponding to books authored by individuals cannot immediately be equated with periodicals such as newspapers and magazines.

It is true that, with recent advances in electronic and communications technologies, information content and its means of transmission have expanded and diversified, and the boundaries between traditional goods and services such as “periodicals” from newspaper companies and publishers and “broadcast programs” from television and radio stations, and other information content transmitted online, are also changing. Nevertheless, this does not mean that the trading circumstances concerning “periodicals” formed over many years of traditional trade are immediately established for the provision of videos and the like online.

別紙２　「オンライン」を末尾に付す標章の一覧表

事例	名称	種類	開設者等	内容（説明）	証拠等
1	国語辞典ＯＮＬＩＮＥ	ウェブサイト	㈱ジテンオン	言葉の読み方や意味を調べることができる辞書サイトです。	甲29の1 乙15
2	電卓オンライン	ウェブサイト	不明	基本的な計算から高度な計算をオンラインで行う必要がある人のための認定プラットフォームです。100％無料のオンライン電卓を提供しました。	甲29の2 乙17
3	漢字辞典ＯＮＬＩＮＥ	ウェブサイト	㈱ジテンオン	漢字の部首・画数・読み方・筆順・意味などを調べることができる漢字辞典サイトです。	甲29の3 乙16
4	小児科オンライン	ウェブサイト	㈱KidsPublic	子どもたち及び子どもたちを守る大人が誰一人孤立しない社会の実現を目指し立ち上がった遠隔健康医療相談サービスです。	甲29の4
5	メディカルオンライン	ウェブサイト	㈱メテオ	医学文献の検索全文閲覧をはじめ医薬品・医療機器・医療関連サービスの情報を幅広く提供する、会員制の医学・医療の総合サイトです。	甲29の5
6	慶應オンライン	ウェブサイト	慶応義塾大学	慶應義塾大学の卒業生（塾員）限定のインターネットサービスです	甲29の6
7	読売新聞オンライン	ウェブサイト	読売新聞社グループ	読売新聞ご購読の皆様のためのデジタルサービスです。	甲29の7 乙46
8	東洋経済ＯＮＬＩＮＥ	ウェブサイト	㈱東洋経済新報社	独自に取材した経済関連ニュースを中心とした情報配信プラットフォームです。東洋経済の業界担当記者のほか、多くのジャーナリスト、ライター、組織との連携のもとで運営しています。	甲29の8
9	ＰＲＥＳＩＤＥＮＴ Ｏｎｌｉｎｅ	ウェブサイト	㈱プレジデント社	プレジデント社が運営する総合情報サイトです。プレジデントオンライン編集部の独自記事と、雑誌「プレジデント」（月２回刊）からの転載記事を中心に、さまざまな情報をお届けしています。	甲29の9
10	クロワッサンＯＮＬＩＮＥ	ウェブサイト	㈱マガジンハウス	…雑誌『クロワッサン』が運営するオンラインメディア。健康、料理、ファッション、コスメ、インテリア、収納、お金などのテーマを扱う40代～50代女性をメインターゲットとするライフスタイルメディアです。	甲29の10 乙47
11	ＦＡＮＣＬ　ＯＮＬＩＮＥ（ファンケルオンライン）	ウェブサイト	㈱ファンケル	株式会社ファンケルまたはその代理人が運営するＷｅｂサイトです。美容と健康に役立つ便利でお得な情報が満載で、ファンケルの取扱商品をその場でご注文いただけます。	甲29の11
12	ジッセン！オンライン	ウェブサイト	SO Technologies㈱	デジタルマーケティングの最先端で活躍する講師陣から「実践的」な知識とノウハウを学べるため、社内研修や勉強会等ですぐにご活用いただけます。	甲29の12
13	月刊総務オンライン	ウェブサイト	㈱月刊総務	…戦略的な視点が求められている総務部門の方々に向けて、実務情報や組織運営に役立つ情報の提供を中心に、さまざまなサービスを提供するプラットフォームです。	甲29の13 乙48

Appendix 2. List of marks with “Online” at the end — English translation

Example 1. 国語辞典ＯＮＬＩＮＥ — Japanese Dictionary ONLINE

Type; operator, etc.: Website; Jitenon Co., Ltd..

Content (explanation): A dictionary website where the readings and meanings of words can be looked up.

Evidence, etc.: Ko 29-1; Otsu 15.

Example 2. 電卓オンライン — Calculator Online

Type; operator, etc.: Website; unknown.

Content (explanation): A certified platform for people who need to perform basic to advanced calculations online. We provided a 100% free online calculator.

Evidence, etc.: Ko 29-2; Otsu 17.

Example 3. 漢字辞典ＯＮＬＩＮＥ — Kanji Dictionary ONLINE

Type; operator, etc.: Website; Jitenon Co., Ltd..

Content (explanation): A kanji dictionary website where radicals, stroke counts, readings, stroke order, meanings, and other matters can be looked up.

Evidence, etc.: Ko 29-3; Otsu 16.

Example 4. 小児科オンライン — Pediatrics Online

Type; operator, etc.: Website; KidsPublic Inc..

Content (explanation): A remote health and medical consultation service established to realize a society in which no child, or adult protecting children, is isolated.

Evidence, etc.: Ko 29-4.

Example 5. メディカルオンライン — Medical Online

Type; operator, etc.: Website; Meteo Inc..

Content (explanation): A members-only comprehensive medical and health-care website providing a broad range of information, including searches and full-text viewing of medical literature and information on pharmaceuticals, medical devices, and medical-related services.

Evidence, etc.: Ko 29-5.

Example 6. 慶應オンライン — Keio Online

Type; operator, etc.: Website; Keio University.

Content (explanation): An internet service limited to graduates (alumni) of Keio University.

Evidence, etc.: Ko 29-6.

Example 7. 読売新聞オンライン — Yomiuri Shimbun Online

Type; operator, etc.: Website; Yomiuri Shimbun Group.

Content (explanation): A digital service for subscribers to the Yomiuri Shimbun.

Evidence, etc.: Ko 29-7; Otsu 46.

Example 8. 東洋経済ＯＮＬＩＮＥ — Toyo Keizai ONLINE

Type; operator, etc.: Website; Toyo Keizai Inc..

Content (explanation): An information distribution platform centered on independently reported economic news. It is operated through collaboration with many journalists, writers, and organizations, in addition to Toyo Keizai reporters responsible for individual industries.

Evidence, etc.: Ko 29-8.

Example 9. ＰＲＥＳＩＤＥＮＴ Ｏｎｌｉｎｅ — PRESIDENT Online

Type; operator, etc.: Website; President Inc..

Content (explanation): A comprehensive information website operated by President Inc. It delivers various information, mainly original articles by the President Online editorial department and articles reprinted from the magazine President (published twice a month).

Evidence, etc.: Ko 29-9.

Example 10. クロワッサンＯＮＬＩＮＥ ― Croissant ONLINE

Type; operator, etc.: Website; Magazine House Co., Ltd..

Content (explanation): …Online media operated by the magazine Croissant. Lifestyle media primarily targeting women in their forties and fifties, covering health, cooking, fashion, cosmetics, interiors, storage, money, and other subjects.

Evidence, etc.: Ko 29-10; Otsu 47.

Example 11. ＦＡＮＣＬ ＯＮＬＩＮＥ（ファンケルオンライン） ― FANCL ONLINE

Type; operator, etc.: Website; FANCL Corporation.

Content (explanation): A website operated by FANCL Corporation or its agent. It is full of convenient, beneficial information useful for beauty and health, and products handled by FANCL can be ordered on the spot.

Evidence, etc.: Ko 29-11.

Example 12. ジッセン！オンライン ― Jissen! Online

Type; operator, etc.: Website; SO Technologies Co., Ltd..

Content (explanation): “Practical” knowledge and know-how can be learned from instructors active at the forefront of digital marketing, and can therefore be used immediately for in-house training, study sessions, and the like.

Evidence, etc.: Ko 29-12.

Example 13. 月刊総務オンライン ― Gekkan Somu Online

Type; operator, etc.: Website; Gekkan Somu Co., Ltd..

Content (explanation): …A platform providing various services to people in general affairs departments, for whom a strategic perspective is required, centered on practical information and information useful for organizational management.

Evidence, etc.: Ko 29-13; Otsu 48.

事例	名称	種類	開設者等	内容（説明）	証拠等
14	朝カルオンライン	ウェブサイト	朝日カルチャーセンター	ご自宅からＰＣやスマートフォン、タブレット端末を使って受講できる講座を行っています。受講される方は、招待メールに記載されているＵＲＬをクリックすることで、比較的簡単にご参加いただけます。	乙32
15	よみカルＯＮＬＩＮＥ	ウェブサイト	㈱読売・日本テレビ文化センター	インターネット環境とパソコン・スマホ・タブレット端末などがあれば、お好きなところで受講できます。	甲29の14
16	神社仏閣オンライン	YouTubeチャンネル	不明	神社・お寺・日本文化をもっと身近にする！①禅語ライブ（毎朝7:45～）…などなど！	甲35の1
17	湘南投資勉強会オンライン	YouTubeチャンネル	不明	もっと企業のＩＲに注目して欲しいという想いで、決算資料を読む動画を中心にアップしています。	甲35の2
18	地政学オンライン	YouTubeチャンネル	不明	不明	甲35の3
19	ひろしま助産師オンライン	YouTubeチャンネル	一般社団法人広島県助産師会	毎年行う妊活セミナーなどを今年はオンラインセミナーに変更し、１種類→４種類に増やしました！期間限定で配信します！	甲35の4
20	総合型選抜対策オンライン	YouTubeチャンネル	不明	不明	甲35の5
21	マンスリー・マジック・レッスン・オンライン	ウェブサイト	不明	不明	乙5
22	Fashion Biz Study オンライン	ウェブサイト	不明	Fashion Biz Study は、ファッションビジネスに必要なスキルを学ぶ場です。オンライン講座	乙6
23	適正取引講習会オンライン	ウェブサイト	中小企業庁	適正価格で取引する方法を実験的に学べる適正取引講習会　実践ライブ配信セミナー	乙7
24	スタディーオンライン	ウェブサイト	不明	インターネットを通じて映像授業を受けることができるサービスです。自宅に居ながら塾さながらの授業を受けることができ…	乙8
25	ラーニングＯＮＬＩＮＥ	ウェブサイト	ＭＯＲＩ ＡＲＴ ＭＵＳＥＵＭ森美術館	シンポジウム…など、森美術館はさまざまな形式で…ラーニング・プログラムを開催しています。「MAMデジタル」ではこれらをウェブサイト…などでお届けします。	乙9
26	政府広報オンライン	ウェブサイト	内閣府	政府の施策や知りたい情報をあなたの暮らしにお届けします。	乙10
27	文化遺産オンライン	ウェブサイト	文化庁	文化庁が運営する我が国の文化遺産についてのポータルサイトです。	乙11
28	数値地図（国土基本情報）オンライン	ウェブサイト	一般財団法人日本地図センター	数値地図（国土基本情報）を２次元メッシュ単位…で、インターネットを利用したオンライン提供を行っています。	乙12
29	Educational Video Online	ウェブサイト	丸善出版㈱	医学・看護の映像教材配信サービスです。	乙13
30	おうちｄｅチャレンジ！ＭＥＳＨ™発明ワークショップ オンライン	ウェブサイト	ソニー㈱	参加する子どもたちは自宅で「MESH」と、一緒に貸し出すタブレットを使ってプログラミングや作品づくりを体験…するワークショップです。	乙14

Appendix 2. List of marks with “Online” at the end — English translation

Example 14. 朝カルオンライン — Asakaru Online

Type; operator, etc.: Website; Asahi Culture Center.

Content (explanation): We hold courses that can be attended from home using a PC, smartphone, or tablet. Participants can join relatively easily by clicking the URL in the invitation email.

Evidence, etc.: Otsu 32.

Example 15. よみカルＯＮＬＩＮＥ — Yomikaru ONLINE

Type; operator, etc.: Website; Yomiuri Nippon Television Culture Center Co., Ltd..

Content (explanation): With an internet connection and a computer, smartphone, tablet, or similar device, you can attend from wherever you like.

Evidence, etc.: Ko 29-14.

Example 16. 神社仏閣オンライン — Shrines and Temples Online

Type; operator, etc.: YouTube channel; unknown.

Content (explanation): Bringing shrines, temples, and Japanese culture closer to you! ① Zen sayings live (every morning from 7:45) …and more!

Evidence, etc.: Ko 35-1.

Example 17. 湘南投資勉強会オンライン — Shonan Investment Study Group Online

Type; operator, etc.: YouTube channel; unknown.

Content (explanation): With the wish that people pay more attention to companies' investor relations, we mainly upload videos reading financial-results materials.

Evidence, etc.: Ko 35-2.

Example 18. 地政学オンライン — Geopolitics Online

Type; operator, etc.: YouTube channel; unknown.

Content (explanation): Unknown.

Evidence, etc.: Ko 35-3.

Example 19. ひろしま助産師オンライン — Hiroshima Midwives Online

Type; operator, etc.: YouTube channel; Hiroshima Midwives Association, general incorporated association.

Content (explanation): This year, we changed our annual seminars on preparing for pregnancy and other subjects to online seminars, and increased the number of types from one to four! They will be streamed for a limited period!

Evidence, etc.: Ko 35-4.

Example 20. 総合型選抜対策オンライン — Comprehensive Selection Preparation Online

Type; operator, etc.: YouTube channel; unknown.

Content (explanation): Unknown.

Evidence, etc.: Ko 35-5.

Example 21. マンスリー・マジック・レッスン・オンライン — Monthly Magic Lesson Online

Type; operator, etc.: Website; unknown.

Content (explanation): Unknown.

Evidence, etc.: Otsu 5.

Example 22. Fashion Biz Study オンライン — Fashion Biz Study Online

Type; operator, etc.: Website; unknown.

Content (explanation): Fashion Biz Study is a place to learn the skills required for the fashion business. Online courses.

Evidence, etc.: Otsu 6.

Example 23. 適正取引講習会オンライン — Fair Transactions Workshop Online

Type; operator, etc.: Website; Small and Medium Enterprise Agency.

Content (explanation): A fair transactions workshop for learning experimentally how to transact at appropriate prices. Practical live-streamed seminar.

Evidence, etc.: Otsu 7.

Example 24. スタディーオンライン — Study Online

Type; operator, etc.: Website; unknown.

Content (explanation): A service through which video lessons can be taken over the internet. While at home, you can take lessons just like those at a cram school…

Evidence, etc.: Otsu 8.

Example 25. ラーニングＯＮＬＩＮＥ — Learning ONLINE

Type; operator, etc.: Website; MORI ART MUSEUM.

Content (explanation): The Mori Art Museum holds …learning programs in various formats, including symposiums…. “MAM Digital” delivers these through the website …and other means.

Evidence, etc.: Otsu 9.

Example 26. 政府広報オンライン — Government Public Relations Online

Type; operator, etc.: Website; Cabinet Office.

Content (explanation): We deliver government measures and information you want to know to your daily life.

Evidence, etc.: Otsu 10.

Example 27. 文化遺産オンライン — Cultural Heritage Online

Type; operator, etc.: Website; Agency for Cultural Affairs.

Content (explanation): A portal website about Japan’s cultural heritage operated by the Agency for Cultural Affairs.

Evidence, etc.: Otsu 11.

Example 28. 数値地図（国土基本情報）オンライン — Digital Maps (Basic Geospatial Information) Online

Type; operator, etc.: Website; Japan Map Center, general incorporated foundation.

Content (explanation): Digital maps (basic geospatial information) are provided online over the internet in two-dimensional mesh units….

Evidence, etc.: Otsu 12.

Example 29. Educational Video Online

Type; operator, etc.: Website; Maruzen Publishing Co., Ltd..

Content (explanation): A distribution service for medical and nursing video teaching materials.

Evidence, etc.: Otsu 13.

Example 30. おうちｄｅチャレンジ！ＭＥＳＨ™発明ワークショップ オンライン — Try It at Home! MESH™ Invention Workshop Online

Type; operator, etc.: Website; Sony Corporation.

Content (explanation): A workshop in which participating children experience programming and creating works …at home using “MESH” and a tablet loaned together with it.

Evidence, etc.: Otsu 14.

事例	名称	種類	開設者等	内容（説明）	証拠等
31	２０２０特許・情報フェア＆コンファレンスＯｎｌｉｎｅ	ウェブサイト	一般社団法人発明推進協会ほか	新型コロナウィルス感染症の収束の見通しが立たない状況から…科学技術館で予定しておりましたリアルの開催から、オンライン展示会に交流の場を移します。	乙18
32	地方自治情報化推進フェアオンライン	ウェブサイト	地方公共団体情報システム機構	情報システムオンライン展示会（出展者セミナーも含む）	乙19
33	隠れん坊 オンライン	ウェブサイト	Google	このゲームについて：リアルタイムのオンラインかくれんぼ	乙20
34	早稲田アカデミーＯｎｌｉｎｅ	ウェブサイト	㈱早稲田アカデミー	塾での学習や、模擬試験の結果の参照、オンライン学習システムの利用など…様々な機能をご利用いただくことができます。	乙21
35	Ken Hirai Films Vol.16「Ken's Bar 2021 -ONLINE-」	ＤＶＤ		オンライン開催された音楽ライブの映像作品	乙22

Appendix 2. List of marks with “Online” at the end — English translation

Example 31. ２０２０特許・情報フェア＆コンファレンスＯｎｌｉｎｅ — 2020 Patent and Information Fair & Conference Online

Type; operator, etc.: Website; Japan Institute for Promoting Invention and Innovation, general incorporated association, and others.

Content (explanation): Because there is no prospect of the COVID-19 outbreak subsiding …we are moving the place for interaction from the in-person event planned at the Science Museum to an online exhibition.

Evidence, etc.: Otsu 18.

Example 32. 地方自治情報化推進フェアオンライン — Local Government Informatization Promotion Fair Online

Type; operator, etc.: Website; Japan Agency for Local Authority Information Systems.

Content (explanation): Information systems online exhibition (including exhibitor seminars).

Evidence, etc.: Otsu 19.

Example 33. 隠れん坊 オンライン — Hide-and-Seek Online

Type; operator, etc.: Website; Google.

Content (explanation): About this game: real-time online hide-and-seek.

Evidence, etc.: Otsu 20.

Example 34. 早稲田アカデミーＯｎｌｉｎｅ — Waseda Academy Online

Type; operator, etc.: Website; Waseda Academy Co., Ltd..

Content (explanation): You can use various functions …including studying at a cram school, viewing mock-examination results, and using an online learning system.

Evidence, etc.: Otsu 21.

Example 35. Ken Hirai Films Vol.16 “Ken’s Bar 2021 -ONLINE-”

Type; operator, etc.: DVD; [blank].

Content (explanation): A video work of a live music performance held online.

Evidence, etc.: Otsu 22.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92967.pdf

[Right of Publicity] Tokyo District Court, 2023 (Wa) No. 70056 <Nakashima> * Infringement of the Right of Publicity Established

Original Ameblo publication: 2024-05-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852378350.html

[Right of Publicity] Tokyo District Court, 2023 (Wa) No. 70056 <Nakashima> Infringement of the Right of Publicity Established

"The plaintiff is widely recognized … as the legendary cabaret-club hostess who earned the most in Japan … the plaintiff's name or likeness … has customer-attracting power that promotes the sale of goods and the like"

"The acts fall within the second category of the Pink Lady judgment and infringe the right of publicity"

(Excerpt from the judgment)

Despite the court's request for clarification, the defendants have not contested whether the acts fall within the three categories in the Pink Lady judgment, but the court will examine the matter below for completeness.

According to the foregoing background facts and factual findings, the plaintiff's name and likeness have customer-attracting power that promotes sales of goods and the like. Considering the manner in which the name and likeness were displayed and other circumstances, and the fact that the brand value of Enrike was placed at the forefront across all services provided by the defendants, it is appropriate to find that the defendants attached the plaintiff's name or likeness to their trade names, marks, web pages and domain names to differentiate their services from those of other businesses of the same kind through that customer-attracting power: Enrike Kukan in its interior-design and related business, Enrike Style in its aesthetic-salon operation and related business, and Enrike Staff in its worker-dispatch and related business.

Accordingly, the defendants' use of the plaintiff's name or likeness falls within the second category of the Pink Lady judgment and infringes the right of publicity.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92634.pdf

IP High Court, 2013 (Gyo-Ke) No. 10089 [Total Parenteral Nutrition Infusion Preparation in a Two-Chamber Container] <Misao Shimizu>

Original Ameblo publication: 2024-05-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852510705.html

2013 (Gyo-Ke) No. 10089 [Total Parenteral Nutrition Infusion Preparation in a Two-Chamber Container] <Misao Shimizu>

* Applying high-pressure steam sterilization causes vitamin decomposition

⇒ A disincentive exists

⇒ Inventive step recognized

Since the amount decomposed differs for each type of vitamin, the amount of each vitamin must be adjusted, creating a separate technical problem.

(Excerpt from the judgment)

… Even if high-pressure steam sterilization of infusion preparations is well known … there is no motivation to apply it to the cited invention. Rather, given the common general technical knowledge that vitamins generally decompose readily through heat and light, high-pressure steam sterilization … after adding a multivitamin preparation could decompose the vitamins and prevent sufficient achievement of the acidosis-prevention effect. Thus there is a disincentive to high-pressure steam sterilization. … Thermal stability varies among vitamins, and the amounts decomposed by high-pressure steam sterilization differ. Accordingly, to achieve the original objective of adequate replenishment of electrolytes and nutrients, simply increasing the dosage of Neolamin Multi V is insufficient; the amount of each type of vitamin must be adjusted, which can only be regarded as a separate technical problem. It is generally difficult to envisage performing high-pressure steam sterilization despite the creation of such a new technical problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84358.pdf

[Unfair Competition Prevention Act Article 2(1)(i) / Criminal] Nagoya District Court, December 16, 2022 <Checkered Pattern (Demon Slayer)>

Original Ameblo publication: 2024-05-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852690966.html

[Unfair Competition Prevention Act Article 2(1)(i) / Criminal] Nagoya District Court, December 16, 2022 <Checkered Pattern (Demon Slayer)>

"When combining four or more types, there are countless choices … selecting similar patterns … is itself … highly unlikely to occur unless they are intentionally selected with knowledge of the work"

Cf. The two-color patterns received decisions of refusal under Trademark Act Article 3(1)(vi)

(Excerpt from the judgment)

First, examining Patterns A through C, each individual pattern merely selects one or two colors and applies them to traditional patterns or generally used decorative designs such as checkered, hemp-leaf and scale patterns. They cannot be said to possess special distinctiveness.

In contrast, Patterns D through F each select three colors. Pattern D itself combines a tortoiseshell pattern and a plain area, with two particular colors assigned to the tortoiseshell pattern and one to the plain area. Pattern E is a gradation of three particular colors, characterized also by their particular order within the gradation and the large proportion of white. Pattern F is characterized by a flame pattern expressed through a particular order of three colors and the shape of the boundary between the yellow and adzuki-bean-colored portions. In addition to these characteristics, research into traditional Japanese and kimono patterns revealed no patterns similar to Patterns D through F (Witness G), and these patterns have individually been registered as trademarks. Taking these matters together, Patterns D through F are found to possess special distinctiveness individually.

Further, as stated in (2) above, "KMT" merchandise comprises a wide variety of products and in many instances each product is commercialized with multiple variants. Thus, even if a combination of the patterns contains patterns that are not specially distinctive individually, at least the combination of Patterns A through D includes Pattern D, which is individually specially distinctive. Moreover, even if Patterns A through C individually are merely combinations of simple colors and simple patterns, there are countless ways to choose and combine four such patterns arbitrarily. The probability of arbitrarily selecting only Patterns A through D from among them is therefore extremely low, and combining Patterns A through D cannot be said to restrict others' freedom to use colors and shapes.

Taken together, these circumstances establish that the combination of Patterns A through D possesses special distinctiveness. Accordingly, the combination of six patterns formed by adding Patterns E and F naturally possesses special distinctiveness as well.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91740.pdf

Tokyo District Court, 2018 (Wa) No. 28931 [Laser Processing Apparatus] <Shibata> ⇛ Article 102(2) Inapplicable, Article 102(1) Applicable

Original Ameblo publication: 2024-05-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852747265.html

Tokyo District Court, 2018 (Wa) No. 28931 [Laser Processing Apparatus] <Shibata>

* The plaintiff manufactured and sold a product (SD engine) corresponding to part of the defendant's product (SD apparatus).

⇒ Article 102(2) inapplicable

⇒ Article 102(1) applicable

★ Always plead paragraph (1) in the alternative as well

* Did the court generally reject cumulative application of Article 102(1) and (3)!?

(Excerpt from the judgment)

(2) Application of Patent Act Article 102(2)

The presumption in Patent Act Article 102(2) … can be said to presuppose a relationship in which, absent the infringer's acts of patent infringement, the patentee could have earned the profits obtained by the infringer through those acts or profits of the same nature. Accordingly, where there is categorically no relationship in which the patentee could have earned profits of the same nature as those obtained by the infringer through patent infringement even if the infringement had not occurred, the basis for applying that Article is lacking.

In this case, the plaintiff manufactures and sells SD engines …, but does not manufacture or sell SD apparatuses. An SD engine is a component of an SD apparatus; customers for SD engines are manufacturers of semiconductor manufacturing equipment, whereas customers for SD apparatuses are semiconductor manufacturers. … The plaintiff merely manufactures and sells SD engines corresponding to components used in the manufacture, etc. of SD apparatuses embodying the inventions, and does not sell SD apparatuses. Thus, even without the defendant's patent infringement, the plaintiff would not have been able to sell SD apparatuses equipped with SD engines in place of the defendant. The defendant's profits in this case are profits from selling SD apparatuses. Even absent the defendant's infringement of the patent rights, it cannot be found that the plaintiff could have earned profits of the same nature as those from selling such SD apparatuses. Thus there is categorically no relationship in which the plaintiff could have earned the profits obtained by the defendant through patent infringement. Accordingly, the basis for applying Patent Act Article 102(2) is lacking in this case. …

(3) Application of Patent Act Article 102(1)

The "articles that [the patentee, etc.] could have sold if there had been no infringement" in Patent Act Article 102(1) need only be the patentee's products whose sales volume is affected by the infringement. The plaintiff patentee sells its engines, which are SD engines. Since an SD engine was necessary for an SD apparatus, the defendant's sales of SD apparatuses affect the sales volume of the plaintiff's engines. Accordingly, there is a basis for applying Patent Act Article 102(1) in this case. …

… Patent Act Article 102(1) presumes the patentee's damages through the paragraph as a whole, including its individual items, and paragraph (3) of the same Article is not applied in addition to paragraph (1).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92821.pdf

[Unfair Competition Prevention Act Article 2(1)(iii)] Tokyo District Court, 2021 (Wa) No. 25324 <Shibata> ⇛ Substantially Identical Configurations; Configuration Imitation Found!!

Original Ameblo publication: 2024-05-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12852882011.html

[Unfair Competition Prevention Act Article 2(1)(iii)] 2021 (Wa) No. 25324 <Shibata>

⇒ Configuration imitation found because the configurations were substantially identical!!

Plaintiff's goods: ¥17,800–19,800

Defendant's goods: ¥1,980–3,980

The shapes are almost identical.

The rear zipper and hooks and the width of the shoulder straps are trivial differences that are noticed only when pointed out.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92651.pdf

原告商品１



被告商品１



[Article] Monosodium Glutamate Case / Tokyo District Court, September 24, 2020 (2016 (Wa) No. 25436) (Yuki Hirai, Patent, September 2021 issue)

Original Ameblo publication: 2024-05-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853008951.html

[Article] Monosodium Glutamate Case / Tokyo District Court, September 24, 2020 (2016 (Wa) No. 25436) (Yuki Hirai, Patent, September 2021 issue)

For goods transferred abroad by an overseas affiliate, an “offer for transfer” was also found because the Japanese defendant had jointly conducted sales activities in Japan with that affiliate.

⇒ In the damages analysis, the overseas affiliate’s profits were also evaluated as the Japanese defendant corporation’s marginal profits (Article 102(2))!

https://jpaa-patent.info/patent/viewPdf/3871

（2）しかし，ここで数字を単純化した以下のような設例を考えた場合，一般的な考え方に従えば，被告が譲渡行為によって得た被告製品1個あたりの限界利益は，10円（120円［売上額］－100円［仕入額］－10円［経費額］＝10円［限界利益額］）となるはずである。これに対して，本判決の算定方法によれば，限界利益額は50円（120円［売上額］－60円［CJインドネシア経費］－10円［被告経費額］＝50円［限界利益額］）となる。

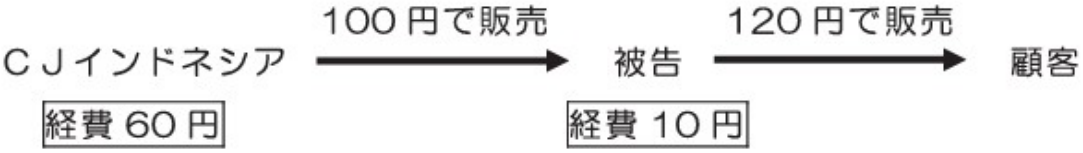


図5　数字を単純化した設例

（3）本判決は，実質的にはCJインドネシアから被告への譲渡に係るCJインドネシアの限界利益額を，被告に対して請求していることになる。上記設例で言えば，CJインドネシアから被告への譲渡に係る限界利益は，40円（100円［売上額］－60円［経費額］＝40円［限界利益額］）となる。本判決の算定では，，本来的な被告の限界利益額である10円に，このCJインドネシアの限界利益である40円を加えた，計50円が被告販売分に係る限界利益として評価されていることになる。

English translation of the excerpt and Figure 5

(2) However, when considering a hypothetical example with simplified figures as set out below, under the usual approach, the marginal profit obtained by the defendant through the transfer per unit of the defendant's product should be JPY 10 (JPY 120 [sales amount] − JPY 100 [purchase amount] − JPY 10 [expenses] = JPY 10 [marginal profit]). In contrast, under the calculation method in this judgment, the marginal profit is JPY 50 (JPY 120 [sales amount] − JPY 60 [CJ Indonesia's expenses] − JPY 10 [defendant's expenses] = JPY 50 [marginal profit]).

Figure 5. Hypothetical example with simplified figures. CJ Indonesia (expenses: JPY 60) sells to the defendant for JPY 100. The defendant (expenses: JPY 10) sells to the customer for JPY 120.

(3) In substance, this judgment results in a claim against the defendant for CJ Indonesia’s marginal profit from the transfer from CJ Indonesia to the defendant. In the hypothetical example above, the marginal profit from the transfer from CJ Indonesia to the defendant is JPY 40 (JPY 100 [sales amount] − JPY 60 [expenses] = JPY 40 [marginal profit]). In the calculation in this judgment, CJ Indonesia’s marginal profit of JPY 40 is added to the defendant’s original marginal profit of JPY 10, and the total of JPY 50 is assessed as the marginal profit from the units sold by the defendant.

[Article] Trademark Rights and Territoriality (Yoshiyuki Tamura, Patent, December 2023 Issue)

Original Ameblo publication: 2024-05-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853142492.html

[Article] Trademark Rights and Territoriality (Yoshiyuki Tamura, Patent, December 2023 Issue)

The purpose of the registered trademark system is to guarantee the source-identifying function

⇒ In the case of use on the Internet, the trademark law of a place where consumers exist to a meaningful extent should apply.

* The server's location does not affect the conclusion.

+ This is also consistent with past Japanese court decisions.

https://jpaa-patent.info/patent/viewPdf/4339

[U.S. Patents] Amgen v. Chugai (1991 CAFC) 927 F.2d 1200

Original Ameblo publication: 2024-05-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853261248.html

[U.S. Patents] Amgen v. Chugai (1991 CAFC) 927 F.2d 1200

For the claim language “a specific activity of at least about 160,000 IU per absorbance unit at 280 nm,” the specification and prosecution history provided no hint as to which intermediate values between that figure and the prior art’s “specific activity of 128,620 IU” would infringe

⇒ Indefinite

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2023/01/ea30b2ac4114b4924753979778009ba8.pdf

[U.S. Patents] Conopco v. May Dept. (1994, CAFC) 46 F.3d 1556

Original Ameblo publication: 2024-05-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853386701.html

[U.S. Patents] Conopco v. May Dept. (1994, CAFC) 46 F.3d 1556

The accused product’s “162.9 : 1” did not satisfy the claim language “about 40 : 1.” No equivalence either

Under the ordinary and customary meaning of “about,” the upper limit of “about 40:1 to 1:1” cannot be expanded “as far as the prior art allows.”

https://law.justia.com/cases/federal/appellate-courts/F3/46/1556/591683/

IP High Court, 2023 (Gyo-Ke) No. 10009 [Wastepaper Processing Apparatus] <Hibiku Shimizu>

Original Ameblo publication: 2024-05-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853895453.html

2023 (Gyo-Ke) No. 10009 [Wastepaper Processing Apparatus] <Hibiku Shimizu>

The fact that the invention and the cited invention have the same purpose was used as the reason for treating the difference as a design matter.

(Other differences were held obvious by combining the primary and secondary cited inventions because they had the same purpose. Parallel reasoning was adopted for design matters and combinations.)

(Excerpt from the judgment)

In the cited invention, the “estimated recycling duration” is displayed on the display unit as a warning to the user when, for example, it is shorter than the “operating duration” set by the user. (According to paragraph [0054] of Ko 1, such a warning is intended to alert the user that operation will continue after the raw material stored in the raw-material storage unit has been used up.) Adopting a technique that displays the “estimated recycling duration” as such a warning and adopting one that displays the “scheduled operation-end time” differ only in displaying a duration rather than a clock time. It is appropriate to find that these are design matters that a person skilled in the art could select as appropriate by exercising ordinary creative ability as means of achieving the same purpose. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92483.pdf

[U.S. Patents] Par v. Hospira (2020, CAFC) * Literal Infringement Affirmed on Appeal; Equivalents Addressed in the Alternative Below

Original Ameblo publication: 2024-05-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853895740.html

[U.S. Patents] Par v. Hospira (2020, CAFC): Claim Language “about 6 to 8 mg/mL”

⇒ The Federal Circuit affirmed literal infringement; the district court had also found infringement under the doctrine of equivalents in the alternative.

① Using “about” with a numerical range avoids a strict interpretation of the boundaries

② The extent to which “about” can expand a numerical range is what a person skilled in the art would regard as reasonable

③ …

https://openlegalcommunity.com/what-is-about/

[2026 editorial clarification] The Federal Circuit affirmed the finding of literal infringement, applying the claim term “about” to the numerical range. It did not decide infringement under the doctrine of equivalents; the district court had reached that issue only in the alternative. This appellate decision should not be cited as holding that infringement under the doctrine of equivalents was established.

[U.S. Patents] Cohesive v. Waters (2008, CAFC): Numerical Range Construed Broadly!

Original Ameblo publication: 2024-05-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853895948.html

[U.S. Patents] Cohesive v. Waters (2008, CAFC)

The claim language requiring an average diameter “greater than about 30 μm” was construed to mean either (1) greater than 25.434 μm, or (2) greater than 23.044 μm and a particle diameter sufficiently large to ensure that the column is capable of attaining turbulent flow.

⇒ Reversed the district court’s summary judgment that 25 μm did not satisfy the claim.

★ The summary judgment of no literal infringement for the 25 μm columns was reversed and remanded, with the numerical range construed broadly. The summary judgment of no infringement under the doctrine of equivalents was affirmed.

https://www.cafc.uscourts.gov/opinions-orders/08-1029.pdf

[U.S. Patents] Ortho-McNeil v. Caraco (2007, CAFC)

Original Ameblo publication: 2024-05-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12853896066.html

[U.S. Patents] Ortho-McNeil v. Caraco (2007, CAFC)

The claim language “about 1 : 5” was construed to mean “approximately 1:5, encompassing a range of ratios no greater than 1:3.6 to 1:7.1”!!

⇒ The accused product’s “1 : 8.67” did not satisfy the claim. No equivalence either

* The district court’s claim construction, which relied on both intrinsic evidence (the claims and the specification) and expert testimony (extrinsic evidence) that the scope included the statistical 95% confidence interval, was affirmed.

https://law.justia.com/cases/federal/appellate-courts/cafc/06-1102/06-1102-2011-03-27.html

[United States] Cordis v. Boston Scientific (2009, CAFC)

Original Ameblo publication: 2024-05-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854022998.html

[United States] Cordis v. Boston Scientific (2009, CAFC)

For qualification as a “printed publication,” public accessibility can be negated where a document is distributed only to a limited number of persons under a binding confidentiality agreement.

However, such a binding confidentiality agreement is not essential.

https://www.cafc.uscourts.gov/opinions-orders/08-1003.pdf

[United States] Weber v. Provisur (2024, CAFC)

Original Ameblo publication: 2024-05-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854145857.html

[United States] Weber v. Provisur (2024, CAFC)

Weber’s product manuals, relied on by Weber as the IPR petitioner, were distributed to a limited number of recipients and carried copyright notices restricting copying and transfer. Nevertheless, they qualified as “printed publications” because interested members of the public could obtain them through reasonable efforts. The Federal Circuit reversed the PTAB’s determination that those notices and related terms defeated public accessibility.

https://patent-law.hatenablog.com/entry/2024/02/11/150656

IP High Court, 2023 (Gyo-Ke) No. 10011 [Device for Remote Operation of a Mobile Terminal] <Miyasaka>

Original Ameblo publication: 2024-05-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854276036.html

2023 (Gyo-Ke) No. 10011 [Device for Remote Operation of a Mobile Terminal] <Miyasaka>

An amendment introducing a disclaimer: "… (excluding images captured by a camera)"

⇒ Although an independent claim in the cited reference recited "… an imaging unit," it was not found to be an essential configuration (for solving the cited invention's problem). …

⇒ No inventive step

https://www.youtube.com/watch?v=V5JxxqbXTZQ

[U.S. Patents] Dyfan v. Target (CAFC, March 2022): MPF in Software Patents

Original Ameblo publication: 2024-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854558605.html

[U.S. Patents] Dyfan v. Target (CAFC, March 2022)

Means-Plus-Function claims in software patents where the word “means” is absent

⇒ Based on expert testimony, the claim terms “code/application” and “system” were held not to invoke MPF because a person skilled in the art would understand them to connote structure.

https://www.cafc.uscourts.gov/opinions-orders/21-1725.OPINION.3-24-2022_1926111.pdf

[Copyright] Osaka High Court, 2023 (Ne) No. 1384: Product Photograph of Vocabulary Cards — Copyrightability Recognized Contrary to the Court Below!!

Original Ameblo publication: 2024-06-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854558738.html

[Copyright] Osaka High Court, 2023 (Ne) No. 1384

Product photograph of vocabulary cards: copyrightability recognized contrary to the court below!!

“By fanning out the second and subsequent vocabulary cards … so that each photograph is just visible, the image expresses that a different photograph is printed on each vocabulary card, and the white background has the effect of … making them stand out”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92728.pdf

[Editorial note: The original article image could not be retrieved; the photograph of the subject product reproduced in the judgment (Attachment “Defendant’s Image List 3”) is shown instead.]

IP High Court, 2022 (Gyo-Ke) No. 10099 [Laser Processing Apparatus] <Honda>

Original Ameblo publication: 2024-06-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854662370.html

2022 (Gyo-Ke) No. 10099 [Laser Processing Apparatus] <Honda>

* A feature whose presence in the primary cited invention was unclear was held not obvious to add!!

<Difference> The invention performs AF (autofocus) control, whereas this is unclear in the primary cited invention.

“It is not established that displacement in the Z-axis direction is of a degree that creates a problem of reduced quality”

(Excerpt from the judgment)

The disclosure … in Ko 1 does not establish that displacement in the Z-axis direction of the position where the modified region is formed, caused by warping of the silicon wafer or vibration of the X- and Y-axis stages, is of a degree that creates a problem of reduced quality. Thus, even in light of that passage, it cannot be said that a person skilled in the art would understand from Ko 1 that AF control of the focal point during processing would naturally be adopted in the Ko 1 invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92185.pdf

[Contract] IP High Court, 2020 (Ne) No. 10016 <Takabe>

Original Ameblo publication: 2024-06-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12854927653.html

[Contract] 2020 (Ne) No. 10016 <Takabe>

Joint-application agreement among four parties, A, B, C and D: “If any party newly acquires any of the rights at issue or engages in production or sales without prior consultation and permission, that party shall be deprived of the rights at issue.”

⇒ A sold products without permission: A lost its ownership share!!

⇒ B, C and D began selling: A could not enforce the rights because it had lost its share

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89675.pdf

IP High Court, 2013 (Gyo-Ke) No. 10228 [Method for Producing a Photocatalyst] * Agreement Concerning Technical Guidance and Ownership of Rights

Original Ameblo publication: 2024-06-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855061241.html

2013 (Gyo-Ke) No. 10228 [Method for Producing a Photocatalyst] * Agreement Concerning Technical Guidance and Ownership of Rights

The “Confirmation Regarding the Handling of Inventions Related to Technical Guidance” between the Saga Ceramics Research Laboratory and Tanaka Tensha provided for obtaining the consent of the governor of Saga Prefecture before filing an application for an independently made invention related to the technical guidance.

⇒ Although the plaintiffs did not obtain the governor’s consent when filing, this does not immediately mean that the right to obtain a patent belongs to the governor.

(All that remains is the question of whether the procedure requiring consent was breached.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84241.pdf

IP High Court, 2021 (Ne) No. 10086 [Lamp] <Honda> ≒ First Instance, Osaka District Court, 2017 (Wa) No. 1390: Prior Use Right Established

Original Ameblo publication: 2024-06-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855106770.html

2021 (Ne) No. 10086 [Lamp] <Honda> ≒ First Instance, Osaka District Court, 2017 (Wa) No. 1390

⇒ Having found variation in the prior-use products, the court recognized the adjustable range as the scope of the prior use right.

* The court mentioned that products worked before the filing date could be encompassed by the patented invention!

⇒ A prior use right is established even without recognition of the parameter

* This judgment has been described as recognizing prior use rights flexibly, and that may be true, but it can also be regarded as consistent with past case law.

① No court decision has required recognition of the parameter for a prior use right in a parameter invention.

In 2017 (Ne) No. 10090 [Pharmaceutical] <Takabe>, the court also noted in dictum that the prior user had not controlled the numerical value (moisture content), but Judge Takabe herself explains in an article that the judgment did not require recognition of the numerical value (moisture content).

https://jpaa-patent.info/patent/viewPdf/4366

② Although this was in the context of the completion of a publicly worked "invention," the Tokyo District Court, 2012 (Wa) No. 11800 [Polyimide Film] <Takano>, held as follows: while repeatability is necessary to say that an "invention" publicly worked has been completed, repeatability was satisfied in that case and public working was recognized. In that case, it was not necessary to have targeted the numerical values of the patented invention. ⇒ The present judgment (Lamp case) likewise identifies the range of variation of the prior-use products and finds that it falls entirely within the numerical range of the patented invention.

"... An 'invention' under Patent Act Article 2(1) is a highly advanced creation of technical ideas utilizing a law of nature. It therefore requires that a person skilled in the art be able to obtain the same result by repeatedly working the created technical subject matter, that is, that it be repeatable (Supreme Court, 1998 (Gyo-Tsu) No. 19 …). The defendant … manufactured 28 prior products falling within the technical scope of the prior invention, and the prior invention was repeatable, so it is clear that the defendant … had completed the prior invention. Certainly, as shown in the attached table, even within a single lot of the prior products, αMD was sometimes below 10 ppm/°C, or αTD was below 3 ppm/°C or above 7 ppm/°C. However, from the entire purport of the oral argument, this is found to have been merely because the defendant did not know the content of Invention 1 and was not targeting αMD of at least 10 ppm/°C and αTD of at least 3–7 ppm/°C. …

The plaintiff argues that the above transfers were for jointly developing polyimide film for COF and that the parties were subject to mutual confidentiality obligations. However, … an article submitted to an industry journal by Toray Industries, Inc., one of the copper-clad laminate manufacturers …, is found to state that a polyimide film with αTD lower than αMD is suitable for COF. In light of this fact, it is difficult to believe that the defendant and the copper-clad laminate manufacturers were subject to mutual confidentiality obligations."

③ Once a prior use right is established, past case law has been very flexible concerning its scope. Except for “encroachment” (2020 (Ne) No. 10004 [Light Irradiation Apparatus] <Otaka> = Osaka District Court, 2017 (Wa) No. 7532 <Sugiura>), modifications within the patented invention’s scope have been held to fall within the scope of prior use rights in the great majority of cases.

https://www.takaishihideki.com/_files/ugd/324a18_7d066756d0994288a8ad244cb6a66bd0.doc?dn=3%EF%BC%A8%EF%BC%B4%E3%80%80Rev.%E7%AC%AC%E4%B8%80%E6%B3%95%E8%A6%8F%EF%BC%88%E5%85%88%E4%BD%BF%E7%94%A8%E6%A8%A9%E3%80%802015%E5%B9%B4%EF%BC%89.doc

(Excerpt from the judgment / 2021 (Ne) No. 10086 [Lamp])

[Claim 1] … A lamp satisfying the relationship $y \geq 1.09x$, where y (mm) is the full width at half maximum of the luminance distribution obtained when the light of each of the plurality of LED chips passes through the outermost boundary of the lamp, and x (mm) is the spacing between the light-emission centers of adjacent LED chips.

… When the y/x values for the two LEDs positioned 25th and 50th from the left were measured for all 24 of the appellee’s 403W products, the 25th LED from the left had a minimum of 1.303, a maximum of 1.388, and mean-value 3σ values of 1.281 and 1.397, while the 50th LED from the left had a minimum of 1.297, a maximum of 1.381, and mean-value 3σ values of 1.272 and 1.403. Industrial products vary in quality for various reasons even when produced through the same production process, and the same is understood to hold for lighting fixtures. As described above, the appellee’s 403W products likewise exhibit variation in their numerical ranges. In addition, one commonly adopted quality-control method is understood to compare product inspection results with the required quality standard and keep the difference (manufacturing error) within three standard deviations (3σ). … In light of these matters, the measured y/x values of the appellee’s 403W products were approximately 1.27–1.38. As for 3σ, which takes ordinary manufacturing error into account, although the quality standard required of the 403W products is unknown, the measured mean can be regarded as that standard in light of ordinary control methods, and the y/x values of the appellee’s 403W products can be found to have been approximately 1.27–1.40. …

In light of the foregoing, the range of y/x values from above 1.4 to 1.7 or above 1.7, constituting the invention embodied in the 403W product, is a range that the appellee had realized by appropriately adjusting x and had brought under its own control. … Further, suppressing the dot-like appearance of LED lighting, which is the problem of each Invention 1, was a problem known to persons skilled in LED lighting before the priority date. Persons skilled in the art can be said to have manufactured lighting fixtures without a dot-like appearance through trial and error, without using the parameter at issue. Under such technological circumstances, where a mathematical formula is used to define an invention of a “product,” products worked or prepared for working before filing (the priority date) may fall within the technical scope defined by the formula of an invention subsequently filed and patented. The establishment of a prior use right should therefore not be denied merely because the appellee did not recognize the parameter at issue. …

https://www.ip.courts.go.jp/app/hanrei_jp/detail?id=6176

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93015.pdf

[Culpa in Contrahendo] Tokyo District Court, 1996 (Wa) No. 20909

Original Ameblo publication: 2024-06-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855357108.html

[Culpa in Contrahendo] Tokyo District Court, 1996 (Wa) No. 20909

No joint development agreement was concluded

— X completed development, but Y failed

— A time-limited memorandum was concluded; marketing activities premised on sales; Y’s letter of apology; Y’s error in selecting hardware; a year and a half of negotiations

⇒ X’s expectations deserved legal protection; claim for development expenses allowed

⇒ Reversed on appeal; lost 💦

home.j02.itscom.net/it-adr/Hanrei-Ichirann-HYOpage1.html

IP High Court, 2022 (Gyo-Ke) No. 10097 [Aminosilane] <Honda>

Original Ameblo publication: 2024-06-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855558148.html

2022 (Gyo-Ke) No. 10097 [Aminosilane] <Honda>

Even if a substance's name appears in a reference, disclosure is not recognized unless a person skilled in the art can work it without trial and error

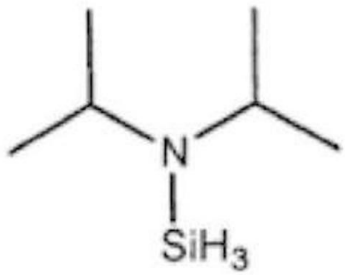
⇒ The mere ability to generalize a reaction formula is insufficient

= 2022 (Gyo-Ke) No. 10091 <Shoji>, 2022 (Wa) No. 9716 <Shibata> [5-Aminolevulinic Acid Phosphate]

1. Claims (Claim 1)

An aminosilane represented by the following formula.

[Chemical Formula 1]



2. Excerpts from the judgment

(1) Novelty

"... At least in chemistry, it may be possible to write a chemical formula or name of a chemical substance formally regardless of whether a method for its manufacture or other acquisition has been found. Accordingly, for a publication to disclose the technical idea constituting an invention of a chemical substance, it should generally be required not merely to disclose the substance's structure, but also to contain a description sufficient to understand its manufacturing method or another means of obtaining it. Where the publication does not contain a description sufficient to understand its manufacturing method or another means of obtaining it, a person skilled in the art encountering the publication must be able to find such a method on the basis of common general technical knowledge at the time of the patent application, without exercising creative ability through thought, trial and error, or the like. …

Although Ko 1 can be said substantially to state 'diisopropylaminosilane,' the name of a chemical substance corresponding to the formula 'SiH3[N(C3H7)2],' it contains no description sufficient to understand a manufacturing method or another means of obtaining it.

… Even if the reaction formula could be generalized, it cannot be found that a person skilled in the art could immediately understand how to synthesize compounds falling within its subordinate concepts, or that such methods were common general technical knowledge. …

Accordingly, 'diisopropylaminosilane' cannot be identified as the chemical substance of an invention described in Ko 1, constituting an 'invention described in a publication' under Patent Act Article 29(1)(iii). …

Even compounds that appear at first sight to be encompassed by the organic aminosilanes of the Ko 1 and Ko 1′ inventions are understood not to be encompassed by the organic aminosilanes of those inventions as inventions described in a publication if they do not satisfy the above prerequisite."

(2) Inventive step

"As examined above … although it was known before the priority date that dimethylaminosilane and diethylaminosilane could be manufactured, it was not known that diisopropylaminosilane could be manufactured or obtained. Even for a person skilled in the art with ordinary creative ability, it cannot be said to have been easy before the priority date to obtain the diisopropylaminosilane of Invention 1."

3. Some observations

This judgment denied qualification as a cited invention because, although the reference named the substance, a person skilled in the art could not work it without trial and error. It is consistent with the recent Tokyo District Court judgment, 2022 (Wa) No. 9716, "5-Aminolevulinic Acid Phosphate" <Presiding Judge Shibata>, and IP High Court judgment, 2022 (Gyo-Ke) No. 10091, "5-Aminolevulinic Acid Phosphate" <Presiding Judge Shoji>, and is important in practice.

In this case, the reference named the substance (the aminosilane of the invention), but a person skilled in the art at the priority date could not obtain or manufacture it without trial and error, so disclosure of the aminosilane in the reference was not recognized, or its qualification as a cited invention was denied.

Not only this judgment but also numerous other decisions require, for disclosure of a cited invention in a reference to be recognized, that a person skilled in the art be able to work (obtain or manufacture) the configuration, etc. of the invention without trial and error, on the basis of the reference's disclosure and common general technical knowledge. Applied to this case, at least a person skilled in the art must have been able to obtain or manufacture the invention's "aminosilane" without trial and error.

However, since the state of the art at the priority date made obtaining or manufacturing the invention's "aminosilane" difficult, novelty was recognized even though the reference named the substance. Inventive step was also recognized because a person skilled in the art at the priority date could not manufacture the compound. One should always bear in mind that, as in this case, even where a publicly known reference names the compound of the invention in words, it may be possible to argue that a person skilled in the art could not obtain or manufacture it without trial and error at the state of the art at the priority date. (This is akin to the requirement, for microorganism inventions, to deposit the microorganism under the "Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure," adopted in 1977, and make samples available upon request (Articles 27-2 and 27-3 of the Regulations under the Patent Act), because a person skilled in the art cannot necessarily obtain or culture the microorganism.)

In other words, at the state of the art on the filing date (priority date), a person skilled in the art could not obtain or manufacture the compound without trial and error, but the patent specification's disclosure enabled that person to manufacture it without trial and error (at least after publication of the application). This explains why novelty was not denied despite the invention's "aminosilane" being named in a publicly known reference, and why the enablement and support requirements were not at issue.

This situation is also useful when considering the different reference dates under the doctrine of equivalents. The third requirement concerns the ease of replacing the invention's configuration with the configuration of the accused product or process at the time of its manufacture or other relevant act. The fourth requirement, by contrast, is that the accused product or process was neither identical to nor easily conceivable from the prior art at the time of the patent application; the subject of the assessment is also different. Satisfaction of both requirements therefore cannot be explained solely by a change in the obviousness of the same subject matter between filing and manufacture.

However, according to the general proposition adopted in numerous decisions, including this one, even where a compound's name appears in a publicly known reference, novelty and inventive step are not immediately denied unless it can be proved that, at the state of the art on the filing date (priority date), a person skilled in the art could manufacture the compound without trial and error. Thus the first person to succeed in manufacturing a particular compound as part of a mixture can be granted a patent without isolating it and can enforce the right against someone who works a mixture containing that compound after filing. (This issue arose directly in the "5-Aminolevulinic Acid Phosphate" judgment cited above, rather than in the present judgment. That case involved an invention of a new substance made by converting known 5-aminolevulinic acid into a "phosphate," while the compound "5-aminolevulinic acid phosphate" itself was expressly named in a publicly known reference. For an invention whose technical significance is the first successful manufacture of the "phosphate," there may be debate over whether granting a patent as a product invention, rather than a manufacturing-method invention, strikes the proper balance, and whether it is appropriate to allow enforcement against an alleged infringer who manufactures, etc. a mixture containing the compound using a method other than the manufacturing method actually invented.)

(Note) Article 66(1) of the Patent Act provides that a patent right becomes effective upon registration of its establishment. Accordingly, a patent right can be enforced only after registration.

On this point, there may also be debate in relation to the public domain in a case such as the IP High Court judgment, 2007 (Gyo-Ke) No. 10378 [Crystalline Azithromycin Dihydrate]. The court held that the issue was whether, on the basis of the common general knowledge before the priority date, a person skilled in the art could understand that the cited reference described an identical product, rather than whether an identical product had in fact existed before that date; it did not find a lack of novelty. In light of that reasoning, if a substance is not in fact new and the inventor is merely the first to notice it, does granting a patent as a product invention strike the proper balance, and is it appropriate to allow enforcement against an alleged infringer who continues manufacturing and selling the prior art (= a product that in fact contained the substance although nobody had noticed it)?

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92666.pdf

Osaka District Court, 2019 (Wa) No. 5620 [… Power Generation Control System] <Takemiya>

Original Ameblo publication: 2024-06-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855682326.html

Osaka District Court, 2019 (Wa) No. 5620 [… Power Generation Control System] <Takemiya>

* Only the defendant can change the settings.

⇒ An accused product configured for dedicated use satisfies the “only” requirement.

“To change a specification once set, the only option is for the defendant … to perform the work using special tools and send the reconfigured device to the site”

(Excerpt from the judgment)

… Performing configuration work on the programs for Specifications ① through ③ installed in the accused product unlocks and activates one of the programs, but nobody other than defendant Field Logic can perform that work. To change a specification once set, the only option is for defendant Field Logic to perform the work using special tools and send the reconfigured device to the site. … Accused Product ②, in which the program for Specification ② was actually running, … is found to be used in the defendant’s system. It is impossible to continue using Accused Product ② while using it with the program for Specification ① or ③ operating; such use therefore cannot be called another use of Accused Product ②. … Indirect infringement under item (i) of that Article is established. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91085.pdf

Osaka District Court, 2021 (Wa) No. 4920 [Functional Water] <Takemiya> * Intention behind Numerical Values of Products in Public Use Not at Issue

Original Ameblo publication: 2024-06-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855815046.html

Osaka District Court, 2021 (Wa) No. 4920 [Functional Water] <Takemiya>

* The intention behind the numerical values of the publicly used products was not at issue.

* An invention reciting a function in the claims lacked novelty due to public use (analyzed like a use)

"The (old product) has a function of maintaining the freshness of fresh fish and was sold primarily for maintaining fish freshness"

(Excerpt from the judgment)

[Claim 1] "… the function is … at least one of maintaining the freshness of seafood or meat, aging seafood or meat, regulating plant growth, extending the life of cut flowers, regulating the flowering of cut flowers, exterminating pests, controlling Anisakis, antimicrobial activity, antiviral activity, reducing fecal odor, lowering blood pressure, raising body temperature, and improving the oral environment …"

The defendant provided one of the stored bottles … to Tosoh Analysis and Research Center, Ltd. The Center … analyzed it and found a weight-average molecular weight of 4.5×10^4. … Mugen Nanasei FISH (無限七星ＦＩＳＨ) has a function of maintaining the freshness of fresh fish and was sold primarily for maintaining fish freshness. Further, the evidence … and the entire purport of the oral argument establish that the ingredients of the old ATW sold by Liberal to the defendant were labeled "polymerized amine, water." …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91670.pdf

[United States] LG v. Immervision (CAFC, July 11, 2022)

Original Ameblo publication: 2024-06-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12855946712.html

[United States] LG v. Immervision (CAFC, July 11, 2022)

* Where a reference’s disclosure contains an obvious error, that disclosure cannot be used as a basis for obviousness.

⇒ In light of the major differences between the examples, it was unreasonable for Tables 3 and 5 to contain the same data.

In re Yale (1970) involved a typographical error. This case involved a copy-and-paste error in a table in the U.S. reference, also confirmed by comparison with the Japanese priority application; the same legal principle applied.

https://knpt.com/contents/cafc/2022.08.10.pdf

[United States] Salazar v. AT&T Mobility LLC (CAFC, April 5, 2023)

Original Ameblo publication: 2024-06-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856060548.html

[United States] Salazar v. AT&T Mobility LLC (CAFC, April 5, 2023)

“a microprocessor” means one or more

⇒ As a general rule, “said microprocessor” refers back to “a microprocessor” and retains its non-singular meaning.

Convolve decision: “a …” and “the …” must perform all steps

Varma decision: “a …” means one request

⇒ In this case, at least one microprocessor must be capable of performing all the recited functions.

* The choice between “a” and “said” depends on the claim as a whole; this decision does not establish a general rule against using “said.”

https://www.fukamipat.gr.jp/region_ip/9674/

[United States] Arbutus v. ModernaTX (CAFC, April 2023)

Original Ameblo publication: 2024-06-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856250601.html

[United States] Arbutus v. ModernaTX (CAFC, April 2023)

A composition having the lipid composition prepared by the DDM (manufacturing method) described in the prior reference necessarily possesses the invention's morphological property, so novelty was denied (regardless of whether that property could have been known).

(What is called an "invention in a publication in the broad sense" in Japan)

https://www.cafc.uscourts.gov/opinions-orders/20-1183.OPINION.4-11-2023_2108936.pdf

[Book] “The Strongest IP Management That Strategy Consultants Do Not Know” (Rikikazu Hayashi, Takahiro Shibuya) “An Offensive Open IP Strategy”

Original Ameblo publication: 2024-06-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856311150.html

[Book] “The Strongest IP Management That Strategy Consultants Do Not Know” (Rikikazu Hayashi, Takahiro Shibuya)

“An Offensive Open IP Strategy”

① Strong players (high technological capability) partner outside their corporate groups and build ecosystems

② Weaker players (high cost competitiveness) secure freedom to operate through cross-licensing

During its rapid-growth period, Japan surpassed Europe and the United States through ②

Later, Japan remained with ② and was overtaken by China, South Korea and Taiwan

Japan should pursue ①

https://www.amazon.co.jp/%E6%88%A6%E7%95%A5%E3%82%B3%E3%83%B3%E3%82%B5%E3%83%AB%E3%81%8C%E7%9F%A5%E3%82%89%E3%81%AA%E3%81%84-%E6%9C%80%E5%BC%B7%E3%81%AE%E7%9F%A5%E8%B2%A1%E7%B5%8C%E5%96%B6-%E6%9E%97%E5%8A%9B%E4%B8%80/dp/4296118269

IP High Court, 2022 (Gyo-Ke) No. 10003 [Method for Preventing Adhesion of Marine Organisms] <Kanno>

Original Ameblo publication: 2024-06-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856435347.html

2022 (Gyo-Ke) No. 10003 [Method for Preventing Adhesion of Marine Organisms] <Kanno>

* The secondary cited invention itself solves the problem of the primary reference and presupposes the use of a chlorine agent. There is therefore no motivation to replace the primary reference's available-chlorine-generating agent with chlorine dioxide and then additionally combine the secondary cited invention.

"The Ko 5 invention … itself solves … the problem of the Ko 1 invention …, so … there is no motivation … to combine the Ko 5 invention … with the Ko 1 invention."

<Decisions to the same effect>

2021 (Gyo-Ke) No. 10082 [Electrically Insulated Cable] <Shoji>

* Although the problem is common, the cited invention has already solved it by other means.

⇒ No motivation to further combine a secondary reference

= 2007 (Gyo-Ke) No. 10238

= 2012 (Gyo-Ke) No. 10328

= 2016 (Gyo-Ke) No. 10103

= 2017 (Gyo-Ke) No. 10013

(Excerpt from the judgment)

The Ko 5 invention … presupposes the problem that adding a chlorine agent in the Ko 1 invention generates trihalomethanes, and adopts the solution of dispersing a hydrogen peroxide agent at a particular concentration in an industrial seawater cooling system in advance and then adding a chlorine agent at a particular concentration; moreover, it specifies … for each particular concentration. … Thus the Ko 5 invention itself solves the above problem of the Ko 1 invention and presupposes use of a chlorine agent. Accordingly, a person skilled in the art cannot be said to have motivation to replace the available-chlorine-generating agent of the Ko 1 invention with chlorine dioxide and then additionally combine the Ko 5 invention. Furthermore, the Ko 5 reference does not contemplate adding chlorine dioxide and thus does not disclose a particular concentration ratio for chlorine dioxide. Therefore, a person skilled in the art could not easily have conceived of the numerical range at issue in Difference 1 by combining the Ko 1 invention with the Ko 5 reference.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92064.pdf

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2015 (Wa) No. 11753

Original Ameblo publication: 2024-06-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856560877.html

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2015 (Wa) No. 11753

“He himself took measures to keep the plaintiff’s customer information confidential … and, after resigning as representative director … promised not to divulge … information obtained during his tenure”

⇒ Secrecy-management requirement satisfied

“Secrecy management also extended to customer information memorized in his capacity as representative director”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87802.pdf

[Article] Relationship between Prior Art from Simultaneous Worldwide Publication and Time Differences, and the Grace Period (Patent, May 2023 issue, Janice Logan et al.)

Original Ameblo publication: 2024-06-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856700852.html

[Article] Relationship between Prior Art from Simultaneous Worldwide Publication and Time Differences, and the Grace Period (Patent, May 2023 issue, Janice Logan et al.)

Japan and South Korea assess novelty by “time of day”

The time of filing in Japan can be confirmed through a request under Patent Act Article 186(1)

Foreign public disclosures are compared using the time converted into Japanese time

https://jpaa-patent.info/patent/viewPdf/4206

[Article] Consumer Surveys for Proving Requirements under the Unfair Competition Prevention Act (2023, Yuriko Inoue)

Original Ameblo publication: 2024-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856817241.html

[Article] Consumer Surveys for Proving Requirements under the Unfair Competition Prevention Act (2023, Yuriko Inoue)

Measures to discourage guesses, such as providing a “don’t know” option, are necessary.

The article presents multiple survey methods for each of well-knownness, likelihood of confusion, and genericization, explaining their characteristics.

https://jpaa-patent.info/patent/viewPdf/4233

[Article] [India] Positive Judgments on Pre-Grant Amendments (Akiko Yamaguchi, Chizai Kanri 2024)

Original Ameblo publication: 2024-06-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12856946733.html

[Article] [India] Positive Judgments on Pre-Grant Amendments (Akiko Yamaguchi, Chizai Kanri, Vol. 74, No. 1, 2024)

NIPPON case <Delhi High Court>

An amendment changing a PBP claim to a method claim was held to be “within the scope of the claims of the specification before amendment.”

Allergan case <Delhi High Court>

The method-of-treatment claims could be changed to product claims, adding features that had not been recited in the original claims but had been disclosed in the original specification.

Vol. 74 Article Details | Chizai Kanri | Journal and Materials | Japan Intellectual Property Association (jipa.or.jp)

[Patents] Joint Ownership of Patent Rights and Unilateral Granting of Non-Exclusive Licenses (Comparison of Countries)

Original Ameblo publication: 2024-06-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12857130830.html

[Patents] Joint Ownership of Patent Rights and Unilateral Granting of Non-Exclusive Licenses (Comparison of Countries)

<Japan> No freedom to grant licenses

<Germany> Permitted with majority consent (majority by size of shares; limited to proper administration and use; BGB Section 745(1))

<United States> Freedom to grant licenses

No statutory provision on licensing to third parties (35 U.S.C. § 262 provides for the co-owners' own practice; licensing to third parties rests on case law: Ethicon, 135 F.3d 1456 (Fed. Cir. 1998)).

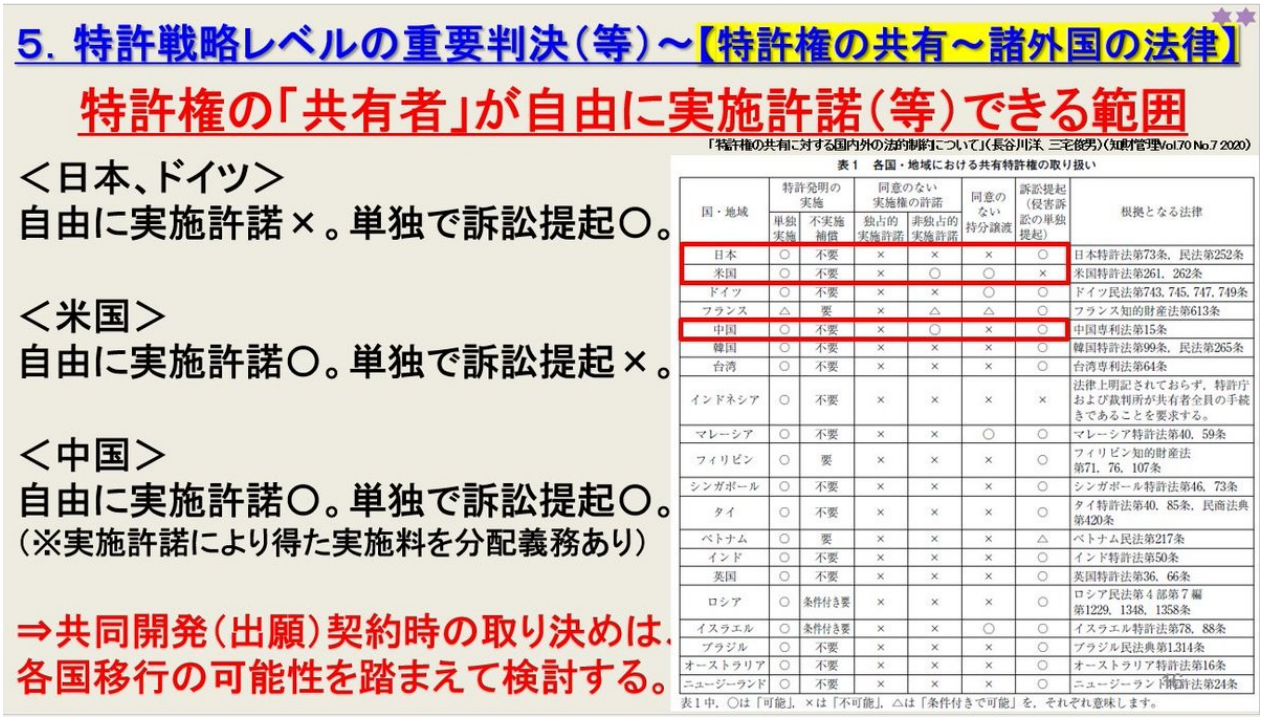
A co-owner cannot grant a license unilaterally if the co-owners have agreed otherwise.

<China> Freedom to grant licenses (non-exclusive licenses absent an agreement; Patent Law, Article 14)

* Obligation to distribute royalties received from licensing

<France> Non-exclusive licenses permitted, subject to equitable compensation of co-owners not working the invention and prior notice with an offer to assign the share; within three months of the notice, other co-owners may oppose by acquiring that share (IP Code, Article L613-29(c)).

Comparative chart on jointly owned patents (source published in 2020)



国・地域	特許発明の実施		同意のない実施権の許諾		同意のない持分譲渡	訴訟提起（侵害訴訟の単独提起）	根拠となる法律
	単独実施	不実施補償	独占的実施許諾	非独占的実施許諾			
日本	○	不要	×	×	×	○	日本特許法第73条，民法第252条
米国	○	不要	×	○	○	×	米国特許法第261，262条
ドイツ	○	不要	×	×	○	○	ドイツ民法第743，745，747，749条
フランス	△	要	×	△	△	○	フランス知的財産法第613条
中国	○	不要	×	○	×	○	中国専利法第15条
韓国	○	不要	×	×	×	○	韓国特許法第99条，民法第265条
台湾	○	不要	×	×	×	○	台湾専利法第64条
インドネシア	○	不要	×	×	×	×	法律上明記されておらず，特許庁および裁判所が共有者全員の手続きであることを要求する。
マレーシア	○	不要	×	×	○	○	マレーシア特許法第40，59条
フィリピン	○	要	×	×	×	○	フィリピン知的財産法第71，76，107条
シンガポール	○	不要	×	×	×	○	シンガポール特許法第46，73条
タイ	○	不要	×	×	×	○	タイ特許法第40，85条，民商法典第420条
ベトナム	○	要	×	×	×	△	ベトナム民法第217条
インド	○	不要	×	×	×	○	インド特許法第50条
英国	○	不要	×	×	×	○	英国特許法第36，66条
ロシア	○	条件付き要	×	×	×	○	ロシア民法第４部第７編第1229，1348，1358条
イスラエル	○	条件付き要	×	×	○	○	イスラエル特許法第78，88条
ブラジル	○	不要	×	×	×	○	ブラジル民法典第1.314条
オーストラリア	○	不要	×	×	×	○	オーストラリア特許法第16条
ニュージーランド	○	不要	×	×	×	○	ニュージーランド特許法第24条

English translation of the 2020 comparative slide

5. Important judgments (and other matters) at the patent-strategy level — Joint ownership of patent rights: laws of various countries.

Extent to which a “co-owner” of a patent right may freely grant licenses and take other actions.

<Japan, Germany> Freedom to grant licenses: no. Bringing an action alone: yes.

<United States> Freedom to grant licenses: yes. Bringing an action alone: no.

<China> Freedom to grant licenses: yes. Bringing an action alone: yes. *There is an obligation to distribute royalties obtained through licensing.

⇒ Arrangements in joint development (application) agreements should take account of the possibility of proceeding in each country.

Table 1. Treatment of jointly owned patents in each country or region (2020 chart)

Symbols: ○ = permitted; × = not permitted; △ = conditionally permitted. “Compensation” means compensation for a co-owner not working the patented invention.

Japan: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patent Act, Article 73; Civil Code, Article 252.

United States: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ○; assignment of a share without consent: ○; bringing an infringement action alone: ×. Legal basis: Patent Act, Sections 261 and 262.

Germany: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ○; bringing an infringement action alone: ○. Legal basis: Civil Code, Sections 743, 745, 747 and 749.

France: Working alone: △; compensation: Required; exclusive licensing without consent: ×; non-exclusive licensing without consent: △; assignment of a share without consent: △; bringing an infringement action alone: ○. Legal basis: Intellectual Property Code, Article 613.

China: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ○; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patent Law, Article 15.

South Korea: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patent Act, Article 99; Civil Act, Article 265.

Taiwan: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patent Act, Article 64.

Indonesia: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ×. Legal basis: Not expressly provided by statute; the Patent Office and courts require action by all co-owners..

Malaysia: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ○; bringing an infringement action alone: ○. Legal basis: Patents Act, Sections 40 and 59.

Philippines: Working alone: ○; compensation: Required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Intellectual Property Code, Sections 71, 76 and 107.

Singapore: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patents Act, Sections 46 and 73.

Thailand: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patent Act, Sections 40 and 85; Civil and Commercial Code, Section 420.

Vietnam: Working alone: ○; compensation: Required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: △. Legal basis: Civil Code, Article 217.

India: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patents Act, Section 50.

United Kingdom: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patents Act, Sections 36 and 66.

Russia: Working alone: ○; compensation: Conditionally required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Civil Code, Part IV, Section VII, Articles 1229, 1348 and 1358.

Israel: Working alone: ○; compensation: Conditionally required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ○; bringing an infringement action alone: ○. Legal basis: Patents Law, Sections 78 and 88.

Brazil: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Civil Code, Article 1314.

Australia: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patents Act, Section 16.

New Zealand: Working alone: ○; compensation: Not required; exclusive licensing without consent: ×; non-exclusive licensing without consent: ×; assignment of a share without consent: ×; bringing an infringement action alone: ○. Legal basis: Patents Act, Section 24.

[Article] “Determining Unreasonableness” in Providing Reasonable Benefits under Employee Invention Rules (Tatsuro Fujita, Chizai Kanri, Vol. 74, No. 1, 2024)

Original Ameblo publication: 2024-06-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12857330295.html

[Article] “Determining Unreasonableness” in Providing Reasonable Benefits under Employee Invention Rules (Tatsuro Fujita, Chizai Kanri, Vol. 74, No. 1, 2024)

2013 (Wa) No. 6158 examined whether the amount compensated for deficiencies in the “state of consultation,” “state of disclosure,” and “hearing of opinions,” but the appeal, 2014 (Ne) No. 10126, found it unreasonable “without even needing to examine the appropriateness of the calculation result.”

“Determining Unreasonableness” in Providing Reasonable Benefits under Employee Invention Rules | CiNii Research

Tokyo District Court, 2013 (Wa) No. 21383 <Shimasue>: Enforcement of Declared-Essential Patents, Abuse of Rights, and Notification of False Facts

Original Ameblo publication: 2024-06-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12857330513.html

Tokyo District Court, 2013 (Wa) No. 21383 <Shimasue>

Notification to the other party's customers that the patentee "has a right to seek an injunction" based on a declared-essential patent. Although the parties had remained far apart on license terms for a long period, the other party's willingness to take a license was not denied, and the circumstances were such that exercise of the right to seek an injunction was impermissible as an abuse of rights.

⇒ Constitutes notification of false facts

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84904.pdf

Tokyo District Court, 2013 (Wa) No. 21383 (February 18, 2015): Judgment

Osaka District Court, 2022 (Wa) No. 9521 [Thermoplastic Resin Composition]: Numerical Limitation — Rounding Argument Rejected, No Equivalence

Original Ameblo publication: 2024-06-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12857582824.html

Osaka District Court, 2022 (Wa) No. 9521 [Thermoplastic Resin Composition]

* Rounding was not allowed and the claim was not satisfied. No equivalence either

<Rounding argument>

"For significant figures … whether to use decimal places or, even for integers, the tens or hundreds place varies by field and purpose of use. … The defendant's UVA has a molecular weight of 699.91848 … and does not … have a molecular weight of 700 or more. …"

<Doctrine of equivalents>

For a numerically limited invention … in which setting a particular numerical value has significance, the patent is considered to have been granted by limiting the invention to technology within that numerical range. Accordingly, absent special circumstances, the limitation of the technical scope by that numerical value constitutes an essential part of the patented invention ⇒ No equivalence

(Excerpt from the judgment)

<Rounding argument>

… The plaintiff points out that, for UVA represented by the same molecular formula as the defendant's UVA, catalogs, other patent publications, etc. sometimes give its molecular weight as 700 … . However, there are also examples using "699.9" or "699.92" …, so it cannot be found to be common general technical knowledge among persons skilled in the art to round the calculated molecular weight of UVA to an integer. (The plaintiff itself admits that whether significant figures are expressed as integers, decimal places, or even tens or hundreds for integers varies by field and purpose of use.) … Accordingly, the defendant's UVA has a molecular weight of 699.91848 and is not a UVA with a "molecular weight of 700 or more" under Elements 1B and 6B. …

<Doctrine of equivalents>

… The essential part of the inventions is found to lie in enabling the provision of a resin composition with excellent heat resistance at the high temperature of 110°C or more, suppression of foaming and bleed-out during high-temperature molding, and reduction of problems caused by UVA volatilization, through the discovery that a UVA having a hydroxyphenyltriazine skeleton and a molecular weight of 700 or more is compatible with a thermoplastic acrylic resin having a ring structure in its main chain. … For an invention that limits its technical scope numerically (a numerically limited invention) and in which setting that numerical value has significance, the patent is considered to have been granted by limiting the invention to technology within that numerical range. Accordingly, absent special circumstances, the numerical limitation of the technical scope should be understood to constitute an essential part of the patented invention. The above examination shows that setting the molecular weight at "700 or more" has technical significance, and no such special circumstances are apparent in this case.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92802.pdf

[Unfair Competition Prevention Act] Tokyo District Court, 2022 (Wa) No. 14148 <Sugiura> ⇛ No Breach of Duty to Clarify the Specific Manner of Conduct

Original Ameblo publication: 2024-06-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12857834321.html

[Unfair Competition Prevention Act] 2022 (Wa) No. 14148 <Sugiura> ⇒ No Breach of Duty to Clarify the Specific Manner of Conduct

"… To be entitled to demand clarification of the specific manner of conduct, from the standpoint of deterring abusive or exploratory litigation and the like, corroboration sufficient to make filing suit, etc. prima facie reasonable is required, taking into account the nature and content of the case and other circumstances"

⇒ The plaintiff's experiments were inappropriate

⇒ No breach of the duty to clarify the specific manner of conduct

* This is also consistent with the approach under Patent Act Article 104-2!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92092.pdf

Hideki Takaishi Article Collection

July–December 2024

English Edition

167 articles

Complete English translations of the revised Ameblo articles

In chronological order of the original Ameblo publication date

Existing website text is retained wherever available; missing articles are supplied from the original Ameblo posts and new complete English translations. Source URLs reflect information verified at compilation on November 1, 2026.

Confirmed errors in wording, legal descriptions, and translations have been corrected. Unless otherwise stated, descriptions of legal rules, outlooks, and statistics reflect the time when each original article was published.

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67 2024-09-08 Osaka District Court, 1998 (Wa) 7191 [Ink Tube for a Writing Instrument] *A case in which adding another substance to an otherwise infringing accused product resulted in noninfringement!!

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75 2024-09-16 [U.S.] November 2015 <CAFC> 805 F.3d 1350, Inphi v. Netlist

76 2024-09-17 [U.S.] June 2014 <CAFC> 752 F.3d 1371, Q.I. Press Controls v. Lee

77 2024-09-18 [U.S.] January 2020 <CAFC> 946 F.3d 1367, Eko Brands v. Adrian Rivera

78 2024-09-18 [U.S.] January 2013 <CAFC> Ernie Ball v. Earvana

79 2024-09-18 [U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

80 2024-09-20 [U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

81 2024-09-21 [Trademark] IP High Court, 2023 (Gyo-Ke) 10018, “プレジャー” (“Pleasure”) <Shoji>

82 2024-09-22 Tokyo District Court, 2022 (Wa) 18830 [Rolling Device] <Shibata>

83 2024-09-24 IP High Court, 2023 (Gyo-Ke) 10013 [Method of Manufacturing a Pole Housing] <Hibiku Shimizu>

84 2024-09-24 [U.S./Trademark] U.S. Supreme Court, June 2023, Abitron v. Hetronic

85 2024-09-25 IP High Court, 2022 (Gyo-Ke) 10131 [Heat Exchanger Using Thermally Conductive Knitted Wire Fabric] <Honda>

86 2024-09-26 IP High Court, 2021 (Ne) 10084 [Printed Retroreflective Sheeting] <Miyasaka> — First Raised on Appeal: Rejected as Untimely

87 2024-09-28 IP High Court, 2023 (Gyo-Ke) 10011 [Device for Remotely Operating a Mobile Terminal] <Miyasaka>

88 2024-09-30 [Patent/Civil Code] Tokyo District Court, 2022 (Wa) 19222 <Kokubu> — Analogous Application of Civil Code Article 94(2)

89 2024-09-30 IP High Court, 2022 (Gyo-Ke) 10124 [Robot System for Transferring Egg Packs] <Miyasaka>

90 2024-10-01 Nepal Tiger — Distinctive; Article 4(1)(xvi) Not Applicable / Tibet Tiger — Not Distinctive

91 2024-10-03 For Patent Attorney Oral-Examination Candidates — Questions on Legislative Purpose (Patents)

92 2024-10-04 [U.S.] May 2024, In re Bystolic (Second Circuit Court of Appeals)

93 2024-10-07 [U.S./Design Patent] May 2024, CAFC en banc, LKQ v. GM Global

94 2024-10-07 IP High Court, 2023 (Gyo-Ke) 10084 and 10089 [Electric Impact Tightening Tool] <Hibiku Shimizu>

95 2024-10-07 IP High Court, 2021 (Ne) 10086 [Lamp] <Honda> *Prior-use right established

96 2024-10-08 Tokyo District Court, 2021 (Wa) 18031 [Mobile Phone; Receiving Apparatus] <Kokubu>

97 2024-10-09 IP High Court, 2024 (Gyo-Ke) 10002 [Nonwoven Fabric for Civil Engineering] <Shoji>

98 2024-10-10 IP High Court, 2023 (Gyo-Ke) 10002 [Light Source Unit] <Honda>

99 2024-10-11 IP High Court, 2023 (Gyo-Ke) 10056 [Hydrophilic Filtration During Manufacture of a Vaccine Adjuvant] <Hibiku Shimizu>

100 2024-10-12 Tokyo District Court, 2019 (Wa) 24736 [… Air-Conditioned Clothing] <Kokubu>

101 2024-10-16 IP High Court, 2023 (Ne) 10086 [5-Aminolevulinic Acid Phosphate] <Miyasaka>

102 2024-10-17 IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Fiber Sheet] <Hibiku Shimizu>

103 2024-10-21 IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu> — Inventive-Step Assessment and Scope of Res Judicata

104 2024-10-21 IP High Court, 2023 (Gyo-Ke) 10015 [Method of Manufacturing a Refractory for a Gas-Blowing Nozzle] <Shoji>

105 2024-10-21 IP High Court, 2023 (Gyo-Ke) 10049 [Optical Imaging Apparatus] <Miyasaka>

106 2024-10-22 IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji> — Design Matters and Motivation

107 2024-10-23 Osaka District Court, 2021 (Wa) 2873 [Apparatus for Dehairing Blocks of Edible Livestock Meat] — Damages: Noncompliance with a Document-Production Order

108 2024-10-24 IP High Court, 2022 (Gyo-Ke) 10123 [Laser Processing Apparatus] <Miyasaka>

109 2024-10-25 IP High Court, 2022 (Gyo-Ke) 10057 and 10054 [Lamp] <Honda> — Support Requirement Satisfied

110 2024-10-26 IP High Court, 2023 (Gyo-Ke) 10101 [Authentication Certification System] <Shoji>

111 2024-10-28 [Article/Unfair Competition Prevention Act] On the Usefulness and Nonpublic Nature of Trade Secrets—The Tin-Alloy Composition Case … Osaka District Court, 2014 (Wa) 11151, “Tin Alloy”

112 2024-10-29 IP High Court, 2023 (Gyo-Ke) 10145 [Light-Emitting Device] <Miyasaka> — Addition of New Matter

113 2024-10-30 [Unfair Competition Prevention Act/Communication of False Facts] Tokyo District Court, 2021 (Wa) 22564 <Kokubu>

114 2024-10-31 Tokyo District Court, 2021 (Wa) 15964 [Elastoplastic Hysteretic Damper] <Shibata>

115 2024-11-01 [Copyright] Tokyo District Court, 2023 (Wa) 70422 <Sugiura>

116 2024-11-05 [New YouTube Video] Infringement Analysis and Claim Construction / Wins + Losses (Reading the Fourth Edition Together, Part 3), September 11, 2024

117 2024-11-05 Osaka District Court, 2023 (Wa) 3375 [Canopy]

118 2024-11-05 IP High Court, 2023 (Ne) 10071 [Chip Fuse] <Miyasaka>

119 2024-11-05 German Patent Attorney Kan Hasegawa: “Has the UPC Abandoned the Problem–Solution Approach?”

120 2024-11-07 IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu>

121 2024-11-10 IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji> — Relationship between Identification of the Cited Invention and Addition of New Matter

122 2024-11-11 [Germany/AI Inventorship]

123 2024-11-12 Tokyo District Court, 2022 (Wa) 9100 [Method of Manufacturing a Molded Coil] <Shibata>

124 2024-11-13 IP High Court, 2023 (Gyo-Ke) 10098 [Laundry Detergent Composition] <Shoji>

125 2024-11-14 Tokyo District Court, 2023 (Wa) 70454 [Method of Providing a Testing and Analysis Service] <Kokubu>

126 2024-11-15 IP High Court, 2022 (Gyo-Ke) 10003 [Method of Preventing Attachment of Marine Organisms] <Kanno>

127 2024-11-16 IP High Court, 2023 (Ne) 10047 [Nursing Unit] <Miyasaka>

128 2024-11-17 IP High Court, 2023 (Gyo-Ke) 10023 [Aircraft Such as High-Speed Drones] <Miyasaka>

129 2024-11-18 IP High Court, 2022 (Gyo-Ke) 10108 [High-Dynamic-Range Tone Mapping] <Honda>

130 2024-11-20 IP High Court, 2019 (Gyo-Ke) 10022 [Optical Information Reading Apparatus] <Takabe>

131 2024-11-21 IP High Court, 2010 (Gyo-Ke) 10400 <Iimura>

132 2024-11-22 [Trademark] IP High Court, 2024 (Gyo-Ke) 10003 <Miyasaka>

133 2024-11-25 [Trademark] Osaka District Court, 2022 (Wa) 9818 — “熱中対策応急キット” (“Emergency Heat Countermeasure Kit”) ⇒ No Distinctiveness

134 2024-11-25 [U.S.] IOENGINE v. Ingenico (CAFC, May 3, 2024)

135 2024-11-25 [Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2020 (Wa) 12387

136 2024-11-27 [Unfair Competition Prevention Act Article 2(1)(i)] Tokyo District Court, 2023 (Wa) 70654 <Nakashima>

137 2024-11-28 IP High Court, 2023 (Gyo-Ke) 10019 [Method of Treating Atopic Dermatitis by Administering an IL-4R Antagonist] <Miyasaka>

138 2024-11-30 IP High Court, 2023 (Gyo-Ke) 10146 [Label Insertion Apparatus] <Honda>

139 2024-12-02 IP High Court, 2022 (Gyo-Ke) 10011 [Electrical Device Formed from Very Low Resistance Material] <Shoji>

140 2024-12-02 IP High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

141 2024-12-03 IP High Court, 2021 (Gyo-Ke) 10089 [Transdermal Absorption Preparation] <Kanno>

142 2024-12-04 IP High Court, 2022 (Gyo-Ke) 10018 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

143 2024-12-05 IP High Court, 2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy] <Honda>

144 2024-12-06 IP High Court, 2021 (Gyo-Ke) 10165 [Delivered-Package Storage Apparatus] <Shoji>

145 2024-12-07 IP High Court, 2021 (Gyo-Ke) 10069 [PTH-Containing Agent for Treating/Preventing Osteoporosis] <Kanno>

146 2024-12-10 IP High Court, 2021 (Gyo-Ke) 10080 [Graphic Display Medium] <Honda>

147 2024-12-10 IP High Court, 2020 (Gyo-Ke) 10071 [Agent for Treating/Preventing Osteoporosis] <Kanno>

148 2024-12-10 IP High Court, 2021 (Gyo-Ke) 10072 [Amplifier Output Circuit] <Honda>

149 2024-12-10 IP High Court, 2021 (Gyo-Ke) 10068 [Ball Game Machine] <Otaka>

150 2024-12-11 Tokyo District Court, 2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

151 2024-12-12 IP High Court, 2021 (Gyo-Ke) 10123 [Tableware] <Otaka>

152 2024-12-13 IP High Court, 2021 (Gyo-Ke) 10097 <Otaka> — General Principles for Amendments Adding Claims

153 2024-12-14 IP High Court, 2021 (Gyo-Ke) 10006 [X-Ray Inspection Apparatus] <Kanno>

154 2024-12-15 IP High Court, 2020 (Gyo-Ke) 10134 [System for Controlling Distribution and Viewing of Digital Art over the Internet and for Image Formation] <Mori>

155 2024-12-16 IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

156 2024-12-17 IP High Court, 2020 (Gyo-Ke) 10110 [Method of Strengthening Blood Vessels] <Kanno>

157 2024-12-18 IP High Court, 2020 (Gyo-Ke) 10032 [Imaging Apparatus] <Kanno>

158 2024-12-19 [Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2015 (Wa) 4169, “Alumina Fiber”

159 2024-12-21 [Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2000 (Wa) 22457, “Temporary Staff List” — Secrecy Management Satisfied

160 2024-12-22 [Unfair Competition Prevention Act/Trade Secrets] Yokohama District Court, 2018 (Wa [criminal]) 1931 (criminal case) ⇒ Guilty

161 2024-12-23 [Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2006 (Wa) 29160, “Coenzyme Q”

162 2024-12-24 [Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2009 (Wa) 47959, “Stroopwafel”

163 2024-12-25 [Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2016 (Wa) 26919, “Eyelash Treatment Know-How”

164 2024-12-26 [Unfair Competition Prevention Act/Trade Secrets] IP High Court, 2019 (Ne) 10016, “Eyelash Extension Treatment Histories”

165 2024-12-27 IP High Court, 2015 (Gyo-Ke) 10095 [Fuel-Consumption Reduction Device for an Internal Combustion Engine] <Shitara>

166 2024-12-28 IP High Court, 2014 (Gyo-Ke) 10186 [Circular Knitting of Elastic Fabric Containing Elastomeric Yarn] <Shimizu>

167 2024-12-30 IP High Court, 2017 (Gyo-Ke) 10075 […Exercise Bike] <Mori>

IP High Court, 2023 (Gyo-Ke) 10057 [Spray Products] <Honda>

Original Ameblo publication: 2024-07-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858278372.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858278372-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858278372-ja

IP High Court, 2023 (Gyo-Ke) 10057 [Spray Products] <Honda>

Examples were added at the time of filing Priority Application 2 for a compound that had been recited in the claims of the Priority Application 1 specification but for which no examples had been provided.

⇒ The claim to priority based on Priority Application 1 was upheld.

The Priority Application 1 specification explained that the compound shared a common mechanism with another compound described in the examples in Specification 1.

* The Artificial Nipple case involved an application filed by another party during the priority period. Had the intervening act instead been another party's public working or publication, it would probably have raised an issue of partial priority, as in the Brunnian Link case.

* In the United States as well, Ian Frazer v. Richard Schlegel (CAFC, August 20, 2007) recognized the effect of priority and the applicant's status as the first inventor for an invention in an application claiming Paris Convention priority in which examples had been added, even though another party had filed an application within the priority period. (Patent, 2024, Vol. 77, No. 7, p. 153)

(Excerpts from the court's reasoning)

… Although the only examples described in the specification and other documents of Priority Application 1 are spray products containing EBAAP as the insect-repellent ingredient, and examples relating to spray products containing icaridin as the insect-repellent ingredient were added in the specification and other documents of Priority Application 2 …, those examples are concrete examples of working Corrected Invention 1 at issue and can also be understood as confirmatory descriptions of concrete examples of working the invention whose defining features had been recited in Claim 1 or 2 of the claims of Priority Application 1. They therefore cannot be said to introduce new technical matters in relation to the technical matters disclosed in the specification and other documents of Priority Application 1. …

In addition to the background art, problem, and means for solving the problem relating to Corrected Invention 1 at issue, the specification and other documents of Priority Application 1 describe the mechanism underlying the effects of the invention and the technical significance of each constituent feature. It can also be understood that these apply in common to EBAAP, p-menthane-3,8-diol, and icaridin. In other words, it is recognized that the specification and other documents of Priority Application 1 set out the technical content of Corrected Invention 1 at issue, including the portion in which the insect-repellent ingredient is icaridin, in a sufficiently concrete and objective form that a person having ordinary knowledge in the relevant technical field (a person skilled in the art) could repeatedly work the invention and achieve its intended technical effects.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92886.pdf

“Dr. Martens’ Yellow Stitching” [Trademark] IP High Court, 2023 (Gyo-Ke) 10003 [Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10048

Original Ameblo publication: 2024-07-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858278614.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858278614-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858278614-ja

“Dr. Martens' Yellow Stitching”

[Trademark] IP High Court, 2023 (Gyo-Ke) 10003 <Honda>

⇒ Lost

The position mark lacks distinctiveness.

The only evidence concerned products that were black apart from the stitching, so Article 3(2) was also not satisfied.

[Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10048 <Miyasaka>

⇒ Won

Well-known status and similarity under Article 2(1)(i) of the Unfair Competition Prevention Act: satisfied

Unlike the first-instance court, the court treated it as an “indication of goods or business” in combination with other features!!

IP High Court, 2023 (Gyo-Ke) 10020 [Steel Pipe Pile Pier] <Honda>

Original Ameblo publication: 2024-07-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858354238.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858354238-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858354238-ja

IP High Court, 2023 (Gyo-Ke) 10020 [Steel Pipe Pile Pier] <Honda>

*Although the specification described only examples under particular conditions, the court held, in light of the problem addressed by the invention, that "a person skilled in the art can … take other conditions into account and appropriately incorporate the above technical concept to solve the problems addressed by each invention at issue."

⇒ Support requirement: satisfied

*The court rejected obviousness of locally increasing strength at particular locations.

⇒ Inventive step: satisfied

(Excerpts from the court's reasoning)

<Support requirement: satisfied>

The defendant argues that the specification merely states that verification was performed through seismic response analysis (simulation) under particular conditions (number of rows of steel pipe piles, water depth, ground structure, wall thickness and diameter of the steel pipe piles), and that it cannot be understood that adopting the numerical range for curvature φp would solve the problem under different conditions as well. Naturally, the ground and other circumstances where steel pipe pile piers are installed vary, and their performance must be verified by an appropriate method suited to the circumstances. What the specification discloses, however, is the technical concept of locally using steel pipe piles having deformation capacity of at least a specified value only at portions of the piles where the generated curvature is large in the underground portions of at least the piles positioned facing the landward side. When actually conducting performance verification such as seismic response analysis, a person skilled in the art who encounters this disclosure can take other conditions into account and appropriately incorporate that technical concept to solve the problems addressed by each invention at issue. Thus, the mere fact that only results under particular conditions are described does not provide a reason to conclude that the inventions fail to satisfy the support requirement….

<Inventive-step requirement: satisfied>

(Difference 3A) The "steel pipe piles" of Invention 3 are such that "among the steel pipe piles constituting the row of steel pipe piles, portions where the generated curvature is large in the underground portions of at least the steel pipe piles positioned facing the landward side, where the curvature arising in the piles in response to an external force is large, satisfy the relationship $\varphi p \geqq 5.65 \times 10^{-3}/D$ between the diameter D of the steel pipe piles and the curvature φp corresponding to their fully plastic moment, while the other portions of the underground portions of the steel pipe piles have lower deformation capacity than those

portions," whereas it is unclear whether the "steel pipe piles 9" of the invention in Exhibit Ko 1 have that configuration. …

…Even if ordinary design practice could involve progressively increasing the strength of steel pipe piles based on seismic response analysis results without using the curvature condition formula, it cannot be said that this would naturally lead further to locally placing high-strength steel pipe piles only at portions where the generated curvature is large. At least, it must be said that it is difficult to conclude that the configurations relating to Difference 3A or 3B could have been readily conceived.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92697.pdf

[Patent/Employee Invention] IP High Court, 2023 (Ne) 10090 <Hibiku Shimizu> — (Joint) inventor status denied

Original Ameblo publication: 2024-07-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858472717.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858472717-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858472717-ja

[Patent/Employee Invention] IP High Court, 2023 (Ne) 10090 <Hibiku Shimizu>

The contribution was only to a part found in the prior art.

⇒ (Joint) inventor status: denied <recognized in the original judgment>

Although preliminary experiments were conducted on formulating orally disintegrating (OD) tablets, it cannot be said that the person recognized concrete methods for establishing the components and structures of the controlled-release microparticles and the like, and of the OD tablets incorporating them.

https://www.tokkyoteki.com/2024/06/2024-03-25-r5-ne-10090.html

IP High Court, 2022 (Gyo-Ke) 10127 [Celecoxib] <Miyasaka> (Second judgment) — Correction satisfies support; clarity not satisfied

Original Ameblo publication: 2024-07-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858605429.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858605429-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858605429-ja

IP High Court, 2022 (Gyo-Ke) 10127 [Celecoxib] <Miyasaka> (Second judgment)

***The correction satisfied the support requirement. Clarity: not satisfied**

"Even when attempting to apply common general technical knowledge, there is not even a clue as to which characteristics should be considered in deciding …." Before even considering impossible or impractical circumstances … clarity is lacking.

(Excerpt from the court's reasoning)

…The specification does not describe what action of the pin mill achieves the low cohesiveness and reportedly improved blend uniformity of "celecoxib particles milled in a pin mill." It is therefore also unclear whether these properties are achieved by impact mills generally, or only by those impact mills sharing some characteristic with a pin mill. Consequently, it must be said that, even when attempting to apply common general technical knowledge, there is not even a clue as to which characteristics should be considered in deciding whether a particular impact mill is an "impact mill such as a pin mill" within the pin-mill limitation at issue. …Before even considering impossible or impractical circumstances, …the manufacturing method itself recited in the claims lacks clarity….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92858.pdf

IP High Court, 2023 (Ne) 10071 [Chip Fuse] <Miyasaka> — No equivalence

Original Ameblo publication: 2024-07-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858729219.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858729219-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858729219-ja

IP High Court, 2023 (Ne) 10071 [Chip Fuse] <Miyasaka>

⇒ **Doctrine of equivalents: not established** (same result as the first-instance Osaka District Court judgment, 2021 (Wa) 10032)

"There is ample motivation to apply to the invention in Exhibit Otsu 1 the configuration of the invention in Exhibit Otsu 3 in which 'the fuse element portion and external electrodes are formed of an integral metal.'"

⇒ The fourth requirement was applied using the same logic as inventive step.

*The first-instance Osaka District Court judgment, 2021 (Wa) 10032 <Takemiya>, is important in holding that equivalence can be established even when some claim elements are absent.

⇒ The conclusion was no equivalence (second requirement not satisfied). The case became a battle of experiments, and identical functions and effects were not found.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92795.pdf

IP High Court, 2023 (Gyo-Ke) 10046 [Liquid Cleansing Agent for Removing Keratin Plugs] <Miyasaka>

Original Ameblo publication: 2024-07-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858971879.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858971879-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858971879-ja

IP High Court, 2023 (Gyo-Ke) 10046 [Liquid Cleansing Agent for Removing Keratin Plugs] <Miyasaka>

*In assessing inventive step, a disclaimer claim was equated with an affirmative numerical limitation.

Cf. IP High Court, 2022 (Gyo-Ke) 10125: addition of new matter

*“Excluding those having 0–10 vol%”

⇒ It suffices to examine whether adopting more than 10 vol% could have been readily conceived.

*The infringement action, IP High Court, 2022 (Ne) 10029 <Otaka> = first-instance Tokyo District Court judgment, 2020 (Wa) 22071 <Kokubu>, found a violation of the support requirement.

(Excerpt from the court's reasoning)

…The limitation “excluding those having 0–10 vol%” in the disclaimer configuration at issue defines the range obtained by “excluding those having 0–10 vol%” from “0–100 vol%.” Ultimately, it means nothing other than a range of “more than 10 vol%” (“incorporating more than 10 vol%”). Accordingly, in assessing the obviousness of the configuration, it suffices to examine whether a rationale can be established that a person skilled in the art could readily have conceived of making the amount of surfactant incorporated in the invention in Exhibit Ko 1 “more than 10 vol%” (“incorporating more than 10 vol%”). …The position might be different if the numerical limitation in the disclaimer configuration had a remarkable effect, but the invention at issue is not found to be such an invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92623.pdf

IP High Court, 2023 (Gyo-Ke) 10054 [Protective Member] <Shoji> — Different from the premise of the publicly worked invention ⇛ Inventive step satisfied

Original Ameblo publication: 2024-07-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12858973126.html

HP: https://www.takaishihideki.com/single-post/ameblo-12858973126-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12858973126-ja

IP High Court, 2023 (Gyo-Ke) 10054 [Protective Member] <Shoji>

Contrary to the “premise” of the publicly worked invention (Exhibit Ko 8), “It can be said that providing a grip portion on the safety cover for carts (protective member) of the invention in Exhibit Ko 8 is not contemplated at all.”

⇒ Inventive step: satisfied

+The statement of the president of the manufacturer of the publicly worked product was also ineffective: priority was given to the objective understanding derived from the brochure.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92759.pdf

[U.S./Lanham Act—False Advertising] Supreme Court No. 12-761, POM v. COCA-COLA (June 12, 2014)

Original Ameblo publication: 2024-07-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859099740.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859099740-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859099740-ja

[U.S./Lanham Act—False Advertising] Supreme Court No. 12-761, POM v. COCA-COLA (June 12, 2014)

The Lanham Act false-advertising claim concerning the food and beverage label at issue is not precluded by the FDCA (Federal Food, Drug, and Cosmetic Act) or FDA (Food and Drug Administration) regulations. The statutes serve different purposes and complement each other.

The FDCA's express pre-emption provision concerning state law does not preclude this claim under the Lanham Act, another federal statute. The decision does not establish a general rule that one federal statute can never preclude claims under another.

https://www.jpaa.or.jp/cms/wp-content/uploads/2017/03/POM-Wonderful-v-Coca-Cola.pdf

IP High Court, 2022 (Gyo-Ke) 10110 [Steel Pipe Sheet Pile Quay] <Miyasaka> — Obviousness of a mathematical formula at issue

Original Ameblo publication: 2024-07-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859226993.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859226993-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859226993-ja

IP High Court, 2022 (Gyo-Ke) 10110 [Steel Pipe Sheet Pile Quay] <Miyasaka>

***The issue was the obviousness of a mathematical formula.**

⇒ Inventive step: satisfied

"Exhibit Ko 1 … merely shows that a configuration relating to the formula for ρ … is theoretically possible … it is not found that deriving the formula for ρ … was easy … and this does not negate the inventive step of the configuration relating to the formula for ρ, which is a numerically limited invention."

*For parameter/numerically limited inventions, merely showing that a mathematical formula is theoretically possible cannot negate inventive step!!

(Excerpt from the court's reasoning)

In light of the common general technical knowledge at the time of the patent application …, it is difficult to find that an object satisfying the formula for ρ could reasonably have been designed using steel with a higher yield strength than SKY490 without using that formula; the existence of such an abstract possibility does not negate the inventive step of the configuration relating to the formula for ρ, which is a numerically limited invention. Figure 6.9 of Exhibit Ko 1 is found to apply irrespective of whether the piles are steel sheet piles or steel pipe sheet piles, just as the graph in Figure 2 applies to steel pipe sheet piles. However, this merely indicates that a steel pipe sheet pile quay satisfying the configuration relating to the formula for ρ is theoretically possible. It is not found that a person skilled in the art could readily have derived the formula for ρ from the graph in Figure 6.9 …, and this does not negate the inventive step of the configuration relating to the formula for ρ, which is a numerically limited invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92832.pdf

Osaka District Court, 2003 (Wa) 10959 [Aluminum-Based Sputtering Target Material] <Yamada>

Original Ameblo publication: 2024-07-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859340371.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859340371-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859340371-ja

Osaka District Court, 2003 (Wa) 10959 [Aluminum-Based Sputtering Target Material] <Yamada>

To determine whether a target material satisfies a numerical limitation, if it is homogeneous, satisfaction can be proved by observing part of the microstructure of the product concerned, some of the products, or offcuts.

(However, this was in the context of a prior-use invention.)

Cf. IP High Court, 2023 (Ne) 10026

(Excerpt from the court's reasoning)

…To determine whether a target material satisfies …, it is sufficient to observe the microstructure of a portion, without observing its entire surface…. Furthermore, where multiple target materials are manufactured using the same manufacturing method and conditions, whether … is satisfied by the other target materials as well can be determined from the observation of some of them. Moreover, if offcuts generated during manufacture can be said to have a microstructure substantially homogeneous with that of target materials manufactured from the same parent rolled plate, observations of those offcuts can be used to determine whether … is satisfied by the target materials manufactured from that same parent rolled plate…. This is because, in industrial practice, observing the microstructure over the entire surface area of target materials that become products … using an optical microscope must be considered practically impossible in the first place. Moreover, observing a target material's microstructure with an optical microscope involves destructive inspection, including polishing its surface …; performing such inspection on a product before shipment would make it unshippable. Thus, it should be understood that observing only part of the surface of some of the multiple final products manufactured using the same method and conditions suffices for microstructural observation. …Even offcuts, insofar as their microstructure is substantially homogeneous with that of the target material that became the product, do not differ in essence from samples obtained from the product target material. Accordingly, observing such offcuts can also be used to determine whether … is satisfied by the final-product target material….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9731.pdf

IP High Court, 2023 (Ne) 10026 [Belt for a Shoe Press] <Miyasaka> (First instance: Osaka District Court, 2017 (Wa) 4178)

Original Ameblo publication: 2024-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859462217.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859462217-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859462217-ja

IP High Court, 2023 (Ne) 10026 [Belt for a Shoe Press] <Miyasaka>

(First instance: Osaka District Court, 2017 (Wa) 4178)

The appellant argues that Ra of 2.0 μm or less "over the entire length" of the drainage groove is unrealistic. However, the claims contain no language that should be interpreted to include cases in which some portions exceed 2.0 μm or the average value is 2.0 μm or less.

(Excerpt from the first-instance Osaka District Court judgment, 2017 (Wa) 4178)

Claim element 2B provides "characterized in that the surface roughness of the wall surface of the drainage groove is 2.0 μm or less in terms of arithmetic average roughness (Ra)," and the other claim elements likewise impose no limitation on the extent, proportion, or the like for which the surface roughness must be 2.0 μm or less. Specification 2 also contains no statement limiting the extent or proportion for which the surface roughness must be 2.0 μm or less, or describing conditions under which the same functions and effects as those obtained at 2.0 μm or less are achieved even where the surface roughness exceeds 2.0 μm. Accordingly, it is appropriate to construe "the surface roughness of the wall surface of the drainage groove is 2.0 μm or less in terms of arithmetic average roughness (Ra)" in claim element 2B literally as requiring that the wall surface roughness be 2.0 μm or less in terms of arithmetic average roughness (Ra) over the entire length of the drainage groove….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92751.pdf

[Article] Recent Trends in Academic Views and Case Law on the Application of Article 2(1)(xxi) of the Unfair Competition Prevention Act (Acts of Communicating or Disseminating False Facts)—A Checklist for Businesses

Original Ameblo publication: 2024-07-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859778925.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859778925-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859778925-ja

[Article] Recent Trends in Academic Views and Case Law on the Application of Article 2(1)(xxi) of the Unfair Competition Prevention Act (Acts of Communicating or Disseminating False Facts)—A Checklist for Businesses (Patent, Vol. 76, No. 5, 2023) (Eri Senoo (妹尾恵里))

<Factors affecting judgments>

Expert opinions

Disputes after the notification

Whether negotiations with the competitor preceded it

Whether customers were sued

Number of communications sent

Whether a particular company was disparaged

Other factors

https://jpaa-patent.info/patent/viewPdf/4201

IP High Court, 2022 (Gyo-Ke) 10052 [Moisture Control Device] <Kanno> — No procedural violation

Original Ameblo publication: 2024-07-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859841240.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859841240-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859841240-ja

IP High Court, 2022 (Gyo-Ke) 10052 [Moisture Control Device] <Kanno>

⇒ No procedural violation

The JPO decision established the technical matters identified in the refusal decision as common general technical knowledge on the basis of Exhibit Ko 2 and other references, and found obviousness based on the cited invention and that knowledge.

⇒ This was to the same effect as the refusal decision and did not change the thrust of its reasoning. Nor did it take the applicant by surprise.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91798.pdf

IP High Court, 2023 (Gyo-Ke) 10024 [Applicator for Applying a Transcutaneous Analyte Sensor] <Hibiku Shimizu>

Original Ameblo publication: 2024-07-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12859957318.html

HP: https://www.takaishihideki.com/single-post/ameblo-12859957318-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12859957318-ja

IP High Court, 2023 (Gyo-Ke) 10024 [Applicator for Applying a Transcutaneous Analyte Sensor] <Hibiku Shimizu>

*Even though not stated in the specification, the evidence shows that water vapor transmission rate is expressed either per hour or per day.

⇒ Adding "/24h" to the unit and limiting the water vapor transmission rate to a daily basis does not add new technical matter!??

(Excerpt from the court's reasoning)

…The evidence establishes that water vapor transmission rate is normally expressed on a one-hour or 24-hour (one-day) basis. On that premise, it is self-evident to a person skilled in the art that "less than 10 grams/100 in^2 or preferably less than 1 gram/100 in^2" in Invention 2 of the application means either "less than 10 grams/100 in^2/h or preferably less than 1 gram/100 in^2/h" or "less than 10 grams/100 in^2/24h or preferably less than 1 gram/100 in^2/24h"…. Converting "less than 10 grams/100 in^2/h or preferably less than 1 gram/100 in^2/h" to a 24-hour basis gives "less than 240 grams/100 in^2/24h or preferably less than 24 grams/100 in^2/24h." Thus, amended Invention 2 defines water vapor transmission rate within a range identical to or narrower than that recited in the claims for Invention 2. Moreover, nothing indicates that this limitation has any technical significance. Accordingly, the amendment cannot be said to have added new technical matter concerning Invention 2.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92665.pdf

[Unfair Competition Prevention Act/Acts Causing Misperception of Quality, etc.] Tokyo District Court, 2022 (Wa) 14148 <Sugiura>

Original Ameblo publication: 2024-07-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860097005.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860097005-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860097005-ja

[Unfair Competition Prevention Act/Acts Causing Misperception of Quality, etc.] Tokyo District Court, 2022 (Wa) 14148 <Sugiura>

Hair-dryer advertisements such as “1.9 times as much moisture in the hair”

⇒ Doubts about the reliability of the plaintiff's Experiments 1–5

⇒ Claims dismissed

The duty to clarify the specific manner of conduct (Article 6) “requires … substantiation sufficient to regard the filing of the action or the like as prima facie reasonable, from the standpoint of deterring abusive or exploratory litigation and the like.”

*When the “effects” stated in comparative advertising are attacked, a useful litigation strategy is to counterattack the reliability of the plaintiff's experiments themselves.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92092.pdf

IP High Court, 2023 (Gyo-Ke) 10011 [Device for Remotely Operating a Mobile Terminal] <Miyasaka> — Disclaimer claim lacks inventive step

Original Ameblo publication: 2024-07-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860214337.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860214337-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860214337-ja

IP High Court, 2023 (Gyo-Ke) 10011 [Device for Remotely Operating a Mobile Terminal] <Miyasaka>

***Disclaimer claim: inventive step not satisfied**

The claim was amended to read “images displayed on a mobile terminal (excluding images captured by a camera).”

⇒ A matter stated in an independent claim of the cited reference was excluded as an “essential feature of the cited invention,” but the argument was rejected.

(Excerpt from the court's reasoning)

Regarding Difference 2 (the images displayed in the cited invention are captured by a camera), the plaintiff argues that “image capture” of the display screen of the terminal display unit is an essential feature of the cited invention and there is no motivation to replace it.

However, nothing in Cited Reference 1 (Exhibit Ko 1) suggests that “image capture,” namely capturing images with a camera, is an essential feature of the cited invention.

Further, according to Cited Reference 2 (Exhibit Ko 2), cited by the JPO decision, and the examples of well-known technology added by the defendant in this action (Exhibits Otsu 1 and 2), as of the application's priority date, miracast—a technology using wireless communication to display images shown on the screen of a mobile terminal such as a smartphone on another device's screen—was widely used in smartphones as a standard in android 4.2. It is also found that outputting smartphone screens via miracast to in-vehicle monitors or car-navigation screens was routinely done. The significance of the “image capture unit 252” in the cited invention is that “by displaying the display screen of the mobile terminal 110 captured by the image capture unit 252 directly on the device display unit 258, the user can recognize the display screen of the mobile terminal 110 as it is” (Exhibit Ko 1, [0081]). In terms of the function of “displaying the display screen of the mobile terminal 110 directly on the device display unit 258,” namely the effect of “enabling the user to recognize the display screen of the mobile terminal 110 as it is,” the “image capture unit 252” and the above technologies such as miracast can be said to have this in common.

Accordingly, using well-known technology such as miracast in place of the “image capture unit 252” in the cited invention to provide a configuration having “a display unit (22) displaying images displayed on a mobile terminal (excluding images captured by a camera),” namely the configuration relating to Difference 2, is something a person skilled in the art could readily have conceived.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92579.pdf

Tokyo District Court, 2021 (Wa) 26762 <Kokubu> — “Usurped application” denied

Original Ameblo publication: 2024-07-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860341879.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860341879-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860341879-ja

Tokyo District Court, 2021 (Wa) 26762 <Kokubu>

⇒ “Usurped application” denied

The person was the head of research, and the monthly reports bore the plaintiff's seal.

⇒ Although in a position to learn the reports' contents concerning the invention, because the invention involved mixing multiple constituents in different proportions, it would not have been easy to remember it completely after merely glancing at a monthly report.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92102.pdf

Tokyo District Court, 2020 (Wa) 29523 [Heat-Shielding Structure Using Uneven Material] <Kokubu> — Substantive point of contact ⇒ Aiding established

Original Ameblo publication: 2024-07-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860459429.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860459429-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860459429-ja

Tokyo District Court, 2020 (Wa) 29523 [Heat-Shielding Structure Using Uneven Material] <Kokubu>

***Acting as the substantive point of contact ⇒ Aiding established**

"AA posted examples of heat-shielding sheet installation on its website and induced BB to request the work at issue…. …AA's representative … had been informed by the defendant of the specific method of installing the heat-shielding sheets…."

(Excerpt from the court's reasoning)

AA posted examples of heat-shielding sheet installation on its website, induced BB to request the work at issue, and entered into a construction contract with BB. It can therefore be said to have been the substantive point of contact for that work in relation to BB as the client. Moreover, AA's representative not only visited the construction site with the defendant's representative to confirm the scope of the work, but had also been informed by the defendant of the specific method of installing the heat-shielding sheets. AA can therefore be assessed as having performed the administrative tasks required for smooth execution of the work while recognizing that the defendant's heat-shielding structure would be created by that work. …It is appropriate to find that AA at least aided the conduct.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92673.pdf

Tokyo District Court, 2021 (Wa) 18262 [Women's Clothing] <Kokubu>

Original Ameblo publication: 2024-07-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860637127.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860637127-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860637127-ja

Tokyo District Court, 2021 (Wa) 18262 [Women's Clothing] <Kokubu>

*The sixth edition of Kojien lists two meanings for “tomoni”: (1) “as one; together; in company; likewise,” and (2) “simultaneously.”

⇒ The defendant (alleged infringer) argued that, where Kojien lists two meanings, the first is the more common. This was rejected, and the court construed “tomoni” in the patented invention as meaning (2), “simultaneously.”

⇒ Claim limitation satisfied (patentee prevailed)

“There is insufficient evidence to find that the sixth edition of Kojien adopted an editorial policy of listing widely used general meanings first. Moreover, …the specific examples of ‘connecting members’ in the specification … are incompatible with the defendant's … interpretation….”

(Excerpt from the court's reasoning)

Regarding “tomoni” in claim element D, the defendant argues that, because dictionaries list meanings beginning with those widely used in general, the term should … mean “as one; together; in company; likewise,” the first meaning listed in the sixth edition of Kojien. However, the order in which meanings are given priority is considered to depend on each dictionary's editorial policy, and …there is insufficient evidence to find that the sixth edition of Kojien adopted a policy of listing widely used general meanings first. Moreover, …none of the specific examples of “connecting members” in the specification permit adjustment of the connection width unless the connection between the connecting members is released, and thus they are incompatible with the defendant's proposed interpretation of “tomoni”….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92632.pdf

Osaka District Court, 2021 (Wa) 10586 [No-Wash Rice Retaining Umami and Nutrients]

Original Ameblo publication: 2024-07-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860831203.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860831203-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860831203-ja

Osaka District Court, 2021 (Wa) 10586 [No-Wash Rice Retaining Umami and Nutrients]

"Because rice is a natural product, even within the same variety, different growing environments produce individual differences in the rice grains …; even when milled under identical conditions, the extent of milling differs from grain to grain."

⇒ Results of other experiments cannot be relied on.

⇒ Claim limitations not satisfied

(⇒ No appeal)

(Excerpt from the court's reasoning)

…Because rice is a natural product, even within the same variety, different growing environments produce individual differences in the size of each cell layer and the constituents contained in each grain, and it is found that, even when milled under identical conditions, the extent of milling differs from grain to grain. Accordingly, even if starch-staining tests (the Exhibit Ko 7 and Ko 30 tests) confirmed that no aleurone cell layer remained on the surface of grains of the defendant's products (Miyagi-grown Tsuyahime Haiga Ichiban harvested in 2020 and 2021), this cannot be taken as a premise when examining the results of the Exhibit Ko 82 test conducted on another defendant product (Miyagi-grown Tsuyahime Haiga Ichiban harvested in 2022). …Whether each test conducted by the plaintiff is considered individually or the tests are considered together, in either case they are insufficient … to establish that the subaleurone cell layer is exposed on the surface of the rice grains of the defendant's products.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92688.pdf

IP High Court, 2022 (Ne) 10055 [Specified Heat-Treated Meat Products] <Shoji> — Use of a particular measurement method could be recognized

Original Ameblo publication: 2024-07-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860831474.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860831474-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860831474-ja

IP High Court, 2022 (Ne) 10055 [Specified Heat-Treated Meat Products] <Shoji>

***Although not stated in the specification, it was possible to recognize that one of two measurement methods should be used.**

⇒ Numerical limitation satisfied!!

“A person skilled in the art recognizes that the SCI method is … strongly affected by the gloss of the packaging … and is therefore … inappropriate … and could recognize that the SCE method should be used.”

(Excerpt from the court's reasoning)

The difference between measurements obtained by the SCE and SCI methods arises from whether specular reflection is included in the measured value. It is generally known that highly glossy substances produce stronger specular reflection…. Since visual inspection of meat and similar products covered with packaging often shows that the packaging is glossy, a person skilled in the art would recognize that the SCI method is inappropriate: it would be strongly affected by the gloss of the packaging and would yield absorbance different from that corresponding to the proportion of myoglobin in the measured object. …Taking into account the significance of the invention and this common general technical knowledge, a person skilled in the art could recognize that the SCE method should be used when measuring absorbance through packaging as the basis for calculating the proportion of myoglobin in roast beef in the invention.

https://www.youtube.com/watch?v=DJUlPRGr0tU

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92732.pdf

IP High Court, 2021 (Ne) 10084 [Printed Retroreflective Sheeting] <Miyasaka>

Original Ameblo publication: 2024-07-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12860956350.html

HP: https://www.takaishihideki.com/single-post/ameblo-12860956350-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12860956350-ja

IP High Court, 2021 (Ne) 10084 [Printed Retroreflective Sheeting] <Miyasaka>

***The support requirement does not demand exhaustive coverage of conditions affecting solution of the problem.**

⇒ Support requirement: satisfied

*The lack-of-inventive-step arguments (1) and (2), first advanced on appeal, were rejected as untimely!! (*The judgment does not make clear whether they were advanced in the statement of reasons for appeal.)

(1) The primary reference asserted at first instance + a different secondary reference

(2) An argument changing the interpretation of the primary reference asserted at first instance (the identification of the primary cited invention)

(Excerpt from the court's reasoning) <Support requirement>

…Although it cannot be denied that conditions other than whether the printed regions are continuous or separate could affect solution of the above problem, the support requirement does not demand exhaustive coverage of those conditions and their effects. A person skilled in the art, comparing the claims of the patent with the specification, would be able to recognize that the invention is described as one contributing to solution of the above problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92685.pdf

Tokyo District Court, 2023 (Wa) 70102 [Semi-Fermented Tea Leaves] <Nakashima>

Original Ameblo publication: 2024-07-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861103242.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861103242-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861103242-ja

Tokyo District Court, 2023 (Wa) 70102 [Semi-Fermented Tea Leaves] <Nakashima>

Construction of the claim language “stems have been removed”

⇒ None of the examples contains stems, and nothing suggests that stems may be included.

⇒ Construed as “containing no stems”

⇒ Claim limitation not satisfied

***Limiting claims to the examples is impermissible, but “matters common to all examples” are considered in many judgments addressing the technical scope of an invention!!**

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92608.pdf

Tokyo District Court, 2020 (Wa) 25891 <Shibata> = IP High Court, 2023 (Ne) 10015 [… Filter Cigarette]

Original Ameblo publication: 2024-07-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861255190.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861255190-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861255190-ja

Tokyo District Court, 2020 (Wa) 25891 <Shibata>

= IP High Court, 2023 (Ne) 10015 <Hibiku Shimizu>

[… Filter Cigarette]

*Claim language was construed based on a line break immediately before claim element I in the claims and the presence or absence of the word “said.”

⇒ It means that mainstream smoke does not substantially contact the smoke-modifying agent before reaching the mouth end.

⇒ Claim limitation not satisfied

(Excerpt from the court's reasoning)

Claim element I provides that “mainstream smoke passes through without substantially contacting the smoke-modifying agent.” Regarding the location on the cigarette of the “smoke-modifying agent” that the mainstream smoke does not contact, the claims have a line break immediately before “mainstream smoke passes through without substantially contacting the smoke-modifying agent” in element I, separating it from the statements in elements A through H. Nor is there language, such as “said smoke-modifying agent,” limiting the smoke-modifying agent in element I to the configuration described in other claim elements. Accordingly, the claims can be understood as separately describing, through the configurations in elements A through H and the configuration in element I, the configuration of the “cigarette” (element J). Thus, on the wording of the claims, “mainstream smoke passes through without substantially contacting the smoke-modifying agent” in element I can be understood to mean that, in the cigarette of the invention, mainstream smoke generated in the tobacco rod does not substantially contact a smoke-modifying agent before reaching the mouth end.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92233.pdf

Tokyo District Court, 2020 (Wa) 25892 [Smoking Article] <Shibata>

Original Ameblo publication: 2024-07-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861321032.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861321032-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861321032-ja

Tokyo District Court, 2020 (Wa) 25892 [Smoking Article] <Shibata>

Based on Kojien, “mating end” is construed as “having a definite shape, with the two mating ends having complementary shapes that cause them to fit together with almost no gap.” All disclosures in the specification are consistent with this.

⇒ Claim limitation not satisfied

(Excerpt from the court's reasoning)

According to the ordinary meanings of the words in … Kojien (seventh edition), “mating end” is understood to mean an end having a definite shape, with the two mating ends each having complementary shapes and fitting together by virtue of those shapes with almost no gap. …

The specification states that the mating end of the cartridge and the mating end (receiving end) of the control housing fit together. As an embodiment, the cartridge is inserted into the receiving chamber of the control housing, so they can be said to have complementary shapes; …this accords with the above ordinary meaning of “mating.” On the other hand, although the specification … and other passages contain descriptions, none states that a part merely contacting or approaching the end face of the cartridge's mating end constitutes the “receiving end” of the control housing. Nor is there any statement suggesting that “mating” is used in a sense different from the above … ordinary meaning. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92563.pdf

IP High Court, 2022 (Ne) 10113 [Compression Supporter] <Miyasaka>

Original Ameblo publication: 2024-07-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861494440.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861494440-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861494440-ja

IP High Court, 2022 (Ne) 10113 [Compression Supporter] <Miyasaka>

Unlike the first-instance Tokyo District Court judgment, 2021 (Wa) 11507,

the court held that, based on the specification and general knowledge, the claim language “made of resin” means “synthetic resin” and cannot be interpreted as “synthetic fiber.”

⇒ Claim limitation not satisfied. Doctrine of equivalents also rejected.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92458.pdf

IP High Court, 2022 (Ne) 10107 [… Electrical Probe Unit] <Honda>

Original Ameblo publication: 2024-07-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861677436.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861677436-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861677436-ja

IP High Court, 2022 (Ne) 10107 [… Electrical Probe Unit] <Honda>

The patentee argued that “sliding” does not mean moving while remaining in contact without separation for even an instant. The court rejected this, holding that, in light of the significance of the invention, continuous contact with one of the pair of plungers is necessary to permit electrical conduction.

⇒ Claim limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92119.pdf

Tokyo District Court, 2022 (Wa) 2049 [Packaging Container] <Sugiura>

Original Ameblo publication: 2024-07-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861679761.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861679761-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861679761-ja

Tokyo District Court, 2022 (Wa) 2049 [Packaging Container] <Sugiura>

*Based on the dictionary meaning and the specification, “bottom panels forming said bottom portion” was narrowly construed to mean members closing the underside of the tubular packaging container.

The plaintiff argued that the bottom portion's shape-retaining function should be considered, but this was rejected because it was not described in the specification.

⇒ Claim limitation not satisfied

(Excerpt from the court's reasoning)

“Bottom portion” means the portion constituting the “bottom,” while “bottom” has meanings including “(1) the lower part of a hollow object or container,” and “(2) the underside of an object; bottom surface; also the lower layers of accumulated material” (Exhibit Otsu 1). Thus, the “bottom portion” in Invention 1 is something that the tubular portion of the “packaging container” has together with an opening, and is understood as the “lower part,” namely the bottom, of the tubular structural portion. Moreover, insofar as the tubular structural portion functions as a “container” (a vessel for holding things; a receptacle), its “bottom portion” is understood to refer to the portion closing the underside of the tubular packaging container. …

The specification likewise indicates that the “bottom portion” is at the lower end of the enclosing portion constituting the tubular portion of the packaging container, forms the packaging container together with the upper opening, and is the bottom of the tubular structural portion functioning as a container; it is understood to refer to the portion closing the underside of the tubular packaging container. The “bottom panels” form such a “bottom portion” and are understood to mean members closing the underside of the tubular packaging container when it is formed into a container.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92237.pdf

Osaka District Court, 2018 (Wa) 10590 [Lower-Limb Garment]

Original Ameblo publication: 2024-07-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861801098.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861801098-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861801098-ja

Osaka District Court, 2018 (Wa) 10590 [Lower-Limb Garment]

*Construction of “vicinity”: a certain spatial extent was recognized based on the specification and common general technical knowledge.

“The vicinity of the iliac spine point” centers on the anterior superior iliac spine but also includes the vicinity of the anterior inferior iliac spine, and does not include the vicinity of the outermost point of the greater trochanter lying outside the vicinity of the anterior inferior iliac spine….

⇒ Claim limitation satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91987.pdf

[Japan Patent Office Annual Report 2024] Sharp Increase in Patent “Divisional Applications”!! ⇒ Applications Back to 300,000!!

Original Ameblo publication: 2024-07-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12861922914.html

HP: https://www.takaishihideki.com/single-post/ameblo-12861922914-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12861922914-ja

[Japan Patent Office Annual Report 2024]

A sharp increase in patent “divisional applications”!!

This is not a bubble. It is the real economy.

⇒ Applications back to 300,000!!

2014 — 27,878 applications

2015 — 28,242 applications

2016 — 29,717 applications

2017 — 27,535 applications

2018 — 27,267 applications

2019 — 27,665 applications

2020 — 26,827 applications

2021 — 29,319 applications

2022 — 33,528 applications

2023 — 37,279 applications

https://www.e-stat.go.jp/stat-search/file-download?fileKind=2&statInfId=000040196634

1-1-17図【JPOにおける特許出願構造】



(備考)・国別内訳は筆頭出願人の国籍でカウントしている。
(資料)・第2部第2章4.（1）を基に特許庁作成。

1-1-18図【USPTOにおける特許出願構造】



(備考)・Utility Patentが対象。
・国別内訳は下記資料の定義に従っている。
(資料)・USPTOウェブサイト（2014年～2020年）及びUSPTO提供資料（2021年～2023年暫定値）を基に特許庁作成。

1-1-19図【EPOにおける特許出願構造】



(備考)・EPC加盟国は各年末における加盟国。
・国別内訳は下記資料の定義に従っている。
(資料)・EPOウェブサイト　Patent Index 2023及びEPO提供資料（2023年暫定値）を基に特許庁作成。

1-1-20図【CNIPAにおける特許出願構造】



(備考)・国別内訳は下記資料の定義に従っている。
・2023年のデータは未公表。
(資料)・CNIPA Annual Reportを基に特許庁作成。

1-1-21図【KIPOにおける特許出願構造】



(1)出願

出願種別		2014年		2015年		2016年		2017年		2018年	
特許	通常出願	〈3,922〉 (49,069)	298,008	〈4,188〉 (49,027)	290,388	〈4,875〉 (48,143)	288,560	〈5,034〉 (48,388)	290,841	〈4,944〉 (50,415)	286,207
	うち延長登録出願		301		376		459		451		539
	分割出願	〈4,598〉 (10,953)	27,878	〈4,744〉 (10,660)	28,242	〈4,460〉 (9,987)	29,717	〈4,804〉 (9,790)	27,535	〈4,806〉 (9,513)	27,267
	変更出願	(8)	103	〈2〉 (7)	91	(7)	104	(11)	105	(5)	93
	計	〈8,520〉 (60,030)	325,989	〈8,934〉 (59,694)	318,721	〈9,335〉 (58,137)	318,381	〈9,838〉 (58,189)	318,481	〈9,750〉 (59,933)	313,567
実用新案	通常出願	(1,581)	6,712	(1,570)	6,532	(1,465)	6,141	(1,440)	5,748	(1,510)	5,081
	分割出願	(0)	3	(8)	13	(1)	1	(2)	2	(4)	7
	変更出願	(85)	380	(69)	315	(86)	338	(86)	356	(64)	300
	計	(1,666)	7,095	(1,647)	6,860	(1,552)	6,480	(1,528)	6,106	(1,578)	5,388
意匠	通常出願	(4,376)	27,815	(4,658)	27,760	(6,015)	28,616	(6,864)	29,524	(7,193)	28,777
	秘密出願	(198)	1,427	(177)	1,657	(95)	1,841	(195)	1,801	(177)	1,855
	分割出願	(290)	337	(258)	297	(218)	258	(449)	482	(574)	602
	変更出願	(6)	147	(5)	185	(5)	152	(1)	123	(9)	167
	却下後の新出願	(0)	12	(1)	4	(3)	12	(20)	31	(0)	5
	一括手続きによる出願	–	–	–	–	–	–	–	–	–	–
	計	(4,870)	29,738	(5,099)	29,903	(6,336)	30,879	(7,529)	31,961	(7,953)	31,406
商標	通常出願	(24,257)	122,015	(29,224)	137,533	(28,390)	142,689	(35,979)	164,996	(39,090)	174,431
	防護標章	(7)	64	(3)	34	(4)	32	(3)	32	(2)	40
	分割出願	(97)	1,921	(74)	9,470	(103)	18,729	(141)	25,314	(110)	9,486
	却下後の新出願	(0)	14	(0)	6	(1)	11	(1)	14	(1)	11
	防護更新	(28)	420	(22)	228	(24)	396	(35)	577	(6)	513
	変更出願	(0)	1	(0)	1	(0)	0	(0)	1	(0)	2
	重複更新	(0)	7	(0)	11	(0)	2	(0)	5	(0)	0
	計	(24,389)	124,442	(29,323)	147,283	(28,522)	161,859	(36,159)	190,939	(39,209)	184,483

出願種別		2019年		2020年		2021年		2022年		2023年	
特許	通常出願	〈4,928〉 (52,708)	280,212	〈4,372〉 (51,892)	261,586	〈4,802〉 (56,021)	259,815	〈4,733〉 (57,991)	255,955	〈4,524〉 (56,385)	262,808
	うち延長登録出願		737		725		798		675		503
	分割出願	〈5,077〉 (9,680)	27,665	〈5,023〉 (9,227)	26,827	〈5,873〉 (10,722)	29,319	〈7,352〉 (12,721)	33,528	〈8,813〉 (14,807)	37,279
	変更出願	(6)	92	〈1〉 (5)	59	(5)	66	(5)	47	(5)	46
	計	〈10,005〉 (62,394)	307,969	〈9,396〉 (61,124)	288,472	〈10,675〉 (66,748)	289,200	〈12,085〉 (70,717)	289,530	〈13,337〉 (71,197)	300,133
実用新案	通常出願	(1,259)	4,902	(1,575)	5,724	(1,412)	4,919	(1,475)	4,217	(2,013)	4,664
	分割出願	(11)	13	(4)	5	(1)	3	(2)	2	(4)	5
	変更出願	(92)	326	(62)	289	(64)	317	(72)	294	(64)	280
	計	(1,362)	5,241	(1,641)	6,018	(1,477)	5,239	(1,549)	4,513	(2,081)	4,949
意匠	通常出願	(7,587)	28,508	(8,318)	29,324	(9,155)	29,454	(8,515)	28,257	(9,479)	28,255
	秘密出願	(313)	2,040	(327)	1,624	(177)	1,583	(350)	1,803	(243)	2,041
	分割出願	(717)	758	(691)	717	(561)	614	(755)	784	(568)	609
	変更出願	(4)	171	(4)	123	(1)	162	(1)	143	(5)	148
	却下後の新出願	(1)	12	(0)	10	(4)	14	(0)	5	(0)	4
	一括手続きによる出願	–	–	–	–	(549)	(698)	(611)	719	(635)	690
	計	(8,622)	31,489	(9,340)	31,798	(10,447)	32,525	(10,232)	31,711	(10,930)	31,747
商標	通常出願	(41,750)	189,704	(45,564)	180,041	(51,478)	183,669	(44,742)	169,148	(41,694)	162,902
	防護標章	(1)	44	(4)	29	(0)	20	(1)	24	(0)	17
	分割出願	(101)	725	(111)	772	(127)	749	(124)	850	(120)	902
	却下後の新出願	(0)	6	(1)	9	(0)	9	(0)	11	(0)	4
	防護更新	(8)	294	(16)	219	(17)	183	(43)	240	(34)	235
	変更出願	(0)	0	(1)	2	(0)	1	(1)	2	(0)	1
	重複更新	(0)	0	(0)	0	(0)	0	(0)	0	(0)	0
	計	(41,860)	190,773	(45,697)	181,072	(51,622)	184,631	(44,911)	170,275	(41,848)	164,061

Axes for Figures 1-1-17–1-1-21: left axis, number of applications (in units of 10,000); right axis, percentage (%); horizontal axis, year of application.

Figure 1-1-17: Breakdown of patent applications at the JPO. Legend: applications by foreign applicants; applications by domestic applicants; proportion of applications by foreign applicants. Notes: The country breakdown is based on the nationality of the first-listed applicant. Source: Prepared by the JPO based on Part 2, Chapter 2, Section 4(1).

Figure 1-1-18: Breakdown of patent applications at the USPTO. Legend: applications by foreign applicants, excluding Japanese applicants; applications by Japanese applicants; applications by domestic applicants; proportion of applications by foreign applicants. Notes: Covers utility patent applications. The country breakdown follows the definitions in the sources listed below. Source: Prepared by the JPO based on the USPTO website (2014–2020) and data supplied by the USPTO (2021–2023, provisional figures).

Figure 1-1-19: Breakdown of patent applications at the EPO. Legend: applications by applicants from non-EPC member states, excluding Japanese applicants; applications by Japanese applicants; applications by applicants from EPC member states; proportion of applications from outside the EPC member states. Notes: EPC member states are those that were members at the end of each year. The country breakdown follows the definitions in the sources listed below. Source: Prepared by the JPO based on the EPO website, Patent Index 2023, and data supplied by the EPO (provisional figures for 2023).

Figure 1-1-20: Breakdown of patent applications at CNIPA. Legend: applications by foreign applicants, excluding Japanese applicants; applications by Japanese applicants; applications by domestic applicants; proportion of applications by foreign applicants. Notes: The country breakdown follows the definitions in the source listed below. Data for 2023 had not yet been published. Source: Prepared by the JPO based on the CNIPA Annual Report.

Figure 1-1-21: Breakdown of patent applications at KIPO. Legend: applications by foreign applicants, excluding Japanese applicants; applications by Japanese applicants; applications by domestic applicants; proportion of applications by foreign applicants.

Table — (1) Applications. Column headings: application type; 2014–2018 (upper table); 2019–2023 (lower table).

Patents — ordinary applications; of which: applications for registration of a patent-term extension; divisional applications; converted applications; total.

Utility models — ordinary applications; divisional applications; converted applications; total.

Designs — ordinary applications; applications requesting secrecy of designs; divisional applications; converted applications; new applications following dismissal of an amendment; applications filed under the multiple-design filing procedure; total.

Trademarks — ordinary applications; applications for defensive mark registration; divisional applications; new applications following dismissal of an amendment; applications to renew defensive mark registrations; converted applications; applications to renew trademark rights arising from duplicate registrations; total.

[Right of Publicity] Tokyo District Court, 2023 (Wa) 3171 <Nakashima>

Original Ameblo publication: 2024-08-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862040369.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862040369-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862040369-ja

[Right of Publicity] Tokyo District Court, 2023 (Wa) 3171 <Nakashima>

The photographs were used on a website introducing affiliated talent to show that affiliation and supplement information about the individuals.

⇒ They were not used as goods or the like, to differentiate goods or the like, or as advertisements for goods or the like.

⇒ No infringement of the right of publicity

In prior litigation, the talent whose exclusive contract had been terminated disputed their contractual status, and the agency continued displaying the photographs until the judgment against the talent became final.

⇒ At least, there was no sufficient evidence that the mental distress exceeded the limits of what should be tolerated under socially accepted norms; therefore, the allegation of infringement of portrait rights was not accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92649.pdf

IP High Court, 2020 (Gyo-Ke) 10033 [Removal of Undesirable Components from an Oil Composition] <Tsuruoka>

Original Ameblo publication: 2024-08-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862350584.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862350584-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862350584-ja

IP High Court, 2020 (Gyo-Ke) 10033 [Removal of Undesirable Components from an Oil Composition] <Tsuruoka>

*The well-known degumming or water-washing treatment could remove hydrophilic impurities as in step (b) of Invention 7, and a skilled person was motivated to apply it to the invention in Exhibit Ko 2.

⇒ The configuration corresponding to the difference in Invention 7 was obvious (likewise for Invention 10).

"Invention 7 … does not differ from … treatment with an aqueous fluid … in that it can separate and remove at least some of the impurities from the oil."

(Excerpt from the court's reasoning)

It is found that, as of the priority date, both performing degumming before deacidification by alkali refining in oil refining … and, as one common degumming method, contacting an oil composition with an aqueous fluid such as water or steam to separate and remove hydrophilic impurities including hydrated gums from the oil were well-known technologies. Further, …as of the priority date, degumming or washing with water before deacidification by distillation (physical refining) was well known, and …it was also well known that proteinaceous compounds are removed by contacting an oil composition with an aqueous fluid such as water or steam and then separating it. …Thus, step (b) of Invention 7 must be said to be no different from the above degumming or water-washing treatment using an aqueous fluid such as water or steam, in that it can separate and remove from the oil at least some hydrophilic impurities, including proteinaceous compounds. …

Exhibit Ko 2 states that the oil may be pretreated before the stripping step…. …Furthermore, …given that degumming or water washing using an aqueous fluid such as water or steam before stripping was well known, a person skilled in the art would naturally have been motivated to perform such degumming or water washing before the stripping treatment in the invention in Exhibit Ko 2, thereby separating and removing at least some hydrophilic impurities from the oil.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90471.pdf

[Trademark] Osaka District Court, 2020 (Wa) 7918 <Takemiya>

Original Ameblo publication: 2024-08-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862350768.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862350768-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862350768-ja

[Trademark] Osaka District Court, 2020 (Wa) 7918 <Takemiya>

Estoppel precludes infringement claims against goods identical or similar to robots excluded during prosecution in response to a notice of reasons for refusal under Article 3(1)(iii).

In the manner of use at issue, consumers do not understand the defendant's mark as meaning “robot” or “store.”

⇒ Article 26(1)(ii) does not apply.

https://bran-design.jp/topics/case/2564/

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92597.pdf

[U.S.] Skinny Labels and “Induced Infringement,” June 2024 <CAFC> Amarin v. Hikma

Original Ameblo publication: 2024-08-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862421999.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862421999-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862421999-ja

[U.S.] Skinny Labels and “Induced Infringement,” June 2024 <CAFC> Amarin v. Hikma

Reversal of the district court’s grant of the motion to dismiss ⇒ The case may proceed in the district court.

Skinny labels for generic drugs and “induced infringement.” Even where a generic drug has been approved with the cardiovascular (CV) indication carved out and its label does not expressly state that indication, labeling and promotional statements may implicate both noninfringing and infringing uses. In this case, the court considered the plaintiff’s allegations about the following labeling, statements, and advertising as a whole and held that they plausibly stated a claim for induced infringement sufficient for the case to proceed.

<1> Amarin alleged that the patient population described in the label’s “Clinical Studies” section overlapped with the population covered by the patented CV indication.

<2> Hikma touted sales figures for Vascepa in its press releases, and Amarin alleged that Hikma knew those sales were largely attributable to the CV indication.

<3> Amarin alleged that Hikma advertised the product under the broad category “Hypertriglyceridemia.”

https://openlegalcommunity.com/amarin-v-hikma-generic-drug-skinny-label-new-inducement-infringement-risk/

[Foreign Law/Article] EPO Enlarged Board of Appeal Decision G 2/21 and Practical Suggestions in Light of the Decision (Peter Hoecherl and Nami Saeki, Intellectual Property Management, Vol. 74, No. 4, 2024)

Original Ameblo publication: 2024-08-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862658119.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862658119-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862658119-ja

[Foreign Law/Article] EPO Enlarged Board of Appeal Decision G 2/21 and Practical Suggestions in Light of the Decision (Peter Hoecherl and Nami Saeki, Intellectual Property Management, Vol. 74, No. 4, 2024)

① Evidence supporting a technical effect may not be disregarded solely because it was not publicly available before the filing date and was filed after that date.

② A technical effect may be relied on if the skilled person, having common general knowledge in mind and based on the application as originally filed, would derive it as encompassed by the technical teaching and embodied by the same originally disclosed invention.

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2404

IP High Court, 2021 (Gyo-Ke) 10091 <Honda> Adhesive Tape Case

Original Ameblo publication: 2024-08-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862674976.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862674976-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862674976-ja

IP High Court, 2021 (Gyo-Ke) 10091 <Honda> Adhesive Tape Case

The specification inadequately described the technical significance of the four parameters (experimental data).

⇒ Inventive step: not satisfied

Where solution of the invention's problem correlates with the claimed parameters, technical significance is more likely to be recognized. (A one-to-one correspondence is strongest!!)

https://www.youtube.com/watch?v=oiVwi2Iiy6w

IP High Court, 2018 (Ne) 10043 [Factor IX/Factor IXa Antibodies and Antibody Derivatives] <Mori>

Original Ameblo publication: 2024-08-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862768595.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862768595-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862768595-ja

IP High Court, 2018 (Ne) 10043 [Factor IX/Factor IXa Antibodies and Antibody Derivatives] <Mori>

*The limitations were held not satisfied even though some measured values fell within the invention's numerical range.

Functional claim

⇒ Invention defined by a numerical range

⇒ The reasons included that "it is considered difficult to ensure identity between a biosimilar … and the original drug."

(Excerpt from the court's reasoning)

Considering …the description in the specification as well as …the wording of the claims for each invention, it is found that a person skilled in the art would understand that, among the several evaluation methods, when a chromogenic assay (FVIII assay) is performed, antibodies or derivatives falling within the inventions are those showing a measured-value-to-background ratio of at least 3 (ratio to the negative control). It is therefore appropriate to find that "increases procoagulant activity" means that, when a chromogenic assay is performed, the ratio to the negative control exceeds 3. …

Taking into account also the fact that, generally for biologics, their complex molecular structures and distinctive manufacturing processes make it difficult to ensure identity between biosimilars (follow-on biologics: products similar to an already approved original biologic by demonstrating similarity in quality characteristics, efficacy, and safety through direct or head-to-head comparison) and original drugs, even if some values exceed 3, the above experimental results, in which values are below 3 in many cases, do not permit a finding that the appellee's product falls within the technical scope of the inventions.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88994.pdf

Tokyo District Court, 2021 (Wa) 10171 [Folding Table] <Kokubu>

Original Ameblo publication: 2024-08-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12862892981.html

HP: https://www.takaishihideki.com/single-post/ameblo-12862892981-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12862892981-ja

Tokyo District Court, 2021 (Wa) 10171 [Folding Table] <Kokubu>

*Even the corresponding portion of the specification imposed no limitation on the “separation-biasing means” beyond describing it as biasing means “for separating the two leg members from one another.”

⇒ The court rejected the defendant’s argument that, because the limitation was functional, its scope was restricted to the structures disclosed in the specification or their equivalents.

⇒ Literal claim limitation satisfied

(Excerpt from the court's reasoning)

…From the above wording of element C, the “separation-biasing means” is found to mean means disposed on the “underside of the tabletop,” capable of biasing “two leg members” located “at positions facing each other across the axis about which the tabletop member rotates” in directions “separating them from one another.” …

On this point, the defendant argues that element C is a so-called functional claim and its technical scope is therefore limited to structures identical to those disclosed in the specification or their equivalents. However, the claims impose no such limitation as the defendant asserts on the “separation-biasing means.” Nor does the portion of the specification considered to correspond to element C impose any limitation beyond stating that it is biasing means “for separating the two leg members from one another” ([0009]). Accordingly, the defendant's argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92520.pdf

[Contract/Patent Warranty] IP High Court, 2023 (Ne) 10064 <Honda>

Original Ameblo publication: 2024-08-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12863239646.html

HP: https://www.takaishihideki.com/single-post/ameblo-12863239646-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863239646-ja

[Contract/Patent Warranty] IP High Court, 2023 (Ne) 10064 <Honda>

“In the event of infringement … at [the party's] expense and responsibility”

⇒ This also stipulates an affirmative obligation to provide technical knowledge and other information upon request and cooperate so that a lack of information does not lead to losing litigation or a disadvantage in negotiations!!

*However, there is no obligation to accept a settlement proposal from a third party.

⇒ No breach of duty

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92496.pdf

[Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10012 <Shoji>

Original Ameblo publication: 2024-08-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12863239752.html

HP: https://www.takaishihideki.com/single-post/ameblo-12863239752-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863239752-ja

[Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10012 <Shoji>

The shape of AstraZeneca's inhaler for bronchial asthma

⇒ The finding that it was not an “indication of goods or business” is understandable.

The court cut the issue short by finding no “likelihood of confusion” because the primary consumers of prescription drugs are physicians and pharmacists, while patients are secondary consumers. (Many judgments are to the same effect.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92524.pdf

IP High Court, 2022 (Gyo-Ke) 10113 [Display Device] <Miyasaka>

Original Ameblo publication: 2024-08-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12863426221.html

HP: https://www.takaishihideki.com/single-post/ameblo-12863426221-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863426221-ja

IP High Court, 2022 (Gyo-Ke) 10113 [Display Device] <Miyasaka>

“Minimum-luminance maintenance control technology and an illuminance–luminance proportional configuration are compatible and can coexist as technical concepts …; this is not a teaching away.”

⇒ Inventive step: not satisfied (refusal decision upheld)

Against an assertion of “teaching away” in inventive step, the response that the technologies “are compatible and can coexist” is effective!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92545.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) 10095 <Miyasaka> *Hermès' Orange Box — Trademark Act Article 3(2) not applicable

Original Ameblo publication: 2024-08-13

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HP: https://www.takaishihideki.com/single-post/ameblo-12863479337-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863479337-ja

[Trademark] IP High Court, 2023 (Gyo-Ke) 10095 <Miyasaka> *Hermès' Orange Box — Trademark Act Article 3(2) not applicable

A trademark for a packaging box consisting solely of the combination of orange over the entire box and brown around its upper perimeter (commonly called the orange box) (Hermès)

⇒ Because the designated goods/services include inexpensive everyday goods such as “leather creams, watches, key rings, paper boxes, etc., stationery, diaries, photo frames, backpacks, card holders, and umbrellas,” the relevant consumers are consumers generally.

⇒ Trademark Act Article 3(2) not applicable (distinctiveness for goods/services through use and advertising denied)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92909.pdf

https://www.nakapat.gr.jp/ja/legal_updates_jp/【商標法★】箱全体の橙色（ｒｇｂの組合せ：ｒ/

[Trademark] IP High Court, 2023 (Gyo-Ke) 10079 <Hibiku Shimizu> “地球グミ” (literally, “Earth Gummies”) Case — Falls under Trademark Act Article 4(1)(x)

Original Ameblo publication: 2024-08-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12863603716.html

HP: https://www.takaishihideki.com/single-post/ameblo-12863603716-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863603716-ja

[Trademark] IP High Court, 2023 (Gyo-Ke) 10079 <Hibiku Shimizu> “地球グミ” (literally, “Earth Gummies”) Case

By the date of the examiner's decision to register the mark, the term “地球グミ” (literally, “Earth Gummies”) had become widely recognized among consumers of gummy candies, including young people, as indicating others' products such as “Planet Gummi.”

⇒ Violation of Trademark Act Article 4(1)(x) (decision maintaining registration set aside)

https://www.nakapat.gr.jp/ja/legal_updates_jp/【商標法★】指定商品「グミキャンディ」（第３/

[Trademark] IP High Court, 2023 (Gyo-Ke) 10067 <Honda> — Comparing the “O!Oi” Portion of the Registered Mark with the Cited Mark

Original Ameblo publication: 2024-08-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12863713938.html

HP: https://www.takaishihideki.com/single-post/ameblo-12863713938-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863713938-ja

[Trademark] IP High Court, 2023 (Gyo-Ke) 10067 <Honda> Separating and assessing the essential part of a composite mark

⇒ The “O!Oi” part of the registered mark was compared with the cited mark and found similar (Trademark Act Article 4(1)(xi)). (Decision maintaining registration set aside)

Registered mark “5252byO!Oi” (individual)

Cited mark “OIOI” (Marui)

登録商標



引用商標



(Excerpts from the court's reasoning)

As stated in Part 2, 1(1) above, the mark at issue consists of the numerals, Roman letters, and exclamation mark “5252byO!Oi” written horizontally in one continuous line in black Gothic type, in the same size and at equal intervals. However, “by” is widely used and familiar in Japan as an English preposition indicating, through the usage “by XXX,” that “the source of the goods or services is XXX.” Considering also that “by” is lowercase, the mark as a whole can be said to be configured so that the “O!Oi” following “by” independently attracts the viewer's attention. Moreover, whereas “5252” merely lists numerals and has no particular distinctiveness, “O!Oi,” though using Roman letters, is not a word recorded in dictionaries. Although it may give rise to pronunciations “oh-oi” or “oh-oh-eye,” its pronunciation is not uniformly determined because it uses an exclamation mark. The alternation of circles and vertical lines gives it a visually striking impression, making it a distinctive element that can be understood as either a coined word or a design. In addition, given that, as stated above,

“by XXX” is widely used and familiar as indicating that “the source of the goods or services is XXX,” the “O!Oi” placed after “by” must be said to give a strong and dominant impression as a source identifier within the mark's composition. Thus, although it is only part of the mark, “O!Oi” is found to perform the source-identifying function of the mark as a whole. It must therefore be permissible to extract this portion as the essential part of the mark and compare only this portion (hereinafter the “essential part at issue”) with another person's mark to assess similarity.

The essential part at issue gives rise to no particular concept, whereas Cited Mark 3 gives rise to the concept of “Marui's logo”; their concepts can therefore hardly be called identical.

Next, the essential part at issue may give rise to “oh-oi” or “oh-oh-eye,” while Cited Mark 3 may give rise to “oh-eye-oh-eye,” “oi-oi,” and “Marui.” Although the pronunciations differ strictly because the essential part includes “!”, they share many sounds and must be considered reasonably similar.

Regarding appearance, both the essential part at issue and Cited Mark 3 comprise four letters or symbols in Gothic type, and both have “O” as the first and third characters. Different letters or symbols appear as the second character (“!” versus “I”) and fourth character (“i” versus “I”), but their shapes are similar in that each consists of either a single vertical line or a single vertical line and a dot on its extension. In addition, the arrangement, including the spacing between characters, is close. Thus, although there are differences on close examination, the two appearances must be said to be confusable when observed separately at different times and places.

In addition to the foregoing, the designated goods of both the mark at issue and the cited marks are fashion/apparel-related goods or items worn by ordinary consumers, and their traders and consumers therefore include the general public. The essential part at issue gives rise to no particular concept. The possible pronunciations of the essential part and Cited Mark 3 are not identical but are reasonably similar, and neither can readily be said to have a single definite pronunciation; pronunciation is therefore unlikely to be decisive as a source identifier for traders and consumers. Ordinary consumers are considered to pay attention primarily to the appearance of the goods or logos in identifying the source of apparel, fashion goods, and wearable items. Considering these matters together, the mark at issue has an essential part whose pronunciation is reasonably similar to Cited Mark 3 and whose appearance is confusable with it. Even allowing for the fact that the overall composition is not identical to Cited Mark 3, if both marks are used for the designated goods of the mark at issue, the possibility that traders and consumers will mistake their sources cannot be excluded, and a likelihood of misidentification and confusion as to the source of the goods is found.

Accordingly, when the impressions, memories, and associations given to traders and consumers are considered together and the marks are examined as a whole in light of the actual trading circumstances of the goods, the mark at issue is found similar to Cited Mark 3.

https://www.nakapat.gr.jp/ja/legal_updates_jp/【商標法★】結合商標の分離・要部観察により下/

[Trademark] IP High Court, 2023 (Ne) 10011 “バレナイ二重” (Undetectable Double Eyelids) Case <Hibiku Shimizu> — Appeal: Dissimilar; First Instance: Not Use as a Trademark

Original Ameblo publication: 2024-08-16

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HP: https://www.takaishihideki.com/single-post/ameblo-12863825783-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863825783-ja

[Trademark] IP High Court, 2023 (Ne) 10011 “バレナイ二重” (Undetectable Double Eyelids) Case <Hibiku Shimizu>

Plaintiff's mark (two lines)

“バレない [Barenai; undetectable; mixed katakana and hiragana]

ふたえ [Futae; double eyelids; hiragana]”

Defendant's mark (two lines)

“バレナイ [Barenai; undetectable; katakana]

二重 [Futae; double eyelids; kanji]”

⇒ The appellate court dismissed the appeal on the ground of dissimilarity. The first-instance court dismissed the claims on the ground that the signs were not used as trademarks (Trademark Act Article 26(1)(vi)).

⇒ The dismissal of the plaintiff’s claims was upheld.

被告標章１及び２



原告商標２



Image labels: top, Defendant Marks 1 and 2; bottom, Plaintiff’s Trademark 2.

(Excerpts from the court's reasoning)

<Similarity>

Even if the mark at issue and the defendant's marks perform a source-identifying function, the expressions “バレないふたえ” and “バレナイ二重” (both meaning “undetectable double

eyelids”) themselves are commonplace expressions concerning the quality and efficacy of the cosmetics at issue. Their source-identifying function must therefore be said to be quite limited. …

In addition, …taking into account also the manner in which the mark at issue and the defendant's marks are used, it is appropriate to find that consumers of the cosmetics generally identify the source of the goods (the cosmetics at issue) by the specific manner of external indications capable of identifying source (visible letters, patterns, colors, and the like) on the goods or their packaging.

“In light of these actual trading circumstances, in assessing similarity between the mark at issue and the defendant's marks, the manner of external presentation of the source identifier specifically used on the goods (the cosmetics at issue) or their packaging—namely similarities and differences in the appearance of the source identifier (trademark)—is relatively more important than similarities and differences in pronunciation and concept, as giving consumers a stronger and more dominant impression.”

Further, “while the mark at issue and the defendant's marks give rise to identical pronunciations and concepts, their appearances differ enough not to be confusable to consumers viewing the cosmetics. Considering these circumstances together as a whole, in light also of the explanation in subsection A above, even if the mark at issue and the defendant's marks are used on the same goods (the cosmetics at issue), a likelihood of misidentification or confusion as to source cannot be found. It is therefore appropriate to assess the defendant's marks as not similar to the mark at issue, at least insofar as they are used for the cosmetics at issue.”

<Trademark Act Article 26(1)(vi) (quotation from the first-instance judgment)>

(1) The evidence (as cited) and the entire purport of oral argument establish the following facts. A. Examples of “ばれない,” “バレない,” and “バレナイ” (all read barenai). (a) “ばれない” (barenai) is formed by adding the negative auxiliary “ない” (nai) to the verb “ばれる” (bareru). “ばれる” (bareru) means the exposure of a secret, lie, or wrongdoing, so “ばれない” (barenai) means that a secret or the like is not exposed. Although “ばれない,” “バレない,” and “バレナイ” differ in writing—hiragana only, a combination of hiragana and katakana, or katakana only—the meaning does not differ with the form of writing. (b) Internet search results show that advertisements for cosmetic procedures creating double eyelids and cosmetics for forming double eyelids use expressions such as “No one will know your double eyelids are artificial,” “Hard-to-detect double eyelids,” “Natural double eyelids that no one will notice!?,” “Absolutely undetectable! How to create natural double eyelids,” “Tips for going undetected,” “How to create truly undetectable double eyelids,” “Undetectable double eyelids,” and “Undetectable, non-swelling double-eyelid surgery” (Exhibits Ko 16 and Otsu 2–5). A webpage introducing double-eyelid cosmetics and the like in a ranking format entitled “[Expert-supervised] 15 popular recommended eyelid glues [including options for students and undetectable ones!]” (Exhibit Hei 3) also states, “Many of you are probably worried that people around you will notice your eyelid glue,” and “You want to keep people from realizing you are using it! If being hard to detect matters most, we recommend fiber or film-forming eyelid glue.” Further, descriptions of double-eyelid-shaping cosmetics other than the plaintiff's and defendant's products include “Undetectable, surgery-level double eyelids” (Exhibit Hei 1-1), “Undetectable! No shine!” (Exhibits Hei 1-2 and 1-3), “Undetectable even with your eyes closed!” (Exhibit Hei 1-4), “Hard to detect

even when closed!” (Exhibit Hei 1-5), “Undetectable double-eyelid shaping with ultrafine fiber” (Exhibit Hei 1-6), and “Undetectable!! Surgery-style makeup” (Exhibit Hei 1-7). In addition to double-eyelid cosmetics, “Undetectable! Easy! Natural-looking finish!” is used to describe nose-contouring cosmetics (Exhibit Hei 2-1), “undetectable artificial nails” to describe artificial nails (nail tips) (Exhibits Hei 2-2 and 2-3), and “undetectable lift” to describe cosmetic cheek procedures (Exhibit Hei 2-4). B. Manner of use of the defendant's marks on its products. According to the evidence (Exhibit Ko 5), the packaging of Defendant Product 1 has a black heart-shaped figure occupying approximately the upper half of its front. Within that figure, the top row contains the underlined words “Long-lasting hold,” and the middle contains Defendant Mark 1, both in pink, the packaging's base color. At the bottom of the figure, “Liquid type” appears in black on a green band, and a black circle attached to the left end of that band contains the word “Fine brush” and an illustration of a brush tip in green. In addition, the upper-left portion of the lower packaging has the two-line wording “Eye Catching” and “Beauty” (the “t” in “Beauty” is designed as a cross whose left and lower arms are longer than its right and upper arms); the center-left lower portion has “FUTAE” and “LIQUID” on two lines; and the right lower portion has “#Eye-area illusion makeup.” Through a transparent window between these lower indications, the body of Defendant Product 1 is visible, bearing “Eye Catching” and “Beauty” in the same arrangement as in the upper-left portion of the lower packaging (however, the evidence is insufficient to establish that this indication is visible through the window for all Defendant Product 1 items). On the back, there are “Eye Catching” and “Beauty” in the same arrangement as on the front, “FUTAE LIQUID” in a single continuous line, and wording including “Eye Catching Beauty Futae Liquid (double-eyelid cosmetics),” but no Defendant Mark 1. Next, the evidence (Exhibit Ko 6) shows that the packaging of Defendant Product 2 has a black heart-shaped figure occupying approximately the upper half of its front. Within it, the top row contains the underlined words “Long-lasting hold,” and the middle contains Defendant Mark 2, both in yellow, the packaging's base color. At the bottom, “Tape type” appears in black on a blue-violet band, and a black circle attached to the band's left end contains a water-drop illustration in its upper portion, with the word “Water” in black inside it and “Apply with” in blue-violet below it. In addition, the upper-left portion of the lower packaging has “Eye Catching” and “Beauty” in the same arrangement as on Defendant Product 1; the center-left lower portion has “FUTAE” and “MESH TAPE” in the same arrangement as on Defendant Product 1; and the right lower portion has “#Eye-area illusion makeup.” (No lettering is visible on the body of Defendant Product 2 through the transparent window between these lower indications.) On the back are “Eye Catching” and “Beauty” in the same arrangement as on the front, “FUTAE MESH TAPE” in a single continuous line, and wording including “Eye Catching Beauty Futae Mesh Tape (single-sided double-eyelid-forming tape),” but no Defendant Mark 2. (2) Manner of use of the defendant's marks, etc. A. Given the products' functions and sales channels (the parties do not dispute that these are physical stores and online retail), the relevant consumers are appropriately regarded as consumers generally, not limited to young women. The defendant's argument on this point cannot be accepted. B. Considering together the indications on the fronts and backs of the packaging found in (1)B above, ordinary consumers appear to recognize the product names as “Eye Catching Beauty FUTAE LIQUID” and its Japanese rendering “アイキャッチングビューティ ふたえリキッド” (Eye Catching Beauty Futae Liquid) (Defendant Product 1), and “Eye Catching Beauty FUTAE MESH TAPE” and its Japanese rendering “アイキャッチングビューティ　ふたえメッシュテープ” (Eye Catching Beauty Futae Mesh Tape) (Defendant Product 2). By contrast, based on the findings in (1), the defendant's marks are understood as follows. “ばれない,” “バレない,” and “バレナイ” all mean that a secret or the like is not exposed, regardless of their written form. In advertising double-eyelid cosmetics of the kind to which the defendant's products belong, and cosmetic procedures for forming double eyelids, many combinations of “ばれない” (barenai) or similar wording with “二重” (double eyelids) are used as expressions understood to describe the efficacy of the cosmetics or procedures, or the nature of the services—namely that others will not readily notice that single eyelids have been made into double eyelids—or as catchphrases promoting such efficacy. Furthermore, for beauty-related goods and

services other than double-eyelid cosmetics, such as other cosmetics and cosmetic surgery, “ばれない” (barenai) and similar words are also used not infrequently as explanations that others will not notice the use of the cosmetics or procedures, or as catchphrases promoting that effect. This is understood as an attempt by providers to promote effects meeting the desire of many consumers of beauty-related goods and services that others not readily realize that the condition has been created artificially and intentionally using those goods or services, and that the resulting appearance be viewed as natural. Given the widespread use of “ばれない” (barenai) and similar words in beauty-related goods and services, ordinary consumers of double-eyelid cosmetics would normally recognize and understand the defendant's marks, combining “バレナイ” and “二重,” as explanations of the products' efficacy—cosmetics whose use to form double eyelids is not readily exposed to others—or as catchphrases promoting that efficacy. This is all the more so considering that, on the packaging, the defendant's marks are positioned between wording such as “Long-lasting hold” and “Liquid type” (Defendant Product 1) or “Tape type” (Defendant Product 2), and that other indications recognizable as the product names are present. This remains true even allowing for the stylization of the lower part of the character “二” in “二重” (double eyelids) in the defendant's marks, which appears to have two upward hooks at its left end. For these reasons, ordinary consumers of the defendant's products understand the defendant's marks as descriptions or catchphrases concerning the products' efficacy, and the marks are not found to function as identifiers distinguishing goods or indicating source.

https://www.nakapat.gr.jp/ja/legal_updates_jp/【商標法★★】黒色の背景に「バレナイ」及び「/

[Trademark] IP High Court, 2009 (Gyo-Ke) 10075 <Nakano> — “太極柔力球” (Taiji Rouliqiu) Case: No Distinctiveness; Article 4(1)(xvi) Applies

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12863940154-ja

[Trademark] IP High Court, 2009 (Gyo-Ke) 10075 <Nakano>

Registered mark “太極柔力球” (Taiji Rouliqiu)

For the designated services “planning, managing, or holding Taiji Rouliqiu events,” “providing sports facilities for Taiji Rouliqiu,” “providing amusement facilities for Taiji Rouliqiu,” and “renting sports equipment for Taiji Rouliqiu” (Class 41), distinctiveness is lacking (Trademark Act Article 3(1)(iii)).

—As of the registration decision, distinctiveness as indicating the trademark owner's activities was not recognized.

Use on “sports equipment used for teaching tai chi” (Class 28) gives rise to a likelihood of misleading consumers as to the quality of the goods; use for certain designated services other than Taiji Rouliqiu services, among others, gives rise to a likelihood of misleading consumers as to the quality of the services (Trademark Act Article 4(1)(xvi)).

(Case summary and excerpts from the judgment, translated into English)

<Trademark Act Article 3(1)(iii)>

(1) Marks listed in Article 3(1)(iii) of the Trademark Act are considered to lack the requirements for registration because they describe or indicate the place of production, place of sale, or other characteristics of goods, and anyone would wish to use them as necessary and appropriate indications in trade. Allowing one particular person exclusive use would therefore be inappropriate in the public interest. In addition, they are commonly used indications that in many cases lack the ability to distinguish one's goods from those of others and cannot function as trademarks (see Supreme Court, Third Petty Bench, April 10, 1979, Collection of Judgments in Civil Cases No. 126, p. 507 [Hanrei Jiho No. 927, p. 233]).

(2) Based on evidence submitted by the parties, the court found that Taiji Rouliqiu was devised as a new sport (the activity at issue) in China in 1991 by A, an associate professor at the Jinzhong College of Shanxi Medical University (assistant professor at Shanxi Provincial Health School); that it is a racket-and-ball sport incorporating tai chi movements; and that it was practiced both competitively by hitting a ball across a net on a court and as a performance to musical accompaniment. Regarding its spread in China, the court found that nationwide instructor training courses were held from 1994 to 1996, that Taiji Rouliqiu was an official event at the Third National Workers' Games in 1996, and that an interview with A appeared in the People's Daily. It also found that, from 2002 onward, the Chinese Senior Citizens' Sports Association held training courses promoting it as a sport for older people and organized national tournaments. The court assessed it as clear that the activity had become established as a sport in China by the registration decision date, August 10, 2004. Regarding its spread in Japan, the court found that Plaintiff X2 received instructor training and obtained coaching qualifications in 2002, introduced it in a Sakai municipal citizens' course, conducted training at the Kanaoka Park Gymnasium in Sakai, and established the Taiji Rouliqiu Promotion Association in August 2003. It further found that the defendant's citizen-exchange delegation to China participated in celebrations in Beijing marking the 25th anniversary of the Japan–China Treaty of Peace and

Friendship, where the activity was demonstrated. The court assessed the activity as having been known in Japan as a Chinese-born sport under the name “Taiji Rouliqiu” by August 10, 2004, the registration decision date.

(3) As of the registration decision date, August 10, 2004, “Taiji Rouliqiu,” the mark at issue, was generally used in China as the name of the sport referring to the activity, and the activity was also known in Japan as a sport originating in China under the name “Taiji Rouliqiu.” Even the facts found above do not permit a conclusion that, as of that date, the mark had distinctiveness as indicating Plaintiff X2's activities. Therefore, for the designated services “planning, managing, or holding Taiji Rouliqiu events,” “providing sports facilities for Taiji Rouliqiu,” “providing amusement facilities for Taiji Rouliqiu,” and “renting sports equipment for Taiji Rouliqiu,” the mark indicates the quality of those goods or services in a manner in common use and consists solely of such an indication (Trademark Act Article 3(1)(iii)); the JPO decision to that effect cannot be said to be erroneous.

<Trademark Act Article 4(1)(xvi)>

As of the registration decision date, August 10, 2004, “Taiji Rouliqiu,” the mark at issue, was generally used in China as the name of the sport referring to the activity, and in Japan the activity was also known as a Chinese-born sport under that name. Accordingly, use of the mark on its designated goods “sports equipment used for teaching tai chi” gives rise to a likelihood of misperception of the quality of the goods. Further, among its designated services, use for “teaching arts, sports, or knowledge relating to tai chi instruction,” and for “planning, managing, or holding sporting events; providing sports facilities; providing amusement facilities; renting sports equipment” other than “planning, managing, or holding Taiji Rouliqiu events; providing sports facilities for Taiji Rouliqiu; providing amusement facilities for Taiji Rouliqiu; renting sports equipment for Taiji Rouliqiu,” can be said to give rise to a likelihood of misperception of the quality of services (Trademark Act Article 4(1)(xvi)). The JPO decision to that effect cannot be said to be erroneous.

https://www.nakapat.gr.jp/ja/legal_updates_jp/【商標法】本件は、商標「太極柔力球」（称呼「/

[Unfair Competition Prevention Act Article 2(1)(i)] IP High Court, 2023 (Ne) 10048 <Miyasaka> “Dr. Martens” Case — Special Distinctiveness Found

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HP: https://www.takaishihideki.com/single-post/ameblo-12864063883-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864063883-ja

[Unfair Competition Prevention Act Article 2(1)(i)] IP High Court, 2023 (Ne) 10048 <Miyasaka> “Dr. Martens” Case

***Special distinctiveness found ⇒ Rights holder prevailed**

Cf. IP High Court, 2023 (Gyo-Ke) 10003 <Honda> denied distinctiveness of the yellow-stitching position mark, citing, among other things, other companies' products with yellow stitching in the same position.

⇒ Under the Unfair Competition Prevention Act, numerous commonalities with the defendant's products beyond yellow stitching were asserted, and “special distinctiveness” was recognized for the combination. <<*This does not mean that different approaches were taken to trademark distinctiveness and special distinctiveness under the Unfair Competition Prevention Act!!>>

(Excerpt from the court's reasoning)

As found above, the “1460 8-hole boots” (leather boots), sold in Japan as products of the appellee's “Dr. Martens” brand, are found, in most of their models, to have the following features of appearance: yellow welt stitching (feature (a)), sole edges ((b)), heel loops ((c)), sole patterns ((d)), a sloping heel portion of the outsole ((e)), a rounded forepart of the shoe ((f)), Puritan stitching ((g)), and eight eyelets ((h)). … As stated above, the appellee's products are found to have conspicuous characteristics differing from other goods of the same kind and to exert strong source-identifying power, particularly in three respects: feature (a) (yellow welt stitching), feature (b) (sole edges), and feature (c) (heel loops). Further, when viewed as a whole in combination with features (d) through (h), which individually cannot be called particularly distinctive, they can be said to possess conspicuous characteristics entirely absent from other goods of the same kind (boots). In other words, the appellee's products having all the above features (a) through (h) are found to possess so-called special distinctiveness.



Image columns, from left to right: Appellee’s products; Appellant Product 1; Appellant Product 2.

https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e4%b8%8d%e6%ad%a3%e7%ab%b6%e4%ba%89%e9%98%b2%e6%ad%a2%e6%b3%95%e2%98%85%e3%80%91%e8%a2%ab%e6%8e%a7%e8%a8%b4%e4%ba%ba%e5%95%86%e5%93%81%e3%81%ae%e5%bd%a2%e6%85%8b%e3%81%af%e3%80%81%e3%81%84/

[Trademark] IP High Court, 2021 (Gyo-Ke) 10028 <Honda> — Mark at Issue “ヒルドマイルド” (Hirudo Mild); Cited Mark “ヒルドイド” (Hirudoid)

Original Ameblo publication: 2024-08-22

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HP: https://www.takaishihideki.com/single-post/ameblo-12864549043-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864549043-ja

[Trademark] IP High Court, 2021 (Gyo-Ke) 10028 <Honda>

Mark at issue: “ヒルドマイルド” (Hirudo Mild)

Cited mark: “ヒルドイド” (Hirudoid)

“ヒルド” (Hirudo) is a coined term; “マイルド” (Mild) has low distinguishing power.

⇒ Separate examination of “ヒルド” (Hirudo) permitted

⇒ (1) Same concept (a moisturizer containing a heparinoid); (2) same first three Japanese characters (cf. the Mevalocut case)

⇒ Similar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90597.pdf

[Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10048 “Dr. Martens” <Miyasaka>

Original Ameblo publication: 2024-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864549172.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864549172-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864549172-ja

[Unfair Competition Prevention Act] IP High Court, 2023 (Ne) 10048 “Dr. Martens” <Miyasaka>

(1) Yellow welt stitching

(2) Sole edges

(3) Heel loops

Conspicuous characteristics and strong source-identifying power in these three respects

+ Other features of shape

⇒ Defendant Product 2 also creates misidentification and confusion. Its heel loop (feature (3)) differs in detail but has the same basic form.

⇒ Rights holder prevailed

(Cf. Trademark registration based on feature (1) alone was denied.)



https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92497.pdf

Tokyo District Court Order, 2023 (Yo) 30214 [Dasatinib] <Sugiura> — Provisional Disposition Order

Original Ameblo publication: 2024-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864549312.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864549312-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864549312-ja

Tokyo District Court Order, 2023 (Yo) 30214 [Dasatinib] <Sugiura>

July 2023

Application for a provisional disposition order

October

The Ministry of Health, Labour and Welfare approved the additional indication/effect “chronic myeloid leukemia.”

November

Provisional disposition order

“Until the end of January 27, 2024, the debtor must not manufacture, sell, or offer for sale the pharmaceutical products listed in attached Schedules 1 and 2 whose ‘indications or effects’ include chronic myeloid leukemia (excluding imatinib-resistant chronic myeloid leukemia).”

https://www.bms.com/assets/bms/japan/pressrelease/20231129-pdf.pdf

[Design] IP High Court, 2023 (Gyo-Ke) 10072 <Hibiku Shimizu> — Design Act Article 46(2)

Original Ameblo publication: 2024-08-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864549411.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864549411-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864549411-ja

[Design] IP High Court, 2023 (Gyo-Ke) 10072 <Hibiku Shimizu>

***Design Act Article 46(2)**: “A reason not attributable to the person's responsibility” was denied.

*The overseas resident had not appointed an administrator.

⇒ Under Patent Act Article 192(3), incorporated by Design Act Article 68(5), service is deemed effected on the date the certified copy of the refusal decision is dispatched, even if it is not actually received.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92589.pdf

[“Justifiable Grounds” under Article 16 of the Act on Management Business of Copyright and Neighboring Rights] IP High Court, 2021 (Ne) 10047 <Kanno>

Original Ameblo publication: 2024-08-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864657700.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864657700-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864657700-ja

[“Justifiable Grounds” under Article 16 of the Act on Management Business of Copyright and Neighboring Rights] IP High Court, 2021 (Ne) 10047 <Kanno>

A live-music venue operator did not enter into a music-use license agreement with JASRAC.

⇒ JASRAC prevailed in litigation, but the operator did not pay.

⇒ JASRAC refused the performers’ applications for performance licenses.

⇒ “Justifiable grounds” established

*Although the operator did not collect venue-use fees from the performers, it was found to be the entity responsible for performing the musical works, taking into account, among other things, the structure under which it earned revenue from food and drink charges.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90653.pdf

IP High Court, 2020 (Gyo-Ke) 10144 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda> — Not “Obviousness upon Obviousness”

Original Ameblo publication: 2024-08-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864780215.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864780215-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864780215-ja

IP High Court, 2020 (Gyo-Ke) 10144 [Infusion Preparation Containing Sulfur-Containing Compounds and Trace Metal Elements] <Honda>

Difference A concerns the “composition of the solution.”

Difference B concerns the “contents and manner of storage.”

⇒ The two differ in technical perspective.

⇒ Even if the differences are identified separately, **this is not “obviousness upon obviousness.”**

(*The ultimate conclusion was that inventive step was satisfied.)

(Excerpt from the court's reasoning)

…The defendant argues that Differences A1-1 and B1-1 should not be identified separately. However, Difference A1-1 concerns the composition of the amino-acid-containing solution, while Difference B1-1 concerns what is contained in a container stored in one chamber of a multichamber infusion container and how that container is stored. The two thus differ in technical perspective. The points relied upon by the defendant merely constitute circumstances supporting the view that the configurations of the corrected inventions relating to Differences A1-1 and B1-1 should be understood as part of a cohesive technical concept constituting one cited invention….

<<⇒ Ultimately neither difference was obvious; inventive step satisfied.>>

https://www.takaishihideki.com/_files/ugd/324a18_b3a0678016994ee093daa962aa909252.doc

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90701.pdf

IP High Court, 2021 (Gyo-Ke) 10129 [… Composition for Cleaving Target DNA] <Kanno> — Not “Obviousness upon Obviousness”

Original Ameblo publication: 2024-08-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12864892576.html

HP: https://www.takaishihideki.com/single-post/ameblo-12864892576-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12864892576-ja

IP High Court, 2021 (Gyo-Ke) 10129 [… Composition for Cleaving Target DNA] <Kanno>

Adding a nuclear localization signal to the Cas9 polypeptide (Difference 2) follows naturally and simultaneously from attempting to apply the cited invention's CRISPR/Cas system to eukaryotic cells (Difference 1).

⇒ Not “obviousness upon obviousness”!! (Not two stages)

(Excerpt from the court's reasoning)

…Because a nuclear localization signal is a conventional means of transferring proteins into the nuclei of eukaryotic cells, when seeking to apply the cited invention's CRISPR/Cas9 system to eukaryotic cells—namely to transfer the Cas9 polypeptide into their nuclei—it is entirely natural to adopt a means for transferring it into the nucleus. Adding a nuclear localization signal to the Cas9 polypeptide follows naturally and simultaneously from attempting to apply the cited invention's CRISPR/Cas system to eukaryotic cells. Thus, adding the nuclear localization signal is not a further modification made on the premise of a CRISPR/Cas9 system already applied to eukaryotic cells, and does not constitute so-called “obviousness upon obviousness.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91645.pdf

https://www.takaishihideki.com/_files/ugd/324a18_b3a0678016994ee093daa962aa909252.doc

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji> — Not “Obviousness upon Obviousness”

Original Ameblo publication: 2024-08-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865028860.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865028860-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865028860-ja

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji>

One of the matters actually disclosed in a publicly available reference was selected for comparison.

*Even if a mental operation of selecting and presenting a refrigerant combination relevant to the difference was involved, this merely selected the same term as in the claimed invention.

⇒ Not “obviousness upon obviousness”

(Excerpt from the court's reasoning)

> The plaintiffs argue that the JPO decision, at the stage of identifying well-known matters, made an estimate or inference by selecting R32 from multiple exemplified refrigerants and did not objectively identify “well-known matters”; that, after encountering the claimed invention, it selected from multiple listed refrigerants the same configuration as the claimed invention, impermissibly introducing an obviousness assessment into the identification of the cited invention; and that, because its findings involved assumptions or inferences at the stage of identifying well-known technology and then an assessment of whether differences between the claimed and cited inventions could be rationalized, this constituted impermissible so-called obviousness upon obviousness…. …
>
> However, …Cited References 2 and 11 are found to actually describe combinations of each of the multiple listed primary-side refrigerants with carbon dioxide, and the combination of R32, one of those refrigerants, with carbon dioxide is one of the combinations actually described. Identification of a cited invention is performed so as to enable error-free comparison with and assessment of the claimed invention. Since Difference 1 identifies that the primary-side refrigerant is R32 in the claimed invention but propane in the cited invention, selecting a combination with R32 as the primary-side refrigerant is naturally appropriate as a refrigerant combination relevant to Difference 1. Even if a mental operation of selecting and presenting a combination relevant to Difference 1 is involved, this merely selects a combination relevant to the difference from the reference's description by searching for the same specific term, “R32,” used in the claimed invention's elements. This cannot be regarded as an estimate, inference, or assumption departing from the reference's disclosure, nor can it be said to be an obviousness assessment.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91747.pdf

https://www.takaishihideki.com/_files/ugd/324a18_b3a0678016994ee093daa962aa909252.doc

[Trademark] IP High Court, 2020 (Ne) 10017 <Honda> — First Cumulative Application of Article 38(2) and (3) of the Trademark Act in a Trademark Case

Original Ameblo publication: 2024-08-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865150608.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865150608-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865150608-ja

[Trademark] IP High Court, 2020 (Ne) 10017 <Honda>

One of three parties that had long used the “守半” (Morihan) indication obtained a trademark registration for “守半” (Morihan).

⇒ Enforcing rights against “守半” (Morihan) constitutes an abuse of rights, but enforcing them against “守半總本舗” (Morihan Sohonpo) does not.

For the first time in a trademark case, cumulative application of Article 38(2) and (3) of the Trademark Act was permitted.—“Nonidentity of markets”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91601.pdf

[Article] Exhaustion in the United Kingdom (Kumiko Yamada, Patent Supplement No. 30)

Original Ameblo publication: 2024-08-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865271332.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865271332-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865271332-ja

[Article] Exhaustion in the United Kingdom (Kumiko Yamada, Patent Supplement No. 30)

“UK+ Regime”

IP rights in goods placed on the market in the European Economic Area (EEA) by or with the consent of the rights holder are generally exhausted in the United Kingdom.

Placement on the UK market by or with the rights holder’s consent does not, by itself, necessarily exhaust rights in the EEA. Treatment in other countries depends on their exhaustion regimes.

https://www.jstage.jst.go.jp/article/patentsp/77/30/77_137/_pdf/-char/en

[Trademark] Osaka District Court, 2023 (Wa) 691, “子どもとママの歯医者さん” (“Dentist for Children and Mothers”) Case

Original Ameblo publication: 2024-08-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865394372.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865394372-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865394372-ja

[Trademark] Osaka District Court, 2023 (Wa) 691, “子どもとママの歯医者さん” (“Dentist for Children and Mothers”) Case

The lettering “こどもとママの歯科医院” (“Dental Clinic for Children and Mothers”) in the defendant's composite mark has weak distinctiveness and cannot be extracted.

⇒ Comparing the marks as a whole, the lettering “香椎照葉” (Kashii Teriha) differs, and their appearance, pronunciation, and concept (indicating an area) differ.

⇒ Dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92972.pdf

被告標章目録

1

香椎照葉こどもとママの歯科医院

2



List of the defendant’s marks. The Japanese wording in both Mark 1 and Mark 2 means “Kashii Teriha Dental Clinic for Children and Mothers.”

商標目録

１　登録商標　「子どもとママの歯医者さん」（標準文字）

登録番号　商標登録第６２２９４８８号

出願日　平成３０年１２月１８日

登録日　令和２年２月２６日

商品及び役務の区分

第３類、第５類、第２１類、第３５類、第４１類、第４４類

２　登録商標　「ママとこどものはいしゃさん」（標準文字）

登録番号　商標登録第５６２４８７２号

出願日　平成２５年５月３１日

登録日　平成２５年１０月２５日

商品及び役務の区分

第３類、第５類、第２１類、第３５類、第４１類、第４４類

List of trademarks

1. Registered trademark: “子どもとママの歯医者さん” (meaning “Dentist for Children and Mothers”; standard characters). Trademark Registration No. 6229488. Filing date: December 18, 2018. Registration date: February 26, 2020. Classes of goods and services: 3, 5, 21, 35, 41, and 44.

2. Registered trademark: “ママとこどものはいしゃさん” (meaning “Dentist for Mothers and Children”; standard characters). Trademark Registration No. 5624872. Filing date: May 31, 2013. Registration date: October 25, 2013. Classes of goods and services: 3, 5, 21, 35, 41, and 44.

[South Korea/Patent] 2016 Heo 7954 — Equivalence Established for a Numerically Limited Invention

Original Ameblo publication: 2024-08-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865518966.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865518966-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865518966-ja

[South Korea/Patent] 2016 Heo 7954 — Equivalence Established for a Numerically Limited Invention

The weight mixing ratio of microcrystalline cellulose to the main component is “at least 0.5 and no more than 3,” whereas the invention subject to the scope-confirmation request has “at least 0.1 and less than 0.5.”

⇒ The configuration of a coated tablet containing 100–500 mg of the active ingredient was not publicly known, and the relevant claim feature had not been amended.

⇒ No intentional exclusion

⇒ For claim 1, equivalence established for both the numerical-range difference and the difference between anhydrous lactose and lactose hydrate.

https://www.jetro.go.jp/ext_images/world/asia/kr/ip/pdf/han_2018.pdf

Tokyo District Court, 2022 (Wa) 22517 <Shibata> [Toilet Roll] [Roll Product Package]

Original Ameblo publication: 2024-09-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12865900106.html

HP: https://www.takaishihideki.com/single-post/ameblo-12865900106-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12865900106-ja

Tokyo District Court, 2022 (Wa) 22517 <Shibata>

[Toilet Roll (First Patent)]

*For the double-embossed defendant products, “the embossing on the front and back does not necessarily overlap, and coincidence of the embossing edges is not guaranteed.” The court therefore held that the embossing edges could not be identified and the embossing depth could not be established.

⇒ Claim limitation not satisfied

[Roll Product Package (Second Patent)]

*The court denied only the third requirement of equivalence (obviousness of substitution at the time of manufacture) and the fifth requirement!!

“In the defendant products …, only the central part of the slit is arcuate upward, and its basic shape differs from the configuration of Invention 2….”

(Excerpts from the court's reasoning)

<Claim element> 1B: The embossing depth of said embossing is 0.05–0.40 mm.

Even assuming the embossing is approximately square, the longest portion a in Specification 1 is not necessarily the length of its horizontal side …, and the location at which the measured sectional curve is obtained to measure embossing depth under the plaintiff's measurement method is not necessarily the location shown in Specification 1. … The one-shot images of each defendant product … show …that the embossing edges of the products cannot be clearly located. …The defendant products cannot necessarily be said to have an embossing edge fr of the kind presupposed by Invention 1. …

Given the nature of embossing in toilet rolls, some variation in the shapes of individual embossings can be expected. However, the embossing depth D in Invention 1 is measured on toilet rolls for which an embossing height profile on the X–Y plane can be obtained …and the embossing edge fr and its longest portion a can be located, after obtaining sectional curves as in Figure 5(b) and Figure 6. The invention states that its effect is achieved in toilet rolls whose embossing depth D, measured in this manner, has specified numerical values. Each defendant product is ordinary two-ply double embossing formed by ply-bonding without specifically adjusting the relative positions of the embossing protrusions and depressions on the sheets…. In such double-embossed toilet rolls, the embossing applied respectively to the front and back does not necessarily overlap, and the edges are not guaranteed to coincide. As a result, the embossing edges are unclear; displacement of protrusions and depressions can also cause interference and produce embossing of indistinct shape. According to the Exhibit Ko 51 report, in each defendant product, a local maximum of upward-convex

curvature in the sectional curve is found at the center of a portion identified by the plaintiff as embossing, among other things. It is therefore not necessarily clear whether that embossing has the depressed shape envisaged for measuring embossing depth D in Invention 1. Nor can it necessarily be said that the embossing height profile on the X–Y plane permits identification of the embossing edge fr and its longest portion a. Thus, even if ten embossings are selected and measured on each defendant toilet roll having such embossing, and a particular depth D is calculated as their average, it cannot be said that the embossing depth D in Invention 1 has been measured.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93308.pdf

IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Fiber Sheet] <Hibiku Shimizu>

Original Ameblo publication: 2024-09-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866026354.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866026354-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866026354-ja

IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Fiber Sheet] <Hibiku Shimizu>

The patentee entered into a basic purchase agreement with Taiki (タイキ), a party other than the petitioner in the invalidation trial, containing a confidentiality clause stipulating that “confidential matters shall be identified in writing.”

⇒ The process document prepared by Shin-ei Senshoku (新栄染色) was faxed by the patentee to Taiki and was also distributed to employees of Taiki, the patentee, and Shin-ei Senshoku without imposing confidentiality obligations. It contained no indication that the patentee or Taiki had specifically identified the information as confidential.

⇒ Publicly known

⇒ Novelty: not satisfied

+ Usurped application was also found!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92893.pdf

IP High Court, 2023 (Gyo-Ke) 10091 [Barrier Laminate] <Miyasaka>

Original Ameblo publication: 2024-09-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866149667.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866149667-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866149667-ja

IP High Court, 2023 (Gyo-Ke) 10091 [Barrier Laminate] <Miyasaka>

*For a difference concerning a numerical limitation, the court held that technical significance and obviousness of the configuration are not directly linked.

*From a cited invention demonstrating technical significance through three elements (carbon, oxygen, silicon), the numerical ranges for only two elements (carbon, silicon) could not be extracted.

⇒ Revocation decision set aside

(Excerpts from the court's reasoning)

The invention …provides a surface-coating layer containing a resin material having polar groups with excellent adhesion between a polypropylene film and a deposited film, thereby preventing interlayer separation. It also provides, on the deposited film, a barrier-coating layer made of a resin composition of a metal alkoxide and a water-soluble polymer, including cases where a silane coupling agent is used together with them, thereby preventing cracks in the deposited film. Further, it sets the ratio of silicon atoms to carbon atoms at the surface of the barrier-coating layer within a specified range so as to suppress deterioration of gas-barrier properties even during boiling or retort treatment. It thus has the technical significance of providing a barrier laminate for boiling or retort use with high gas-barrier properties. According to the specification, the upper limit of the silicon-to-carbon ratio (Si/C) is set from the standpoint of suppressing deterioration of gas-barrier properties even when the laminate is bent, while the lower limit is set from the standpoint of suppressing such deterioration even when it is heated…. Therefore, Difference 1-3, concerning whether the laminate is for boiling or retort use, and Difference 1-2, concerning the numerical range of the silicon-to-carbon ratio, should be considered together. …

Even if a person skilled in the art contemplated using the food-packaging material of the invention in Exhibit Ko 3 for boiling or retort applications, the ratio of metal atoms among the atoms constituting the overcoat layer in Exhibit Ko 4 is unrelated to whether gas-barrier properties are maintained upon heating. Moreover, Exhibit Ko 4 states the opposite of Exhibit Ko 3 regarding the ratio of carbon to metal atoms and the brittleness of the film. Given these matters, it is unreasonable to derive motivation to focus, within the laminate of Exhibit Ko 4 concerning an outer covering for vacuum insulation material—which differs in both technical field and layered structure from the invention in Exhibit Ko 3—on the descriptions of the overcoat and inorganic layers in the overcoat-coated film, and to refer to the ratio of metal atoms to carbon atoms in the overcoat layer (number of metal atoms/number of carbon atoms) for application to the invention in Exhibit Ko 3. The decision's assessment is erroneous. …

The defendant argues that the Si/C numerical range has no particular technical significance, and that, considering also that it was publicly known, as in Exhibit Ko 4, to examine numerical ranges using “Si/C” for the common technology concerning layered structure, a person skilled in the art could readily have adopted the configuration of the invention relating to Difference 1-2 in the invention in Exhibit Ko 3 by referring to Exhibit Ko 4. …

…However, concerning (1) above, …it cannot immediately be said that there is no technical significance. In the first place, whether technical significance is substantiated and whether a configuration is obvious are not directly linked issues.

Regarding (2) above, merely because the …numerical range of the invention in Exhibit Ko 3 encompasses “at least 0.90 and no more than 1.60,” the numerical range of Invention 1, there is no reasonable basis or technical necessity for extracting only carbon and silicon from Exhibit Ko 3's disclosure, which demonstrates a certain technical significance through numerical ranges of carbon, oxygen, and silicon.

Table 1 of Exhibit Ko 4 discloses …a value within the numerical range of Invention 1, but the table does not show film properties or indicate that this Si/C ratio is superior to other parts-by-mass values outside the range of Invention 1. It therefore cannot be said that a person skilled in the art would focus on that value. Moreover, merely because Exhibit Ko 4—which has no more in common with Exhibit Ko 3 than being “an invention concerning a layered structure”—describes examining numerical ranges using “Si/C,” it cannot be said that a person skilled in the art could readily have adopted the configurations relating to Differences 1-2 and 1-3 by referring to Exhibit Ko 4.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92977.pdf

IP High Court, 2012 (Ne) 10018 [Skeletal Structure of a Large Articulated Soft-Vinyl Doll] <Shibata>

Original Ameblo publication: 2024-09-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866280093.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866280093-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866280093-ja

IP High Court, 2012 (Ne) 10018 [Skeletal Structure of a Large Articulated Soft-Vinyl Doll] <Shibata>

*Equivalence can be established even when some claim elements are absent.

⇒ Not established in this case

= Osaka District Court, 2021 (Wa) 10032 [Chip Fuse]

Tokyo District Court, 2012 (Wa) 31523 [Flow Control Valve] <Hasegawa> found equivalence where part of a claim element was absent.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-82638.pdf

[Contract/Extinctive Prescription] Supreme Court, April 24, 1998, 1995 (O) 2472

Original Ameblo publication: 2024-09-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866400622.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866400622-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866400622-ja

[Contract/Extinctive Prescription] Supreme Court, April 24, 1998, 1995 (O) 2472

For a contractual obligation, the prescription period for a damages claim arising from impossibility of performance attributable to the obligor begins to run when performance of the original obligation could have been demanded.

⇒ <<Take care>> Not from the time performance becomes impossible!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-62776.pdf

[China] Supreme People's Court, (2016) Zui Gao Fa Xing Zai No. 41, “Daiichi Sankyo Case”

Original Ameblo publication: 2024-09-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866528331.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866528331-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866528331-ja

[China] Supreme People's Court, (2016) Zui Gao Fa Xing Zai No. 41, “Daiichi Sankyo Case”

Markush-form claims are construed under a generalization approach.

⇒ Deletion of arbitrary alternatives raises the issue of uncertainty. The principle is that amendment of a Markush-form claim must not give rise to a group of compounds or an individual compound having new properties and functions, while the circumstances of the individual case must also be considered.

Cf. In Europe, the question is whether the subject matter remaining after deletion of alternatives is within the original disclosure; deletion may be permissible.

⇒ Strengthen dependent claims and disclosure of specific combinations with China and Europe in mind.

https://ipc.court.gov.cn/zh-cn/news/view-14.html

Osaka District Court, 1998 (Wa) 7191 [Ink Tube for a Writing Instrument] *A case in which adding another substance to an otherwise infringing accused product resulted in noninfringement!!

Original Ameblo publication: 2024-09-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866686154.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866686154-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866686154-ja

Osaka District Court, 1998 (Wa) 7191 [Ink Tube for a Writing Instrument] *A case in which adding another substance to an otherwise infringing accused product resulted in noninfringement!!

*Without a gelling agent the limitation was satisfied, but adding a gelling agent resulted in non-satisfaction.

In light of the purpose of the claimed utility-model device (a backflow-preventing agent), gelled polybutene was found to be a different substance from polybutene before gelation.

⇒ “The backflow-preventing agent is polybutene” not satisfied

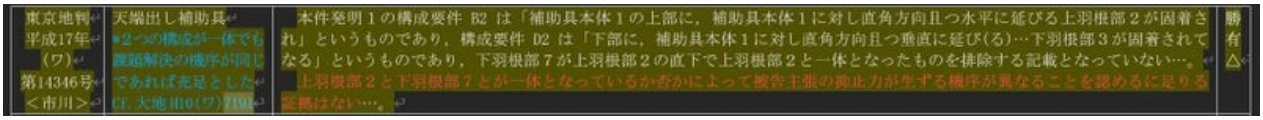
Cf. Tokyo District Court, 2005 (Wa) 14346

(Excerpts from the court's reasoning)

…Although the polybutene in the backflow-preventing agent of the accused product is gelled by a gelling agent, it continues to exist as polybutene within the gelling agent's three-dimensional network. There is therefore some room to view it as having the configuration of the device at issue, “the backflow-preventing agent consists of polybutene.” …

Polybutene gelled by a gelling agent is found normally to exhibit high viscosity, while, as ink flows out during writing, the shear rate of the backflow-preventing agent increases, lowering its apparent viscosity so that it follows the ink. …

From the standpoint of its use as a backflow-preventing agent, it is inappropriate to divide polybutene gelled by a gelling agent into “addition of the gelling agent (or the network structure of the gelling agent)” and “polybutene,” and treat the former as a merely additional configuration. Pure polybutene and polybutene gelled by a gelling agent should be considered different substances. Accordingly, the accused product, whose backflow-preventing agent consists of polybutene gelled by a gelling agent, must be said not to have the configuration of the device at issue, “the backflow-preventing agent consists of polybutene.”



Comparison table: Tokyo District Court, 2005 (Wa) 14346 [Top-Level Setting Aid] <Ichikawa>

*The claim limitations were held to be satisfied even where two configurations were integrated, provided that the mechanism for solving the problem was the same.

Cf. Osaka District Court, 1998 (Wa) 7191.

Claim element B2 of Invention 1 states that “an upper wing portion 2 extending horizontally and perpendicular to the aid body 1 is fixed to the upper portion of the aid body 1,” while claim element D2

states that “a lower wing portion 3 extending vertically and perpendicular to the aid body 1 … is fixed to the lower portion.” The wording does not exclude a lower wing portion 7 positioned directly beneath and integrated with upper wing portion 2….

There is insufficient evidence to establish that the mechanism generating the restraining force asserted by the defendant differs depending on whether upper wing portion 2 and lower wing portion 7 are integrated….

Table notation: 勝 (“win”); 有 (literally, “present”); △.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12566.pdf

Tokyo District Court, 2005 (Wa) 14346 [Top-Level Setting Aid] <Ichikawa>

Original Ameblo publication: 2024-09-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866869405.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866869405-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866869405-ja

Tokyo District Court, 2005 (Wa) 14346 [Top-Level Setting Aid] <Ichikawa>

The accused product integrated the two configurations of claim elements B2 and D2.

⇒ (1) The claims do not exclude an integrated structure. + (2) No evidence shows a different mechanism for solving the problem (restraining force).

⇒ Claim limitations satisfied

Cf. Osaka District Court, 1998 (Wa) 7191

(Excerpts from the court's reasoning)

Claim element B2 of Invention 1 states that “an upper wing portion 2 extending horizontally and perpendicular to the aid body 1 is fixed to the upper portion of the aid body 1,” while element D2 states that “a lower wing portion 3 extending …vertically and perpendicular to the aid body 1 is fixed to the lower portion.” The wording does not exclude a lower wing portion 7 positioned directly beneath and integrated with upper wing portion 2….

There is insufficient evidence to establish that the mechanism generating the restraining force asserted by the defendant differs depending on whether upper wing portion 2 and lower wing portion 7 are integrated….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33256.pdf

[Copyright/Corporate Authorship] IP High Court, 2010 (Ne) 10081 — Corporate Authorship Denied (“Initiative of a Corporation or Other Employer” Denied)

Original Ameblo publication: 2024-09-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12866999188.html

HP: https://www.takaishihideki.com/single-post/ameblo-12866999188-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12866999188-ja

[Copyright/Corporate Authorship] IP High Court, 2010 (Ne) 10081

(1) The publisher asked individual employees to write.

(2) The company's minutes contained no record of a writing request.

(3) The portions assigned to departing employees were not handed over to other employees.

(4) The series was planned by the publisher.

(5) The publisher paid manuscript fees to the individual employees.

⇒ Corporate authorship denied (“initiative of a corporation or other employer” denied)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81151.pdf

[Europe] EPO Decision T 61/14 — Requirements for a parameter invention to satisfy sufficiency of disclosure under Article 83 EPC

Original Ameblo publication: 2024-09-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867121432.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867121432-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867121432-ja

[Europe] EPO Decision T 61/14

*For a parameter invention to satisfy the sufficiency-of-disclosure requirement under Article 83 EPC, throughout the entire claimed range, not only the method of measuring the parameter but also the method of adjusting it must be described in the application as filed, or be practicable by a person skilled in the art based on common general technical knowledge at filing.

When a parameter is claimed, its method of adjustment must be disclosed | Reflections on European IP Practice (hasegawa-ip.com)

[U.S.] July 2023 <CAFC> In re Float’N’Grill LLC — Reissue Application

Original Ameblo publication: 2024-09-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867247179.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867247179-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867247179-ja

[U.S.] July 2023 <CAFC> In re Float’N’Grill LLC

Limits on generalization in a reissue application (35 U.S.C. § 251, Reissue)

⇒ Essential features cannot be deleted.

Because “magnets” are essential to the invention, reissue is unavailable for an invention deleting them.

⇒ The limits on generalization are the same as in Japan!!

https://www.youtube.com/watch?v=caYkLhd5rYM

https://www.cafc.uscourts.gov/opinions-orders/22-1438.OPINION.7-12-2023_2156183.pdf

[Trademark] IP High Court, 2019 (Gyo-Ke) 10101 <Otaka> “南三陸キラキラ丼” (Minamisanriku Kirakira Don) Case

Original Ameblo publication: 2024-09-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867365147.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867365147-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867365147-ja

[Trademark] IP High Court, 2019 (Gyo-Ke) 10101 <Otaka> “南三陸キラキラ丼” (Minamisanriku Kirakira Don) Case

For a trademark right registered in the name of the representative of an unincorporated association, the court held that “it is appropriate to treat the defendant and the Minamisanriku Restaurant Association as the same person,” and denied that they were “another person” under Trademark Act Article 4(1)(x), (xv), and (xix).

⇒ Trademark right upheld

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89123.pdf

Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheeting] <Tanaka>

Original Ameblo publication: 2024-09-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867551138.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867551138-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867551138-ja

Tokyo District Court, 2018 (Wa) 1130 [Printed Retroreflective Sheeting] <Tanaka>

*Although no comparative examples outside the numerical range were provided, the support requirement was satisfied.

(The appellate judgment, IP High Court, 2021 (Ne) 10084 <Miyasaka>, also found the support requirement satisfied.)

The specification's statement that “at least 0.15 mm² is preferable because moldability is excellent …, and no more than 30 mm² is preferable because … interlayer adhesion strength is not reduced” contributed!!

(Excerpts from the court's reasoning)

Paragraph [0030] states: “An area of at least 0.15 mm² for an independent printed region is preferable because moldability is excellent and hue adjustment is easy, while an area of no more than 30 mm² is preferable because it does not reduce the interlayer adhesion strength of the two layers sandwiching the printed layer (2) around the printed region.” A person skilled in the art encountering this disclosure would understand that, if the area of a printed layer for improving or adjusting the hue of a retroreflective sheet is too small, the benefit of hue adjustment cannot be obtained, so a certain size is necessary. They would also understand that, if the area of a printed layer having poor adhesion is too large, interlayer adhesion strength decreases, so the printed layer must be sufficiently small. Accordingly, the technical significance of the invention can be understood even without examples comparing printed-region areas below 0.15 mm² or above 30 mm²….

The appellate judgment, IP High Court, 2021 (Ne) 10084 <Miyasaka>, also found the support requirement satisfied.

“The problem addressed by the invention can be said to be providing retroreflective sheeting with improved hue by solving, through an extremely simple and inexpensive method, the prior-art shortcomings of poor weather resistance and water resistance arising when a continuous printed layer is provided to improve hue in triangular-pyramidal cube-corner retroreflective sheeting, vapor-deposited triangular-pyramidal cube-corner retroreflective sheeting, and the like. Although it cannot be denied that conditions other than whether the printed regions are continuous or separate could affect solution of this problem, the support requirement does not demand exhaustive coverage of those conditions and effects. A person skilled in the art, comparing the claims of the patent and the specification, would be able to recognize that the invention is described as one contributing to solution of the above problem.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90776.pdf

[U.S.] September 2012 <CAFC> Santarus v. Par Pharmaceutical

Original Ameblo publication: 2024-09-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867551677.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867551677-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867551677-ja

[U.S.] September 2012 <CAFC> 694 F.3d 1344, Santarus v. Par Pharmaceutical

The negative expression "the gastric medication does not contain sucralfate" satisfied the written-description requirement.

The reason was explained in the specification.

⇒ The specification identified disadvantages of using sucralfate, allowing a skilled person to understand a reason to avoid it. The court did not find that sucralfate itself caused gastric mucosal damage.

https://www.cafc.uscourts.gov/opinions-orders/10-1360.-1380.pdf

[U.S.] November 2015 <CAFC> 805 F.3d 1350, Inphi v. Netlist

Original Ameblo publication: 2024-09-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867728040.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867728040-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867728040-ja

[U.S.] November 2015 <CAFC> 805 F.3d 1350, Inphi v. Netlist

The negative expression “excluding ‘CAS, RAS, or bank address signals’” satisfied the written-description requirement.

An industry association's standards publication concerning the technology of the invention was incorporated into the specification, enabling a person skilled in the art reasonably to infer that particular signals were excluded.

(The court cited Santarus.)

https://jp.youme.com/sub_news/ipboardopen.aspx?idx=1562

[U.S.] June 2014 <CAFC> 752 F.3d 1371, Q.I. Press Controls v. Lee

Original Ameblo publication: 2024-09-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12867852708.html

HP: https://www.takaishihideki.com/single-post/ameblo-12867852708-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12867852708-ja

[U.S.] June 2014 <CAFC> 752 F.3d 1371, Q.I. Press Controls v. Lee

The negative expression “the printing-press substrate is not supported at the illumination point” failed the written-description requirement.

Figure 2 appears at first glance not to show support at the illumination point, but the substrate in Figure 2 is floating, and there is no reference to the printing press's roller hardware or additional drawings, so a person skilled in the art cannot recognize this.

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/81703/1/59_05-Tokii.pdf

[U.S.] January 2020 <CAFC> 946 F.3d 1367, Eko Brands v. Adrian Rivera

Original Ameblo publication: 2024-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868000111.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868000111-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868000111-ja

[U.S.] January 2020 <CAFC> 946 F.3d 1367, Eko Brands v. Adrian Rivera

In a partial dissent, Judge Reyna criticized the construction importing a negative limitation excluding “broad, thin mesh” as unsupported. The majority upheld the construction and the finding of non-infringement.

According to that dissent, the specification does not mention mesh, let alone broad, thin mesh, and contains no disclosure supporting the exclusion.

(The dissent observed that the mesh exclusion came from a feature of Eko’s accused product.)

https://www.cafc.uscourts.gov/opinions-orders/18-2215.opinion.1-13-2020.pdf

[U.S.] January 2013 <CAFC> Ernie Ball v. Earvana

Original Ameblo publication: 2024-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868002697.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868002697-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868002697-ja

[U.S.] January 2013 <CAFC> 502 Fed. Appx. 971, Ernie Ball v. Earvana

Claim 1, which included a limitation that the arrangement "does not form a sinusoidal arc …," was held indefinite under former 35 U.S.C. § 112, second paragraph.

The problem was that the curve through the intonation portions was not uniquely specified: the same arrangement could be depicted with sinusoidal or non-sinusoidal curves. The holding did not rest merely on the absence of a definition of "sinusoidal."

https://www.cafc.uscourts.gov/opinions-orders/12-1276.opinion.1-22-2013.1.pdf

[U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

Original Ameblo publication: 2024-09-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868002849.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868002849-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868002849-ja

See also the separate article on the same case, published on 2024-09-20.

[U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

The negative expression requiring administration “at a dosage of 0.5 mg/day without an immediately preceding loading dose” failed the written-description requirement.

As a general rule, where the specification states a basis for exclusion,

or

even without an express statement, the written-description requirement may be satisfied if a skilled person would understand the disclosure necessarily to exclude that matter. Neither basis was established in this case.

https://www.itohpat.co.jp/ip/1900/

[U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

Original Ameblo publication: 2024-09-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868237057.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868237057-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868237057-ja

See also the separate article on the same case, published on 2024-09-18.

[U.S.] June 2022 <CAFC> 38 F.4th 1013, Novartis v. Accord

The negative expression requiring administration “at a dosage of 0.5 mg/day without an immediately preceding loading dose” failed the written-description requirement.

As a general rule, where the specification states a basis for exclusion,

or

even without an express statement, the written-description requirement may be satisfied if a skilled person would understand the disclosure necessarily to exclude that matter. Neither basis was established in this case.

https://www.cafc.uscourts.gov/opinions-orders/21-1070.OPINION.6-21-2022_1967294.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) 10018, “プレジャー” (“Pleasure”) <Shoji>

Original Ameblo publication: 2024-09-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868349184.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868349184-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868349184-ja

[Trademark] IP High Court, 2023 (Gyo-Ke) 10018, “プレジャー” (“Pleasure”) <Shoji>

*Even if evidence of use was not submitted during a nonuse cancellation trial, it may be submitted in an action to set aside the trial decision.

⇒ Use established (trial decision set aside)

“In the case decided by the Supreme Court in 1991, too … no allegation or proof of trademark use was made … at the trial-proceeding stage.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92746.pdf

Tokyo District Court, 2022 (Wa) 18830 [Rolling Device] <Shibata>

Original Ameblo publication: 2024-09-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868467962.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868467962-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868467962-ja

Tokyo District Court, 2022 (Wa) 18830 [Rolling Device] <Shibata>

*Effects of the invention

⇒ The functional claim “composed of multiple rolling elements interposed so as to roll freely between the raceways” means a configuration capable of increasing or decreasing the orbital speed of individual rolling elements and adjusting the spacing between them accordingly.

⇒ Claim limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92809.pdf

IP High Court, 2023 (Gyo-Ke) 10013 [Method of Manufacturing a Pole Housing] <Hibiku Shimizu>

Original Ameblo publication: 2024-09-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868714473.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868714473-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868714473-ja

IP High Court, 2023 (Gyo-Ke) 10013 [Method of Manufacturing a Pole Housing] <Hibiku Shimizu>

"There is motivation to apply … Well-Known Matter 1." "There is motivation to apply Well-Known Matter 2 …." "A person skilled in the art could readily have conceived … by applying Well-Known Matters 1 and 2 to the cited invention."

⇒ Inventive step: not satisfied. "Obviousness upon obviousness" was not treated as an issue.

(Excerpts from the court's reasoning)

(5) Application of Well-Known Matter 2 to the cited invention …

…The cited invention belongs to the technical field of pole housings for electric motors, and Well-Known Matter 1 belongs to the technical field of cylindrical covers and the like used in electric motors, or motors using such covers. On the other hand, …Well-Known Matter 2 is also found to belong to the technical field of tubular housings and the like used in electric motors, or motors using such housings. Accordingly, the cited invention as modified by Well-Known Matter 1, on the one hand, and Well-Known Matter 2, on the other, share the same technical field. …Because Well-Known Matter 1 presupposes forming a stepped portion at the end of a motor housing, the cited invention as modified by it naturally raises the need to consider how to form that stepped portion. This can be called a problem inherent in the cited invention as modified by Well-Known Matter 1. …Well-Known Matter 2 presents a specific method (use of a press apparatus) for forming a stepped portion at the end of a tubular member. It can therefore be said to be a means (technology) capable of solving the above …problem naturally inherent in the cited invention as modified by Well-Known Matter 1. …

For these reasons, it is appropriate to find that there was motivation to apply Well-Known Matter 2 to the cited invention as modified by Well-Known Matter 1.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92628.pdf

[U.S./Trademark] U.S. Supreme Court, June 2023, Abitron v. Hetronic

Original Ameblo publication: 2024-09-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868714556.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868714556-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868714556-ja

[U.S./Trademark] U.S. Supreme Court, June 2023, Abitron v. Hetronic

97% of the defendant products' sales were outside the United States.

⇒ Extraterritorial application involves a two-step test.

(1) Does the statutory provision apply extraterritorially?

if no

(2) Did conduct relevant to the focus of congressional concern occur within U.S. territory?

⇒ Extraterritorial application of U.S. trademark law, §§ 1114(1)(a) and 1125(a)(1), denied

https://www.jetro.go.jp/ext_images/_Ipnews/us/2023/20230706.pdf

IP High Court, 2022 (Gyo-Ke) 10131 [Heat Exchanger Using Thermally Conductive Knitted Wire Fabric] <Honda>

Original Ameblo publication: 2024-09-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868833391.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868833391-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868833391-ja

IP High Court, 2022 (Gyo-Ke) 10131 [Heat Exchanger Using Thermally Conductive Knitted Wire Fabric] <Honda>

*Merely reciting the functions and effects produced by a configuration does not narrow the claim.

= IP High Court, 2021 (Gyo-Ke) 10090 [Spray Product and Spraying Method] <Otaka>

“Selecting metal as the material for … is a routine material selection by a person skilled in the art…. It is also routine, when forming a metal member, to form it integrally by casting or welding.”

⇒ Inventive step: not satisfied

Obviousness upon obviousness was not treated as an issue.

(Excerpt from the court's reasoning)

Since a person skilled in the art could readily have provided the cited invention with configurations A through C of the claimed invention, configurations D and F would naturally also be satisfied accordingly…. Configuration D specifies the function achieved by having configurations A through C. Because configuration C does not specify what physical components are included in the “device requiring heat dissipation or heat absorption,” whatever components are contained inside the cited invention's “heat pipe 4 having a heat-generating portion” does not affect identification of the common features and differences concerning configuration C, or the obviousness assessment, and likewise does not affect the assessment of configuration D. …Because configuration F does not specify a comparison standard, “rapidly conducting generated heat over the shortest distance to the largest heat-dissipating surface” in configuration F is a function of a device having configurations A through C, not an action defined by comparison with any standard. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92501.pdf

IP High Court, 2021 (Ne) 10084 [Printed Retroreflective Sheeting] <Miyasaka> — First Raised on Appeal: Rejected as Untimely

Original Ameblo publication: 2024-09-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12868946802.html

HP: https://www.takaishihideki.com/single-post/ameblo-12868946802-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12868946802-ja

IP High Court, 2021 (Ne) 10084 [Printed Retroreflective Sheeting] <Miyasaka>

(1) The lack-of-inventive-step arguments (i) and (ii), first advanced on appeal, were rejected as untimely!!

(i) The primary reference asserted at first instance + a different secondary reference

(ii) An argument changing the interpretation of the primary reference asserted at first instance (the identification of the primary cited invention)

*The judgment does not make clear whether these were asserted in the statement of reasons for appeal.

(2) *The support requirement does not demand exhaustive coverage of every condition and effect that could influence solution of the problem.

“The problem addressed by the invention can be said to be providing retroreflective sheeting with improved hue by solving, through an extremely simple and inexpensive method, the prior-art shortcomings of poor weather resistance and water resistance arising when a continuous printed layer is provided to improve hue in triangular-pyramidal cube-corner retroreflective sheeting, vapor-deposited triangular-pyramidal cube-corner retroreflective sheeting, and the like. Although it cannot be denied that conditions other than whether the printed regions are continuous or separate could affect solution of this problem, the support requirement does not demand exhaustive coverage of those conditions and effects. A person skilled in the art, comparing the claims of the patent and the specification, would be able to recognize that the invention is described as one contributing to solution of the above problem.”

⇒ Support requirement: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92685.pdf

IP High Court, 2023 (Gyo-Ke) 10011 [Device for Remotely Operating a Mobile Terminal] <Miyasaka>

Original Ameblo publication: 2024-09-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869249848.html

IP High Court, 2023 (Gyo-Ke) 10011 [Device for Remotely Operating a Mobile Terminal] <Miyasaka>

*The disclaimer claim "… images (excluding images captured by a camera)" lacked inventive step.

The argument that "in the cited invention, 'image capture' of the terminal display unit's display screen is an essential feature and there is no motivation to replace it" was rejected.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92579.pdf

[Patent/Civil Code] Tokyo District Court, 2022 (Wa) 19222 <Kokubu> — Analogous Application of Civil Code Article 94(2)

Original Ameblo publication: 2024-09-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869448646.html

[Patent/Civil Code] Tokyo District Court, 2022 (Wa) 19222 <Kokubu>

An unauthorized assignment of the right to obtain a patent, followed by successive assignments of the patent right

⇒ The plaintiff bore responsibility for creating a false appearance.

(1) Partly caused by the plaintiff's own internal circumstances and conduct

(2) Left unaddressed for four years despite knowledge

(3) Left unaddressed for another six months after the judgment finding the shareholders' resolutions nonexistent became final

+ The defendants acted in good faith and without negligence.

⇒ Civil Code Article 94(2) applied by analogy

(Excerpts from the court's reasoning)

(2) Whether the requirements for analogous application of Civil Code Article 94(2) are satisfied in this case

A. The plaintiff's responsibility for creating the false appearance

(a) The evidence cited below and the entire purport of oral argument establish the following facts.

a. D, as an employee of Total Life Factory, was planning with Eternal Co., Ltd. a business manufacturing and selling the “Afloat” hair-treatment iron. H (hereinafter “H”), who supported the plan, established the plaintiff on October 11, 2011 for that business (Exhibits Ko 1 and 26).

b. A, as an assistant at Total Life Factory, handled the company's customer service and administration under D's instructions (Exhibit Ko 26; plaintiff's representative).

c. Around 2014, H decided to resign as the plaintiff's representative and transfer the plaintiff's shares to Total Life Factory in order to concentrate on the business of Grace Co., Ltd., which H managed.

D therefore asked A to become the plaintiff's representative. A assumed that position around June of that year, and the appointment was registered.

As for the plaintiff's shares, to avoid a direct transfer from H to Total Life Factory, a business partner of Grace Co., Ltd., it was decided to transfer them through A. On June 11, it was contractually agreed, in documentation prepared by D, that the shares would be

transferred first from H to A and then from A to Total Life Factory. (Exhibit Ko 26; plaintiff's representative)

d. D and E assigned the right to obtain a patent for the invention to the plaintiff on November 16, 2014, and the plaintiff filed the application on April 6, 2015. A remained the plaintiff's representative at least until around June 11 of that year. (Exhibits Ko 3–5 and 7)

e. On July 15, 2015, A convened an extraordinary shareholders' meeting asserting that A was a shareholder of the plaintiff. The meeting adopted resolutions removing D as a director and appointing A as a director and representative director (Shareholders' Resolution (1)); those matters were registered on July 22. A also convened an extraordinary shareholders' meeting on July 30, which adopted a resolution appointing B as a director (Shareholders' Resolution (2)); that appointment was registered on July 31. (Exhibits Ko 7 and 8) D learned around that month that those registrations had been made. D was not acquainted with B (Exhibit Ko 26; plaintiff's representative).

f. On August 18, 2015, A entered into Assignment Agreement (1) with B and prepared, in the name of the plaintiff's representative director, a deed assigning to B the right to obtain a patent for the invention (the Assignment Deed) (Exhibit Ko 6).

g. On March 1, 2016, A convened an extraordinary shareholders' meeting, which adopted a resolution dissolving the plaintiff and appointing attorney F as its representative liquidator (this resolution, together with Shareholders' Resolutions (1) and (2), is hereinafter referred to as the “Shareholders' Resolutions at Issue”). Those matters were registered on March 14 (Exhibits Ko 7 and 8).

h. On April 19, 2016, attorney F, as the plaintiff's representative liquidator, applied for a payment order against D seeking damages, alleging, among other things, that D had misappropriated the plaintiff's deposits. The application proceeded to ordinary litigation (hereinafter the “Damages Action”). The validity of the Shareholders' Resolutions at Issue became an issue in that action. (Exhibit Ko 26)

i. By November 29, 2016, D had learned that the right to obtain a patent for the invention had been transferred to B. D asked patent attorney L of SOCO IP LAW FIRM, who had represented the plaintiff in the patent application (hereinafter “patent attorney L”), about the application's status. L informed D that the applicant had been changed from the plaintiff to B and, correspondingly, the application representative had been changed to Kyoto International Patent Office, a patent professional corporation (Exhibit Ko 30; plaintiff's representative).

j. Examination of the patent application was requested on April 6, 2018, a decision to grant was issued on February 14, 2019, and B obtained registration establishing the patent right on May 17, 2019 (Exhibit Ko 5; Exhibits Otsu 1 and 2).

By around that month, D knew that B had obtained registration of the patent right through the above course of events (plaintiff's representative).

k. In the Damages Action, the Tokyo District Court rendered a judgment dismissing the action as inadmissible on October 11, 2019. An appeal was filed, but the Tokyo High Court dismissed it on March 19, 2020, and that judgment became final (Exhibit Ko 26; plaintiff's representative).

l. D subsequently asked attorney F to hand over documents concerning the plaintiff. Because F did not comply, D brought an action against the plaintiff in 2021 seeking a declaration that the Shareholders' Resolutions at Issue did not exist. Despite being duly summoned, the plaintiff did not appear at the oral hearing. On July 20, 2021, the Tokyo District Court granted D's claim, and the judgment became final on August 5, 2021. (Exhibits Ko 7, 8, and 26; plaintiff's representative)

m. Following finalization of the judgment in item l, registrations dated August 30, 2021 recorded, among other things, that the judgment declaring nonexistent the resolution removing D as a director had become final and that D's status as a director had been restored. Further, on September 29, 2021, the registration dated July 15, 2015 of D's departure from office was canceled ex officio, and restoration of D's status as representative director was registered (Exhibit Ko 7).

n. On February 1, 2022, B and Reizvoll entered into Assignment Agreement (2), and on April 8, 2022, Reizvoll and the defendant entered into Assignment Agreement (3) (Exhibit Ko 4; Exhibits Otsu 5 and 10; entire purport of oral argument).

(b) As stated in (a)b through d, A, as an assistant at Total Life Factory, handled customer service and administrative tasks under D's instructions. At D's request, A became representative director around June 2014 and remained the plaintiff's representative director at least until around June 11, 2015. Moreover, H, the plaintiff's founder, decided to transfer the plaintiff's shares through A to Total Life Factory. On June 11, 2014, it was contractually agreed, in documentation prepared by D, that the shares would be transferred first from H to A and then from A to Total Life Factory. A also used those contractual arrangements in becoming the plaintiff's representative director through Shareholders' Resolution (1).

As stated in (a)e and f, A convened an extraordinary shareholders' meeting on July 15, 2015, at which Shareholders' Resolution (1) appointing A as representative director was adopted. On August 18, 2015, A and B entered into Assignment Agreement (1), assigning B the right to obtain a patent for the invention.

Accordingly, A's execution of Assignment Agreement (1) arose from the conduct of H, a shareholder of the plaintiff, and D, said to be its true representative. The plaintiff's own

internal circumstances and conduct must therefore be said to have played a substantial role in creating the false appearance that B held the patent right.

(c) Further, as stated in (a)e and h, by around July 2015 D knew that registrations had been made removing D as a director, appointing A as a director and representative director, and appointing B as a director. In the Damages Action, too, the validity of the Shareholders' Resolutions at Issue, which included appointing A and B as directors and the like, was disputed.

Moreover, according to (a)e and i and the entire purport of oral argument, by November 29, 2016 at the latest, D knew that the right to obtain a patent for the invention had been transferred to B, with whom D was unacquainted and who appeared to cooperate with A; that the applicant had been changed from the plaintiff to B; and that the application representative had correspondingly been changed to Kyoto International Patent Office.

Further, as stated in (a)j, examination was requested on April 6, 2018, a decision to grant was issued on February 14, 2019, and B obtained registration establishing the patent right on May 17, 2019. D also knew of this course of events.

Thus, D, said to be the plaintiff's true representative, knew by around July 2015 that A had taken steps such as having A appointed the plaintiff's representative director. By November 29, 2016, D also knew that the right to obtain a patent had been assigned to B, whom D did not know and who appeared to cooperate with A.

Nevertheless, as stated in (a)k and l, even after the appeal in the Damages Action was dismissed on March 19, 2020, D did not bring an action seeking a declaration of nonexistence of the Shareholders' Resolutions at Issue until 2021. The entire purport of oral argument also establishes that D took no other measures, such as other contentious or noncontentious proceedings or approaches to B.

(d) Further, as stated in (a)l, even after the plaintiff obtained a favorable judgment on July 20, 2021 in the action seeking a declaration of nonexistence of the Shareholders' Resolutions at Issue and that judgment became final on August 5, 2021, until the patent right was transferred from B to Reizvoll on February 1, 2022, the plaintiff took neither legal measures, such as demanding that B complete registration of transfer of the patent right or seeking a provisional disposition prohibiting transfer, nor other measures, such as contacting B to request return of the patent registration to the plaintiff or that registration not be transferred to others (plaintiff's representative; entire purport of oral argument).

(e) As explained above, the plaintiff's own internal circumstances and conduct were part of the reason A entered into Assignment Agreement (1) and created the false appearance that B was the patentee. Moreover, although D, said to be the plaintiff's true representative, knew by November 29, 2016 at the latest that this false appearance existed, D did not bring an action seeking a declaration of nonexistence of the Shareholders' Resolutions at Issue or

take similar steps for approximately four years, until 2021. Further, even after the judgment declaring those resolutions nonexistent became final on August 5, 2021, no measures were taken against B during the approximately six months before B transferred the patent right to Reizvoll.

In these circumstances, the plaintiff must be found to bear, for creating the false appearance, responsibility so serious as to be equivalent to having actively participated in creating it or having deliberately left it unaddressed despite knowing of it.

(f) In response, the plaintiff argues that its (D's) conduct after the judgment declaring the Shareholders' Resolutions at Issue nonexistent became final on August 5, 2021 was unobjectionable: the court-commissioned registration was not completed until around mid-October, and after the judgment became final it was difficult to envisage B further transferring the patent right, so the plaintiff was seeking the documents from attorney F.

However, by August 5, approximately six years had already elapsed since Assignment Agreement (1), and B was unacquainted with D and appeared to cooperate with A. Once the judgment declaring the resolutions nonexistent became final, there was therefore a strong need promptly to take legal measures against B, such as demanding completion of registration of transfer of the patent right.

Further, as stated in (a)k and l, even after the judgment dismissing the Damages Action became final, attorney F did not comply with D's request for documents. F, who was regarded as the plaintiff's representative liquidator in the action seeking a declaration of nonexistence of the resolutions, also failed to attend the oral hearing despite being duly summoned. Given F's responses and litigation conduct, even after the judgment declaring the resolutions nonexistent became final, it was not reasonable to expect F to comply with D's request for the documents.

In addition to those circumstances, the plaintiff could have demanded the documents from F while simultaneously pursuing a demand against B for registration of transfer of the patent right. Accordingly, the plaintiff's argument that there was nothing wrong with its (D's) conduct after the judgment became final on August 5, 2021 cannot be accepted.

(g) The plaintiff further argues that B was a party to the unlawful takeover of the plaintiff, and that B's patent attorney would be expected to act according to B's wishes and would not cooperate with D. Thus, even if D had approached B or B's patent attorney, it would not have helped remove the false appearance and might even have been counterproductive.

However, first, there is insufficient evidence to establish that B personally was a party to an unlawful takeover of the plaintiff. Moreover, since D never contacted B, there was no indication of how B would respond, and it is unreasonable to conclude categorically that approaching B would not have removed the false appearance or would have been counterproductive. Further, if B or B's patent attorney did not respond to D's approach, that

would simply mean that B and D disputed ownership of the patent right. In that event, D should promptly have brought an action seeking a declaration of nonexistence of the Shareholders' Resolutions at Issue or taken similar steps.

Accordingly, that argument of the plaintiff cannot be accepted.

B. The defendants' good faith and absence of negligence

(a) The evidence cited below and the entire purport of oral argument establish the following facts.

a. Around May 2021, G, the defendant's employee in charge, received a request from the defendant's development department to investigate patents relating to a hair iron under development. G discovered the patent and asked a patent attorney firm to conduct a freedom-to-operate investigation into whether the hair iron fell within the invention's technical scope and whether grounds for invalidity existed (Exhibit Otsu 9; witness G).

b. The investigation in item a concluded that the defendant's hair iron under development fell within the invention's technical scope but that grounds for invalidity existed. The defendants therefore decided both to request an invalidation trial and to negotiate with B for assignment of the patent right, entrusting the negotiations to a patent attorney (Exhibits Otsu 6 and 9; witness G).

c. The patent attorney engaged under item b negotiated with B. On February 1, 2022, B visited the patent attorney firm to which that attorney belonged, and B and Reizvoll entered into Assignment Agreement (2) (Exhibit Ko 4; Exhibits Otsu 5, 9, and 10; witness G; entire purport of oral argument).

d. At the time of execution of Assignment Agreement (2), G had received no report from the patent attorney engaged under item b of suspicious circumstances concerning Reizvoll's entering into that agreement (witness G).

(b) As stated in items a through d above, G asked a patent attorney belonging to a patent attorney firm to conduct a freedom-to-operate investigation and negotiate with B for assignment of the patent right. The attorney arranged for Assignment Agreement (2) to be concluded on February 1, 2022, and G received no report from the attorney of suspicious circumstances concerning its conclusion.

In addition to these circumstances, as of February 1, 2022, when Assignment Agreement (2) was executed, more than six years and five months had elapsed since Assignment Agreement (1), yet its validity was not then expressly disputed. Taking this into account as well, it is appropriate to find that, at the time of Assignment Agreement (2), the defendants were in good faith and without negligence regarding the fact that B had not acquired the right to obtain a patent for the invention and did not hold the patent right.

(c) In response, the plaintiff argues that the defendants must have known, by checking the plaintiff's commercial register, that A was not its representative on August 18, 2015, when Assignment Agreement (1) was executed, and thus knew that B did not hold the patent right.

However, the evidence (witness G) and the entire purport of oral argument establish that the defendants did not check the plaintiff's commercial register. Nor does all the evidence establish that the defendants knew that A was not the plaintiff's representative as of August 18, 2015. The plaintiff's argument therefore lacks its premise and cannot be accepted.

Accordingly, it is not established that the defendants knew B did not hold the patent right.

(d) The plaintiff also identifies the following suspicious circumstances: (1) it is extremely unusual, as with this patent, for an individual applicant and patentee not to be the inventor; (2) it is highly unnatural for the plaintiff, a corporation practicing the invention for which it applied, to assign the right to obtain a patent to B, an individual; (3) while A used a seal bearing the plaintiff's name and A's position as representative director on the April 22, 2015 “Certificate for Application of the Exception to Loss of Novelty,” A used a different personal seal on the Assignment Deed; (4) it is highly unnatural for the plaintiff corporation, only four months after filing, to assign to B, an individual, the right to obtain a patent for an invention it was itself practicing; and (5) neither B individually nor the security and maintenance company B apparently represented was engaged in a hair-iron business, making assignment by the plaintiff to such a B unnatural. On these grounds, the plaintiff argues that the defendants had a duty to verify whether A had authority to represent the plaintiff on August 18, 2015.

However, whether it is unnatural that the applicant and patentee was an individual (B) different from the inventor (point (1)), or that the plaintiff corporation assigned the right to obtain a patent to B four months after filing despite practicing the invention (points (2) and (4)), must be assessed in light of the plaintiff's internal circumstances. The defendants were not in a position to know the plaintiff's internal circumstances explained in A(b) above. In those circumstances, it would have been difficult to question the validity of Assignment Agreement (1) and the appearance created by the JPO registration based on it.

As for use of A's personal seal on the Assignment Deed (point (3)), relatively small companies may use a representative's personal seal when entering into contracts. This does not immediately entail that the validity of Assignment Agreement (1) and the appearance of the JPO registration based on it should have been questioned.

Nor does the fact that B was not engaged in a hair-iron business (point (5)), by itself, negate a need for B to acquire from the plaintiff the right to obtain a patent for the invention.

In addition to these circumstances, as explained in (b), the validity of Assignment Agreement (1) had not been expressly disputed for more than six years and five months after its execution, and the appearance that B was the patentee had persisted for a substantial

period. Even considering all the suspicious circumstances identified by the plaintiff together, they cannot be said to establish a duty on the defendants to question the validity of Assignment Agreement (1) and the JPO registration based on it, and to verify whether A had authority to represent the plaintiff as of August 18, 2015.

Accordingly, that argument of the plaintiff cannot be accepted.

(3) Summary

For these reasons, it is appropriate to construe Civil Code Article 94(2) as applying by analogy in this case, with the result that the plaintiff cannot assert against the defendant that it holds the right to obtain a patent for the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92949.pdf

IP High Court, 2022 (Gyo-Ke) 10124 [Robot System for Transferring Egg Packs] <Miyasaka>

Original Ameblo publication: 2024-09-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869448833.html

IP High Court, 2022 (Gyo-Ke) 10124 [Robot System for Transferring Egg Packs] <Miyasaka>

"The specification … describes a configuration in which one machine performs two roles …; therefore, … implementing them as separate devices (dedicated configurations) is technically easy and … can be carried out based on common general technical knowledge."

⇒ Support and enablement requirements: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92564.pdf

Nepal Tiger — Distinctive; Article 4(1)(xvi) Not Applicable / Tibet Tiger — Not Distinctive

Original Ameblo publication: 2024-10-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869571388.html

[Trademark] IP High Court, 2023 (Gyo-Ke) 10115 <Shoji> “Nepal Tiger” — Distinctiveness satisfied (Article 3(1)(iii)); Article 4(1)(xvi) not applicable

Several websites describe “Tibetan carpets” shaped like tigers as “Tibetan Tiger Rugs” and the like, but none uses “Nepal Tiger.”

+The court regarded “Nepal Tiger” as a unitary coined expression that did not immediately indicate the goods’ origin, place of sale, or quality.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92920.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) 10116 <Miyasaka> “Tibet Tiger” — No distinctiveness; Article 4(1)(xvi) applicable

It conveys the meaning of a tiger of Tibet.

There is no evidence that the place name Tibet is not well known.

Numerous “Tibetan carpets” shaped like tigers are sold as “Tibetan Tiger Rugs” and the like.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92801.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) 10114 <Hibiku Shimizu> “Tibetan Tiger” — No distinctiveness

“Tibetan carpets” shaped like tigers are called “Tibetan Tiger Rugs” and the like.

⇒ A mark consisting solely of an indication describing characteristics such as the quality of Tibetan carpets (goods) shaped in the plan-view outline of a tiger seen from above.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92927.pdf

For Patent Attorney Oral-Examination Candidates — Questions on Legislative Purpose (Patents)

Original Ameblo publication: 2024-10-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869897875.html

For Patent Attorney Oral-Examination Candidates — Questions on Legislative Purpose (Patents)

⇒ Likewise, memorize ten purposes each for designs and trademarks.

• Encouragement of inventions + development of industry

• Legal stability

• Prevention of unforeseen disadvantage to third parties

• Guaranteeing an opportunity to defend

• International harmonization

• Speed (resolution in a single proceeding)

• Fairness

• Balance between disclosure and exclusive rights (equity)

• Balance between rights holders and the public's freedom to practice inventions (equity)

• Alleviating difficulty of proof: presumptions of damages, document-production orders, inspection by a court-appointed expert

• Protecting trade secrets: confidentiality orders, restrictions on inspection and copying, in-camera proceedings

• Excluding double patenting

• Ensuring rational decisions

(Purpose of the patent system)

Grant an exclusive right in exchange for disclosure of the invention.

Encourage inventions and thereby contribute to the development of industry.

(Amendment)

(1) Ensure sufficient disclosure of the invention from the outset and fairness of treatment between applications with insufficient disclosure and applications with sufficient disclosure from the outset.

(2) Prevent unforeseen disadvantages to third parties who acted on the basis of the scope of the invention disclosed at filing.

(Patent Act Article 39)

Exclude double patenting under the principle of one patent per invention.

(Patent Act Article 29-2)

Also take account of avoiding a situation in which appropriate and prompt processing of later applications becomes impossible.

The purpose of requiring reasons in trial decisions (Patent Act Article 157(2)(iv)) is to ensure careful, fair, and appropriate decisions and assist in deciding whether to appeal.

(Patent Act Article 101(ii): indirect infringement involving products indispensable to solving the problem addressed by the invention)

Wholly enjoining the production, transfer, etc. of such products and ordering their destruction accords with the purpose of Patent Act Article 101(ii), which extends the effect of the patent right to acts highly likely to lead to infringement even where multipurpose products are concerned.

(Prior-use right)

The purpose of the system is to achieve fairness between the patentee and a person who had previously practiced the patented invention.

= Adjustment of interests

(Patent Act Article 77(4))

It provides that an exclusive licensee may grant a nonexclusive license to another person with the patentee's consent, on the premise that granting such a license to a third party does not affect the exclusive licensee's exclusive license.

(Patent Act Article 102(2))

Purpose: alleviate the difficulty of proving the amount of damages.

Purpose of the system of confidentiality orders

= Protect parties' trade secrets disclosed in litigation.

(Patent Act Article 167: after a trial decision becomes final and binding, the parties and intervenors may not request another invalidation trial on the same facts and evidence.)

Achieve resolution of disputes in a single proceeding between the same parties.

(Patent Act Article 157(2): requires reasons in the written trial decision)

Ensure rationality and the like in trial decisions, restrain arbitrariness, and eliminate the risk of findings not based on objective evidence (technical materials) or decisions lacking logical reasoning.

(Patent Act Article 134(2), main clause: when an amendment to the trial request is permitted, a copy of the amendment must generally be served on the respondent, who is given an opportunity to file an answer.)

Guarantee the opposing party an opportunity to defend.

[U.S.] May 2024, In re Bystolic (Second Circuit Court of Appeals)

Original Ameblo publication: 2024-10-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12869949108.html

[U.S.] May 2024, In re Bystolic (Second Circuit Court of Appeals)

A large and unjustified reverse payment in a pharmaceutical patent settlement may be subject to antitrust scrutiny under the rule of reason, but is not automatically unlawful. In this case, the court affirmed dismissal because the plaintiffs failed plausibly to allege that the payments were unjustified or unexplained.

—Comparison with litigation costs and the value of goods and services is important.

*An issue that often warrants consideration in Japan as well, including outside the pharmaceutical field!!

https://openlegalcommunity.com/pharmaceutical-patent-settlement-reversepayment-antitrust-litigation-case/

[U.S./Design Patent] May 2024, CAFC en banc, LKQ v. GM Global

Original Ameblo publication: 2024-10-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870330677.html

[U.S./Design Patent] May 2024, CAFC en banc, LKQ v. GM Global Tech.

The court overturned the 40-year-old Rosen-Durling test (which required a primary reference “basically the same” as the claimed design when assessing design-patent obviousness), holding that the obviousness standard in the Supreme Court's 2007 KSR decision applies.

Changing Design-Law Orthodoxy: En Banc CAFC Adopts a More Flexible Standard for Design-Patent Obviousness — Open Legal Community

IP High Court, 2023 (Gyo-Ke) 10084 and 10089 [Electric Impact Tightening Tool] <Hibiku Shimizu>

Original Ameblo publication: 2024-10-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870330748.html

IP High Court, 2023 (Gyo-Ke) 10084 and 10089 [Electric Impact Tightening Tool] <Hibiku Shimizu>

The primary reference states that its embodiment may be applied to outer-rotor and inner-rotor types.

⇒ In the outer-rotor type, arranging multiple magnets along the outer circumferential side of the stator (the inner circumferential side of the rotor) to hold them was well-known technology.

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93258.pdf

IP High Court, 2021 (Ne) 10086 [Lamp] <Honda> *Prior-use right established

Original Ameblo publication: 2024-10-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870330915.html

IP High Court, 2021 (Ne) 10086 [Lamp] <Honda> *Prior-use right established

*For a numerically limited invention, products after design changes were also held within the scope of the prior-use right.

⇒ After finding the variation of the prior-use products (slightly broader than the actual prior-used articles), the court identified the range permitting appropriate adjustment as the range of identity covered by the prior-use right.

⇒ A prior-use right is established even without recognition of the parameter.

“There are no circumstances indicating that Kanaden … participated through joint research or otherwise …; given that … in April 2012, when delivery to Kanaden occurred … the product was already being sold to the public …, it is difficult to regard delivery … to Kanaden as presupposing … a duty of confidentiality.”

⇒ Public working: novelty not satisfied

[Claim 1] …A lamp satisfying the relationship y ≧ 1.09x, where y (mm) is the full width at half maximum of the luminance distribution obtained when light from each of the multiple LED chips passes through the outermost enclosure of the lamp, and x (mm) is the distance between emission centers of adjacent LED chips.

(Excerpts from the court's reasoning)

…For all 24 of the appellee's 403W products, y/x was measured for the 25th and 50th LEDs from the left. For the 25th LED, the minimum was 1.303, the maximum 1.388, and the mean-value 3σ limits were 1.281 and 1.397; for the 50th, the minimum was 1.297, the maximum 1.381, and the mean-value 3σ limits were 1.272 and 1.403. Industrial products exhibit quality variation due to various causes even when produced in the same process, and the same can be said of lighting fixtures. As noted, each of the appellee's 403W products showed numerical variation. It is also understood that one commonly adopted quality-control method compares inspection results with the required quality standard and keeps the difference (manufacturing error) within three standard deviations (3σ)…. In light of these matters, the measured y/x values of the appellee's 403W products were approximately 1.27–1.38. For 3σ, taking ordinary manufacturing error into account, although the required quality standard for the 403W product is unknown, ordinary control methods would treat the measured mean as that standard; the products' y/x values can therefore be found to have been approximately 1.27–1.40. …

In light of the foregoing, the range of y/x extending above 1.4 to 1.7 or beyond 1.7 in the invention embodied in the 403W product was a range the appellee had achieved by appropriately adjusting x and controlled as its own. …Further, reducing the grainy appearance of LED lighting, the problem addressed by each Invention 1, was known to persons skilled in LED lighting before the claimed priority date. They can be said to have manufactured lighting fixtures without that grainy appearance through trial and error without using the parameter at issue. In such technical circumstances, where a formula is used to define a product invention, a product practiced or prepared for practice before filing (the claimed priority date) may fall within the technical scope defined by the formula of an invention subsequently filed and patented. The appellee's lack of recognition of the parameter at issue should therefore not negate establishment of a prior-use right. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93015.pdf

Tokyo District Court, 2021 (Wa) 18031 [Mobile Phone; Receiving Apparatus] <Kokubu>

Original Ameblo publication: 2024-10-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870440371.html

Tokyo District Court, 2021 (Wa) 18031 [Mobile Phone; Receiving Apparatus] <Kokubu>

Identifying the gist of a subcombination invention

The wording “for transmitting and receiving to and from the mobile phone of claim 4” does not specify the receiving apparatus's own structure, functions, or the like, and therefore does not define the invention relating to the receiving apparatus.

⇒ Excluded from identification of the gist of the invention

⇒ Novelty: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92974.pdf

IP High Court, 2024 (Gyo-Ke) 10002 [Nonwoven Fabric for Civil Engineering] <Shoji>

Original Ameblo publication: 2024-10-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870567413.html

IP High Court, 2024 (Gyo-Ke) 10002 [Nonwoven Fabric for Civil Engineering] <Shoji>

*Even if compliance with specifications is required to maintain a product's identity and quality, developing a new product based on it by changing some specifications is naturally done.

⇒ There is no teaching away from changing the proportion of black fibers in the publicly worked product.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93103.pdf

IP High Court, 2023 (Gyo-Ke) 10002 [Light Source Unit] <Honda>

Original Ameblo publication: 2024-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870690677.html

IP High Court, 2023 (Gyo-Ke) 10002 [Light Source Unit] <Honda>

Identifying the gist of the invention: JPO decision set aside / inventive step not satisfied

The invention does not specify a concrete configuration, such as bolts or hooks, for attaching the “mounting member” to the fixture body.

⇒ Any suitable configuration may be adopted in light of the state of the art.

⇒ Common feature

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92987.pdf

IP High Court, 2023 (Gyo-Ke) 10056 [Hydrophilic Filtration During Manufacture of a Vaccine Adjuvant] <Hibiku Shimizu>

Original Ameblo publication: 2024-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870814041.html

IP High Court, 2023 (Gyo-Ke) 10056 [Hydrophilic Filtration During Manufacture of a Vaccine Adjuvant] <Hibiku Shimizu>

Identification of the cited invention: inventive step not satisfied

Step (III) in the primary reference can be viewed as a step provided for convenience because there are cases in which the adjuvant is combined with an antigen solution and cases in which it is not; in the latter case, the step is not technically essential.

(Excerpt from the court's reasoning)

Step (III) asserted by the intervenor (filling large bottles with bulk adjuvant emulsion) can be viewed as a step provided for convenience because the adjuvant emulsion may or may not be combined with an antigen solution. At least in the latter case, undergoing that step cannot be said to be technically essential. Accordingly, performing the first and second filtration steps consecutively in the invention described in Exhibit Ko 11 does not in any way conflict with that invention's technical concept…. Thus, the first and second filtration steps of that invention cannot be said to be separate steps incapable of consecutive performance, and …the intervenor's argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92860.pdf

Tokyo District Court, 2019 (Wa) 24736 [… Air-Conditioned Clothing] <Kokubu>

Original Ameblo publication: 2024-10-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12870994669.html

Tokyo District Court, 2019 (Wa) 24736 [… Air-Conditioned Clothing] <Kokubu>

A person skilled in the art encountering the publicly worked invention would recognize the problem of "tying a pair of adjustment cords to the desired length."

⇒ The adjustment method is well known in the clothing field.

⇒ The fact that air-conditioned clothing itself is an innovative technology does not support inventive step.

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92975.pdf

IP High Court, 2023 (Ne) 10086 [5-Aminolevulinic Acid Phosphate] <Miyasaka>

Original Ameblo publication: 2024-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12871443866.html

IP High Court, 2023 (Ne) 10086 [5-Aminolevulinic Acid Phosphate] <Miyasaka>

*Merely naming a substance in a reference does not disclose the invention unless the reference enables a skilled person to practice it without thought or trial and error requiring creative ability.

⇒ Novelty and inventive step: satisfied

"For a person who invents a manufacturing method or the like after the patent application, interests are adjusted with those of the patentee through an award establishing a nonexclusive license (Article 92 of the same Act)."

(Excerpts from the court's reasoning)

The appellant argues that, for a substance-patent invention whose compound is expressly identified in a publicly available reference and whose technical significance lies in having made the compound for the first time, the compound itself is publicly known, so the invention should be deemed to lack novelty. Alternatively, if it has novelty, because its technical significance lies in having made the compound, its technical scope should be limited to products made by the manufacturing method actually invented by the inventor or to isolated high-purity compounds. However, this cannot be accepted for the following reasons.

A. Given that an invention is a creation of a technical idea (see Patent Act Article 2(1)), for a product invention to be described in a publication distributed before filing (Article 29(1)(iii)), the publication must disclose not only the invention's configuration but also its technical idea sufficiently for a person skilled in the art encountering it to implement that idea based on common general technical knowledge at filing without exercising creative ability through thought, trial and error, or the like.

Particularly where the product is a new chemical substance, finding a manufacturing method or other means of obtaining it is often difficult. Thus, for the technical idea to be disclosed in a publication, generally the publication must not merely disclose the substance's constitution but describe enough to permit understanding of its manufacturing method. Where it does not, a person skilled in the art encountering the publication must be able to discover a manufacturing method or other means of obtaining it based on common general technical knowledge at filing, without exercising creative ability through thought, trial and error, or the like.

Here, the cited reference, a publicly available publication, contains no description of a manufacturing method for 5-aminolevulinic acid phosphate. Nor do the papers in Exhibits Otsu 16–18 establish that a person skilled in the art could have found a manufacturing method or other means of obtaining it based on common general technical knowledge at

filing. (The foregoing is the same as Part 3, 3(1)B of the “Facts and Reasons” in the original judgment [p. 14 onward].)

B. By contrast, the specification not only discloses the constitution of 5-aminolevulinic acid phosphate ([0009], [0014]–[0016]) but also contains sufficient description for a person skilled in the art to understand its manufacturing method ([0007], [0019]–[0028], [0034]–[0036]). This discloses the technical idea of the invention, an invention of a new chemical substance, sufficiently for a person skilled in the art to practice it; its technical significance is not limited to a mere manufacturing method.

Where a patent is granted for a product invention, the patent right extends to any product identical in structure, characteristics, and the like, regardless of its manufacturing method (see Supreme Court, Second Petty Bench, June 5, 2015, 2012 (Ju) 1204, Minshu Vol. 69 No. 4, p. 700).

C. For persons who were manufacturing or otherwise practicing at the time of the patent application, as the appellant points out, adjustment of interests with the patentee is achieved through a nonexclusive license by prior use (Patent Act Article 79). For persons who invent a manufacturing method or the like after the application, it is achieved through an award establishing a nonexclusive license (Article 92).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92864.pdf

IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Fiber Sheet] <Hibiku Shimizu>

Original Ameblo publication: 2024-10-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12871573705.html

IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Fiber Sheet] <Hibiku Shimizu>

*Usurped application established (JPO decision set aside)

The true inventor's statement: pile length 2–3 mm

Claim 4 specifies 3–10 mm, so the statements are consistent.

Even if the usurping applicant devised various refinements to the dyeing process, none was included in the claims.

⇒ Could adding “the configuration devised by the usurping applicant” through correction have complicated the issue?

*Since patentability existed even without “the configuration devised by the usurping applicant,” perhaps this would merely become a violation of the joint-application requirement. If patentability were recognized only after adding that configuration through correction, the invention might have been solely that of the inventor named in the publication. A judgment offering lessons on points to consider when filing alone for an invention involving others!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92893.pdf

IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu> — Inventive-Step Assessment and Scope of Res Judicata

Original Ameblo publication: 2024-10-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872054956.html

IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu>

*Inventive-step determinations: distinguish res judicata concerning Invention 4 from the binding effect concerning Invention 1 and related claims.

Concerning Invention 1 and related claims, although there were points the first judgment did not decide, inventive step is a legal determination based on identification of the invention and cited invention and their common features and differences.

The binding effect of the first judgment prevents the trial examiners from finding different facts and making a different determination.

"In light of the purpose of the Supreme Court Grand Bench judgment of March 10, 1976 …, res judicata attaches not to the absence of illegality in the trial decision generally, but to the absence of illegality in the decision on inventive step based on the invention (publicly known technology) described in the particular reference examined in the patent invalidation trial."

(Excerpts from the court's reasoning)

In light of the purpose of the Supreme Court Grand Bench judgment of March 10, 1976 (1967 (Gyo-Tsu) 28), Minshu Vol. 30 No. 2, p. 79, it is appropriate to understand that the res judicata effect of a judgment dismissing a claim in an action to set aside a decision in a patent invalidation trial concerning inventive step attaches not to the absence of illegality in that decision generally, but to the absence of illegality in its determination of inventive step based on the invention (publicly known technology) described in the particular reference examined in the invalidation trial.

Applying this to the present case, as found above, the first judgment (the portion dismissing the plaintiff's claim; the same applies below) held that Invention 4 could not be said to have been readily invented before filing by a person skilled in the art based on the cited invention in Exhibit Ko 1. It upheld the first trial decision to the same effect and dismissed the plaintiff's claim. Because that judgment subsequently became final, the absence of illegality in the first trial decision, which held that Invention 4 could not be said to lack inventive step based on the cited invention in Exhibit Ko 1, must be regarded as conclusively established with res judicata effect.

The issue here is the illegality of the present trial decision, not the first trial decision. However, the plaintiff's assertion in this action that Invention 4 lacks inventive step based on the cited invention in Exhibit Ko 1 (Ground for Cancellation 3), and that the portion of the present decision denying lack of inventive step is unlawful, substantively seeks a different

determination on the part concerning illegality of the first trial decision that is subject to res judicata (the determination that inventive step cannot be denied on the basis of the same cited invention). This must be regarded as impermissible.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92861.pdf

IP High Court, 2023 (Gyo-Ke) 10015 [Method of Manufacturing a Refractory for a Gas-Blowing Nozzle] <Shoji>

Original Ameblo publication: 2024-10-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872056015.html

IP High Court, 2023 (Gyo-Ke) 10015 [Method of Manufacturing a Refractory for a Gas-Blowing Nozzle] <Shoji>

"The bricks of the invention in Exhibit Ko 2 are more likely than the refractory of the invention in Exhibit Ko 1 to be exposed to harsh environments causing damage …; even if preventing deformation … is important for those bricks …, it cannot be said that the invention in Exhibit Ko 1 … necessarily requires the same properties."

⇒ No motivation: inventive step satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92719.pdf

IP High Court, 2023 (Gyo-Ke) 10049 [Optical Imaging Apparatus] <Miyasaka>

Original Ameblo publication: 2024-10-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872056398.html

IP High Court, 2023 (Gyo-Ke) 10049 [Optical Imaging Apparatus] <Miyasaka>

"Reducing the diameter of the insertion portion is a well-known problem in the technical field of endoscopes … and is therefore … inherent in the cited invention…. The well-known method provides a means of solving that problem inherent in the cited invention …, so … motivation exists…."

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92742.pdf

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji> — Design Matters and Motivation

Original Ameblo publication: 2024-10-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872170863.html

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji>

***Design matters and motivation**

"Where the claimed invention is reached by adopting, in the primary cited invention, design changes or design matters accompanying the concrete application of technology for solving its problem, adoption of such **design changes or design matters … permits a finding of obviousness even without particular motivation"**

(Excerpts from the court's reasoning)

B. Whether there is motivation to apply well-known technology to the primary cited invention

(a) Whether motivation was assessed

The plaintiffs argue that, even when something is regarded as a design matter based on well-known matters, the mere fact that it is well known does not permit omission of consideration of whether obviousness can be rationalized (including whether there is motivation to apply it or any teaching away). Because the JPO decision did not make these assessments, they argue that its determination is erroneous (Part 3, 3, [Plaintiffs' Arguments], (2)A above).

In principle, affirming obviousness of the claimed invention requires motivation to combine the primary cited invention with an invention described in a secondary reference or with well-known technology. However, where the claimed invention is reached by adopting design changes or design matters accompanying the concrete application of technology to solve the primary invention's problem, adopting them is merely an exercise of the ordinary creative ability of a person skilled in the art. Obviousness should therefore be recognized even without particular motivation. As stated in (1) and (2) above, applying to the cited invention the configurations of the claimed invention relating to Differences 1 and 2 is merely an exercise of ordinary creative ability and can be regarded as a design matter; obviousness is recognized even without a showing of particular motivation for that application.

Moreover, as stated in (1) and (2), the problem addressed by the cited invention can be solved by adopting its means of solution, and there are no circumstances indicating that applying the configurations relating to Differences 1 and 2 would prevent solution of that problem. Thus, there is no teaching away from their application. The JPO decision identified the plaintiffs' teaching-away arguments and rejected them (section 6(3)B [pp. 26–27 of the decision]), and no error is found in that determination. As explained, particular motivation is

not required to recognize the obviousness of Differences 1 and 2, but the plaintiffs' arguments are examined below for completeness.

(b) Whether the technical fields are related

The plaintiffs contend that, when assessing the relationship between technical fields, each technology must not be generalized. They argue that, whereas the claimed invention concerns a multisplit air-conditioning system for buildings, the cited invention focuses on a problem peculiar to a pair-type system and concerns a two-cylinder rotary compressor. Because their specific technical fields differ, motivation to combine other technology with the cited invention to arrive at the claimed invention is extremely weak (Part 3, 3, [Plaintiffs' Arguments], (2)B above).

However, as stated in 3(2)C, the claimed invention is not limited to a multisplit system for buildings, nor does it specify the concrete structure of the medium pressurizer or the like. Further, as stated in (2), the cited invention's problem is not peculiar to a pair-type system. The plaintiffs' argument therefore cannot be accepted at the level of its premise.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91747.pdf

Osaka District Court, 2021 (Wa) 2873 [Apparatus for Dehairing Blocks of Edible Livestock Meat] — Damages: Noncompliance with a Document-Production Order

Original Ameblo publication: 2024-10-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872297200.html

Osaka District Court, 2021 (Wa) 2873 [Apparatus for Dehairing Blocks of Edible Livestock Meat]

A document-production order was issued to calculate damages under Patent Act Article 102(2), but the defendant did not produce the documents.

⇒ “Under the plaintiff's assertions, the profit margin on ten defendant machines would exceed 60%, which can hardly be called reasonable.”

⇒ The defendant's marginal profit rate was found to be approximately 31%.

★Document-production orders are rarely issued on issues concerning whether the claim limitations are satisfied.

★On damages, document-production orders are often issued when defendants do not produce documents voluntarily.

⇒ Even if the defendant further disobeys the order and refuses production, the court is authorized, but not required, to deem the plaintiff's assertions true; as this case shows, the amount of damages asserted by the plaintiff is not necessarily awarded.

[Patent] Document-Production Orders (3): Effects of Nonproduction; Denial of Possession

Hideki Takaishi, related material on “Document-Production Orders (3): Effects of Nonproduction; Denial of Possession”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93136.pdf

IP High Court, 2022 (Gyo-Ke) 10123 [Laser Processing Apparatus] <Miyasaka>

Original Ameblo publication: 2024-10-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872420296.html

IP High Court, 2022 (Gyo-Ke) 10123 [Laser Processing Apparatus] <Miyasaka>

"The invention in Exhibit Ko 1 … forms a modified region by focusing inside the workpiece and splits it along a planned cutting line…. There is no description … of controlling the laser focal point in the Z-axis direction."

⇒ No motivation to apply the well-known technology!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92618.pdf

IP High Court, 2022 (Gyo-Ke) 10057 and 10054 [Lamp] <Honda> — Support Requirement Satisfied

Original Ameblo publication: 2024-10-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872532550.html

IP High Court, 2022 (Gyo-Ke) 10057 and 10054 [Lamp] <Honda>

In light of the common general technical knowledge that residuals exist between a linear approximation and measured data, a person skilled in the art can understand that even samples falling slightly short of the stated effect in the specification provide “approximately the desired” luminance uniformity and can solve the invention's problem.

⇒ Support requirement: satisfied

(Excerpts from the court's reasoning)

A person skilled in the art encountering the specification would recognize that …if the parameter satisfies 1.09 < y/x, the problem of suppressing graininess can be solved. On the other hand, the parameter in each invention defined by the corrected claims appropriately specifies lower and upper limits of y/x within 1.09 < y/x, and further specifies ranges of x (claims 5–8). Thus, it can be understood that the …inventions define a range in which luminance uniformity is approximately 85% or higher. …

The plaintiff argues that a person skilled in the art could not recognize from the experimental results that the problem can be solved, because Figure 7A includes samples …whose luminance uniformity does not reach 85% at y = 1.09x. However, …a person skilled in the art understands the inventions in light of the common general technical knowledge at filing that residuals exist between a linear approximation and measured data. Regarding samples 10, 13, and the like identified by the plaintiff, that knowledge permits understanding that approximately the desired luminance uniformity is obtained and the problems of the inventions can be solved.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92986.pdf

IP High Court, 2023 (Gyo-Ke) 10101 [Authentication Certification System] <Shoji>

Original Ameblo publication: 2024-10-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872707022.html

IP High Court, 2023 (Gyo-Ke) 10101 [Authentication Certification System] <Shoji>

*Common general technical knowledge at filing concerning private and public keys

⇒ Private key α1 assigned to product 1 requiring authentication and private key β1 assigned to guarantee card 2 can be understood to be used for identity authentication together with their paired public keys.

⇒ Enablement requirement: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92988.pdf

[Article/Unfair Competition Prevention Act] On the Usefulness and Nonpublic Nature of Trade Secrets—The Tin-Alloy Composition Case … Osaka District Court, 2014 (Wa) 11151, “Tin Alloy”

Original Ameblo publication: 2024-10-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12872886872.html

[Article/Unfair Competition Prevention Act] On the Usefulness and Nonpublic Nature of Trade Secrets—The Tin-Alloy Composition Case … Osaka District Court, 2014 (Wa) 11151, “Tin Alloy” (Chen Keyu, Intellectual Property Law and Policy Journal, Vol. 52 (2018))

*“Usefulness” denied: although adopted in the plaintiff's product, the asserted effects were insufficiently proved.

= Tokyo District Court, 2001 (Wa) 7445, “Crepe Mix,” also denied usefulness, in part because the evidence did not establish any particular effect from the specified formulation conditions.

Cf. Osaka District Court, 2007 (Wa) 11138, “Heat-Generating Cement,” denied usefulness as a design matter a person skilled in the art could readily develop from information disclosed in the specification.

⇒ Tokyo District Court, 2013 (Wa) 30447, “Microscope Assembly Drawings,” recognized usefulness because, although a person skilled in the art could develop them, they shortened development time, among other reasons.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2019/01/26139757b3a2882c15acc0420875315f.pdf

IP High Court, 2023 (Gyo-Ke) 10145 [Light-Emitting Device] <Miyasaka> — Addition of New Matter

Original Ameblo publication: 2024-10-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873009502.html

IP High Court, 2023 (Gyo-Ke) 10145 [Light-Emitting Device] <Miyasaka> ⇒Addition of new matter

Embodiment 3 uses through-hole F as a means of forming the open space, and there is no description or suggestion of a configuration without through-hole F.

⇒ The amendment “the open space is formed by arranging adhesive … without extending around the entire perimeter …” was held to add new matter!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93204.pdf

[Unfair Competition Prevention Act/Communication of False Facts] Tokyo District Court, 2021 (Wa) 22564 <Kokubu>

Original Ameblo publication: 2024-10-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873131844.html

[Unfair Competition Prevention Act/Communication of False Facts] Tokyo District Court, 2021 (Wa) 22564 <Kokubu>

"No circumstances are found establishing that, by the time of the notification, the defendants could specifically have recognized that the patent would be invalidated…. At that time … no assertion whatsoever had been made that it was invalid…."

⇒ False facts because the patent was invalid, but no negligence!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92973.pdf

Tokyo District Court, 2021 (Wa) 15964 [Elastoplastic Hysteretic Damper] <Shibata>

Original Ameblo publication: 2024-10-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873249493.html

Tokyo District Court, 2021 (Wa) 15964 [Elastoplastic Hysteretic Damper] <Shibata>

*The fact that every example had a feature was one reason for a restrictive interpretation.

"The problem … to be solved … exists where inputs from multiple directions are contemplated…. Every example described in the specification involves … inputs from multiple directions…."

⇒ Claim limitation not satisfied

(Excerpt from the court's reasoning)

…The problems addressed by the inventions arise where inputs from multiple directions, rather than a single direction, are contemplated. The specification describes the above … significance of the inventions, and every example is found to involve inputs from multiple directions that can be accommodated by adopting the configuration of Invention 1. No other part of the specification describes accommodating input from a single direction. From these descriptions and the wording of elements G and H, it is appropriate to construe the damper of Invention 1 as a damper used in portions of structures and the like where inputs from multiple directions are contemplated, receiving inputs from multiple directions at its shear portion and capable of accommodating them.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92956.pdf

[Copyright] Tokyo District Court, 2023 (Wa) 70422 <Sugiura>

Original Ameblo publication: 2024-11-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873372809.html

[Copyright] Tokyo District Court, 2023 (Wa) 70422 <Sugiura>

"For the video …, the photograph was used as a thumbnail after mosaic processing …; for the video …, the photograph was used as a thumbnail after removing the background and also cropping E's portrait portion."

⇒ Infringement of the right of integrity

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93296.pdf

[New YouTube Video] Infringement Analysis and Claim Construction / Wins + Losses (Reading the Fourth Edition Together, Part 3), September 11, 2024

Original Ameblo publication: 2024-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873878657.html

[New YouTube Video]

[Patent] IP LAB: Infringement Analysis and Claim Construction / Wins + Losses (Reading the Fourth Edition Together, Part 3), September 11, 2024

A comprehensive review in a single video, with case law, of every type of claim construction concerning the technical scope of patented inventions!

https://www.youtube.com/watch?v=aaoI1dK98xc

Osaka District Court, 2023 (Wa) 3375 [Canopy]

Original Ameblo publication: 2024-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873878717.html

Osaka District Court, 2023 (Wa) 3375 [Canopy]

The invention's purpose of “downsizing the canopy and simplifying its structure”

⇒ A configuration in which the portion whose “front face serves as a guide surface directing rainwater downward” is spaced apart from the portion “abutting the open front end face of the canopy plate,” and the front face of the latter portion does not serve as a guide surface, is not included in the “vertical plate portion.”

⇒ Claim limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92899.pdf

IP High Court, 2023 (Ne) 10071 [Chip Fuse] <Miyasaka>

Original Ameblo publication: 2024-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873910495.html

IP High Court, 2023 (Ne) 10071 [Chip Fuse] <Miyasaka>

Claim 3 was first asserted after the first-instance court disclosed its preliminary assessment.

⇒ Intended to circumvent the fourth requirement of equivalence, which had been an issue from the outset

Adding an invention under another claim of the same patent as a cause of action is not an amendment of the action, but a means of attack or defense.

⇒ Rejected as untimely

★This directly relates to the extremely important issue of the scope of res judicata!!

*The first-instance Osaka District Court, 2021 (Wa) 10032, treated the addition of the asserted basis for the claim as an amendment adding a claim and disallowed it because it would significantly delay the proceedings (Code of Civil Procedure Article 143(1), proviso, and (4)).

Cf. IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu>

*The binding effect of the first judgment extends to factual findings concerning the differences!!

⇒ Perhaps it is somewhat harsh to require the petitioner who obtained a finding of invalidity of Invention 1 and the like in the first JPO decision to advance, in the prior lawsuit, arguments that the decision did not address….

⇒ Even the party that prevailed before the JPO must make alternative arguments, or the binding effect may prevent it from raising them in the second lawsuit.

Cf. IP High Court, **2005 (Gyo-Ke) 10179 [Fashion Hair-Enhancement Appliance] <Mimura>***A case upholding a patent-revocation decision after switching the primary and secondary references: “Making arguments different from the trial or revocation decision regarding common features and differences … or combinations … does not … immediately go beyond the framework of comparison with publicly known facts examined and decided in the trial or patent opposition….”

Cf. **[Article] Transcript of a Lecture by Former Judge Shiotsuki (Patent, 2011)**

Q: Where two invalidity grounds are asserted in a trial, and the decision finds Ground A established but rejects Ground B, issuing a decision of invalidity

A: “Since the two grounds for invalidity have been decided in the JPO decision, I consider that it may be possible to examine and decide both grounds in the action to set aside that decision, within the framework of the 1976 Supreme Court Grand Bench judgment.”

(Note) In the record of Judge Shiotsuki’s lecture (Patent, Vol. 64, No. 15 (2011)), the original wording of this answer is: “Since the two grounds for invalidity have been decided in the trial decision, I consider that it may be possible to examine and decide both grounds in the action to set aside that decision, within the framework of the 1976 Supreme Court Grand Bench judgment.”
https://system.jpaa.or.jp/patents_files_old/201112/jpaapatent201112_120-134.pdf

Third Lecture Commemorating the Department's 30th Anniversary: Scope of Examination in Actions to Set Aside Trial Decisions

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92795.pdf

German Patent Attorney Kan Hasegawa: “Has the UPC Abandoned the Problem–Solution Approach?”

Original Ameblo publication: 2024-11-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12873910851.html

An article by Kan Hasegawa, German and Japanese patent attorney

“Has the UPC Abandoned the Problem–Solution Approach?”

If the Unified Patent Court changes Europe's distinctive inventive-step logic (selection of the primary reference), might at least the logic of inventive-step assessment be moving toward a common worldwide approach?

—A double standard with the European Patent Office would be complicated…

https://hasegawa-ip.com/ep-patent/upc-psa/

IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu>

Original Ameblo publication: 2024-11-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874115556.html

IP High Court, 2023 (Gyo-Ke) 10069 [Soldering Apparatus] <Hibiku Shimizu>

*The binding effect of the first judgment extends to factual findings concerning the differences!!

⇒ Perhaps it is somewhat harsh to require the petitioner who obtained a finding of invalidity of Invention 1 and the like in the first JPO decision to advance, in the prior lawsuit, arguments that the decision did not address….

⇒ Even the party that prevailed before the JPO must make alternative arguments, or the binding effect may prevent it from raising them in the second lawsuit.

(Excerpt from the court's reasoning)

Admittedly, …the first judgment did not decide the matters the plaintiff identifies as Grounds for Cancellation 1 and 2 in this action (whether the portions corresponding to the configuration at issue among the configurations of Invention 1 and the like relating to Differences 2 or 4 constitute substantial differences)…. However, the inventive-step assessment of Invention 1 and the like based on the cited invention in Exhibit Ko 1 is a legal determination made on the basis of identification of those inventions and the cited invention, and the resulting common features and differences. …Because binding effect extends to factual findings and legal determinations necessary to derive the judgment's operative part, the first judgment's binding effect also extends to the factual findings concerning differences between Invention 1 and the like and the cited invention in Exhibit Ko 1 that formed the premise for its legal determination denying lack of inventive step…. Accordingly, when assessing inventive step based on the same cited invention in Exhibit Ko 1, the trial examiners were not permitted by the first judgment's binding effect to find different facts and make a different determination. The present trial decision, rendered in accordance with that binding effect, is lawful.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92861.pdf

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji> — Relationship between Identification of the Cited Invention and Addition of New Matter

Original Ameblo publication: 2024-11-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874480718.html

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transfer System] <Shoji>

*An optional additional configuration not essential to solving the cited invention's problem may be disregarded in identifying that invention!!

⇒ Parallel to addition of new matter!?

Disclosure of the invention in the new-matter context and disclosure of the cited invention in the novelty/inventive-step context can be considered parallel. The standard in this judgment is the same as for new matter.

However, because inventive step involves the range of what is obvious, this does not mean the conclusions are the same.

*Each specifically enumerated alternative in a cited reference is disclosed.

(Excerpts from the court's reasoning)

…Although the embodiment in Cited Reference 1 can be understood as a pair-type system as described above, claim 1 specifies the compressor configuration constituting the means for solving the problem (one of the two cylinders can switch between compression and noncompression operation), but does not specify concrete configurations such as the number of indoor heat exchangers. Nor does the detailed description suggest that the problem-solving means and concrete configurations such as the number of indoor heat exchangers are inseparably linked. In light of these claim and specification statements, concrete configurations such as the number of indoor heat exchangers 270 are not essential to solving the problem but are optional additions, and the invention described in Cited Reference 1 is not found limited to a pair-type system. Accordingly, the JPO decision did not err in identifying simply “indoor heat exchanger 270,” without specifying their number or the like, based on that reference….

…

…Where primary-side refrigerants are specifically enumerated, as in Cited References 2 and 11, rather than presented in the form of a general formula, combinations of each listed refrigerant with carbon dioxide are found to be actually described in parallel. The publication therefore permits identification of a configuration expressing a concrete technical idea for a particular alternative consisting of a combination of one primary-side refrigerant and carbon dioxide…. …

https://youtube.com/watch?v=caYkLhd5rYM

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91747.pdf

[Germany/AI Inventorship]

Original Ameblo publication: 2024-11-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874579575.html

[Germany/AI Inventorship]

For a patent application naming the artificial intelligence “DABUS” as inventor, Germany's Federal Court of Justice held that artificial intelligence cannot be an inventor.

https://www.jetro.go.jp/ext_images/_Ipnews/europe/2024/20241021.pdf

The EPO Legal Board of Appeal also upheld the refusal of patent applications naming “DABUS” as inventor.

https://www.jetro.go.jp/ext_images/_Ipnews/europe/2022/20220711.pdf

Japan takes the same approach.

https://www.tokkyoteki.com/2024/05/2024-05-16-r5-gyo-u-55001.html

Tokyo District Court, 2022 (Wa) 9100 [Method of Manufacturing a Molded Coil] <Shibata>

Original Ameblo publication: 2024-11-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874704876.html

Tokyo District Court, 2022 (Wa) 9100 [Method of Manufacturing a Molded Coil] <Shibata>

In the defendant's method:

(1) The gap width, shape, structure, and the like are unknown.

(2) The specific particle-size distribution is unknown.

(3) The evidence is “insufficient to establish that the minimum particle size is larger than ●(omitted)●.”

⇒ The factual premises of the mechanism asserted by the plaintiff were not proved!

⇒ Claim limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92824.pdf

IP High Court, 2023 (Gyo-Ke) 10098 [Laundry Detergent Composition] <Shoji>

Original Ameblo publication: 2024-11-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874830821.html

IP High Court, 2023 (Gyo-Ke) 10098 [Laundry Detergent Composition] <Shoji>

*The component is of low importance.

—No particular technical significance in the numerical range

⇒ A design matter!

“A component positioned as optional … was not highly important …; the examples did not achieve better deodorizing effects than other examples …”; no “particular technical significance”

(Excerpt from the court's reasoning)

…The specification indicates that component (G), meaning “a surfactant other than component (A),” is positioned as an optional component and was not highly important. Further, for G-2, G-2′, and G-3 included in component (G) specified in Invention 1, the examples using them did not achieve superior deodorizing effects compared with other examples in the deodorizing-effect evaluation. Thus, no particular technical significance is found in specifying component (G) as general formula (I) or (II) in Invention 1. At least, examining the nonionic surfactant (component (G)) content within the range in the invention in Exhibit Ko 1 and setting it at “20–25 mass%” is found to be a design matter for a person skilled in the art.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93047.pdf

Tokyo District Court, 2023 (Wa) 70454 [Method of Providing a Testing and Analysis Service] <Kokubu>

Original Ameblo publication: 2024-11-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12874951385.html

Tokyo District Court, 2023 (Wa) 70454 [Method of Providing a Testing and Analysis Service] <Kokubu>

The defendant's server does not contemplate loading samples for testing and analysis and does not have a testing-and-analysis unit that analyzes and tests information and the like by remote operation from a user.

⇒ Not a “testing and analysis apparatus”; claim limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92755.pdf

IP High Court, 2022 (Gyo-Ke) 10003 [Method of Preventing Attachment of Marine Organisms] <Kanno>

Original Ameblo publication: 2024-11-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875069072.html

IP High Court, 2022 (Gyo-Ke) 10003 [Method of Preventing Attachment of Marine Organisms] <Kanno>

*No motivation to combine the secondary cited invention with the primary reference to address a problem of the primary reference that the secondary cited invention has already solved

"…These are examples of the invention in Exhibit Ko 5 … and presuppose a diffuser …; a person skilled in the art would not … simply apply only the numerical values for the chlorine dioxide concentration after the conversion at issue and the hydrogen peroxide concentration in Examples 16 to 20 to the invention in Exhibit Ko 1 … without a diffuser."

⇒ Inventive step: satisfied

(Excerpt from the court's reasoning)

The invention in Exhibit Ko 5 …presupposes the problem that adding a chlorine agent in the invention in Exhibit Ko 1 generates trihalomethanes, and adopts the solution of first dispersing a hydrogen-peroxide agent at a specified concentration in an industrial seawater-cooling system and then adding a chlorine agent at a specified concentration. It also provides …regarding those specified concentrations…. Thus, the invention in Exhibit Ko 5 itself solves the above problem of the invention in Exhibit Ko 1 and presupposes use of a chlorine agent. A person skilled in the art therefore cannot be said to have motivation to replace the available-chlorine-generating agent in the invention in Exhibit Ko 1 with chlorine dioxide and additionally combine it with the invention in Exhibit Ko 5. Moreover, Exhibit Ko 5 does not contemplate adding chlorine dioxide and therefore does not disclose a particular concentration ratio for it. Accordingly, a person skilled in the art could not readily have conceived the numerical range at issue within Difference 1 by combining the invention in Exhibit Ko 1 with Exhibit Ko 5.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92064.pdf

IP High Court, 2023 (Ne) 10047 [Nursing Unit] <Miyasaka>

Original Ameblo publication: 2024-11-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875188362.html

IP High Court, 2023 (Ne) 10047 [Nursing Unit] <Miyasaka>

"The nursing room of the invention in Exhibit Otsu 6 … was installed by bringing … an enclosure composed of members independent of the walls and floor … into an existing building …; relocation due to a change of installation site or temporary removal … is therefore fully contemplated…. It inherently contains motivation to facilitate movement."

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92420.pdf

IP High Court, 2023 (Gyo-Ke) 10023 [Aircraft Such as High-Speed Drones] <Miyasaka>

Original Ameblo publication: 2024-11-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875349583.html

IP High Court, 2023 (Gyo-Ke) 10023 [Aircraft Such as High-Speed Drones] <Miyasaka>

*A holding reminiscent of the Supreme Court's Lipase decision

“Even if the examples in Figures 7–9 have such a configuration, it must be said that the term ‘inscribed’ itself cannot be construed in that restrictive sense when no correction (narrowing) adding that configuration to the claims has been made.”

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92412.pdf

IP High Court, 2022 (Gyo-Ke) 10108 [High-Dynamic-Range Tone Mapping] <Honda>

Original Ameblo publication: 2024-11-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875436355.html

IP High Court, 2022 (Gyo-Ke) 10108 [High-Dynamic-Range Tone Mapping] <Honda>

The well-known technology solves the problem of the invention in Exhibit Ko 1 and can replace its configuration using a tone-mapping function with little temporal variation in a pre-prepared LUT.

⇒ Motivation to apply it exists.

—Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92315.pdf

IP High Court, 2019 (Gyo-Ke) 10022 [Optical Information Reading Apparatus] <Takabe>

Original Ameblo publication: 2024-11-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875688524.html

IP High Court, 2019 (Gyo-Ke) 10022 [Optical Information Reading Apparatus] <Takabe>

*Inventive step denied based on public working

The technical field and problem are common.

⇒ It was obvious to combine well-known technology with the publicly worked invention and “reduce the degree of obliqueness of reflected light … by arranging the aperture so that the reflected light enters the imaging lens after passing through the aperture.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89110.pdf

IP High Court, 2010 (Gyo-Ke) 10400 <Iimura>

Original Ameblo publication: 2024-11-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875817484.html

IP High Court, 2010 (Gyo-Ke) 10400 <Iimura>

*Public working established

“Even if the document's author did not personally write it from memory, its contents cannot immediately be said to be untrue …; there is insufficient evidence of circumstances contradicting them…. There is insufficient evidence to support … the suspicion of fabrication … of the receipt stamp … on the drawing-issue document.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81528.pdf

[Trademark] IP High Court, 2024 (Gyo-Ke) 10003 <Miyasaka>

Original Ameblo publication: 2024-11-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12875939739.html

[Trademark] IP High Court, 2024 (Gyo-Ke) 10003 <Miyasaka>

“骨格診断 7 タイプ” (“Seven Types of Body-Structure Analysis”) ⇒ No distinctiveness

“Article 3(1)(iii) of the Act concerns ‘a trademark consisting solely of a mark indicating the quality of the services in a commonly used manner’ …; in objectively identifying what an applied-for mark indicates …, assessment must be based on the perceptions of traders and consumers.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93028.pdf

[Trademark] Osaka District Court, 2022 (Wa) 9818 — “熱中対策応急キット” (“Emergency Heat Countermeasure Kit”) ⇒ No Distinctiveness

Original Ameblo publication: 2024-11-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876269862.html

[Trademark] Osaka District Court, 2022 (Wa) 9818

Registered mark “熱中対策応急キット” (“Emergency Heat Countermeasure Kit”)

⇒ Distinctiveness denied (Trademark Act Article 3(1)(iii))

*Actual trading circumstances: at the registration decision date, third parties used “熱中対策応急キット” (“Emergency Heat Countermeasure Kit”) to mean heatstroke countermeasures.

⇒ It is not unnatural to understand “熱中” (necchu) as “熱中症” (necchusho, heatstroke) with “症” (sho, condition) omitted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92615.pdf

[U.S.] IOENGINE v. Ingenico (CAFC, May 3, 2024)

Original Ameblo publication: 2024-11-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876269974.html

[U.S.] IOENGINE v. Ingenico (CAFC, May 3, 2024)

Under the printed matter doctrine, the court first asks whether a limitation is directed to the communicative content of information. If so, it asks whether the information has a functional or structural relationship with its substrate to determine whether the limitation receives patentable weight.

⇒ The limitations “encrypted communications” and “program code” in the invention's claims do not claim merely the communicative content of information.

https://openlegalcommunity.com/printed-matter-doctrine-clarified-by-cafc-communicative-content-only/

[Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2020 (Wa) 12387

Original Ameblo publication: 2024-11-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876270153.html

[Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2020 (Wa) 12387

*Injunction against use of experimental equipment obtained with Grants-in-Aid for Scientific Research denied

The identified information was too abstract to understand concretely. The three requirements for a trade secret could not be examined.

Donation = gratuitous transfer of ownership of the experimental equipment

The information embodied in the equipment did not remain at Osaka University.

The plaintiff argued that the confidential information was not publicly known because it could not readily be analyzed, but the court turned that argument around and ruled this way.

Concluding a confidentiality agreement is important.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92216.pdf

[Unfair Competition Prevention Act Article 2(1)(i)] Tokyo District Court, 2023 (Wa) 70654 <Nakashima>

Original Ameblo publication: 2024-11-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876512673.html

[Unfair Competition Prevention Act Article 2(1)(i)] Tokyo District Court, 2023 (Wa) 70654 <Nakashima>

*A book title was held not to constitute an “indication of goods or business.”

“Unless special circumstances exist, a book title … does not constitute an ‘indication of goods or business’…. The title ‘牧野日本植物圖鑑’ (Makino’s Illustrated Flora of Japan) directly indicates the book's content: an illustrated guide to Japanese plants written by Makino.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93208.pdf

IP High Court, 2023 (Gyo-Ke) 10019 [Method of Treating Atopic Dermatitis by Administering an IL-4R Antagonist] <Miyasaka>

Original Ameblo publication: 2024-11-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876631434.html

IP High Court, 2023 (Gyo-Ke) 10019 [Method of Treating Atopic Dermatitis by Administering an IL-4R Antagonist] <Miyasaka>

The only difference from the primary reference (a clinical-trial protocol) is whether it is a medicine or an investigational drug.

⇒ The Phase 2 success rate for allergic diseases is 33%.

⇒ A person skilled in the art cannot be said to understand, without waiting for the trial results, that the investigational drug is necessarily therapeutically effective.

⇒ Inventive step: satisfied

*For medical-use patents, when to file during clinical trials requires consideration in relation to the support requirement. One would like to file early and claim priority in several stages, but clinical trials last more than a year, so this is always difficult.

https://yorozuipsc.com/blog/510019

“The above mechanism of action is that mAb1, one of the antibodies at issue, binds to IL-4R and blocks IL-4 signaling. In the patients at issue who received mAb1, the clinical symptoms of atopic dermatitis improved and the biomarkers of atopic dermatitis also decreased. It is therefore clear that a person skilled in the art can understand that the other antibodies and fragments at issue—the 32 types other than mAb1, which are anti-IL-4R antagonist antibodies—also have similar functions and effects. The plaintiff’s observation that the pharmacological test results disclosed in the specification concern only mAb1 does not alter the above findings and conclusions.”

⇒ Support requirement: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93292.pdf

IP High Court, 2023 (Gyo-Ke) 10146 [Label Insertion Apparatus] <Honda>

Original Ameblo publication: 2024-11-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12876876407.html

IP High Court, 2023 (Gyo-Ke) 10146 [Label Insertion Apparatus] <Honda>

"The plaintiff argues that the cited invention achieves … its purpose … by having the downward extension direction of the incline intersect … the egg-pack conveyance direction …, and that changing the conveyance direction … would defeat that purpose…."

However, the cited invention's purpose is achieved even if the conveyance direction is changed.

⇒ Inventive step: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93254.pdf

IP High Court, 2022 (Gyo-Ke) 10011 [Electrical Device Formed from Very Low Resistance Material] <Shoji>

Original Ameblo publication: 2024-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877133845.html

IP High Court, 2022 (Gyo-Ke) 10011 [Electrical Device Formed from Very Low Resistance Material] <Shoji>

Obtaining the Josephson effect at resistivity within the claimed numerical range contradicts common general technical knowledge at filing.

⇒ The specification or other application documents must contain test results or the like substantiating that such a phenomenon can occur.

⇒ Enablement requirement: not satisfied

(Excerpt from the court's reasoning)

"…Given that it was common general technical knowledge at the original filing date that a Josephson junction uses two conductors that are superconductors, obtaining the Josephson effect with resistivity in the above range even when the conductor's resistance is not zero is a phenomenon contrary to that knowledge. Accordingly, unless the specification and other application documents describe test results or the like substantiating that such a phenomenon can occur, a person skilled in the art would not recognize that the claimed inventions can be practiced…."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91802.pdf

IP High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

Original Ameblo publication: 2024-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877134847.html

IP High Court, 2022 (Gyo-Ke) 10059 [Glass] <Kanno>

*A desirable numerical range was claimed.

⇒ In this case, the claimed range was selected from desirable ranges disclosed in the specification, and the support requirement was satisfied even though its endpoints did not coincide with the disclosed endpoints.

“It suffices that the upper and lower limits in the claim are values within the numerical range stated in the specification.”

*The court identified the problem addressed by the invention, which comprises physical-property and composition requirements, as distinct from the physical-property requirements themselves. It therefore held that recognition of a high probability that glass meeting the composition requirements would also meet all the physical-property requirements was unnecessary.

(*Distinguished from IP High Court, 2016 (Gyo-Ke) 10189!!)

(Excerpts from the court's reasoning)

[Claim 1] …Glass that is an oxide glass having (B) a liquidus temperature of 1140°C or lower, (C) a glass-transition temperature of 672°C or higher, (D) a refractive index nd of 1.825–1.850, and (E) an Abbe number νd of 41.5–44 …

…The upper limit “0.828” in element A⑦ is below “0.85,” the most preferred upper limit in Table 2 of paragraph [0026] of the specification, and can therefore also be called a preferred upper limit…. Similarly, the upper limit “0.50” in element A⑫ is below “0.6,” the most preferred upper limit in Table 22 of paragraph [0063], and can also be called a preferred upper limit…. The invention is found merely to claim a desirable numerical range from the range described in the specification. Thus, it cannot be said that the support requirement fails unless the claimed upper and lower limits match those in the specification; it is sufficient that the upper and lower limits are values within the disclosed numerical range. …

…If a person skilled in the art can understand that, based on the component-adjustment methods explained in the specification and starting with the reference examples, ordinary trial and error in the optical-glass field can lead to a concrete composition satisfying all elements of Invention 1, that invention falls within the scope recognized as capable of solving the problem in light of the detailed description's statements or suggestions, or common general technical knowledge at filing.

The plaintiff argues, among other things, that …some glasses meet the composition requirements but not the physical-property requirements, and that it is impossible to find a correlation between satisfaction of the two sets of requirements….

However, the invention's problems are …to reduce the proportions of Gd, Ta, and Yb in the glass composition, provide glass with excellent thermal stability, and provide glass suitable for machining, in order further to enhance the usefulness of high-refractive-index, low-dispersion glass. It seeks to solve these problems by adopting a configuration satisfying both the composition and physical-property requirements.

Accordingly, the composition and physical-property requirements cannot be said to stand in a problem-and-solution relationship. It is therefore unnecessary to recognize a

relationship in which glass defined by the composition requirements is highly likely to satisfy all physical-property requirements, including glass-transition temperature. The invention claims glass satisfying both sets of requirements; it does not state that, throughout all numerical ranges of the composition requirements, any glass satisfying them also satisfies the physical-property requirements. Any glass satisfying the composition requirements but not the physical-property requirements is simply outside the claims. Moreover, considering the numerical ranges described as preferred in the specification and the reasons for their selection, the ranges of the composition requirements cannot be found excessively broad. …

(The plaintiff also argues that the criterion stated in another IP High Court judgment [Exhibit Ko 7] should govern support here: “A person skilled in the art must recognize, from the statements or suggestions in the detailed description or common general technical knowledge at filing, that the optical glass defined by the composition requirements is highly likely to satisfy the physical-property requirements.” However, compliance with the support requirement must be determined in relation to the invention's problem. That judgment identified the problem as “providing optical glass with specified optical constants, high refractive index and high dispersion, and a small partial-dispersion ratio.” It is inappropriate to apply unchanged to this case the reasoning given as a case-specific determination concerning a different problem in a different invention.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92153.pdf

IP High Court, 2021 (Gyo-Ke) 10089 [Transdermal Absorption Preparation] <Kanno>

Original Ameblo publication: 2024-12-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877261654.html

IP High Court, 2021 (Gyo-Ke) 10089 [Transdermal Absorption Preparation] <Kanno>

*Adjusting the viscosity of a liquid solution dried in a mold

⇒ Even a viscous solution can be filled into a mold.

⇒ Considering the drying purpose, increasing the viscosity of the liquid solution is obvious.

⇒ Making a liquid solution containing hyaluronic acid and a drug into “a string-forming paste” is a design matter (inventive step not satisfied).

[Editorial note: The original article image could not be retrieved.]

IP High Court, 2022 (Gyo-Ke) 10018 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

Original Ameblo publication: 2024-12-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877384905.html

IP High Court, 2022 (Gyo-Ke) 10018 [Pressure-Sensitive Transfer Adhesive Tape] <Kanno>

"Configured to be capable of causing paper tearing"

⇒ Clarity: satisfied (Almost tautological!?)

"Understood as configured 'to be capable of causing paper tearing'…. Even if … the occurrence rate and conditions … are not specified …, third parties are not exposed to unforeseen loss…."

(Excerpt from the court's reasoning)

…Taking the specification and drawings together, "paper tearing" in Invention 1 can be understood as the phenomenon in which, when the adhesive layer of an adhesive product is peeled off, the surface layer of paper adheres to the adhesive and the paper ruptures in its thickness direction. The defining limitation "configured to be capable of causing paper tearing" in Invention 1 can be understood as referring, among "pressure-sensitive transfer adhesive tapes" satisfying the other elements, to those configured "to be capable of causing paper tearing"…. Thus, even if …the occurrence rate or conditions are not specified, the claims are not so unclear as to expose third parties to unforeseen loss. …There is no need to add an interpretive condition that the paper tears "in a state visible to an ordinary user."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91549.pdf

IP High Court, 2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy] <Honda>

Original Ameblo publication: 2024-12-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877510785.html

IP High Court, 2021 (Gyo-Ke) 10164 [Conductive Member Using a Copper–Silver Alloy] <Honda>

The reference expressly states that Ni contributes to corrosion resistance. Only Comparative Example 7 lacks added Ni, fails corrosion resistance, and is expressly described as undesirable.

⇒ Adding Ni is essential to solving the cited invention's problem.

—There is a teaching away from omitting Ni.

⇒ Inventive step: satisfied

(Excerpt from the court's reasoning)

Exhibit Ko 16 (Cited Reference 5) was not identified during examination or in advance during the appeal proceedings, but was identified for the first time in the JPO decision…. … Had Exhibit Ko 16 (Cited Reference 5) been presented in a notice of reasons for refusal, …the plaintiff's course of action would have been substantially affected…. …From the standpoint of safeguarding the plaintiff's procedural rights, assessing inventive step of the amended claimed invention using Cited Invention 5 as the primary reference must be regarded as impermissible.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91524.pdf

IP High Court, 2021 (Gyo-Ke) 10165 [Delivered-Package Storage Apparatus] <Shoji>

Original Ameblo publication: 2024-12-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877625987.html

IP High Court, 2021 (Gyo-Ke) 10165 [Delivered-Package Storage Apparatus] <Shoji>

"Invention 1 in Exhibit Ko 2 … is hung … outside the front door … when not storing a delivery, while the wire … connected to the delivery container is connected … inside the front door…. Thus, the wire … must have sufficient length."

⇒ There is a teaching away from shortening it!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91446.pdf

IP High Court, 2021 (Gyo-Ke) 10069 [PTH-Containing Agent for Treating/Preventing Osteoporosis] <Kanno>

Original Ameblo publication: 2024-12-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12877743594.html

IP High Court, 2021 (Gyo-Ke) 10069 [PTH-Containing Agent for Treating/Preventing Osteoporosis] <Kanno>

*Remarkable effects denied ⇒ Inventive step not satisfied

"The defendant argues that, if the fracture-suppressing effect in patients satisfying the three conditions is statistically significant compared with placebo, while that in patients not satisfying the three conditions is not, it can immediately be said that the osteoporosis treatment of Invention 1 has a superior effect in patients satisfying the three conditions.

However, absence of statistical significance merely means that it is unclear whether the effect is superior; it does not immediately mean that the effect is not superior. Nor can it be excluded that the absence of significance results from an insufficient number of cases."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91346.pdf

IP High Court, 2021 (Gyo-Ke) 10080 [Graphic Display Medium] <Honda>

Original Ameblo publication: 2024-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878154847.html

IP High Court, 2021 (Gyo-Ke) 10080 [Graphic Display Medium] <Honda>

*The cited reference contains no limitation.

⇒ In light of the evidence showing the common general knowledge at the filing date, Exhibit Ko 4 is understood as also being compatible with printing using light-transmitting ink.

“At the filing date … light-transmitting … CMY inks were widely used …; a person skilled in the art would readily have understood Exhibit Ko 4, which contains no statement or suggestion limiting it to non-light-transmitting … ink, as compatible with light-transmitting … ink.”

(Excerpt from the court's reasoning)

…Since CMY inks having light-transmitting properties (transparency) were widely used in solvent inkjet printing at the filing date, even if non-light-transmitting inks were sometimes used at that date, a person skilled in the art encountering Exhibit Ko 4—which is compatible with solvent inkjet printing and …contains no statement or suggestion limiting solvent inkjet printing to non-light-transmitting inks—would readily have understood it as compatible with solvent inkjet printing using light-transmitting inks. …The JPO decision's contrary finding is erroneous.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91172.pdf

IP High Court, 2020 (Gyo-Ke) 10071 [Agent for Treating/Preventing Osteoporosis] <Kanno>

Original Ameblo publication: 2024-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878155081.html

IP High Court, 2020 (Gyo-Ke) 10071 [Agent for Treating/Preventing Osteoporosis] <Kanno>

*Common general technical knowledge at filing ⇒ Obvious

"Given the common general technical knowledge that osteoporosis incidence increases with age …, age 65 or older … is an entirely natural choice." "Even if … the risk-reduction rate … for those aged 75 or older is low …, this does not affect … motivation to select patients aged 65 or older … for administration."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90895.pdf

IP High Court, 2021 (Gyo-Ke) 10072 [Amplifier Output Circuit] <Honda>

Original Ameblo publication: 2024-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878155229.html

IP High Court, 2021 (Gyo-Ke) 10072 [Amplifier Output Circuit] <Honda>

"The plaintiff's argument that the cited and claimed inventions differ in input/output voltage assumes a configuration not included in the defining limitations of the claimed invention, and therefore lacks its premise and cannot … be accepted."

⇒ Inventive step: not satisfied (clarity requirement satisfied)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90951.pdf

IP High Court, 2021 (Gyo-Ke) 10068 [Ball Game Machine] <Otaka>

Original Ameblo publication: 2024-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878155388.html

IP High Court, 2021 (Gyo-Ke) 10068 [Ball Game Machine] <Otaka>

"When … the state occurs …, the selection rate of the second operating means is high, and when … the state does not occur …, the selection rate of the first operating means is high."

⇒ Clarity requirement: satisfied

"It cannot be read as prescribing … a case in which both the first and second operating means are operated."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91103.pdf

Tokyo District Court, 2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

Original Ameblo publication: 2024-12-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878219145.html

Tokyo District Court, 2020 (Wa) 22071 [Liquid Cleansing Agent for Removing Keratin Plugs] <Kokubu>

*Although the problem section was amended, an abstract problem was not accepted.

⇒ Support requirement: not satisfied

"This is not affected … by the fact that, during prosecution …, an amendment deleted the wording 'made to solve the above problem.'"

(Excerpts from the court's reasoning)

…Paragraph [0006] merely states that the invention's purpose is "to provide a liquid cosmetic capable of extracting proteins," and says nothing about the presence or amount of surfactant or its effect on protein extraction. However, in the specification, [0006] and [0005] are positioned as descriptions of the "Problem to Be Solved by the Invention." Paragraph [0005] states: "Because surfactants can burden the skin and cause roughness or the like, a method using no surfactant or an extremely small amount of surfactant was sought." It is therefore reasonable to interpret the purpose in [0006] as premised on solving the prior-art problem described in [0005]. …

The invention's problem cannot be understood merely as providing a liquid cosmetic capable of extracting proteins; it is providing such a cosmetic capable of extracting proteins even without surfactant or with only a very small amount of surfactant….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90979.pdf

IP High Court, 2021 (Gyo-Ke) 10123 [Tableware] <Otaka>

Original Ameblo publication: 2024-12-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878353710.html

IP High Court, 2021 (Gyo-Ke) 10123 [Tableware] <Otaka>

*The court held that detailed dimensions could not be read from the catalog photographs.

⇒ Novelty and inventive step: satisfied

“In light of … the angles, resolution, and the like of the photographs … in Exhibit Ko 4 (see Attachment 2), it is difficult to recognize even the angle ‘between the upright surface and the bottom surface’ or the dimension of the ‘radius.’”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91193.pdf

IP High Court, 2021 (Gyo-Ke) 10097 <Otaka> — General Principles for Amendments Adding Claims

Original Ameblo publication: 2024-12-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878473969.html

IP High Court, 2021 (Gyo-Ke) 10097 <Otaka>

***General principles for amendments adding claims**

"If a new claim after amendment limits the defining features of a particular corresponding pre-amendment claim …, it constitutes … narrowing."

⇒ Here, the amendment was held not to narrow the claims and to violate the amendment requirements.

*For amendments adding claims, see Yoshinori Aoki, "Case-Law Review: Recent Judgments," Tokugikon No. 307, pp. 114–120.

https://www.tokugikon.jp/gikonshi/307/307hanketsu.pdf

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91141.pdf

IP High Court, 2021 (Gyo-Ke) 10006 [X-Ray Inspection Apparatus] <Kanno>

Original Ameblo publication: 2024-12-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878638981.html

IP High Court, 2021 (Gyo-Ke) 10006 [X-Ray Inspection Apparatus] <Kanno>

*The problems of the primary and secondary references were understood abstractly and found identical.

⇒ Obvious

"Cited Reference 2 … does not disregard cost…. Even if Cited Invention 1 is an apparatus for a product-manufacturing site and Cited Reference 2 … contemplates use in medical inspection equipment, the amount spent … is not directly linked to the technical field."

⇒ Inventive step: not satisfied

(Excerpts from the court's reasoning)

The technical matters in Cited Reference 2 use substance-specific highly absorbed X-rays to inspect for drugs concealed in baggage or the human body, or contraband such as explosives and ivory. They therefore concern not only human-body inspection but also X-ray baggage inspection for hidden objects…. Thus, the technical field of Cited Invention 1, an X-ray detection apparatus inspecting foreign matter in food and the like, and the field of Cited Reference 2's technical matters, concerning medical or baggage inspection, are related as fields using X-ray inspection apparatuses…. …Cited Invention 1 and those technical matters have close relationships and commonalities in technical field, problems addressed, and functions …, providing strong motivation to combine them….

…Even if Cited Invention 1, being a foreign-matter inspection apparatus checking for metal and other foreign matter in workpieces on a conveyor path, is equipment for a product-manufacturing site, while Cited Reference 2 directly contemplates medical inspection equipment, the extent of expenditure is not directly linked to the technical field. Disregarding the nature of the products, the scale of the manufacturing site, and the products' sales channels, it cannot naturally be said that all manufacturing-site equipment need only be low-performance, that persons skilled in the art pay no attention to improving performance, or that they have no interest in technology for medical inspection equipment….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90649.pdf

IP High Court, 2020 (Gyo-Ke) 10134 [System for Controlling Distribution and Viewing of Digital Art over the Internet and for Image Formation] <Mori>

Original Ameblo publication: 2024-12-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878750393.html

IP High Court, 2020 (Gyo-Ke) 10134 [System for Controlling Distribution and Viewing of Digital Art over the Internet and for Image Formation] <Mori>

*Different technical fields ⇒ Inventive step satisfied

(Excerpts from the court's reasoning)

…Whereas the technology in Exhibit Ko 3 concerns a peer-to-peer system …, the cited invention can perform complex tasks including content ingestion, automatic publishing, distribution, storage, and monetization, and is understood as a method that itself actively performs content ingestion, distribution, and the like. The technology in Exhibit Ko 3 and the cited invention must therefore be said to differ in technical field to a non-negligible extent. Merely because they fall within the broad field of “methods for transmitting and receiving data among transmitting clients, receiving clients, and servers,” it is difficult to find that applying the technology in Exhibit Ko 3 to the cited invention would be obvious without considering their relationships or the like at all. Nor is any other statement in Exhibit Ko 3 found to motivate or suggest applying its technology to the cited invention.

“In Exhibit Ko 2 …, display 110 is treated solely as an external device connected to … display controller 105, and there is no description … of acquiring any information…. It cannot be found that information about display quality or the like is included.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90508.pdf

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

Original Ameblo publication: 2024-12-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878881346.html

IP High Court, 2019 (Gyo-Ke) 10120 [Oil-Cooled Screw Compressor] <Tsuruoka>

***A general problem**

***No teaching away: failure to prove the "facts" underlying the alleged teaching away**

"…Even if it bypasses …, compressor 10 is not found to become nonfunctional. Nor is there a basis for concluding that changing the configuration in this way … would substantially increase the number of liquid-pipe joints."

(Excerpts from the court's reasoning)

…A person skilled in the art would recognize that the problem of reverse thrust force (a reverse-thrust load state) arises …in screw compressors generally, and could recognize that it also arises in the invention in Exhibit Ko 1…. Thus, for that invention too, …motivation arises to provide an unpressurized path to eliminate reverse-thrust loading and solve that problem…. Accordingly, even if Exhibit Ko 1 does not directly mention the technical problem of reverse thrust force (a reverse-thrust load state) or its elimination, motivation arises to provide an unpressurized path in that invention to solve the problem….

…

The defendant argues that providing a path that does not pass through pressurizing pump 140 or cavity 134 would cause liquid supplied to thrust piston chamber 60 to bypass filter 146, allowing foreign matter …to reach that chamber and cause clogging or other problems, ultimately causing compressor 10 to malfunction; it therefore asserts …a teaching away…. However, even if the liquid supplied to thrust piston chamber 60 bypasses filter 146, most foreign matter will eventually pass through and be removed by the filter as liquid repeatedly circulates through the compressor. If necessary, the configuration can also be changed so that liquid passes through a filter before the pump, allowing both pressurized and unpressurized liquid to pass through the filter. Compressor 10 therefore cannot be found to become nonfunctional. Nor is there a basis for concluding that such a change would substantially increase the number of liquid-pipe joints outside the compressor.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90385.pdf

IP High Court, 2020 (Gyo-Ke) 10110 [Method of Strengthening Blood Vessels] <Kanno>

Original Ameblo publication: 2024-12-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12878945879.html

IP High Court, 2020 (Gyo-Ke) 10110 [Method of Strengthening Blood Vessels] <Kanno>

"The Ko 1-3 invention contains no description or suggestion of … controlling the pressure-adjusting means that alternately repeats pressurization and depressurization … so that the tightening force applied by the tightening device to the designated site at the 'lower peak' … is controlled to a state in which no pressurizing force tightening the particular portion is applied…."

⇒ Inventive step: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90140.pdf

IP High Court, 2020 (Gyo-Ke) 10032 [Imaging Apparatus] <Kanno>

Original Ameblo publication: 2024-12-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879064177.html

IP High Court, 2020 (Gyo-Ke) 10032 [Imaging Apparatus] <Kanno>

*Claiming an effect ⇒ A difference, because the cited invention does not achieve that effect

⇒ Inventive step: satisfied

(Excerpts from the court's reasoning)

Even if the imaging apparatus is …rotated …into a state parallel to …the horizontal plane …, although use of the first and second inclinations can be read from the disclosure, it does not disclose detecting pitch-direction inclination and using it for the determination. …

The “inclination detector” that “detects” “inclination in the pitch direction” in Invention 1 can be understood as an inclination detector detecting the degree of tilt of the imaging apparatus about its horizontal axis. …By contrast, …the first and second inclinations measured in Exhibit Ko 1 do not calculate pitch-direction inclination, namely the degree of tilt about the apparatus's horizontal axis, except where that axis is parallel to the horizontal plane. …This is a difference, not a common feature.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90205.pdf

[Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2015 (Wa) 4169, “Alumina Fiber”

Original Ameblo publication: 2024-12-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879193975.html

[Unfair Competition Prevention Act/Trade Secrets] Osaka District Court, 2015 (Wa) 4169, “Alumina Fiber”

⇒ Injunction granted based on a “risk”

“The defendant … copied and saved the information … with a job change in mind…. Sowa Kasei Co., Ltd. … also entered into a certain relationship with the defendant shortly after the plaintiff dismissed the defendant for disciplinary reasons, despite awareness …; there is ample risk of disclosure … and use.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87262.pdf

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2000 (Wa) 22457, “Temporary Staff List” — Secrecy Management Satisfied

Original Ameblo publication: 2024-12-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879486435.html

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2000 (Wa) 22457

“Temporary Staff List”

⇒ Secrecy management: satisfied

“…The defendant merely did not submit an undertaking because … the defendant was a director … when confidentiality agreements were concluded with other employees; the defendant knew the importance of the information more thoroughly than ordinary employees.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10714.pdf

[Unfair Competition Prevention Act/Trade Secrets] Yokohama District Court, 2018 (Wa [criminal]) 1931 (criminal case) ⇛ Guilty

Original Ameblo publication: 2024-12-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879575276.html

[Unfair Competition Prevention Act/Trade Secrets] Yokohama District Court, 2018 (Wa [criminal]) 1931 (criminal case) ⇒ Guilty

Although the drawings had no confidential mark, the head office had five officers and 33 employees, and it can be inferred that only a limited number of employees at each factory could access technical information such as drawings.

⇒ In light of the “company's size,” the other measures objectively made the intention to maintain secrecy sufficiently recognizable.

https://plaza.rakuten.co.jp/03459/diary/202107070000/

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2006 (Wa) 29160, “Coenzyme Q”

Original Ameblo publication: 2024-12-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879660203.html

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2006 (Wa) 29160, “Coenzyme Q”

*Repayment of retirement benefits under the work rules was allowed against a former employee who removed trade secrets without authorization.

“If disloyal conduct committed during employment is discovered after retirement, …retirement allowances and pensions already paid may be required to be repaid….”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80188.pdf

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2009 (Wa) 47959, “Stroopwafel”

Original Ameblo publication: 2024-12-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879777167.html

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2009 (Wa) 47959, “Stroopwafel”

*A business partnership for operating a store was discussed with a business partner, but no partnership resulted.

⇒ The plaintiff asserted that the partner used trade secrets (the business model) without authorization, but there was no evidence that a confidentiality agreement had been delivered or explained, or that assent had been obtained.

⇒ Lost

https://www.xn--zdkzaz18wncfj5sshx.com/2018/07/blog-post_19.html

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2016 (Wa) 26919, “Eyelash Treatment Know-How”

Original Ameblo publication: 2024-12-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12879911911.html

[Unfair Competition Prevention Act/Trade Secrets] Tokyo District Court, 2016 (Wa) 26919, “Eyelash Treatment Know-How”

⇒ Secrecy management: not satisfied

(1) The confidentiality provision in the work rules did not clearly identify the specific contents of confidential/secret information.

(2) The specific contents of the confidential information listed in the confidentiality undertaking submitted on departure were also unclear.

(3) No document comprehensively described the know-how at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88127.pdf

[Unfair Competition Prevention Act/Trade Secrets] IP High Court, 2019 (Ne) 10016, “Eyelash Extension Treatment Histories”

Original Ameblo publication: 2024-12-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12880026268.html

[Unfair Competition Prevention Act/Trade Secrets] IP High Court, 2019 (Ne) 10016, “Eyelash Extension Treatment Histories”

⇒ Secrecy management: not satisfied

*The work rules' wording “customer information, …business information, confidential information concerning products” is extremely broad and abstract. Such a comprehensive provision cannot be understood as specifically designating treatment histories as secret.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88887.pdf

IP High Court, 2015 (Gyo-Ke) 10095 [Fuel-Consumption Reduction Device for an Internal Combustion Engine] <Shitara>

Original Ameblo publication: 2024-12-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12880154027.html

IP High Court, 2015 (Gyo-Ke) 10095 [Fuel-Consumption Reduction Device for an Internal Combustion Engine] <Shitara>

*It is …common general technical knowledge …that infrared absorption bands for a water-vapor layer also exist in the …wavelength regions.

⇒ Which infrared wavelength absorption band to use to improve engine combustion efficiency is a design matter a person skilled in the art may appropriately select.

(Excerpt from the court's reasoning)

It is …common general technical knowledge in fields using infrared or near-infrared light …that infrared absorption bands for a water-vapor layer exist not only at approximately 2.4–3.4 μm, but also at approximately 1.33–1.5 μm and approximately 1.8–2.0 μm. Thus, which absorption band of infrared light to use to improve engine combustion efficiency (reduce fuel consumption) is a design matter a person skilled in the art aware of that knowledge may appropriately select. A person skilled in the art encountering Cited Reference 1 is also found to have motivation to use an absorption band at approximately 1.33–1.5 μm, namely in the near-infrared region, to improve engine combustion efficiency (reduce fuel consumption).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85706.pdf

IP High Court, 2014 (Gyo-Ke) 10186 [Circular Knitting of Elastic Fabric Containing Elastomeric Yarn] <Shimizu>

Original Ameblo publication: 2024-12-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12880267810.html

IP High Court, 2014 (Gyo-Ke) 10186 [Circular Knitting of Elastic Fabric Containing Elastomeric Yarn] <Shimizu>

The upper draw-ratio limit of 2.5 times in the claimed invention was not particularly high at filing.

*The cited invention uses a close value (2.7 times) for the same parameter (draw ratio).

⇒ The cited invention is not at a limiting value.

—A design matter

(Excerpt from the court's reasoning)

Assuming ordinary yarn is used, the upper draw-ratio limit of 2.5 times in the claimed invention was not particularly high at filing, regardless of yarn thickness (Exhibit Otsu 5). Indeed, Example 1 of the cited reference …selects a draw ratio of 2.7 times to achieve commercially acceptable shrinkage at 44 dtex, a decitex value within the claimed invention. Thus, there is no technical difficulty in setting a draw ratio of no more than 2.5 times, smaller than 2.7 times. Accordingly, the shrinkage envisaged by the cited invention was not a limiting value under the state of the art at filing. There is no teaching away from increasing the draw ratio while increasing the decitex value in the cited invention, and setting “no more than 2.5 times” in that case is also a design matter a person skilled in the art could readily implement.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85181.pdf

IP High Court, 2017 (Gyo-Ke) 10075 [… Exercise Bike] <Mori>

Original Ameblo publication: 2024-12-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12880489765.html

IP High Court, 2017 (Gyo-Ke) 10075 [… Exercise Bike] <Mori>

*Differences 1 through 6 were held obvious.

*No new problem solved (no technical significance)

⇒ A design matter

*A limited set of alternatives is a design matter.

*Well-known technology makes it a design matter.

"Because there is no statement that a previously unknown new problem was solved …, it is a design matter."

(Excerpts from the court's reasoning)

…The specification contains no statement that adopting the configuration "a city bicycle with dragonfly-style handlebars" solves a previously unknown new problem. Making the handlebars of the exercise bike in Publication 1's invention into well-known dragonfly-style handlebars is therefore a design matter a person skilled in the art may appropriately select.

…

…For training equipment, selecting dimensions suited to the user's physique and ability is routinely done. A crank is either adjustable or not adjustable. Therefore, making the …crank in Publication 1's invention "a crank length suited to the person training" and "nonadjustable" is a design matter a person skilled in the art may appropriately select. …

…Exercise-bike saddles that are "height-adjustable" are well known …; making the saddle of Publication 1's exercise bike height-adjustable is therefore a design matter a person skilled in the art may appropriately select. …

…A "city bicycle with dragonfly-style handlebars" is well-known technology. Thus, providing the handlebars, saddle, and pedals of Publication 1's exercise bike with "a function of establishing the same riding posture and maintaining the operating feel of an actual city bicycle with dragonfly-style handlebars, excluding the perceived height differences from the rider's viewpoint" is a design matter a person skilled in the art may appropriately select. …

…For exercise bikes, which provide training through simulated bicycle riding, it is well known …to provide a gear-changing mechanism like that of an actual bicycle. …Where on the exercise bike to place the device operating that mechanism and what form it should take are design matters a person skilled in the art may appropriately select. Accordingly, providing Publication 1's exercise bike with "a gear-changing function that manually changes the pedal load through a button switch on the electronic equipment and changes the speed of movement of the current position in proportion to the changed load" is a design matter a person skilled in the art may appropriately select.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87429.pdf

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181 articles

Complete English translations of the revised Ameblo articles

In chronological order of the original Ameblo publication date

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53 2025-02-19 IP High Court, 2023 (Gyo-Ke) 10016 [Wireless Scuff Plate] <Miyasaka>

54 2025-02-20 [Copyright] IP High Court, 2022 (Ne) 10044 <Honda>

55 2025-02-21 Osaka District Court, 2022 (Wa) 2058 [Floor Opening Cover] <Takemiya> — Only the third requirement under the doctrine of equivalents was not satisfied!!

56 2025-02-22 [Copyrightability (of Photographs)] IP High Court, 2005 (Ne) 10094, “Smell Get Case/Appeal” <Tsukahara>

57 2025-02-23 [Article/Copyright] A Case Rejecting Copyright Infringement by an Illustration Made with Reference to a Photograph (Bao Miaokun, 2021)

58 2025-02-24 [Article] A Case Denying Business Preparations Where the Nature of the Business Had Not Been Determined (Ye Peng, 2022)

59 2025-02-26 Osaka District Court, 1991 (Wa) 585 [Method of Manufacturing Anchors]

60 2025-02-26 Sapporo District Court, 2000 (Wa) 407 [Method and Apparatus for Raw Shucking of Bivalves]

61 2025-02-27 [Article/Trademark] A Functional Examination of the Theory of Trademark Use (2, Final Part) (Takuto Hirasawa, Intellectual Property Law and Policy Journal, 2017)

62 2025-02-28 Osaka District Court, 2022 (Wa) 5553 [Playpen for Infants] <Takemiya>

63 2025-03-01 Tokyo District Court, 2023 (Wa) 70001 — Wastewater Treatment Apparatus (Shibata)

64 2025-03-02 Civil Law — Osaka District Court, 2021 (Wa) 11286 and 2022 (Wa) 9132: No Contractual Nonconformity

65 2025-03-03 Trademark — IP High Court, 2023 (Gyo-Ke) 10050: “美容医局” (Biyō Ikyoku) (designated services: employment placement and others) (Hibiku Shimizu)

66 2025-03-04 Design — IP High Court, 2023 (Gyo-Ke) 10113: Violation of Article 5(ii) of the Design Act, the Hermès Case (Miyasaka)

67 2025-03-05 Patents / Employee Inventions — IP High Court, 2022 (Ne) 10018: No “Monopoly Benefit”!! ⇒ Claim (Appeal) Dismissed (Honda)

68 2025-03-06 Trade Secrets — Osaka High Court, 2023 (Ne) 1657: The Secret Was Not “Disclosed” (Morisaki)

69 2025-03-07 IP High Court, 2023 (Gyo-Ke) 10039 — Laser Processing Apparatus (Miyasaka)

70 2025-03-08 IP High Court, 2023 (Gyo-Ke) 10055 — Laser Processing Apparatus (Miyasaka)

71 2025-03-09 IP High Court, 2024 (Ne) 10026 — Thermoplastic Resin Composition: Rounding and Equivalents (Miyasaka)

72 2025-03-10 IP High Court, 2023 (Gyo-Ke) 10085 — Image Forming Apparatus (Miyasaka)

73 2025-03-11 Trademark — IP High Court, 2023 (Ne) 10091: “Gendai no Riron” (Miyasaka)

74 2025-03-12 Tokyo District Court, 2024 (Yo) 30029 — Age-Related Macular Degeneration (Nakashima, Civil Division 40)

75 2025-03-13 Tokyo District Court, 2024 (Yo) 30028 — Age-Related Macular Degeneration (Kokubu, Civil Division 29)

76 2025-03-14 Two Judgments Specifying the End Date of an Injunction: Patent Expiration or the Expiration Date Before Extension

77 2025-03-15 Contract — Tokyo District Court, 2023 (Wa) 70422: Copyright Assignment Without a Written Agreement (Sugiura)

78 2025-03-17 IP High Court, 2022 (Gyo-Ke) 10118 — Program: A Disclaimer Claim and Inventive Step (Honda)

79 2025-03-18 Osaka District Court, 1998 (Wa) 12899 — Electric Pipe Bending Apparatus

80 2025-03-19 IP High Court, 2023 (Gyo-Ke) 10011 — Device for Remote Operation of a Mobile Terminal (Miyasaka)

81 2025-03-20 Three-Dimensional Trademark — IP High Court, 2024 (Gyo-Ke) 10047: Shin Godzilla (Miyasaka)

82 2025-03-21 IP High Court Grand Panel, 2023 (Ne) 10040 — Composition for Breast Augmentation

83 2025-03-23 IP High Court, 2024 (Ra) 10002 — Jurisdiction over a Taiwanese Provider (Miyasaka)

84 2025-03-23 IP High Court, 2024 (Ne) 10010 — Women’s Clothing: A Late Invalidity Defense (Nakadaira)

85 2025-03-24 IP High Court, 2024 (Ra) 10003 — Restricting Access to Settlement Terms and Litigation Records

86 2025-03-25 Article — Scope of Review in Patent Trial-Decision Revocation Actions: Admissibility of New Arguments on Well-Known Technology — The Laser Processing Optical Apparatus Case (Peng Zhang, 2012)

87 2025-03-26 JPO Status Report 2025

88 2025-03-27 Copyright Article — Identifying the Author of a Compilation (Katsuyuki Izumi, 2013)

89 2025-03-28 Trademark Appeal 2024-278 — “AONO” Does Not Fall Under Article 3(1)(iv)

90 2025-03-29 The JPO’s “Toward Strategic Intellectual Property Management” (2007)

91 2025-03-29 Compilation Copyright — Legal Protection for Works Distributed in Parts over the Internet — The Daily Tear-Off Calendar Case (Takuto Hirasawa, 2009)

92 2025-03-30 Osaka District Court, 2022 (Wa) 3344 — Method for Producing a High-Purity PTH-Containing Lyophilized Preparation (Takemiya)

93 2025-03-31 Deletion of All Claims Is Permitted in the JPO’s Q&A

94 2025-04-01 IP High Court, 2024 (Gyo-Ke) 10002 — Nonwoven Fabric for Civil Engineering Work (Shoji) — Motivation to change the specifications of a publicly worked product

95 2025-04-01 A Revised Edition of the “Trade Secret Management Guidelines” Has Been Published.

96 2025-04-02 IP High Court, 2021 (Gyo-Ke) 10131 [Sheet-Affixed Structure] <Honda>

97 2025-04-03 [U.S. Patents] Claim Differentiation and 35 U.S.C. § 112(d)

98 2025-04-04 [U.S. Patents] UTTO v. Metrotech (October 2024, CAFC)

99 2025-04-07 IP High Court, 2022 (Gyo-Ke) 10039 [Reservation Support Method] <Honda>

100 2025-04-07 IP High Court, 2017 (Gyo-Ke) 10167 [Laminated Film] <Mori>

101 2025-04-07 IP High Court, 2014 (Gyo-Ke) 10097 [Flat Nonaqueous Electrolyte Secondary Battery] <Shimizu>

102 2025-04-08 [Trademark] Kobe District Court, 1995 (Wa) 661, “Chafukumame”

103 2025-04-09 IP High Court, 2016 (Gyo-Ke) 10146 [Method and Compositions for Preparing Antibodies and Antibody Derivatives with Low Core Fucosylation] <Shimizu>

104 2025-04-10 [Trademark] Osaka District Court, 2013 (Wa) 12788 <Tani> — Registered mark “Raisapo”

105 2025-04-11 [Article/China and Trade Secrets] Trade Secret Protection in China: Focusing on Academic Views and Court Decisions concerning the Secret-Management Requirement

106 2025-04-12 IP High Court, 2023 (Ne) 10051 [High-Capacity Water Supply System] <Miyasaka>

107 2025-04-13 [Article] Examining the Scope of New Evidence Admissible in Actions to Rescind Trial Decisions: A Classification of Court Decisions (Masanori Takahashi, 2014)

108 2025-04-13 Tokyo District Court, 2012 (Wa) 12351 [Rice Cake] — <Damages> Article 102(2): 90% reduction for noncontribution

109 2025-04-14 [Article] Agreements Not to Exercise Authors' Moral Rights: A Law-and-Economics Analysis (Nobuko Kawashima, Intellectual Property Law and Policy Journal, Vol. 29 (2010))

110 2025-04-15 [Article] Copyrightability of two-dimensional patterns — Appeal in the Futon Pattern case (Yuanjie Li, Intellectual Property Law and Policy Journal, Vol. 69, 2024)

111 2025-04-16 IP High Court, 2017 (Ne) 10068, “Random Packing” Case <Mori>

112 2025-04-17 IP High Court, 2014 (Ne) 10080 [Method of Manufacturing Spinel-Type Lithium Manganate] <Shimizu>

113 2025-04-18 [Article / Copyright] Copyrightability denied for makeup, hairstyling, and the selection and coordination of clothing and accessories in a fashion show, Parts 1–2 (Shun Hashiya, Vol. 47, 2015; Vol. 48, 2016)

114 2025-04-20 [Article / Copyright] Including tweets in a book held to be lawful quotation under Copyright Act Article 32(1) — #KuToo case (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 66, 2022)

115 2025-04-21 [Article/Copyright] Ownership of Rights concerning Unknown Methods of Exploitation — The Kaiketsu Lion-Maru Case (Kazuhiro Ando, Intellectual Property Law and Policy Journal, Vol. 26, 2010)

116 2025-04-22 [Article/Unfair Competition Prevention Act] Trends in Regulation of Dead Copies of Product Configuration — Evaluating Legislative Amendments and Case Law in Light of the Purpose of the System (Yoshiyuki Tamura, Intellectual Property Law and Policy Journal, Vol. 25, 2009)

117 2025-04-23 [Article/Portrait Rights] Copyrightability of Snapshot Portrait Photographs and Whether They May Be Freely Used: The Tokyo Outsiders Case (2010)

118 2025-04-24 IP High Court, 2022 (Gyo-Ke) 10084 [Therapeutic Agent for Severe Heart Failure] <Honda>

119 2025-04-25 IP High Court, 2018 (Gyo-Ke) 10094 [System for Characterizing a Stenosis in a Fluid-Filled Vessel] <Mori>

120 2025-04-26 [Freedom to Choose One's Occupation] IP High Court, 2022 (Ne) 10059 <Honda>

121 2025-04-27 [Copyright] IP High Court, 2021 (Ne) 10048 <Otaka>

122 2025-04-28 [Unfair competition] IP High Court, 2019 (Ne) No. 10002 (Judge Otaka)

123 2025-04-30 [Unfair Competition Prevention Act/Trade Secrets] IP High Court, 2017 (Ne) 10076 <Takabe>

124 2025-05-01 [Contract] Tokyo District Court, 2023 (Wa) 70722 <Nakashima>

125 2025-05-02 [Civil Code/Tort] IP High Court, 2018 (Ne) 10089 <Takabe>

126 2025-05-03 [Trademark/Non-Use Cancellation] IP High Court, 2020 (Gyo-Ke) 10114 <Otaka>

127 2025-05-04 [Article/Trademark] The Possibility of Trademark Parody under Japanese Law: The SHI-SA Case (Takuto Hirasawa, 2009)

128 2025-05-07 [Trademark] IP High Court, 2016 (Gyo-Ke) 10053 <Takabe>

129 2025-05-07 [Trademark] IP High Court, 2015 (Gyo-Ke) 10111 <Takabe>

130 2025-05-07 [Trademark/Management of Affairs without Mandate] IP High Court, 2018 (Ne) 10074 <Takabe>

131 2025-05-08 [Trademark] IP High Court, 2024 (Gyo-Ke) 10029 <Nakadaira>

132 2025-05-09 [Unfair Competition Prevention Act] IP High Court, 2024 (Ne) 10024 <Hibiku Shimizu>

133 2025-05-10 [Article] Comprehensive Survey of Civil Intellectual Property Judgments of District Courts Other Than Tokyo and Osaka (2020) (Kazuyuki Tanikawa, 2023)

134 2025-05-11 [Article] A Court Decision concerning Application of “Offers to Transfer (Including Offers for Sale)” to Cross-Border Conduct, the Scope of Damages and the Doctrine of Equivalents

135 2025-05-12 IP High Court, 2015 (Gyo-Ke) 10127 [Laser Processing Apparatus] <Takabe>

136 2025-05-13 IP High Court, 2015 (Gyo-Ke) 10122 [System for Dermatological Treatment] <Takabe>

137 2025-05-15 Tokyo District Court, 2021 (Wa) 11507 [Compression Supporter] <Nakashima>

138 2025-05-16 [Article/Unfair Competition Prevention Act] Usefulness and Non-Public Status of Trade Secrets: The Tin Alloy Composition Case (Chen Keyu, 2018)

139 2025-05-18 [Article/Copyright] Scope of Protection for Works of Pictorial Expression: The Professor Illustration Case (Emi Tsubata, 2009)

140 2025-05-18 [Design] Tokyo District Court, 2021 (Wa) 30281 and Other Cases, “Protective Member and Push Handle” <Kokubu>

141 2025-05-19 [U.S. Patents] August 20, 2007, CAFC, Ian Frazer v. C. Richard Schlegel

142 2025-05-20 [Article/Copyright] The Duty of Care Owed by a Party Commissioning Advertising Materials to Avoid Copyright Infringement (Hajime Moriwaki)

143 2025-05-21 [Article/Trademark] The Meaning of “Goods” under the Trademark Act (Takuya Ueda, Theory and Practice of Intellectual Property Law, Vol. 3)

144 2025-05-22 [Copyright] IP High Court, 2010 (Ne) 10029 <Takizawa>

145 2025-05-23 [Article/Works Made in the Course of Duties] The Air-Conditioning Equipment Training Text Case (Shigeki Ishii, Patent, 2007)

146 2025-05-24 [Copyright] IP High Court, 2005 (Ne) 10070 [Vibration Controller Program Case]

147 2025-05-25 [Article/Trade Secrets] Can a Company Enjoin an Employee’s Use or Disclosure of Trade Secrets the Employee Developed or Acquired Personally?

148 2025-05-26 IP High Court, 2016 (Ne) 10047 [Electrical Connector Assembly] <Takabe>

149 2025-05-28 IP High Court, 2016 (Ne) 10042 [Contact Terminal] <Takabe>

150 2025-05-29 [Trademark/Foreign Server] IP High Court, 2024 (Ne) 10031 <Hibiku Shimizu> — “Sushi Zanmai” Case

151 2025-05-30 Tokyo District Court, 2002 (Wa) 23687 [Telephone Card] <Iimura>

152 2025-05-31 Tokyo High Court, 1999 (Ne) 3800 [Underarm Sweat-Absorbing Pad]

153 2025-06-01 Osaka District Court, 2005 (Wa) 12207 [Goggles]

154 2025-06-04 Kyoto District Court, 1996 (Wa) 1597 [Thermal Head]

155 2025-06-04 Tokyo District Court, 1995 (Wa) 23005 [Topical Antifungal Agent]

156 2025-06-04 Shizuoka District Court, 1990 (Wa) 360 and 1992 (Wa) 524 [Alfacalcidol]

157 2025-06-05 Tokyo District Court, 2023 (Wa) 70178 [Zinc Acetate Hydrate Tablets and Method of Manufacturing Them] <Nakashima>

158 2025-06-06 [Article/Trademark] Trademark-Related Judgments in the Reiwa Era (Kentaro Hattori, Patent News, February 14, 2025)

159 2025-06-07 IP High Court, 2010 (Gyo-Ke) 10121 [Natto Food] <Takizawa>

160 2025-06-08 IP High Court, 2024 (Gyo-Ke) 10023 [Information Processing Terminal] <Hibiku Shimizu>

161 2025-06-09 Tokyo District Court, 2022 (Wa) 18332 [Method of Transmitting and Receiving Reference Signals in a Wireless Communication System] <Nakashima>

162 2025-06-10 Tokyo District Court, 2022 (Wa) 70139 and 2023 (Wa) 70009, “Claim for a Declaration of the Right to Obtain a Patent” <Nakashima>

163 2025-06-11 [Copyright] Tokyo District Court, 2023 (Wa) 70080, “Action for Disclosure of Sender Information” <Nakashima>

164 2025-06-12 [Trademarks] Tokyo District Court, 2022 (Wa) No. 16062 — “仙修” (Judge Shibata)

165 2025-06-13 [Unfair Competition Prevention Act/Communication of False Facts] Osaka District Court, 2022 (Wa) 11394, “Shogi Game-Record Information” <Takemiya>

166 2025-06-14 IP High Court, 2023 (Ne) 10093, “Copyright Owner of a Cinematographic Work” <Shoji>

167 2025-06-15 [Trademark] IP High Court, 2023 (Gyo-Ke) 10131, “hololive Indonesia” <Miyasaka>

168 2025-06-16 IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Pile Sheet] <Hibiku Shimizu>

169 2025-06-17 [Article] The Scope of “Quality” in Acts Causing Misapprehension of Quality and the Like under the Unfair Competition Prevention Act (Michihiko Otsuka, Patent, 2025)

170 2025-06-18 [Article] Interpretation of Broad Patent Claims (Koichi Hirota, Patent, 2005, Vol. 58, No. 7)

171 2025-06-19 [U.S. Patents] CloudofChange v. NCR (Fed. Cir. 2024)

172 2025-06-20 [Article/Europe] After the Long-Awaited Decision: Are SEPs Now Worthless in Europe? (Christoph Rademacher, 2016)

173 2025-06-23 IP High Court, 2022 (Ne) 10078 [Display Device Supportable with One Hand] <Kanno>

174 2025-06-23 [Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10058 (Judge Hibiku Shimizu)

175 2025-06-23 [Article/Copyright] The Public’s Freedom to Use Accessible Works: The Working Vehicles Case — Maiko Murai

176 2025-06-25 [U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC — Willfulness

177 2025-06-27 IP High Court, 2022 (Ne) 10055 [Specified Heat-Treated Meat Product] <Shoji>

178 2025-06-29 IP High Court, 2005 (Gyo-Ke) 10366 [Method of Manufacturing Bottles for Carbonated Beverages] <Tsukahara>

179 2025-06-29 [U.S.] Finjan v. Secure Computing <November 2010, CAFC>

180 2025-06-29 [U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC

181 2025-06-30 [Criminal/Unfair Competition Prevention Act/Trade Secrets] Acquittal: Nagoya District Court, March 18, 2022, 2017 (Wa) No. 427

IP High Court, 2015 (Gyo-Ke) 10200 [Press-Through Pack] <Takabe> — Merely improving accuracy is a matter of design choice

Original Ameblo publication: 2025-01-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881038971.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881038971-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881038971-ja

2015 (Gyo-Ke) 10200 [Press-Through Pack] <Takabe>

***Merely improving accuracy is a matter of design choice**

Even specifying ANSI grade “A” scanning accuracy is a matter of design choice.

“So long as the applied barcode can be read accurately, the degree of barcode-reading accuracy is a matter that a person skilled in the art appropriately determines.”

(Excerpt from the court's reasoning)

The space for displaying a barcode necessarily is limited … the size of the barcode display is a matter of design choice appropriately selected according to the space for displaying it, so long as its function can be ensured … and a barcode size of “nominally 0.169 mm/module” for barcodes used on prescription drugs … is conventional, well-known technology …. Moreover, it goes without saying that barcodes should be easy to read. So long as a barcode reader can accurately read the applied barcode, the degree of barcode-reading accuracy is a matter that a person skilled in the art appropriately determines. Accordingly, … achieving the highest quality, “A,” in the “overall evaluation prescribed by the ANSI standard when scanned ten times with a barcode verifier” is merely a matter of design choice ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86043.pdf

[Article] The Defense of Abuse of Trademark Rights: Internal Disputes within Organizations under the Iemoto System and among Noren-Wake Businesses (Mio Ishii, 2023)

Original Ameblo publication: 2025-01-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881039113.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881039113-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881039113-ja

[Article] The Defense of Abuse of Trademark Rights: Internal Disputes within Organizations under the Iemoto System and among Noren-Wake Businesses (Mio Ishii, Intellectual Property Law and Policy Journal, Vol. 67 (2023))

1. There can be only one iemoto (head of a traditional school). This is a legal status carrying authority to direct and represent the organization.

⇒ When the iemoto dies without designating a successor, a successor has not been recognized on circumstantial facts alone. In the Shinmakoto-kai case, neither adopted child was recognized as the successor.

(In such a case, even if one party acquires trademark rights, exercising those rights against the other constitutes an abuse of rights.)

2. Noren-wake (allowing a branch business to operate under the original business's name)

⇒ Unlike designation of a successor under the iemoto system, a license may be recognized by implication. Even if one noren-wake business acquires trademark rights, exercising those rights against other legitimate noren-wake businesses often constitutes an abuse of rights.

(However, in the appellate judgment in the Morihan case, the defendant began using the mark “Morihan Sohonpo.” Because it was not identical under generally accepted social norms to “Morihan,” which had long been used, the court did not allow the abuse-of-rights defense for “Morihan Sohonpo.” In that sense, acquiring trademark rights first has some significance.)

3. In principle, rights do not lapse merely because they have not been exercised for a long time, but exercising them may constitute an abuse of rights in the following two types of cases.

(1) The defendant's mark has become famous.

(2) There is a special relationship between the plaintiff and defendant.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2023/03/5769c93edd3bc55eeeabc293c04d0411.pdf

[Trademark] Tokyo High Court, 2002 (Gyo-Ke) 169, “Saikyo Miso”

Original Ameblo publication: 2025-01-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881039203.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881039203-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881039203-ja

[Trademark] Tokyo High Court, 2002 (Gyo-Ke) 169, “Saikyo Miso”

*Although the plaintiff requested deletion or revision of the entries in dictionaries and encyclopedias after registration, this did not overturn the finding that the term was generic!!

⇒ This does not affect the understanding at the time of registration.

• Even an out-of-print publication continues influencing readers until it becomes difficult to consult in libraries and elsewhere.

• It could not be determined whether the publishers' responses reflected acceptance of the plaintiff's assertions as true or measures intended to avoid a dispute.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10803.pdf

IP High Court, 2015 (Gyo-Ke) 10205 [Vehicle Roof Antenna] <Shitara> — Orientation is a matter of design choice

Original Ameblo publication: 2025-01-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881046800.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881046800-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881046800-ja

2015 (Gyo-Ke) 10205 [Vehicle Roof Antenna] <Shitara>

*Orientation is a matter of design choice

"The orientation in which AM antenna 22, installed in the internal space in the projecting fin of fin-shaped cover 21, is installed … can be said to be a matter of design choice that can be appropriately determined according to the reception sensitivity of the car radio, the dimensions of the internal space, and other considerations."

*A case in which a configuration (positional relationship) could be understood by reading the drawings in the cited reference together with its specification.

(Excerpts from the court's reasoning)

…A person skilled in the art … can design a shorter overall length by adjusting the coil pitch, coil diameter, number of turns, and so on. Thus, even if AM antenna 22 is installed with its axial direction perpendicular to signal amplification circuit board 23, it is possible to configure it so as to avoid problems such as inability to fit inside fin-shaped cover 21 or interference with signal amplification circuit board 23 …. Furthermore, whether AM antenna 22, installed in the internal space in the projecting fin of fin-shaped cover 21, is installed along the upper portion (the invention in Exhibit Ko 1, Figure 2), with its axial direction perpendicular to signal amplification circuit board 23 (Invention 1 at issue, Exhibit Ko 12, Figure 2), or in another orientation is a matter of design choice that can be appropriately determined according to the reception sensitivity of the car radio, the dimensions of the internal space, and other considerations …. Moreover, holding a coil antenna with a retaining cylinder is well-known technology. Accordingly, when installing the "AM antenna" in the invention in Exhibit Ko 1 with its axial direction perpendicular to the signal amplification circuit board, there is no particular difficulty in configuring it to be held by a retaining cylinder projecting from the upper surface of the fin-shaped cover. The configuration of Invention 1 relating to Difference 3 is therefore found to be one that a person skilled in the art could readily have conceived.

Figure 1 of the Ko 1 reference shows an external perspective view of an embodiment of the invention in Exhibit Ko 1. In that drawing, "metal base 25" is drawn with solid lines surrounding the lower portion of "fin-shaped cover 21" and is shown with some thickness. It can therefore be understood that "metal base 25" is positioned below the periphery of the bottom opening of "fin-shaped cover 21." Furthermore, the "Best Mode for Carrying Out the Invention" in the Ko 1 reference states that "metal base 25 is attached to the bottom of fin-type antenna device 20" ([0013]) and that fin-type antenna device 20 is formed in combination with "fin-shaped cover 21" positioned above "metal base 25" ([0009], Figure 2). These descriptions also make it natural to understand that "metal base 25" is positioned below the periphery of the bottom opening constituting the bottom of "fin-shaped cover 21."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85864.pdf

IP High Court, 2023 (Gyo-Ke) 10097 and 10120 [Content Receiving Device] <Hibiku Shimizu>

Original Ameblo publication: 2025-01-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881126907.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881126907-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881126907-ja

2023 (Gyo-Ke) 10097 and 10120 [Content Receiving Device] <Hibiku Shimizu>

*An action to rescind a trial decision dismissing an appeal against a decision of refusal is compulsory joint litigation requiring all joint applicants to participate!!

⇒ The action brought by one joint applicant was dismissed as inadmissible.

⇒ The other applicant applied to intervene as a co-plaintiff after expiry of the period for bringing the action, but this did not cure the defect.

***Joint application by a corporation and its representative director.**

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92690.pdf

IP High Court, 2008 (Gyo-Ke) 10274 [Antibodies against HCV] <Iimura> — Enablement across the full claim scope is necessary

Original Ameblo publication: 2025-01-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881247875.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881247875-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881247875-ja

2008 (Gyo-Ke) 10274 [Antibodies against HCV] <Iimura>

***Enablement is required across the full scope of the claims.**

(The general principle is the same for biotechnology/antibodies!)

"The degree of disclosure in the specification supporting the public disclosure … should not be understood as sufficient merely because it enables only a part of 'the product.'"

(Excerpts from the court's reasoning)

The plaintiff argues … that whether the claimed invention is enabled should properly be understood as satisfied when the specification describes how to produce and use one arbitrarily selected part (here, a polypeptide), and that the trial decision erred in requiring that they be obtained "exhaustively." …

Considering that the patent system, in exchange for public disclosure, permits the holder to exclusively practice "the product" recited in the claims in the case of a product invention, it is natural that the specification supporting that disclosure must describe the invention sufficiently to enable the entirety of "the product." It should not be understood as sufficient merely because the disclosure enables only a part of "the product." …

The plaintiff argues that, in biotechnology-related fields, the current enablement requirement does not demand that all embodiments be obtained exhaustively, and that imposing such a demand would produce harsh consequences for applicants, ultimately contrary to the Patent Act's purpose of encouraging inventions, and would be markedly unreasonable. Certainly, in biotechnology-related fields, even where the detailed description of the invention does not specifically describe every embodiment having a "deletion, insertion or substitution," it may be permissible for the claims to identify a particular amino acid sequence and additionally encompass cases in which "one or several [amino acids] are deleted, inserted or substituted," or the like. …However, even where claims in that form are permitted, …if circumstances are found that allow a modified polypeptide having activity similar to that of the original polypeptide to be readily obtained, it is appropriate to regard the so-called enablement requirement as satisfied. But …where practicing the entirety of the technology falling within the claims would require trial and error or ingenuity exceeding what can be expected of a person skilled in the art, the so-called enablement requirement must be regarded as not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-37946.pdf

[Copyright/Copyrightability of Photographs] Osaka High Court, 2023 (Ne) 1384 — Copyrightability recognized in photographic composition!

Original Ameblo publication: 2025-01-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881384383.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881384383-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881384383-ja

[Copyright/Copyrightability of Photographs] 2023 (Ne) 1384

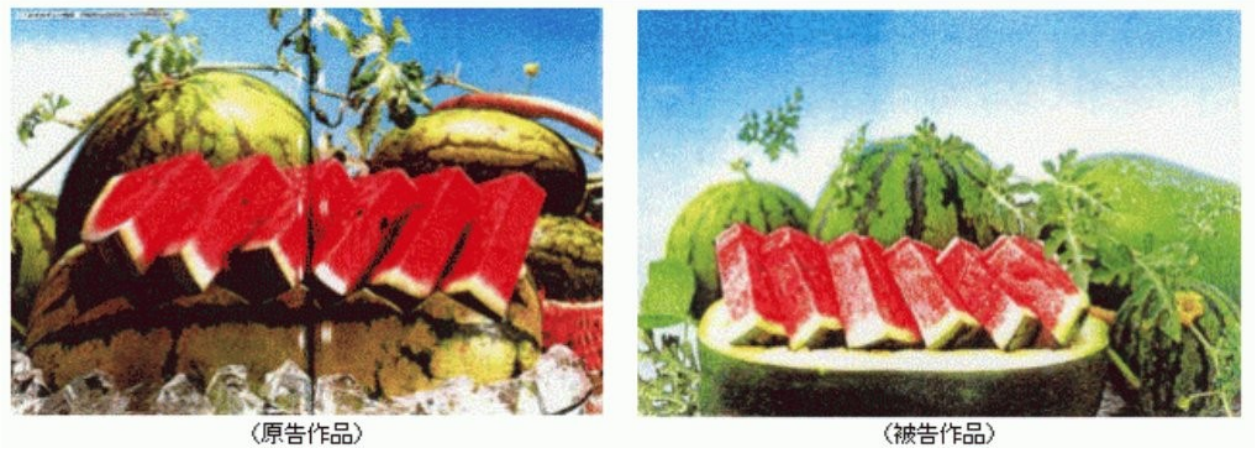
***Copyrightability was recognized in the composition of the photograph!**

The first since the Tokyo High Court's June 21, 2001 watermelon case?

“There are multiple possible choices for selecting, combining and arranging the subjects, adjusting lighting and shading, and selecting the background, and the photographer's individuality is expressed in the expression of Defendant Image 3 itself.”

⇒ The ultimate conclusion was that no adaptation was established.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92728.pdf



Watermelon photographs in the referenced case: plaintiff’s work (left); defendant’s work (right).


BTS JIMIN
ハングル単語カード
JIMIN
한글 단어카드
韓流BANK

[Article/Unfair Competition Prevention Act] The Validity and Scope of Contracts Prohibiting the Use of Know-How after Leaving Employment (Takuto Hirasawa)

Original Ameblo publication: 2025-01-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881495720.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881495720-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881495720-ja

[Article/Unfair Competition Prevention Act] The Validity and Scope of Contracts Prohibiting the Use of Know-How after Leaving Employment (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 31 (2010))

Osaka High Court, 2009 (Ne) 1456: the rights holder lost on reversal.

⇒ Of the appellee's technologies, the portions used by the appellants “include, to a substantial extent, existing technologies or technologies that a practitioner of eyebrow beauty treatments could readily acquire or master, and the appellee cannot secure exclusive rights in those portions alone.”

To the same effect: Tokyo District Court, 2006 (Wa) 15404.

“It is appropriate to construe the noncompetition agreement at issue as prohibiting only business conducted using confidential business information held by the plaintiff. Business conducted using knowledge, experience and the like concerning routine, general operations acquired by the defendant while working for the plaintiff, or using knowledge, experience and the like held by the defendant before the contract at issue, is not subject to the noncompetition obligation.”

The article also introduces numerous other court decisions and considers the limits of post-employment noncompetition obligations. For example, one decision limited the period for which an injunction based on a noncompetition obligation could be granted to two years (Tokyo District Court, 2006 (Wa) 22955, the “Total Service” case).

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/44347/1/IPLPJ31_009.pdf

IP High Court, 2022 (Ne) 10113 [Compression Supporter] <Miyasaka>

Original Ameblo publication: 2025-01-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881658443.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881658443-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881658443-ja

2022 (Ne) 10113 [Compression Supporter] <Miyasaka>

The synthetic “resin” in claim element C does not literally encompass “synthetic fiber.”

⇒ Doctrine of equivalents also rejected.

“Claim element C is a part directly linked to the functions and effects of the invention at issue and is included in its essential part … because claim element C is not satisfied … the essential part is not present.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92458.pdf

[Commercial Code/Copyright] IP High Court, 2023 (Ne) 10060 <Hibiku Shimizu>

Original Ameblo publication: 2025-01-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881740000.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881740000-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881740000-ja

[Commercial Code/Copyright] 2023 (Ne) 10060 <Hibiku Shimizu>

Publishing-contract negotiations broke down ⇒ A claim for remuneration under Article 512 of the Commercial Code was allowed for work performed by the publisher.

Based on the manuscript revised by the plaintiff (the heir), the publisher proofread it while hearing the plaintiff's views and prepared a final printing manuscript formatted to a publishable state once printed.

*Commercial Code, Article 512: “When a merchant performs an act for another person within the scope of its business, the merchant may claim reasonable remuneration.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92644.pdf

[Trademark] IP High Court, 2014 (Gyo-Ke) 10067, “Nationwide Common Meal Voucher” Case <Shitara>

Original Ameblo publication: 2025-01-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12881865738.html

HP: https://www.takaishihideki.com/single-post/ameblo-12881865738-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12881865738-ja

[Trademark] 2014 (Gyo-Ke) 10067, “Nationwide Common Meal Voucher” Case <Shitara>

The designated service, “issuance of meal vouchers” … issuance of meal vouchers usable nationwide even at nonparticipating establishments … is practically inconceivable …. The indication “Nationwide Common Meal Voucher” does not … cause misapprehension of the quality of the services.

⇒ No violation of Article 4(1)(xvi).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84595.pdf

IP High Court, 2019 (Gyo-Ke) 10015 <Tsuruoka> — A disclaimer claim held to add new matter!!

Original Ameblo publication: 2025-01-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882062461.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882062461-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882062461-ja

2019 (Gyo-Ke) 10015 <Tsuruoka>

***A “disclaimer claim” was held to add new matter!!**

From the specification's … descriptions … one cannot discern a correlation between heat-treatment time and bringing the zero-crossing time closer to zero seconds while suppressing whisker growth … less than 2.30 seconds … is not … self-evident.

[Claim 3] … A tab terminal for an electrolytic capacitor, comprising … in the welded portion between the lead wire and said aluminum core wire (excluding, however, tab terminals for electrolytic capacitors having a zero-crossing time of 2.50 seconds or more as measured in accordance with JIS C-0053, solderability testing method (wetting balance method)).

(Excerpt from the court's reasoning)

...The specification … contains no express description of a tab terminal having a zero-crossing time of at least zero seconds and less than 2.30 seconds. …Because the specification does not disclose a correlation between heat-treatment time and bringing the zero-crossing time closer to zero seconds while suppressing whisker growth, …it is not self-evident … to suppress whisker generation while setting the zero-crossing time to at least zero seconds and less than 2.30 seconds.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89038.pdf

[Article] The Limits of the Concepts of “Publicly” and “the Public” under Copyright Law: The Happy Science Prayer Scripture Case (Takuto Hirasawa, 2015)

Original Ameblo publication: 2025-01-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882328852.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882328852-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882328852-ja

[Article] The Limits of the Concepts of “Publicly” and “the Public” under Copyright Law: The Happy Science Prayer Scripture Case (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 46 (2015))

Right to prohibit recitation: “The author has the exclusive right to recite the author's literary work publicly.” (Copyright Act, Article 24)

Copyright Act, Article 2(5): “the public” includes a large number of specified persons.

⇒ Cases often concern playing recordings of recitations of works, but this case (Tokyo District Court, 2012 (Wa) 24933) concerned the recitation itself.

The issue was whether the recitation to persons who visited the defendant after being introduced by E could be said to have been made “publicly.”

⇒ “Whether the use of the work is directed to the public should appropriately be determined in accordance with generally accepted social norms, taking into account not only the strength of preexisting personal ties but also the type and nature of the work, the manner of use, and other factors.”

• The court found that there were five or six people and held that this was not a “large number.”

• The court held that the persons were not “unspecified”: their number did not increase or decrease under arbitrary conditions; the money was not consideration for the prayers; and the readings occurred at most ten times, not regularly or continuously.

⇒ In conclusion, the “publicly” requirement was not satisfied.

*These factual findings also appear in the context of rejecting the plaintiff's arguments, and their relevance to applying the “unspecified” criterion is unclear.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2015/06/f8b597eaecaf77a4b0a1ee3a9d424afa.pdf

[Article] Whether Genuine Goods May Continue to Be Imported in Parallel After Assignment of Trademark Rights: The Converse Parallel Import Case (Yoshiyuki Tamura)

Original Ameblo publication: 2025-01-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882329007.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882329007-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882329007-ja

[Article] Whether Genuine Goods May Continue to Be Imported in Parallel After Assignment of Trademark Rights: The Converse Parallel Import Case (Yoshiyuki Tamura, Intellectual Property Law and Policy Journal, Vol. 30 (2010))

⇒ IP High Court, 2009 (Ne) 10058 <Appeal>, and Tokyo District Court, 2006 (Wa) 26725 and 2007 (Wa) 15580: both found trademark infringement (neither the parallel-import defense nor the abuse-of-rights defense was established).

(1) The defendant was parallel-importing genuine goods of Converse, which held the U.S. trademark rights.

(2) Converse assigned its Japanese trademark rights to Itochu Corporation, which sued the defendant.

⇒ Because “identity of the trademark proprietors” and “quality control” were not satisfied, the Fred Perry parallel-import defense failed (as did the abuse-of-rights defense).

(3) Although the defendant had been parallel-importing genuine goods, the change of trademark owner turned this into trademark infringement!!

*In the Tokyo District Court's December 7, 1984 [LACOSTE] case, the court recognized a common source by following a chain consisting of a capital relationship between the trademark owner and the licensor and a licensing relationship between the licensor and the overseas distributor.

⇒ The author's view is that the Converse case, too, should still have been treated as noninfringing parallel imports of genuine goods, because Itochu had held 5% of the shares of the new Converse, and the brand was still recognized in Japan as that of the former trademark owner, Converse.

The Tokyo District Court's January 18, 1999 [ellesse] case, by contrast, rejected parallel imports of genuine goods in circumstances where the Japanese and Korean trademark rights had originally belonged to one person, but only the Japanese rights were assigned, there was no capital relationship, and quality differed, making it difficult to regard them as one group.

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol30/30_9.pdf

[Article] Research on Estoppel concerning Chinese Patent Rights (JIPA's 3rd International Affairs Committee, 1st Subcommittee, Intellectual Property Management, Vol. 74, No. 9, 2024)

Original Ameblo publication: 2025-01-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882385586.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882385586-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882385586-ja

[Article] Research on Estoppel concerning Chinese Patent Rights (JIPA's 3rd International Affairs Committee, 1st Subcommittee, Intellectual Property Management, Vol. 74, No. 9, 2024)

● Estoppel established

Supreme People's Court, (2022) Zhi Min Zhong No. 905

Claim 2 lists alternatives together ⇒ One was added to claim 1.

● Estoppel not established

Supreme People's Court, (2021) Zhi Min Zhong No. 712

Product invention: a manufacturing method was asserted in the written opinion, but it did not affect patentability.

Supreme People's Court, (2020) Zhi Min Zhong No. 1593

Deletion of the claim term “substantially.”

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2409

Tokyo District Court, 1997 (Wa) 5741 [Toy Gun with Automatic Bullet-Feeding Mechanism] <Mimura>

Original Ameblo publication: 2025-01-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882551685.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882551685-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882551685-ja

Tokyo District Court, 1997 (Wa) 5741 [Toy Gun with Automatic Bullet-Feeding Mechanism] <Mimura>

(Damages)

*Expert accounting opinion

*Royalty-equivalent damages may be claimed against each infringing wholesaler, retailer or other distributor, subject to a limit on total recovery for the same product.

*In this case, the manufacturing company and the sales company within the same corporate group were jointly and severally liable.

“When goods pass through successive stages of distribution … damages may be claimed … against each person.”

Cf. 1999 (Wa) 12586

*Claims against infringers at multiple distribution stages do not permit double recovery for the same product.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12681.pdf

[Trademark] Tokyo High Court, 2001 (Gyo-Ke) 363 <Nagai>

Original Ameblo publication: 2025-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882765471.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882765471-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882765471-ja

[Trademark] Tokyo High Court, 2001 (Gyo-Ke) 363 <Nagai>

Mark at issue: “鳳凰” (Hōō, phoenix)

Cited mark: “宝桜” (capable of being pronounced “Hōō”; literally, “treasure” and “cherry blossoms”)

*At the filing date, the cited mark's owner had been declared bankrupt and its dissolution registered.

⇒ “It was a trademark lacking any substantive goodwill to be protected that should be formed through use by a legitimate owner … nor was there … any possibility of confusion.”

⇒ Article 4(1)(xi) inapplicable.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11969.pdf

[Trademark] IP High Court, 2010 (Gyo-Ke) 10171 <Nakano>

Original Ameblo publication: 2025-01-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882771948.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882771948-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882771948-ja

[Trademark] 2010 (Gyo-Ke) 10171 <Nakano>

Applied-for mark: “BOOKING.COM” with figurative elements

Cited mark: “Book-ing” with figurative elements (pronounced “bukkingu”)

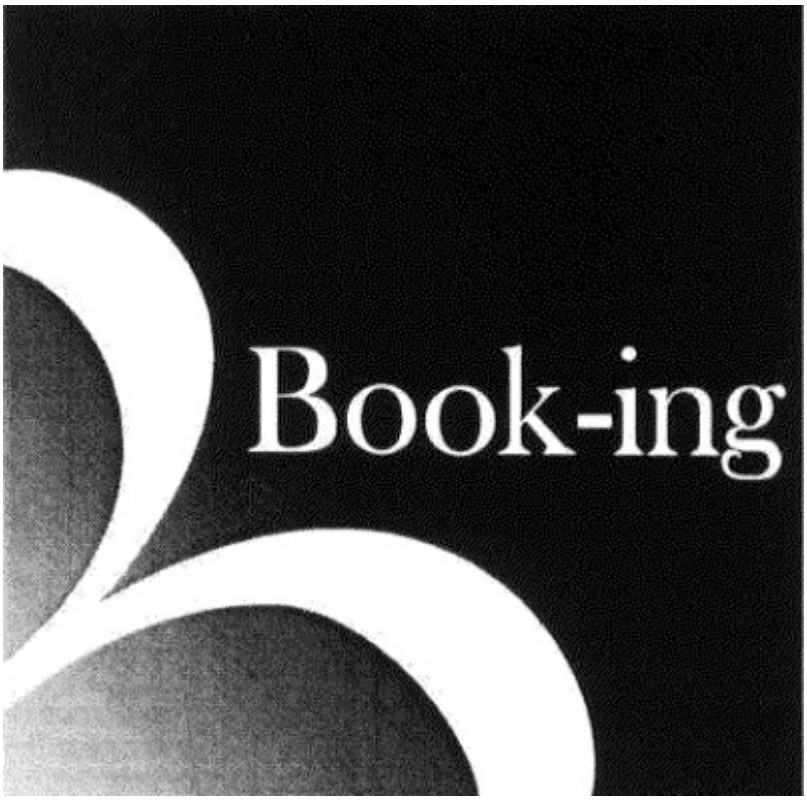
Appearance: considerably different

Pronunciation: generally shared

Concept: partially shared in the sense of “reservation”

Actual circumstances of trade: in a non-use cancellation trial requested after the original trial decision, the cited mark was found not to have been used.

⇒ Article 4(1)(xi): dissimilar



https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80945.pdf

[Unfair Competition Prevention Act/Misleading Indications of Quality] Tokyo District Court, 2022 (Wa) 2551, “Food Waste Processor” Case <Kokubu>

Original Ameblo publication: 2025-01-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882961467.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882961467-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882961467-ja

[Unfair Competition Prevention Act/Misleading Indications of Quality] Tokyo District Court, 2022 (Wa) 2551, “Food Waste Processor” Case <Kokubu>

*The stated sales performance differed from the facts.

⇒ Sales performance lends authority to goods as being of superior quality and gives consumers reassurance; the indication therefore misleads consumers as to quality.

⇒ No rebuttal of the damages amount calculated from marginal profit!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92506.pdf

[Trademark] IP High Court, 2010 (Gyo-Ke) 10101 — Mark at issue “Kitto, Sakura Saku yo” + a cherry-blossom-petal design

Original Ameblo publication: 2025-01-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12882961744.html

HP: https://www.takaishihideki.com/single-post/ameblo-12882961744-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12882961744-ja

[Trademark] 2010 (Gyo-Ke) 10101

Mark at issue: “Kitto, Sakura Saku yo” (Surely, the cherry blossoms will bloom for you) + a cherry-blossom-petal design

Cited mark: “Sakura Saku” (Cherry blossoms bloom)

Appearance: significantly different

Pronunciation: quite similar

Concept: the cited mark means “cherry blossoms bloom” or “passed an examination,” while the mark at issue conveys a message to examination candidates and the like; the concepts therefore differ to some degree.

⇒ Article 4(1)(xi): dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80620.pdf



[Unfair Competition Prevention Act/Misleading Indications of Quality] IP High Court, 2023 (Ne) 10112, “Food Waste Processor” Appeal <Shoji>

Original Ameblo publication: 2025-01-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883037707.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883037707-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883037707-ja

[Unfair Competition Prevention Act/Misleading Indications of Quality] 2023 (Ne) 10112, “Food Waste Processor” Appeal <Shoji>

Even if performance does not differ greatly from comparable goods, that does not mean that displaying sales figures higher than the actual figures is not a misleading indication of quality.

+Sales efforts also contributed, constituting grounds to rebut the presumption.

⇒ 50% rebuttal

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93284.pdf

[Unfair Competition Prevention Act/Misleading Indications of Quality] Tokyo District Court, 2018 (Wa) 3789, “Hagukumi Oligo” Case <Shibata>

Original Ameblo publication: 2025-01-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883134705.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883134705-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883134705-ja

[Unfair Competition Prevention Act/Misleading Indications of Quality] Tokyo District Court, 2018 (Wa) 3789, “Hagukumi Oligo” Case <Shibata>

⇒ The advertising prominently featured characteristics other than the purity of the oligosaccharides.

— 97% of the statutory damages presumption rebutted

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90080.pdf

Appeal: 2021 (Ne) 10018 <Shoji>

⇒ Continued for four years and four months; direct competition

— 91% of the statutory damages presumption rebutted

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90899.pdf

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Tokyo District Court, 2019 (Wa) 11673 <Kokubu>

Original Ameblo publication: 2025-01-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883260957.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883260957-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883260957-ja

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Tokyo District Court, 2019 (Wa) 11673 <Kokubu>

Difference (1): no approximately 2 cm ribbon at the center of the cup section

Difference (2): the lowest of the three pieces of fabric forming the left and right front panels is lace fabric

⇒ These are commonplace configurations, and the idea of replacing them cannot be said to be difficult to conceive.

⇒ Claim for over ¥200 million allowed

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90576.pdf

左側：原告商品　右側：被告商品 1





In both comparisons, the plaintiff’s product is on the left and Defendant’s Product 1 is on the right.

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2021 (Wa) 4467 <Matsuami>

Original Ameblo publication: 2025-01-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883263884.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883263884-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883263884-ja

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2021 (Wa) 4467 <Matsuami>

"The differences … as to whether the hem of the yoke at the upper back is stitched down or is a floating yoke … and whether there is a notch between the collar and lapel … cause little change in the overall configuration of the product and are only minor differences when viewed in the context of the product as a whole."

原告商品目録

「０１６４１１」との品番の以下の写真に示される婦人用コート（色はベージュとネイビーの２色である。）

［正面（腰ベルトあり）］



［正面（腰ベルトなし）］



Plaintiff's product: women's coat, item no. 016411, available in beige and navy. Front views: with waist belt (left); without waist belt (right).

被告商品目録

以下の写真（正面、背面、及び側面）により示される婦人用コート（「２１０１３」との品番が付されているものを含みこれに限られない。）。

［正面（腰ベルトあり）］



［正面（腰ベルトなし）］



Defendant’s products: women’s coats shown in the photographs (front, back, and side views), including but not limited to products bearing item no. 21013. Front views shown here: with waist belt (left); without waist belt (right).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91578.pdf

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2022 (Wa) 6582

Original Ameblo publication: 2025-01-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883396626.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883396626-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883396626-ja

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2022 (Wa) 6582

Differences: “luster and texture” are also subjects of comparison when imitation of clothing configuration is at issue, and the difference in texture here is such that the garments are worn in different seasons.

⇒ This strongly affects the impression consumers receive of the product as a whole, so the products are not substantially identical.



Plaintiff’s Product 1-1: model 21W-001D. Colors: BEIGE, BLACK, DOT BLACK. Shown in DOT BLACK: front (left), back (center), and enlarged pearl-decoration detail (right).

被告商品目録

１の１　商品名　　：ワンサイドパールジャンスカ

商品番号：１３８８１０

商品色　　：ベージュ

正面　　背面







Defendant’s Product 1-1: One-Side Pearl Pinafore Dress (ワンサイドパールジャンスカ), item no. 138810, beige. Front view (left); back view (center); enlarged detail (right).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92492.pdf

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Tokyo District Court, 2023 (Wa) 4333 <Shibata>

Original Ameblo publication: 2025-01-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883525179.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883525179-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883525179-ja

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Tokyo District Court, 2023 (Wa) 4333 <Shibata>

The masks are distributed and purchased by consumers inside their packaging.

⇒ The entire package, together with the masks inside it, constitutes the “product,” and the packaging design constitutes the product's “patterns and colors.”

⇒ The configurations are substantially identical!!

(However, the claim was dismissed because no causal relationship was found between the damages asserted by the plaintiff and sales of the defendant's goods.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92679.pdf



Comparison of mask packages: 富源 mask (top); ラザフォード mask (bottom).

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2022 (Wa) 3577 <Matsuami>

Original Ameblo publication: 2025-01-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883664197.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883664197-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883664197-ja

[Unfair Competition Prevention Act, Article 2(1)(iii)/Imitation of Product Configuration] Osaka District Court, 2022 (Wa) 3577 <Matsuami>

Although the products differ in whether they have a back pocket and in the number and placement of small pockets for storing cards and the like, these are all minor differences that do not affect consumers' impression of the overall product configuration.

⇒ Substantially identical.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92601.pdf

被告商品目録

1　被告商品１（通帳ケース）



（正面）



（背面）



（ケース内部）

Defendant’s Product 1 (bankbook case): front (upper left), back (upper right), and interior (lower left).

原告商品目録

1　原告商品１（通帳ケース）



（正面）



（背面）



（内部）

Plaintiff’s Product 1 (bankbook case): front (upper left), back (upper right), and interior (lower left).

[Unfair Competition Prevention Act/Misleading Indications of Quality] Osaka District Court, 2014 (Wa) 12570 <Morisaki>

Original Ameblo publication: 2025-01-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12883975466.html

HP: https://www.takaishihideki.com/single-post/ameblo-12883975466-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12883975466-ja

[Unfair Competition Prevention Act/Misleading Indications of Quality] Osaka District Court, 2014 (Wa) 12570 <Morisaki>

“Designated toner” is understood as … being used in the plaintiff's printers …. …In actual practice, genuine and nongenuine products are treated as differing … in quality.

⇒ The expression is understood to indicate … a certain appropriate quality and content.

⇒ It is an indication of “quality and content.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86620.pdf

IP High Court, 2024 (Ra) 10003, “Immediate Appeal against a Decision Dismissing an Application to Restrict Inspection and the Like”

Original Ameblo publication: 2025-01-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884026265.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884026265-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884026265-ja

2024 (Ra) 10003, “Immediate Appeal against a Decision Dismissing an Application to Restrict Inspection and the Like”

“[The party] expresses the view that even if a nondisclosure clause existed, a request by a third party to inspect the records could not … be refused …. However, an application to restrict inspection and the like was made promptly after the settlement was concluded, and there is … no fact showing that inspection or the like actually occurred …. The argument cannot be accepted.”

⇒ If the records are inspected, an application to restrict inspection and the like may fail!!

Anticipating inspection by third parties, a party needing to protect confidential information should promptly apply to restrict inspection and confirm with the court how the records will be handled after the application.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93381.pdf

[Article/Patents] What Does “So as to Enable Use” in the Enablement Requirement Mean? (Atsushi Nagano, Intellectual Property Management, 2024)

Original Ameblo publication: 2025-01-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884026476.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884026476-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884026476-ja

[Article/Patents] What Does “So as to Enable Use” in the Enablement Requirement Mean? (Atsushi Nagano, Intellectual Property Management, Vol. 74, No. 11, 2024)

Court decisions are divided on whether “so as to enable use” under the enablement requirement should be construed to mean enabling use in a manner that solves the problem addressed by the invention.

Example 11 in the Examination Handbook adopts the view that the functions and effects need not be achieved.

Looking at decisions from 2010 through 2024, 27 adopt the view that functions and effects are not required, while 15 require them.

*However, many decisions adopting the view that functions and effects are required ultimately found the enablement requirement satisfied, and some decisions adopting the view that functions and effects are not required found a violation of the support requirement. Thus, this issue was decisive to the ultimate patentability outcome in relatively few cases.

https://www.fukamipat.gr.jp/wp/wp-content/uploads/2024/12/202411_chizaikanri.pdf

IP High Court, 2023 (Gyo-Ke) 10107 [Induction Heating Coil Unit] <Hibiku Shimizu>

Original Ameblo publication: 2025-01-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884147129.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884147129-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884147129-ja

2023 (Gyo-Ke) 10107 [Induction Heating Coil Unit] <Hibiku Shimizu>

“From the principle of induction heating … electrically insulating nonmagnetic materials … have the property of allowing magnetic flux to pass through them … and it was well known that ceramics and resins were such materials …. …Selecting … well-known ceramics or resins as electrically insulating nonmagnetic materials … that allow magnetic flux to pass through … could readily have been conceived.”

The patentee also argued, in identifying the gist of the invention, that the entire case consisted of electrically insulating ceramic or resin, but that argument was rejected. (This point could presumably have been addressed by correction.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93344.pdf

[Trademark] IP High Court, 2024 (Gyo-Ke) 10030, “Remote Champagne” <Hibiku Shimizu>

Original Ameblo publication: 2025-01-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884272998.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884272998-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884272998-ja

[Trademark] 2024 (Gyo-Ke) 10030, “Remote Champagne” <Hibiku Shimizu>

The applicant argues that the term means sending champagne or similar gifts without actually visiting the establishment. But that meaning is not generally recognized, and it remains the case that the term presupposes the famous “Champagne” and uses that name.

⇒ Violation of Article 4(1)(vii)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93339.pdf

商　標　目　録

【商標登録を受けようとする商標】

遠隔シャンパン（標準文字）

【指定商品又は指定役務並びに商品及び役務の区分】

（注）令和４年１０月２７日付け補正後のもの

第９類　シャンパーニュ地方産の発泡性のワインを注文するためのコンピュータソフトウェア用アプリケーション（電気通信回線を通じてダウンロードにより販売されるもの）、シャンパーニュ地方産の発泡性のワインを注文するための電子計算機用プログラム

以　上

Applied-for mark: 遠隔シャンパン (‘Remote Champagne’), in standard characters. Designated goods, as amended on October 27, 2022 — Class 9: computer software applications for ordering sparkling wine produced in the Champagne region, sold by download via telecommunications lines; computer programs for ordering sparkling wine produced in the Champagne region.

IP High Court, 2023 (Gyo-Ke) 10124 [Moving Image Decoding Device] <Miyasaka>

Original Ameblo publication: 2025-01-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884413992.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884413992-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884413992-ja

2023 (Gyo-Ke) 10124 [Moving Image Decoding Device] <Miyasaka>

None of the “change flag,” “threshold Th” or “maximum number of vectors” in the specification constitutes “control information for changing the number of motion vector candidates” … and the amendment was not made within the scope of the matters disclosed in the specification and other documents.

⇒ Addition of new matter

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93350.pdf

[Tort/Damage to Business Reputation] IP High Court, 2024 (Ne) 10014 <Honda>

Original Ameblo publication: 2025-01-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12884544939.html

HP: https://www.takaishihideki.com/single-post/ameblo-12884544939-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12884544939-ja

[Tort/Damage to Business Reputation] 2024 (Ne) 10014 <Honda>

*Posts on the business-matching site Lancers are consulted as a reference for matters such as what work someone does, so they concern matters of public interest and serve a public-interest purpose.

+The material portions were true.

+They did not exceed the bounds of opinion or commentary.

⇒ The first-instance award of ¥500,000 was overturned!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93320.pdf

[U.S.] November 2023, CAFC, Actelion v. Mylan, 85 F.4th 1167

Original Ameblo publication: 2025-02-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885080409.html

HP: https://www.takaishihideki.com/single-post/ameblo-12885080409-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12885080409-ja

[U.S.] November 2023, CAFC, Actelion v. Mylan, 85 F.4th 1167

The issue was construction of “a pH of 13 or higher.”

“A pH greater than 11” had been narrowed to secure nonobviousness.

Original judgment: “pH 13” encompasses 12.5–13.4.

This judgment: the prosecution history merely distinguished pH 12; extrinsic evidence is important.

⇒ On remand, the federal district court (1:20-cv-110, D.I. 239) construed the term as “a pH of 12.98 or higher” and found the limitation not satisfied.

https://www.finnegan.com/a/web/wZSb7oZT8Kiz2EnxQd2jVd/2024_08_1011a-battle-of-what-a-ph-of-13-or-higher-means_jipa_ck.pdf

IP High Court, 2023 (Gyo-Ke) 10053 [Pellicle Film] <Miyasaka>

Original Ameblo publication: 2025-02-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885143547.html

HP: https://www.takaishihideki.com/single-post/ameblo-12885143547-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12885143547-ja

2023 (Gyo-Ke) 10053 [Pellicle Film] <Miyasaka>

*Rough arguments that the cited reference necessarily satisfies the condition, or that it would ordinarily do so, were rejected.

“Merely because the cited invention … has in-plane orientation … does not justify finding that it necessarily satisfies the RB-at-least-0.4 limitation …. Nor are there specific allegations or evidence identifying … the ordinary conception ….”

⇒ Inventive step: satisfied

(Excerpt from the court's reasoning)

The mere fact that the CNT bundles of Cited Invention 1 have in-plane orientation does not justify finding that they necessarily satisfy the RB-at-least-0.4 limitation. …There are no allegations or evidence specifically identifying the method of manufacturing the thin-film free-standing disordered SWCNT sheet that the defendant says was “manufactured based on an ordinary conception, using SWCNTs having ordinary properties and an ordinarily used process,” or the “film thickness, bundle diameter and self-supporting properties” of that sheet. Accordingly, the nature of the “thin-film free-standing disordered SWCNT sheet considerably more similar to Example 1 than to Comparative Example 1” is also unclear …. On the contrary, …the CNT free-standing films … prepared by the plaintiffs using the method described in Cited Reference 2 had RB values of −0.38 and −0.26 respectively, whereas the CNT free-standing film manufactured when the invention at issue was completed had a value of 1.04. It therefore cannot be said that a thin-film free-standing disordered SWCNT sheet necessarily satisfies the RB-at-least-0.4 limitation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93155.pdf

IP High Court, 2023 (Gyo-Ke) 10104 [Electrical Devices, Mechanical Devices, Computer Devices, and/or Other Devices Formed from Very Low Resistance Materials] <Hibiku Shimizu>

Original Ameblo publication: 2025-02-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885143688.html

HP: https://www.takaishihideki.com/single-post/ameblo-12885143688-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12885143688-ja

2023 (Gyo-Ke) 10104 [Electrical Devices, Mechanical Devices, Computer Devices, and/or Other Devices Formed from Very Low Resistance Materials] <Hibiku Shimizu>

To satisfy the enablement requirement, the specification and other documents must describe that

1) both ELR conductors are in a superconducting state,

and

2) a tunneling current flows through the barrier material.

Such descriptions are necessary!!

⇒ No test results in the specification

⇒ The effect may be something other than superconductivity.

⇒ Enablement requirement: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93330.pdf

Osaka District Court, 2022 (Wa) 9112 and 11173 [Leak-Prevention Sealing Material] <Matsuami>

Original Ameblo publication: 2025-02-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885143862.html

HP: https://www.takaishihideki.com/single-post/ameblo-12885143862-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12885143862-ja

Osaka District Court, 2022 (Wa) 9112 and 11173 [Leak-Prevention Sealing Material] <Matsuami>

*The parameter/numerical value cannot be identified from the accused product. ⇒ Limitation not satisfied

The yarn cross sections reported from the image analysis are irregular and lack a circular or nearly circular shape, and it is difficult to identify anything that could be called a “diameter” from those images. … Satisfaction of claim element 1C cannot be said to have been proved ….

⇒ Limitation not satisfied

(Excerpts from the court's reasoning)

The plaintiff's … measurement involved dripping adhesive onto the sealing material of the defendant's product and allowing it to penetrate; after drying, fixing it with masking tape; placing a metal ruler against the sealing material perpendicular to the alignment direction of the pile yarns; cutting it with a single slice of a razor blade used as a cutting jig along the ruler; imaging the cross section; and analyzing the image to determine the cross-sectional areas of the weft and pile yarns. …

However, …claim element 1C concerns the relative sizes of the yarn “diameters.” Using cross-sectional area to compare yarn thickness is contrary to the unambiguous meaning of the wording and is also inconsistent with the common general technical knowledge of a person skilled in the art discussed above …. …Moreover, looking at the specific measurement means as well, the measurement is performed after processing and destroying the defendant's product, and thus differs in its premise even from what the plaintiff itself calls “measurement in the product state” …. In addition, the cutting method does not guarantee an accurately perpendicular cut relative to the fiber direction, and appears to take no account of changes in cross-sectional area arising from differences in cutting angle or location, raising doubts about control of measurement conditions. In the image analysis as well, it can be seen that the “cross-sectional area” may differ depending on how the outline of the yarn (and its constituent fibers) is identified, whether voids are included, and other factors. …It must therefore be said that neither the image-creation process nor the image analysis ensures accurate and reasonable measurement. Further, the yarn cross sections reported from the image analysis (outlines including voids) are irregular and lack a circular or nearly circular shape, and it is difficult to identify anything that could be called a “diameter” from those images. Accordingly, … satisfaction of claim element 1C cannot be said to have been proved ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93329.pdf

[U.S.] December 2021, CAFC, AstraZeneca v. Mylan

Original Ameblo publication: 2025-02-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885213270.html

[U.S.] December 2021, CAFC, AstraZeneca v. Mylan

*Construction of the claim term “0.001% w/w”: the original judgment construed it as expressed to one significant figure (0.0005%–0.0014%).

⇒ Limitation satisfied

This judgment construed it as “0.00095%–0.00104%,” citing, among other reasons, the prosecution history of narrowing “about 0.0005 to about 0.05% w/w” to “0.001%” and deleting “about.”

⇒ The infringement judgment was vacated and the case remanded. The appellate court did not finally determine noninfringement.

The Claim Scope Indicated by Digits after the Decimal Point Is Strongly Influenced by Intrinsic Evidence — Open Legal Community

IP High Court, 2023 (Gyo-Ke) 10110 [Intraoral OCT with Color Texture (Method)] <Honda>

Original Ameblo publication: 2025-02-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885338026.html

2023 (Gyo-Ke) 10110 [Intraoral OCT with Color Texture (Method)] <Honda>

Because either “with registration or without registration” is necessarily satisfied, the matters defining the claimed invention do not substantially change depending on whether that claim element is present.

*Accused infringers should consider invalidity arguments on the assumption that the claims will be narrowed to the configuration/process of their own products!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93166.pdf

Osaka District Court, 2021 (Wa) 1720 [Battery] <Matsuami> — (Damages) Refusal to produce documents under a document production order

Original Ameblo publication: 2025-02-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885462031.html

Osaka District Court, 2021 (Wa) 1720 [Battery] <Matsuami>

(Damages)

The defendant refused to produce documents pursuant to a document production order.

⇒ This corresponds to the risk, when granting a license, that the patentee cannot ascertain the licensee's accurate sales volumes, profits and the like, and is a factor to be considered in calculating (increasing) the royalty.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93058.pdf

IP High Court, 2023 (Ne) 10101 [Lighting Device] <Shoji>

Original Ameblo publication: 2025-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885745547.html

2023 (Ne) 10101 [Lighting Device] <Shoji>

"[The patentee] argues that the essential part is changing color temperature according to the degree of wakefulness while keeping illuminance substantially constant. However, …the patented invention's contribution cannot be regarded as large compared with the prior art, so …it cannot be generalized to a broader concept …."

⇒ First requirement of the doctrine of equivalents: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93282.pdf

[Unfair Competition] Tokyo District Court, 2022 (Wa) 19400, NHK v. an Individual — “Smash NHK!”

Original Ameblo publication: 2025-02-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885745697.html

[Unfair Competition] 2022 (Wa) 19400, NHK v. an Individual

“Smash NHK!” Along with that slogan, the individual stated that the information at issue would be disseminated unless a meeting with NHK's president took place.

⇒ Intent to publicize the leak of NHK's trade secrets and damage confidence in its trade-secret management system

+The full ¥550,000 in attorney fees for the provisional injunction was awarded!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93076.pdf

[Unfair Competition Prevention Act] Tokyo District Court, 2021 (Wa) 29242 <Kokubu> — “teamLab”

Original Ameblo publication: 2025-02-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885852447.html

[Unfair Competition Prevention Act] 2021 (Wa) 29242 <Kokubu>

Although the indication qualified as a famous indication of goods or business by the time relevant to the judgment, it became famous no earlier than around July 2021, approximately three years after **teamLab** Borderless and teamLab Planets opened.

+The defendant had been using its indications and the like before then.

⇒ Plaintiff lost

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93291.pdf

[Article] Use of Claim Charts in Obtaining and Utilizing Standard-Essential Patents (Kuniyuki Kajita, Intellectual Property Management, 2024)

Original Ameblo publication: 2025-02-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12885969163.html

[Article] Use of Claim Charts in Obtaining and Utilizing Standard-Essential Patents (Kuniyuki Kajita, Intellectual Property Management, Vol. 74, No. 9, 2024)

Filing and obtaining SEP rights

Patent application ⇒ Standardization proposal ⇒ Adoption in the standard ⇒ Aligning the claims

Another company may make a new proposal based on your company's proposal and file an application for it.

⇒ File in a timely manner before making the standardization proposal!!

https://www.jipa.or.jp/official-publication/intellectual-property-management-journal/backnumber/mokuji2409

Tokyo District Court, 2022 (Wa) 11921 [Side Ditch and Catch Basin] <Sugiura>

Original Ameblo publication: 2025-02-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886106866.html

Tokyo District Court, 2022 (Wa) 11921 [Side Ditch and Catch Basin] <Sugiura>

*At the March 2021 meeting, the plaintiff expressed the understanding that this was a contractual issue rather than patent infringement.

Considering the sequence of events, at that meeting the plaintiff gave Litag its consent to Litag's licensing agreement with the defendant retroactively to the date the agreement was concluded.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93295.pdf

IP High Court, 2023 (Gyo-Ke) 10098 [Laundry Detergent Composition] <Shoji>

Original Ameblo publication: 2025-02-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886230241.html

2023 (Gyo-Ke) 10098 [Laundry Detergent Composition] <Shoji>

*The component has low importance; the numerical range has no particular technical significance ⇒ A matter of design choice

“According to the specification, component (G), meaning a ‘surfactant other than component (A),’ was an optional component … and was not highly important.”

(Excerpt from the court's reasoning)

…According to the specification, component (G), meaning a “surfactant other than component (A),” was an optional component and was not highly important. Moreover, as to G-2, G-2′ and G-3 included within component (G) specified in Invention 1, the examples using these components did not achieve superior deodorizing effects compared with the other examples in the deodorizing-effect evaluation at issue. Thus, specifying component (G) by general formula (I) or general formula (II) in Invention 1 is not found to have any particular technical significance. At least, examining the content of the nonionic surfactant (component (G)) within the content range of the invention in Exhibit Ko 1 and setting it at “20–25% by mass” is found to be a matter of design choice for a person skilled in the art.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93047.pdf

Tokyo District Court, 2023 (Wa) 70114 [Brake Control Device] <Shibata>

Original Ameblo publication: 2025-02-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886554890.html

Tokyo District Court, 2023 (Wa) 70114 [Brake Control Device] <Shibata>

Although formula A in the specification can, at first glance, be understood as a calculation, it does not calculate the inclination angle constituting the problem addressed by the invention, and, in the first place, makes no physical sense.

+It cannot be understood that formula A is a typographical error for formula A′.

⇒ Support requirement: not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92866.pdf

IP High Court, 2022 (Gyo-Ke) 10084 [Method for Treating Severe Heart Failure and Pharmaceutical Agent Therefor] <Honda>

Original Ameblo publication: 2025-02-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886898017.html

2022 (Gyo-Ke) 10084 [Method for Treating Severe Heart Failure and Pharmaceutical Agent Therefor] <Honda>

Although treatment methods differ between acute and chronic heart failure and between severe and mild-to-moderate cases, diuretics were widely used for treatment regardless of those distinctions.

A different mechanism of action and pharmacological effect from existing diuretics instead provides motivation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92879.pdf

IP High Court, 2023 (Gyo-Ke) 10086 [Skin-Stimulating Brush] <Miyasaka>

Original Ameblo publication: 2025-02-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886913373.html

2023 (Gyo-Ke) 10086 [Skin-Stimulating Brush] <Miyasaka>

*An inhibiting factor exists ⇒ Inventive step satisfied

"The invention in Exhibit Ko 1 … presupposes that the comb teeth extend and retract smoothly through contact of their bottom ends with the scalp. Configuring sliding sleeve 4 to bend in the radial direction … impedes smooth sliding."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93071.pdf

[Article/Copyright] Comprehensive Implied Consent to Modification and the Right of Integrity (Yukari Hira, Intellectual Property Law and Policy Journal, Vol. 53 (2019))

Original Ameblo publication: 2025-02-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886913483.html

[Article/Copyright] Comprehensive Implied Consent to Modification and the Right of Integrity (Yukari Hira, Intellectual Property Law and Policy Journal, Vol. 53, 2019)

Tokyo District Court, 2016 (Wa) 23604

⇒ Modifications were planned; no objection to modifications; express consent

⇒ Implied “comprehensive consent” recognized!

*Factors considered in the court decisions

Mention of modifications; modifications assumed; tacit acceptance

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2019/03/9d80bfea7f6db2985368e76ce8643da0.pdf

[Article/U.S.] Research on Exceptions to Infringement of U.S. Process Patents (JIPA's 1st International Affairs Committee, Intellectual Property Management, Vol. 74, No. 8, 2024)

Original Ameblo publication: 2025-02-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12886928183.html

[Article/U.S.] Research on Exceptions to Infringement of U.S. Process Patents (JIPA's 1st International Affairs Committee, Intellectual Property Management, Vol. 74, No. 8, 2024)

35 U.S.C. § 271(g)

= Importing into the United States, without authority and during the patent term, a product made by a process patented in the United States constitutes patent infringement.

Exceptions: (1) materially changed by subsequent processes; (2) becomes a trivial and nonessential component of another product.

*Guidance on the “materially changed” exception under § 271(g)(1): the two-phase test

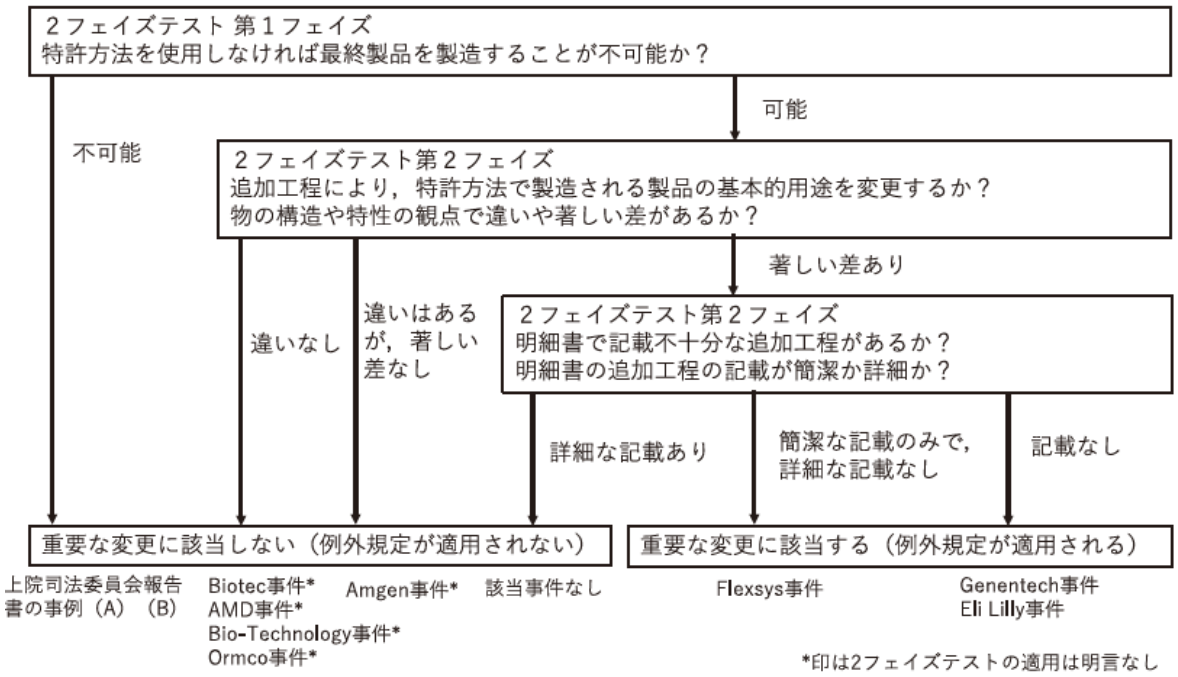


図１　２フェイズテストのガイダンスに沿った重要な変更について判断された事件の分類

English translation of Figure 1 — Classification of Cases Under the Two-Phase Test for Material Change

The figure concerns the “materially changed by subsequent processes” exception in 35 U.S.C. § 271(g)(1).

Phase 1

Is it impossible to manufacture the final product without using the patented process? If manufacture is impossible, the result is “no material change,” and the exception does not apply. If manufacture is possible, proceed to Phase 2.

Phase 2

Does subsequent processing change the basic use of the product made by the patented process? Is there a difference, or a marked difference, in the product's structure or properties?

If there is no difference, or there is a difference but it is not marked, the result is "no material change," and the exception does not apply. If there is a marked difference, continue with the following questions in Phase 2.

Are any additional processing steps insufficiently described in the specification? Is the specification's description of the additional processing steps brief or detailed?

Route in the figure	**Result under the material-change exception**	**Examples and cases classified in the figure**
Phase 1: Manufacture without the patented process is impossible.	No material change; the exception does not apply.	Examples (A) and (B) in the Senate Judiciary Committee Report.
Phase 2: No difference.	No material change; the exception does not apply.	Biotec*; AMD*; Bio-Technology*; Ormco*.
Phase 2: There is a difference, but it is not marked.	No material change; the exception does not apply.	Amgen*.
Phase 2: A marked difference; the additional processing steps are described in detail in the specification.	No material change; the exception does not apply.	No corresponding case.
Phase 2: A marked difference; the specification provides only a brief description, with no detailed description.	Material change; the exception applies.	Flexsys.
Phase 2: A marked difference; no description in the specification.	Material change; the exception applies.	Genentech; Eli Lilly.

* The decision does not expressly state that the two-phase test was applied.

Figure 1: Classification of cases in which material change was assessed according to the guidance of the two-phase test. Source: 1st International Affairs Committee, "Research on Exceptions to Infringement of U.S. Process Patents," Intellectual Property Management, Vol. 74, No. 8 (2024), p. 965.

IP High Court, 2023 (Gyo-Ke) 10016 [Wireless Scuff Plate] <Miyasaka>

Original Ameblo publication: 2025-02-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887008237.html

2023 (Gyo-Ke) 10016 [Wireless Scuff Plate] <Miyasaka>

"…Modifying the invention in Exhibit Ko 1 in this way changes the "Ko 1 battery housing configuration," which is directly connected with solving the problem … so there is no motivation …. …Because there is no … bottom plate …, the abstract point of providing a battery cover from below … does not establish substitutability."

⇒ Inventive step: satisfied

*Whether the invention has a new part that solves a problem compared with the prior art is not a matter to be considered in assessing the support requirement.

⇒ Support requirement: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92607.pdf

[Copyright] IP High Court, 2022 (Ne) 10044 <Honda>

Original Ameblo publication: 2025-02-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887128482.html

[Copyright] 2022 (Ne) 10044 <Honda>

*A screenshot of another person's social-media post was attached. ⇒ This constitutes a “quotation”!!

(1) Fair practice: satisfied (purpose of criticism + ensuring objectivity)

(2) Within the extent justified by the purpose of quotation: satisfied (capturing and sharing images is a commonly used method of sharing information)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91494.pdf

Osaka District Court, 2022 (Wa) 2058 [Floor Opening Cover] <Takemiya> — Only the third requirement under the doctrine of equivalents was not satisfied!!

Original Ameblo publication: 2025-02-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887242987.html

Osaka District Court, 2022 (Wa) 2058 [Floor Opening Cover] <Takemiya>

*Only the third requirement of the doctrine of equivalents was rejected!! (Second requirement satisfied)

(Note) The court stated that, in view of the circumstances of the case, it would examine the second and third requirements (judgment, p. 12, line 16). It found the second requirement satisfied and the third requirement not satisfied, and did not decide the first, fourth or fifth requirements.

"There is no evidence … that would establish that a person skilled in the art could readily replace the 'screw hole' configuration of Invention 1 with the proposed configuration despite the resulting reduction in fastening strength …. Accordingly, the third requirement for infringement by equivalence cannot be recognized."

(Excerpts from the court's reasoning)

Invention 1 produces the functions and effects of preventing level differences and rattling by screwing screws into "screw holes" formed on the rear surface of the cover frame to secure the cover surface plate and cover base plate in close contact. In contrast, in the "cover (flooring specification)," a cover-frame assist screw is tightened into the space formed by combining the cover-frame assist-screw arcuate portion provided in the cover frame of Defendant Product 1 with the corresponding arcuate portion of the back cover, securing the back cover and flooring material in close contact and preventing level differences and rattling. In this respect it produces the same functions and effects as Invention 1, so the second requirement for infringement by equivalence is recognized.

On the other hand, it is understood to be common general technical knowledge that forming the space into which a screw is tightened from a single member achieves stronger screw fastening (fixing force) than forming it from multiple members. There is no sufficient evidence establishing that a person skilled in the art could readily replace the "screw hole" configuration of Invention 1 with the above configuration of Defendant Product 1, even though that replacement would be expected to reduce fastening strength. Accordingly, the third requirement for infringement by equivalence cannot be recognized.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93073.pdf

[Copyrightability (of Photographs)] IP High Court, 2005 (Ne) 10094, “Smell Get Case/Appeal” <Tsukahara>

Original Ameblo publication: 2025-02-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887424323.html

[Copyrightability (of Photographs)] 2005 (Ne) 10094, “Smell Get Case/Appeal” <Tsukahara>

The photographs are copyrightable, but their degree of creativity is extremely low, close to a borderline case.

⇒ Nevertheless, the photographs were copied as they were and posted on the appellee's website, constituting infringement of the reproduction right!!

*Similar to copyright in maps!?

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-32817.pdf



〔スメルゲット事件〕販売商品の写真

[Article/Copyright] A Case Rejecting Copyright Infringement by an Illustration Made with Reference to a Photograph (Bao Miaokun, 2021)

Original Ameblo publication: 2025-02-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887477528.html

[Article/Copyright] A Case Rejecting Copyright Infringement by an Illustration Made with Reference to a Photograph (Bao Miaokun, Intellectual Property Law and Policy Journal, Vol. 60 (2021))

It lacks the essential characteristics (relationship between the subject and light, combination of colors, contrast between the subject and background, etc.).

⇒ Not an adaptation

+Copyrightability of photographs: introduces numerous court decisions with photographs

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2021/09/096165a7406ab415defc9185bed40ded.pdf

[Editorial note: The original article image could not be retrieved.]

[Article] A Case Denying Business Preparations Where the Nature of the Business Had Not Been Determined (Ye Peng, 2022)

Original Ameblo publication: 2025-02-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887605177.html

[Article] A Case Denying Business Preparations Where the Nature of the Business Had Not Been Determined (Ye Peng, Intellectual Property Law and Policy Journal, Vol. 62 (2022))

Numerous decisions have rejected an “intent to practice immediately” where a prototype had been completed but was subsequently improved.

⇒ Some decisions have nevertheless recognized preparation for a business where improvements were made because of defective-product problems!!

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/84916/1/62_06.pdf

Osaka District Court, 1991 (Wa) 585 [Method of Manufacturing Anchors]

Original Ameblo publication: 2025-02-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887859081.html

Osaka District Court, 1991 (Wa) 585 [Method of Manufacturing Anchors]

*The contract was terminated because of defects in prototypes, but repeated improvements led to completion of Product Ha.

⇒ Preparation for a business: established

⇒ Prior-use right: established

“The defendant's method differs in using an eccentric rotary press, but the patented invention … places no limitation on the tool used for caulking … within the same technical concept.”

Osaka District Court judgment of July 11, 1995 (1991 (Wa) No. 585, claim for an injunction against manufacture and sale based on patent rights, etc.)

Prior-use right recognized: yes

Subject: method of manufacturing anchors (patent right)

[Facts]

• April 1977: The defendant was established as a stock company for the purpose of designing, manufacturing and selling various anchors

and related activities.

• Around 1978–1979: As an anchor for foamed concrete, the defendant began manufacturing a type inserted into a drilled hole in foamed concrete,

whose leg portions at the tip spread like an umbrella when a nut is tightened

(trade name “Ever Catch”), and began selling it to Seiwa Shoji Co., Ltd. and others engaged in

selling and brokering industrial fasteners.

• Summer 1983: At the time, among anchors whose leg pieces expand when driven into foamed concrete,

the prevalent type consisted of two or three overlapping leg pieces welded together at their heads. However, their appearance

was not very good, so the defendant's representative considered improvements. Referring to the generally practiced method of pressing metal parts to join them to other

parts, he conceived the idea of making an anchor by pressing the heads of leg pieces inserted into a ring.

To realize this structure,

he asked Kazutaka Yoshida, doing business as Yoshida Ironworks, to bundle three iron leg pieces and make an anchor by

crushing their heads under pressure. Shortly thereafter, Kazutaka Yoshida

bundled three iron leg pieces, interference-fitted a washer (ring) around them, removed the drill from a drill press

(a machine that drills holes in metal and other materials by rotating a drill and pressing down from above),

and replaced it with a head having a recess at its tip. While rotating that head, he pressed the projecting portions of the leg pieces,

plastically deforming them to join the leg pieces to each other and to the ring.

By this method (hereinafter the “prior-use method”), he realized the defendant's representative's idea

and taught it to him. Based on the prior-use method, the defendant ordered dies for the leg pieces from Sanei Ironworks Ltd.

and had subcontractors, including Yasuo Nii, who operated an ironworks, begin manufacturing anchors

(at this stage, Product Ni, with neither support projections nor bulging portions on the leg pieces).

• Second half of 1983: The defendant presented samples of anchors manufactured using the prior-use method to the above Seiwa Shoji Co., Ltd.

and solicited sales. After confirming that the samples were usable in practice,

Seiwa Shoji marketed them to Densan Kogyo Co., Ltd. (current trade name: JEFCOM Co., Ltd.).

Densan Kogyo confirmed their practical usability and decided to purchase them.

An agreement was reached between Seiwa Shoji and the defendant for Seiwa Shoji to purchase the anchors

from the defendant on a continuing basis.

• Around April 1984: To strengthen its production system, the defendant supplied Yoshio Toyoshima, doing business as Toyoshima Ironworks,

with a head, rings and leg pieces like those described above and asked him to process the anchors.

Yoshio Toyoshima accepted.

• April–September 1984: Yoshio Toyoshima processed a total of 2,215 anchors.

• Around May 1984: To finalize the product, Seiwa Shoji requested final manufacturing drawings from the defendant,

and the defendant submitted drawings.

• May 11, 1984: Yoshihiko Kusumi, the person in charge at Seiwa Shoji, approved the final drawings. Shortly thereafter,

Seiwa Shoji ordered 100,000 anchors in each of the three principal sizes,

300,000 in total, from the defendant, with delivery promised three months later. The defendant, however,

was unable to deliver by the deadline, so approximately one month to forty days after that deadline,

Seiwa Shoji terminated the anchor sales contract.

● Filing date: November 29, 1984

• Around the end of 1985: Because the above anchors lacked both bulging portions and support projections and had problems, the defendant made repeated improvements.

Ultimately, it decided to provide support projections on the leg pieces below the desired ring-fixing position,

and made recesses in the die for manufacturing leg pieces with bulging portions to form those support projections. However,

the recesses were placed incorrectly, so in the anchors manufactured with that die (Product I),

the ring was not fixed at the proper position. Another recess was therefore added at the correct position in the die,

forming support projections on the leg pieces where the ring should be fixed (Product Ha). As a result,

anchor manufacture proceeded smoothly, and the defendant began selling anchors on a full scale through Osaka Tohiuke Seisakusho.

Subsequently, the defendant made a new die

and began manufacturing and selling anchors with support projections at the proper ring-fixing position on the leg pieces

(Product Ro).

[Court's reasoning]

“III. Issue 3 (Whether the defendant has a prior-use right in relation to the patent at issue)

1. According to the evidence (Exhibits Otsu 4, 6, 7-1 through 7-16, 8-1 through 8-5, 9 through 12, 15,

18-1 through 18-3, 19 through 24, and 26; witnesses Yoshihiko Kusumi, Kazutaka Yoshida and Yoshio Toyoshima;

and the defendant's representative) and the entire purport of oral argument, the following facts are found.

(1) The defendant is a stock company established in April 1977 for the purpose of designing, manufacturing and selling various anchors and related activities.

From around 1978–1979, it manufactured anchors for foamed concrete that are inserted into a drilled hole in foamed concrete

and whose leg portions at the tip spread like an umbrella when a nut is tightened (trade name “Ever Catch”),

and sold them to Seiwa Shoji Co., Ltd. and others engaged in selling and brokering industrial fasteners.

In 1983, among anchors whose leg pieces expand when driven into foamed concrete,

the prevalent type consisted of two or three overlapping leg pieces welded together at their heads. Their appearance was not very good,

so the defendant's representative was considering improvements. In the summer of that year, referring to the generally practiced method

of pressing metal parts to join them to other parts, he conceived the idea of making anchors

by pressing the heads of leg pieces inserted into a ring. To realize this idea, he asked Kazutaka Yoshida, doing business as Yoshida Ironworks,

to bundle three iron leg pieces and make an anchor by crushing their heads under pressure.

(2) Shortly thereafter, Kazutaka Yoshida bundled three iron leg pieces, interference-fitted a washer (ring) around them,

removed the drill from a drill press (a machine that drills holes in metal and other materials by rotating a drill and pressing down from above),

and replaced it with a head having a recess at its tip. While slowly rotating that head, he used it to press the projecting portions of the leg pieces,

plastically deforming those portions to join the leg pieces to each other and to the ring. By this method (hereinafter the “prior-use method”),

he realized the defendant's representative's idea and taught it to him. Based on the prior-use method, the defendant ordered leg-piece dies from Sanei Ironworks Ltd.

and had subcontractors, including Yasuo Nii, who operated an ironworks, begin manufacturing anchors.

(3) In the second half of 1983, the defendant presented samples of anchors manufactured using the prior-use method to the above Seiwa Shoji Co., Ltd.

and solicited sales. After confirming that the samples were usable in practice, Seiwa Shoji

marketed them to Densan Kogyo Co., Ltd. (current trade name: JEFCOM Co., Ltd.). Densan Kogyo likewise

confirmed their practical usability and decided to purchase them. Consequently, an agreement was reached between Seiwa Shoji

and the defendant for Seiwa Shoji to purchase the anchors from the defendant on a continuing basis.

In response, to strengthen its production system, around April 1984 the defendant also asked Yoshio Toyoshima, doing business as Toyoshima Ironworks,

to process the anchors, providing him with a head, rings and leg pieces like those described above. Judging from the processing quantity and fees,

it was an extremely small job, but Yoshio Toyoshima was impressed by the defendant's representative's enthusiasm and accepted. Yoshio Toyoshima

processed a total of 2,215 anchors from April through September of that year (at ¥3.2 each, totaling ¥7,088)

(the delivery slips issued in Toyoshima Ironworks' name to the defendant [Exhibits Otsu 7-1 through 7-16] were in practice filled out by the defendant's representative

so as not to trouble Yoshio Toyoshima. Further, because the defendant lost the receipts for these processing fees,

around April 1991, when the defendant was to undergo a tax audit, Yoshio Toyoshima reissued them at the defendant's representative's request

[Exhibits Otsu 8-1 through 8-5].).

(4) Seiwa Shoji requested final manufacturing drawings from the defendant to finalize the product.

Around May 1984, the defendant submitted the drawings in Exhibit Otsu 4 (dated April 5 of that year; trade name “Sun Nail”),

and on May 11 Yoshihiko Kusumi, Seiwa Shoji's person in charge, approved them. The drawings show three leg pieces bundled together

to the left (toward the anchor tip) of “C,” apparently the ring, while anchor head E is shown to the right of “C”

(toward the anchor head). E's diameter is larger than the diameter of the three bundled leg pieces,

and the lower left of the drawing states: ‘Pass the head portion “E” through “C” and caulk it.’ (Thus, it can be understood

that three leg pieces are bundled together, a ring fitted around them, and their projecting head portions pressed by caulking and deformed

so that they spread outward.)

Shortly after submission of the final drawings, Seiwa Shoji ordered 100,000 anchors in each of the three principal sizes,

300,000 in total, from the defendant, with delivery promised three months later. However, owing to the circumstances described in (5) below,

the defendant was unable to deliver the anchors by the deadline. Approximately one month to forty days after the deadline,

Seiwa Shoji terminated the anchor sales contract.

(5) Those anchors lacked both bulging portions and support projections immediately below the rings on the leg pieces (Product Ni),

causing problems such as the ring slipping too far down or stopping at an angle after pressing. Even when skilled technicians

carefully took time to manufacture them, twenty to thirty percent were defective.

The defendant therefore asked Kazutaka Yoshida to improve them. He first added bulging portions to the leg pieces to stop the rings there,

but defects still occurred. The defendant then devised a method of narrowing the heads (projecting portions) of the leg pieces and reducing the ring-hole diameter,

thereby creating a step so that the ring would stop where the leg-piece diameter became larger.

However, because the heads were narrow and the allowance for crushing was small, the ring could not be adequately fixed.

(6) In view of these circumstances, the defendant ultimately decided to provide support projections on the leg pieces below the position

where it wished to fix the ring.

(i) First, to save costs, the defendant made recesses for forming support projections in the die used to manufacture the leg pieces with bulging portions described in (5).

However, because the recesses were placed incorrectly, in the anchors manufactured with that die (Product I),

the support projections were located entirely away from the intended ring-fixing position and did not contact the ring. Consequently,

the ring ended up fixed by the bulging portions of the leg pieces.

(ii) To save costs, the defendant then added another recess at the correct position in the die described in (i),

providing support projections where the ring should be fixed on the leg pieces (the leg pieces thus had support projections

at both the correct and incorrect positions: Product Ha). As a result, anchor manufacture proceeded smoothly,

and around the end of 1985 the defendant began selling anchors on a full scale through Osaka Tohiuke Seisakusho.

(iii) Subsequently, the defendant made a new die and began manufacturing and selling anchors with support projections

at the intended ring-fixing position on the leg pieces (Product Ro).

2. (1) According to the facts found in 1 above, in 1983 the prevalent type of anchor whose leg pieces expand

when driven into foamed concrete consisted of two or three bundled leg pieces welded together at their heads. Because their appearance

was not very good, the representative of the defendant, a stock company established to design, manufacture and sell various anchors and conduct related activities,

was considering improvements. In the summer of that year, referring to the generally practiced method of pressing metal parts to join them to other parts,

he conceived the idea of making anchors by pressing the heads of leg pieces inserted into a ring.

To realize that idea, he asked Kazutaka Yoshida, doing business as Yoshida Ironworks, to bundle three iron leg pieces and crush their heads

under pressure to make anchors. Kazutaka Yoshida bundled three iron leg pieces, interference-fitted a washer

(ring) around them, removed the drill from a drill press and replaced it with a head having a recess at its tip,

and, while slowly rotating that head, used it to press the projecting portions of the leg pieces, plastically deforming them

and joining the leg pieces to each other and to the ring. By this method, namely the prior-use method, he realized the defendant's representative's idea

and taught it to him. Accordingly, the fundamental technical concept of the prior-use method—manufacturing anchors by bundling three iron leg pieces,

interference-fitting a ring around them and crushing their projecting portions under pressure—can be said to have been invented by the defendant's representative

without knowledge of the patented invention. Even if completion of the invention required inclusion of the specific pressing method

of removing the drill from a drill press, replacing it with a head having a recess at its tip, and, while slowly rotating that head,

using it to press the projecting portions of the leg pieces, the defendant's representative can be said to have learned that method

from Kazutaka Yoshida.

It is clear that the prior-use method possesses claim element A of the patented invention, ‘fitting a ring around the ends of two or more leg blanks,’

claim element B, ‘caulking those ends to integrate the leg blanks with each other and with the ring, thereby forming the anchor head’

(which, as explained above, means ‘striking or tightening the ends of two or more leg blanks around which a ring has been fitted, using a tool,

to bring the leg blanks and ring into close contact, join and integrate them, and thereby form the anchor head’), and claim element C,

‘a method of manufacturing anchors characterized by the foregoing,’ and falls within the technical scope of the patented invention.

(2) Moreover, since the summer of 1983, before November 29, 1984, the filing date of the patented invention,

the defendant had already been having subcontractors manufacture anchors using the prior-use method (at that stage, Product Ni, namely anchors whose leg pieces

had neither support projections nor bulging portions). Although there is insufficient evidence to find that those anchors were actually sold to others,

in the second half of 1983 the defendant showed samples of anchors manufactured using the prior-use method (Product Ni) to Seiwa Shoji Co., Ltd.,

a preexisting business partner engaged in selling and brokering industrial fasteners, and solicited sales.

It reached an agreement to sell the anchors to that company on a continuing basis. Around May 1984,

at the company's request, it submitted final manufacturing drawings for the anchors and obtained approval. Shortly thereafter,

it received an order for 300,000 anchors with delivery promised three months later. Even after termination of that sales contract, it continued improving the prior-use method,

and around the end of 1985, when Product Ha was completed, it began selling anchors on a full scale through Osaka Tohiuke Seisakusho and others.

Accordingly, at the time of filing of the patented invention, the defendant can be said to have been actually preparing in Japan

at least to conduct a business of manufacturing anchors using the prior-use method and selling anchors manufactured

using that method.

The prior-use method uses, as the machine pressing the leg-piece heads, a drill press whose drill has been removed and replaced

with a head having a recess at its tip, whereas the defendant's method differs in using an eccentric rotary press.

However, a prior-use right extends not only to the form of practice that the prior user was actually preparing

at the time of filing of the patented invention, but also to modified forms of practice within a scope that preserves the identity of the invention embodied therein.

The patented invention places no limitation on the tool used for caulking in claim element B, and it is clear that the method using a punch

shown in the specification (publication, column 2, line 13 through column 4, line 3) is one embodiment. Thus, the defendant's method

must be regarded as merely a modification of the form of practice within the same technical concept as the prior-use method.

Further, Methods I through Ha among the defendant's methods differ from the prior-use method in that the leg pieces used as material have support projections or bulging portions.

However, the entry of support projections 3b, 3b, 3b or bulging portions 3d, 3d into the circular hole of ring 14 is merely

an additional configuration and does not prevent a finding that the method falls within the technical scope of the patented invention, as explained in II.3 above.

Accordingly, these likewise must be regarded as merely modifications of the form of practice

within the same technical concept as the prior-use method.

(3) According to (1) and (2) above, the defendant must be held to have a prior-use right in relation to the patent at issue within the scope

of manufacturing anchors using the defendant's method and selling anchors manufactured using that method.”

https://www.jpo.go.jp/system/patent/gaiyo/senshiyo/document/index/saibanrei.pdf

Sapporo District Court, 2000 (Wa) 407 [Method and Apparatus for Raw Shucking of Bivalves]

Original Ameblo publication: 2025-02-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887859361.html

Sapporo District Court, 2000 (Wa) 407 [Method and Apparatus for Raw Shucking of Bivalves]

*Although the design needed revision after prototype manufacture, preparation for a business was established.

⇒ Prior-use right: established

“Although it differs from Product I in such respects as whether the scallop is positioned horizontally or at an angle, the temperature and spraying time of the warm water sprayed onto the shellfish are substantially identical … and it falls within the technical scope of the patented invention.”

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2022/04/46282a1a111b8c8b275ecab10484142a.pdf

[Article/Trademark] A Functional Examination of the Theory of Trademark Use (2, Final Part) (Takuto Hirasawa, Intellectual Property Law and Policy Journal, 2017)

Original Ameblo publication: 2025-02-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12887985939.html

[Article/Trademark] A Functional Examination of the Theory of Trademark Use (2, Final Part) (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 49 (2017))

*Similarity based on post-sale confusion

Tokyo District Court, January 21, 2003; Tokyo High Court, August 31, 2004, “RISOGRAPH”

Karl Storz Endoscopy-America, Inc. v. Surgical Technologies, Inc., 285 F.3d 848 (9th Cir. 2002)

*Similarity based on confusion among other persons

Cartier v. Aaron Faber Inc., 396 F. Supp. 2d 356 (S.D.N.Y. 2005)

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2017/06/5ec22a603cefe6b8ffe7ffb4b1f647f9.pdf

Osaka District Court, 2022 (Wa) 5553 [Playpen for Infants] <Takemiya>

Original Ameblo publication: 2025-02-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12888104124.html

Osaka District Court, 2022 (Wa) 5553 [Playpen for Infants] <Takemiya>

The plaintiff argues that the screws in the publicly worked product are not used in locations that are routinely removed repeatedly, so removal at the risk of being unable to reassemble it is not contemplated. But the invention as corrected contains no limitation on the manner, frequency or other circumstances of removal.

⇒ Novelty: lacking

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92566.pdf

Tokyo District Court, 2023 (Wa) 70001 — Wastewater Treatment Apparatus (Shibata)

Original Ameblo publication: 2025-03-01

Article type: Case note

Categories: Patents

Topics: Claim interpretation

First published on this website: 2026-10-16

Case information: 2023 (Wa) 70001

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12888273127.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12888273127-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888273127-ja

Tokyo District Court, 2023 (Wa) 70001 — Wastewater Treatment Apparatus (Shibata)

“The means for solving the problem … ‘oxygen supply means for supplying micro-nanobubbles containing oxygen into the second containment tank,’ unlike the supply means for the first containment tank, … does not include supply means that supplies micro-nanobubbles to which ozone has been actively added.”

⇒ The claim limitation was not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92925.pdf

Originally published: 2025-03-01

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12888273127.html

Civil Law — Osaka District Court, 2021 (Wa) 11286 and 2022 (Wa) 9132: No Contractual Nonconformity

Original Ameblo publication: 2025-03-02

Article type: Case note

Categories: Other Japanese law

Topics: Contracts, Contract interpretation

First published on this website: 2026-10-16

Case information: 2021 (Wa) 11286 / 2022 (Wa) 9132

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12888358739.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12888358739-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888358739-ja

Civil Law — Osaka District Court, 2021 (Wa) 11286 and 2022 (Wa) 9132

In response to claims including a claim for compensation for failing to meet the minimum planned purchase quantity, termination and mistake were asserted, but neither was accepted.

The contract did not specify the efficacy of the products, their mechanism of action in the body, the amount of hydrogen generated, or similar matters. These matters could not be found to have been specifically agreed upon as terms of the contract.

⇒ No contractual nonconformity.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92359.pdf

Originally published: 2025-03-02

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12888358739.html

Trademark — IP High Court, 2023 (Gyo-Ke) 10050: “美容医局” (Biyō Ikyoku) (designated services: employment placement and others) (Hibiku Shimizu)

Original Ameblo publication: 2025-03-03

Article type: Case note

Categories: Trademarks

Topics: Well-known and famous marks, Public order and morality

First published on this website: 2026-10-16

Case information: 2023 (Gyo-Ke) 10050

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12888476433.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12888476433-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888476433-ja

Trademark — IP High Court, 2023 (Gyo-Ke) 10050 (Hibiku Shimizu)

The trademark at issue: “美容医局” (Biyō Ikyoku; designated services: employment placement and others).

The relevant consumers are “cosmetic surgeons, cosmetic dermatologists, and persons associated with their medical facilities.”

Physicians with no possibility of changing jobs to cosmetic surgery or cosmetic dermatology are not relevant consumers.

⇒ Well-known status: established.

⇒ Violation of Article 4(1)(x) of the Trademark Act.

“Article 4(1)(vii) of the Trademark Act lists ‘a trademark likely to harm public order or morality’ as one category of trademarks that cannot be registered. This includes not only cases in which the composition of the trademark itself is contrary to public order or morality, but also cases in which, in light of the circumstances of the application for trademark registration, permitting registration would be markedly lacking in social propriety.”

⇒ “Considering also that, even in this litigation, the plaintiff has made the factually incorrect assertion that it did not know of the cited trademark and has proposed transferring the trademark for an extremely high price, it is natural to find that the plaintiff’s motive in applying to register the trademark at issue was to have a company under its control indicate that it would use that trademark to provide services of the same kind as the services at issue, thereby confusing consumers, and to await a protest from the defendant so as to secure a transaction on terms favorable to itself.”

⇒ Violation of Article 4(1)(vii) of the Trademark Act.

(The proposal during the litigation to transfer the trademark for payment was used as one of the reasons!!)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92774.pdf

Originally published: 2025-03-03

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12888476433.html

Design — IP High Court, 2023 (Gyo-Ke) 10113: Violation of Article 5(ii) of the Design Act, the Hermès Case (Miyasaka)

Original Ameblo publication: 2025-03-04

Article type: Case note

Categories: Designs

Topics: Confusion, Well-known and famous marks

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Case information: 2023 (Gyo-Ke) 10113

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888606812-ja

Design — IP High Court, 2023 (Gyo-Ke) 10113 (Miyasaka)

Violation of Article 5(ii) of the Design Act (a design likely to cause confusion with an article pertaining to another person’s business).

① The padlock attached at the upper center of the design has the characteristics of Hermès’ H trademark, Registration No. 5864813, which stylizes the Roman letter “H.”

② The H trademark is famous as an indication of source for Hermès.

③ Hermès uses the H trademark on clasps (cadenas).

https://ipagent.jp/magazine/hatsumei2024.05.pdf

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92792.pdf

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Reference illustrations: the two original image links were unavailable. These illustrations are from the May 2024 Hatsumei article cited in the original post; identity with the missing images has not been confirmed.

https://ipagent.jp/magazine/hatsumei2024.05.pdf



Figure labels: X’s design; X’s padlock (circled).



Figure label: Y’s trademark.

Patents / Employee Inventions — IP High Court, 2022 (Ne) 10018: No “Monopoly Benefit”!! ⇛ Claim (Appeal) Dismissed (Honda)

Original Ameblo publication: 2025-03-05

Article type: Case note

Categories: Patents

Topics: Employee inventions

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Case information: 2022 (Ne) 10018

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888734028-ja

Patents / Employee Inventions — IP High Court, 2022 (Ne) 10018 (Honda)

* No “monopoly benefit”!! ⇒ Claim (appeal) dismissed.

“Even if, as the appellant argues, the solvent fractionation method entails danger and may sometimes cause serious accidents, … it is difficult to find that, through the exclusionary effect of the patent right, the appellee excluded competitors from adopting the dry fractionation method at issue and thereby obtained benefits exceeding those obtainable from working the invention under the non-exclusive license it holds as an employer.

Furthermore, the increase in the appellee’s share of the CBE market after the facility at issue began operating appears to have resulted from the appellee anticipating increased international demand for CBE in light of deregulation and economic trends, establishing a new production facility with FVO as its base, and that facility actually commencing operations. There are no circumstances suggesting that adoption of the dry fractionation method at issue particularly enabled an expansion of market share.

Taking all of the above together, it cannot be found that the appellee obtained excess benefits through exclusive working under the patent beyond the amount of benefits obtainable from working Invention A2 under the non-exclusive license it holds in respect of Patent Right A2. Accordingly, no monopoly benefit from Invention A2 is recognized for the appellee.”

* Working of the invention by a subsidiary

“With regard to Invention A, … a subsidiary of the appellee … is working it. Therefore, … when examining the benefits that the appellee should receive, it is appropriate to examine the matter as equivalent to a case in which the appellee, whose business purpose is management as the holding company of the appellee’s group, … works the invention itself.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92793.pdf

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Trade Secrets — Osaka High Court, 2023 (Ne) 1657: The Secret Was Not “Disclosed” (Morisaki)

Original Ameblo publication: 2025-03-06

Article type: Case note

Categories: Unfair competition law

Topics: Trade secrets

First published on this website: 2026-10-16

Case information: 2023 (Ne) 1657

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12888875693.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12888875693-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888875693-ja

Unfair Competition / Trade Secrets — Osaka High Court, 2023 (Ne) 1657 (Morisaki)

* A trade secret allegedly embodied in experimental equipment cannot be said to have been “disclosed.”

⇒ Claim (appeal) dismissed.

In response to the argument that the trade secret could not be acquired without the appellants’ involvement, the court turned that argument back on them and held that receiving the donation did not constitute having the trade secret “disclosed.”

This can be considered parallel to the patent-law proposition that transfer does not constitute public working where a person skilled in the art cannot readily analyze the invention.

(Excerpt from the decision)

“The appellants argue that the information at issue, which constitutes a trade secret, cannot be analyzed merely by looking at the external appearance of the property at issue and cannot be acquired without the appellants’ involvement, so its non-public nature is maintained. … However, if that is so, even if the appellee received the property as a donation and placed it under its management, that alone would not enable it to learn the information. … There is therefore no room to find the facts alleged by the appellants, namely that, by receiving the property as a donation, the appellee thereby, or on that occasion, had the information constituting the trade secret disclosed to it. The appellants have neither alleged nor proved that, in addition to handing over the property, they disclosed the information to the appellee, and there are no facts suggesting such a disclosure. Moreover, on the appellants’ own arguments, even use of the property for experiments or similar purposes should not enable the appellee thereby to learn the information relating to the structure of the property or other matters. Thus, it cannot be found that the appellee has had the information ‘disclosed’ to it even at the present time.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92747.pdf

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IP High Court, 2023 (Gyo-Ke) 10039 — Laser Processing Apparatus (Miyasaka)

Original Ameblo publication: 2025-03-07

Article type: Case note

Categories: Patents

Topics: Inventive step, Motivation and teaching away

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Case information: 2023 (Gyo-Ke) 10039

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12888984577-ja

IP High Court, 2023 (Gyo-Ke) 10039 — Laser Processing Apparatus (Miyasaka)

“Exhibit Ko 1 does not describe any need to ascertain the position or size of the modified region relative to the principal surface of the processing region. … It merely suggests that, by using an infrared image sensor, reflected infrared light (laser light) is used to adjust focus and image the surface of the workpiece. … Nor can it be found that the existence of such a need was well known or part of common general technical knowledge.”

⇒ Inventive step: affirmed.

* The court held that it was inappropriate for the trial decision, as a reason for denying motivation, to attribute to Features F and G of Invention 1 relating to Difference 1 a technical significance not described in the specification. Nevertheless, the conclusion did not change.

Merely pointing out flaws in the trial decision is insufficient to have it revoked. From the patentee’s perspective, there is no need to defend the trial decision’s reasoning.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92772.pdf

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IP High Court, 2023 (Gyo-Ke) 10055 — Laser Processing Apparatus (Miyasaka)

Original Ameblo publication: 2025-03-08

Article type: Case note

Categories: Patents

Topics: Inventive step, Motivation and teaching away

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Case information: 2023 (Gyo-Ke) 10055

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12889146059-ja

IP High Court, 2023 (Gyo-Ke) 10055 — Laser Processing Apparatus (Miyasaka)

The trial decision stated: “Exhibit Ko 1 has no modified region in the thickness direction of the substrate. Accordingly, there is no need to ascertain the position or size of a modified region in the substrate’s thickness direction, and it cannot be said that a person skilled in the art who encounters Exhibit Ko 1 has a motivation to adopt Feature G relating to Difference 2.” The court held: “Accordingly, Invention Ko 1 has no modified region inside the semiconductor wafer, and it must be said that there is no motivation to configure it to image a modified region that does not exist, that is, to adopt the configuration of Invention 1 at issue relating to Difference 2.”

⇒ Inventive step: affirmed.

* If the “modified region” of the invention at issue is a groundbreaking technical concept absent from the prior art, this is a strong patent. (If a “modified region” had also existed in the prior art, using that prior art as the principal reference might have led to a different conclusion, but this would depend on the other features.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92782.pdf

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IP High Court, 2024 (Ne) 10026 — Thermoplastic Resin Composition: Rounding and Equivalents (Miyasaka)

Original Ameblo publication: 2025-03-09

Article type: Case note

Categories: Patents

Topics: Numerical limitations and parameters, Doctrine of equivalents, Claim interpretation

First published on this website: 2026-10-16

Case information: 2024 (Ne) 10026

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IP High Court, 2024 (Ne) 10026 — Thermoplastic Resin Composition (Miyasaka)

Numerical rounding and the doctrine of equivalents

The issue was whether the ultraviolet absorber contained in the appellee's product, with a molecular weight of 699.91848, satisfied the numerical limitation of a molecular weight of "700 or more."

⇒ Ultimately, because the applicant had "deliberately" drawn the line at the integer "700 or more," a rounding argument could not be used. The fifth requirement of the doctrine of equivalents also failed, because the applicant had objectively and externally acknowledged the exclusion of values below that line from the technical scope.

On this reasoning, if the claim had said "700.0 or more," would a value of 699.95 or more have satisfied it through rounding?

Would it be better to write "7.00 × 10^2 or more" to make clear that the number has three significant digits, rather than being an integer? Certainly, patents are not exactly the same as science: this is a matter of construing the wording of the claims. A neatly rounded "700" may therefore not be the same as "7.00 × 10^2 or more."

The molecular weight of the specific compound at issue was calculated from its structural formula; this was not a case involving variability in a measured value. The case may therefore have been less suited to a rounding argument.

Because the numerical limitation failed the fifth requirement for equivalence in this case, a rounding argument, as in earlier cases, may still offer a better prospect than equivalence for numerical limitations.

That said, considering predictability for third parties, patents do not permit either rounding or equivalents to be interpreted as flexibly as in science. The conclusion of this judgment may therefore be appropriate.

* This resonates with Osaka District Court, 2002 (Wa) 10511, which, in rejecting a measurement-error argument, held: "Quite apart from the number of significant digits, where '3 microns' is claimed as the upper limit of the technical scope on the basis of the examples, it is questionable to regard the maximum range of error in the examples as falling within the scope of the right. This is because, if there is an error of 0.5 microns in the examples, the claims could state an upper limit covering that error, namely 'less than 3.5 microns.' Yet, without doing so, to state the upper limit in the claims as '3 microns' while asserting that 'less than 3.5 microns' is the technical scope would impair the clarity of the claims."

… Of course, it only becomes apparent upon reading the judgment that this should have been done, so it is harsh on the patentee in that particular case. Nevertheless, we practitioners should draft claims for future applications with this judgment in mind.

★ Conclusion: "Numerical values (ranges) in science differ from numerical values (ranges) in patents!!"

(Excerpts from the judgment in 2024 (Ne) 10026)

① Literal satisfaction (rounding argument) ⇒ Not satisfied

“The numerical range of ‘700 or more’ (for the molecular weight of the ultraviolet absorber) at issue here was set by the right holder (applicant) itself to define the scope of its rights. It is nothing other than a boundary dividing, by a single line, what falls within the technical scope of the patented invention (the scope of the monopoly) from what does not. Accordingly, ‘700,’ the lower limit of that range, should be construed as an integer in its original sense, with neither a fractional part that has been rounded down nor a fractional part that has been rounded up. If a different meaning or role is intended for the numerical range, the claims or specification should explain the method of calculating molecular weight, the treatment of decimal values, and similar matters. As stated above, the specification and other documents at issue contain no such description. Consequently, the claim limitation ‘a molecular weight of 700 or more’ must be construed as not being satisfied (i.e., as not falling within the technical scope) if the molecular weight is below 700 by even 0.00001.”

② Doctrine of equivalents: first requirement satisfied, but fifth requirement not satisfied

“The numerical range has no critical significance. The molecular weight having technical significance in relation to the functions and effects of the inventions at issue is considered to extend across a fairly broad range, rather than being precisely 700. It is therefore understood that the numerical limitation of ‘700 or more’ was adopted as, so to speak, a ‘round number.’ … It is difficult to consider that the properties as an ultraviolet absorber differ substantially between a molecular weight of 699.91848 and one of 700. … Accordingly, the difference in molecular weight cannot be regarded as relating to an essential part of the inventions at issue. The first requirement of the doctrine of equivalents is satisfied in this case.”

“The integer value ‘700 or more’ was deliberately used. In this case, no critical significance is recognized in the molecular-weight value of 700. That value can therefore be said to have been selected and set, so to speak, arbitrarily by the appellant. Furthermore, although it is construed that the appellant could easily have set the numerical range as ‘699.5 or more’ or specified how decimal values of molecular weight were to be treated, it deliberately took neither measure. This should be construed as presupposing not only an understanding that decimal values are not technically meaningful numbers, but also that they have no particular legal implications (are not given any special meaning). Thus, by specifying in the claims the molecular-weight range of ‘700 or more,’ the appellant defined the technical scope of the patented invention by the dividing line between ‘700 or more’ and ‘less than 700.’ It is appropriate to find that the appellant objectively and externally acknowledged that substances with molecular weights even slightly below the lower limit of ‘700’ were excluded from the technical scope. … Accordingly, in this case, the fifth requirement of the doctrine of equivalents is not satisfied, and infringement under the doctrine of equivalents as alleged by the appellant is not established.”

* The first-instance judgment, Osaka District Court, 2022 (Wa) 9521, had also rejected the first requirement of the doctrine of equivalents, holding that “where setting a numerical value has significance for the invention, absent special circumstances, the limitation of the technical scope by that numerical value constitutes an essential part of the patented invention.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93860.pdf

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IP High Court, 2023 (Gyo-Ke) 10085 — Image Forming Apparatus (Miyasaka)

Original Ameblo publication: 2025-03-10

Article type: Case note

Categories: Patents

Topics: Divisional applications, Patent corrections

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Case information: 2023 (Gyo-Ke) 10085

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IP High Court, 2023 (Gyo-Ke) 10085 — Image Forming Apparatus (Miyasaka)

* Even if a defect in the divisional procedure for a patent application has been overlooked, a “correction” to clarify an ambiguous statement cannot be made to cure it.

If a defect in an amendment or division is overlooked and the patent is registered, the situation may become irreparable!!

There have also been cases in which a violation of the amendment requirements was overlooked and registration took place, breaking the chain of divisional applications. (Osaka High Court, 2002 (Ne) 2776 (Wakabayashi); Tokyo High Court, 2003 (Gyo-Ke) 65 (Shinohara).)

Pair a challenging amendment or divisional application with a safe sibling divisional application!!

(Excerpt from the decision)

“The plaintiffs argue that, because the patent application at issue has a procedural defect in the divisional application, a correction to cure that defect falls within clarification of an ambiguous statement under item (iii) of that paragraph. This argument is understood as follows: ① although the statements in the specification and other documents at the time of registration at issue were within the scope of the statements in the original specification and other documents of the parent application, they were not within the scope of the matters stated in the specification and other documents immediately before division, which had been amended by the time of the patent application at issue; ② as a result, the requirements for a divisional application were not satisfied, but a decision to grant a patent was made without attention being drawn to the problem through a notice of reasons for refusal, leaving the patent at issue defective; and ③ the substantive content of the correction matters being examined is to eliminate that defect by correcting the statements in the specification and other documents at issue from content corresponding to the original specification and other documents of the parent application to content corresponding to the subsequently amended specification and other documents immediately before division. However, ‘the description’ or ‘drawings’ attached to the application as referred to in Article 126(1) of the Patent Act should be understood as the patent specification and drawings at the time of the request for a trial for correction. Accordingly, whether the requirements concerning the purpose of correction under items (ii) and (iii) of that paragraph are satisfied should be determined by comparing the specification and other documents at the time of the request for a trial for correction with those after correction. This is clear both from the wording of the provision and from its purpose (see (2) above). Even if circumstances ①–③ above are found in this case, the defect in the divisional procedure in the relationship between the application specification and other documents immediately before division and the specification and other documents at the time of registration at issue is an issue concerning the application of Article 44 of the Act. That in itself does not

mean that the specification and other documents at the time of registration, which are the subject of correction, themselves contain an ambiguous statement (Article 126(1)(iii) of the Act), nor does it constitute an error or incorrect translation under item (ii) of that paragraph. Even assuming that a defect in the divisional procedure for the patent application at issue was overlooked, the plaintiffs' argument must be regarded as equivalent to seeking to redo the divisional application under the guise of correcting the specification and other documents. No basis can be found to justify this."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92813.pdf

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English translation of the source figure | 1/2

Image Forming Apparatus — Divisional Applications

Tokyo District Court, 2019 (Wa) 23164 (Tanaka)
Cf. IP High Court, 2020 (Gyo-Ke) 10313 (Otaka)

If the child application violates the divisional requirements, the grandchild's filing date goes back only to the child's actual filing date, not to the parent's filing date.
Same approach: Osaka High Court, 2002 (Ne) 2776; Tokyo High Court, 2003 (Gyo-Ke) 65.

Additional statements in the specification constitute added matter — since the Artificial Nipple case, 2002 (Gyo-Ke) 539!?

“Comparing the specification and other documents of Application 1 at the time Application 2 was filed as a divisional … with those of Application 2 (the specification at division …), the latter adds, for example: a statement about retaining processing conditions after power is switched off through the designated-retention instruction unit and displaying them on the initially displayed screen on subsequent occasions (paragraph [0100]); a statement about reducing the number of settings for magnification, a frequently used processing condition, and the number of menu settings through ‘one up’ and ‘one down’ magnification indications (paragraph [0105]); a statement about preventing erroneous instructions caused by easy menu changes by providing means to lock registered menus against alteration (paragraph [0145]); and Figures 7–15 and related statements (paragraph [0041] …). It differs from the specification at the decision on Application 1 and contains matters absent from that specification, so it cannot be said to fall within the scope of the matters stated there. … Application 2 therefore … fails divisional requirement ②. …”
⇒ Lack of inventive step based on a cited invention arising after the parent's filing date and before the child's.

Partial priority may exist when priority is claimed, but additional specification text on division is all disadvantage and no advantage.
(If disclosed in the original specification and other documents, addition is unnecessary; if not disclosed, it is added matter.)

Source: Hideki Takaishi, Ameblo, March 2025

Parent–Child–Grandchild Applications: Retroactive Effects

⑤ IP High Court, 2016 (Gyo-Ke) 10263
“The substantive requirements for a lawful divisional application are: ① the original application's specification or drawings contained two or more inventions; ② the invention in the new application is part of the inventions stated in the original application's specification or drawings; and ③ the invention in the new application falls within the matters stated in the original application's initial specification and other documents. The application at issue is a fifth-generation divisional counted from the first application. To be deemed filed at the time of the first application, this application and the fourth, third, and second applications must each satisfy requirements ①–③ above in relation to their respective parent applications, and the invention must fall within the matters stated in the initial specification and other documents of the first application.”
Same approach: ① Osaka High Court, 2002 (Ne) 2776; ② Tokyo High Court, 2003 (Gyo-Ke) 65.

Even if lawful when the child is filed, amending the child after filing can, by the amendment's retroactive effect, cause the child to violate the divisional requirements!!
⇒ The grandchild's filing date goes back only to the child's filing date!!

① Osaka High Court, 2002 (Ne) 2776 (Wakabayashi)
② Tokyo High Court, 2003 (Gyo-Ke) 65 (Shinohara)
If the amended text adds matter, the divisional requirements are violated.
③ IP High Court, 2004 (Gyo-Ke) 14649 (Shitara)

If amendment cures the divisional defect (change of gist), the violation is avoided.
④ Tokyo High Court, 1975 (Gyo-Ke) 75

Divisional requirements = amendment requirements.
⑧ Tokyo District Court, 2003 (Wa) 9215 (Mimura)

Timeline: parent's filing date → child's filing date → amendment of child → grandchild's filing date. The amendment has retroactive effect.

“Because all claims were deleted by correction, the utility model registration at issue is deemed never to have existed.”
⑥ Tokyo High Court, 2001 (Gyo-Ke) 421 (Yamashita)

Even if the child is withdrawn, the grandchild's filing date goes back to the parent's.
⑦ Tokyo District Court, 2015 (Wa) 8517, Levee-Coating Machine (Shimasue)
⇒ In that case there was no divisional defect before withdrawal.
(Withdrawal has no retroactive effect except under Article 39(5) of the Patent Act: 1989 (Gyo-U) 123.)

If refusal or invalidity becomes final while a divisional application still contains added matter, the grandchild's filing date does not go back to the parent's.
⇒ Even if it will end in refusal, one should attempt an amendment eliminating the added matter!!

Source: Hideki Takaishi, Ameblo, March 2025

Trademark — IP High Court, 2023 (Ne) 10091: “Gendai no Riron” (Miyasaka)

Original Ameblo publication: 2025-03-11

Article type: Case note

Categories: Trademarks

Topics: Abuse of rights, Trademark use

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Case information: 2023 (Ne) 10091

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12889488165-ja

Trademark — IP High Court, 2023 (Ne) 10091: “Gendai no Riron” (Miyasaka)

* No abuse of rights. Ultimately, the defendant nonprofit organization’s failure to register the trademark was the reason it lost.

As a member of the “Gendai no Riron Editorial Committee,” the plaintiff has published an electronic edition of “Gendai no Riron” since 2014.

The defendant has published the magazine “Gendai no Riron” since June 2016.

The defendants argued that, as soon as the defendant announced in February 2016 that it would resume publication of the magazine “Gendai no Riron,” the plaintiff obtained Trademark Right 1 with Class 9 “electronic publications” and Class 16 “printed matter” as the designated goods.

The defendants further pointed out that, on March 24, 2021, a trial decision became final revoking, on grounds of non-use, the registration for Class 16 “printed matter” among the designated goods of Trademark 1. Soon afterward, however, on September 6, 2021, the first-instance plaintiff applied to register Trademark 2 with Class 16 “printed matter” as the designated goods, obtained registration, and filed this lawsuit.

⇒ The defendants’ use of their respective signs on printed matter can, at a minimum, be regarded as use on goods similar to Class 9 “electronic publications,” which are designated goods of Trademark 1. Thus, even if the plaintiff has no plans to publish “Gendai no Riron” as “printed matter,” such as a magazine, it can seek an injunction against the first-instance defendants’ acts on the basis of its trademark right designating “electronic publications.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92814.pdf

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Tokyo District Court, 2024 (Yo) 30029 — Age-Related Macular Degeneration (Nakashima, Civil Division 40)

Original Ameblo publication: 2025-03-12

Article type: Case note

Categories: Patents, Unfair competition law

Topics: Claim interpretation, Novelty, Patent linkage, False allegations, Injunctions

First published on this website: 2026-10-16

Case information: 2024 (Yo) 30029

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12889616530-ja

Tokyo District Court, 2024 (Yo) 30029 — Age-Related Macular Degeneration (Nakashima, Civil Division 40)

★ Application for a provisional injunction based on violation of the Unfair Competition Prevention Act: a case denying patent infringement by finding that the medical-use invention was not worked under an “exclusively” standard and that, on the patentee’s argument that a certain proportion sufficed, novelty would be lacking.

* However, the word “exclusively” does not mean 100%.

1. The court’s reasoning ①: infringement of a use invention

As set out below, the court denied patent infringement. It found non-satisfaction under an “exclusively” standard for working a medical-use invention: “working” under Article 2(3) of the Patent Act satisfies the use limitation when production, use, transfer, or similar acts are performed exclusively for the medical use specified in the claims (in this invention, for administration to the specified patient group). It also held that, on the patentee’s argument that a certain proportion sufficed, the invention lacked novelty.

“A use invention is technically characterized by discovering an unknown property of a known substance and, on the basis of that property, creating a novel use with a remarkable effect. Accordingly, ‘working’ under Article 2(3) of the Patent Act in relation to a use invention should be construed as producing, using, transferring, or otherwise dealing with a known substance exclusively for use in the novel use. Applying this to the invention at issue, the claims and the specification ([0005], [0006], and [0018]) show that anti-VEGF agents, which are known substances, were conventionally recognized as effective for wAMD patients having predominantly classic active subfoveal CNV regions occupying at least 50% of the total lesion size (pCNVwAMD patients). The invention at issue is characterized by creating a novel use with a remarkable effect through administration to wAMD patients who meet certain inclusion and exclusion criteria and have an active CNV lesion size of less than 50% of the total lesion size (sCNVwAMD patients; also referred to below as ‘the specified patient group’), based on the discovery of the unknown property of anti-VEGF agents that they exhibit a superior therapeutic effect in those patients compared with pCNVwAMD patients. Accordingly, ‘working’ under Article 2(3) of the Patent Act for this invention should be construed as producing, using, transferring, or otherwise dealing with an anti-VEGF agent exclusively for administration to the specified patient group. …

Turning to the creditor’s product in this case, according to the underlying facts, the creditor’s product is a biosimilar of the debtor’s product. The proposed package insert for the creditor’s product submitted with the approval application at issue merely states ‘age-related macular degeneration with subfoveal choroidal neovascularization’ as the indication. Neither the ‘Indications or Effects’ section nor the ‘Dosage and

Administration' section contains any reference to the specified patient group, and no statement can be found to the effect that administration to that group produces a remarkable effect. On these findings, the approval application for the creditor's product cannot be said to be an application for administration to the patient group defined by Claim Limitations A2, B, and C of the invention (the specified patient group). The position might be different if special circumstances established a likelihood that the creditor would deliberately sell or otherwise deal with its product for a use different from that in the approval application. However, even all of the prima facie evidentiary materials in this case are insufficient to clearly establish such special circumstances. In these circumstances, manufacture and sale or similar acts concerning the creditor's product cannot be regarded as producing, using, transferring, or otherwise dealing with an anti-VEGF agent exclusively for administration to the specified patient group, and are insufficient to establish infringement of the patent right at issue.

Moreover, even if one were to adopt the debtor's view that manufacture and sale or similar acts concerning the creditor's product infringe the patent because the product may ultimately be administered to a certain proportion of the specified patient group, the underlying facts show that the creditor's product is a biosimilar of the debtor's product, has equivalence and similarity in quality to it, and that the debtor's product had been manufactured and sold before the priority date at issue. Therefore, like the creditor's product, the debtor's product must also be found to have been administered to a certain proportion of the specified patient group. It is thus self-evident that manufacture and sale of the debtor's product constitutes public working under Article 29(1)(ii) of the Patent Act and that the patent at issue should be invalidated."

2. The court's reasoning ②: the Unfair Competition Prevention Act / communication of false facts

The court found that the patentee's act of responding to the Ministry of Health, Labour and Welfare and others that "manufacturing and selling a biosimilar of the debtor's product would infringe this patent" (the communication at issue) constituted communication of false facts. However, as set out below, it held that this violates the Unfair Competition Prevention Act only "where there are special circumstances in which the act is found to be markedly inappropriate in light of the purpose and objectives of patent linkage." It did not find a violation in this case.

"If, under patent linkage, a response by the aforementioned patentees or others stating that there is a patent conflict between a patent relating to an originator drug and a generic drug were immediately unlawful as communication of false facts whenever it differed from a subsequently final court determination, those patentees or others would be unable to fully state their own views on the existence of a patent conflict in the pharmaceutical patent information reporting form. The Ministry of Health, Labour and Welfare and others would consequently be unable to accurately determine whether a stable supply of the generic drug could be ensured, potentially undermining the purpose and objectives of patent linkage. However, patent linkage is intended, from the perspective of ensuring a stable supply of generic drugs, to confirm during approval review whether there is a patent conflict between a patent relating to an originator drug and a generic drug. It is therefore clear that it does not permit patentees or others relating to originator drugs to provide arbitrary information or grant them broad immunity. Accordingly, where a false response under patent linkage by a patentee or other person relating to an originator drug, stating that there is such a patent conflict, outwardly takes the form of information provision under patent linkage but in substance seeks to place the applicant for manufacturing and marketing approval of the generic drug at a disadvantage and to secure a competitive advantage for the respondent, it is appropriate, in light of the above purpose and objectives of Article 2(1)(xxi) of the Unfair Competition Prevention Act, to regard that act as a category of unfair competition obstructing fair competition among businesses. From this perspective, a false response by a patentee or other person relating to an originator drug under patent linkage, stating that there is a patent conflict between the patent relating to the originator drug and a generic drug, should be regarded as unfair competition under Article 2(1)(xxi) where special circumstances establish that it is markedly inappropriate in light of the purpose and objectives of patent linkage, because it communicates false facts damaging the

business reputation of a competing applicant for manufacturing and marketing approval of the generic drug."

3. Some observations

(1) Definition of a "use invention"

First, a "use invention" must be defined as the basis for discussion. Having comprehensively examined Japanese patent judgments, I consider that inventions for which there is no infringement unless manufacture and sale expressly present the relevant "use" are cases where the structural features of the product alone, excluding the "for …" use limitation, lack novelty or inventive step, and novelty or inventive step is recognized only through specification of the "for …" use.

This decision states: "A use invention is technically characterized by discovering an unknown property of a known substance and, on the basis of that property, creating a novel use with a remarkable effect." It thus defines a "use invention" as an invention whose product features alone, excluding the use limitation, lack novelty. This is a case in which novelty or inventive step is recognized only through specification of the use, and falls within the above category in which manufacture and sale do not infringe unless the "use" is expressly presented.

(2) Technical scope of a "(medical) use invention" specifying the recipients of administration

For a medical-use invention limiting the recipients of administration, under this decision's "exclusively" standard, the use limitation would apparently not be satisfied unless the product is manufactured and sold with labeling, promotion, or similar representations indicating that the recipients are persons "aged 60 or older," persons "who have not had a recurrence of breast cancer," or persons "who have not developed allergic asthma."

Moreover, Patent No. 5705483, whose novelty was recognized in IP High Court, 2018 (Gyo-Ke) 10036, concerns an invention specifying a newly discovered mechanism as an invention-defining feature, a recent hot topic. Its claim reads: "A composition comprising an antagonist of interleukin-23 (IL-23), for use in an in vivo treatment method for inhibiting interleukin-17 (IL-17) production by T cells." Since this too appears to be a use invention, the analysis would be that the limitation is satisfied when it is sold or otherwise dealt with "to inhibit IL-17 production"; in other words, it would not be satisfied unless the product is manufactured and sold with labeling or promotion indicating that the recipients are "patients showing elevated IL-17 levels."

(3) Comparison with the "knowing" requirement for indirect infringement involving multifunctional products (the 25% rule)

The "knowing" requirement for indirect infringement involving multifunctional products (Article 101(ii) and (v) of the Patent Act) concerns producing, transferring or otherwise dealing in an item while knowing that the invention is patented and that the item will be used in working that invention. As in the cases reproduced below, it is held to be satisfied where the indirect infringer knows that persons within a "range that cannot be regarded as exceptional" use it to produce directly infringing products. (This appears to draw on the standard adopted in the Supreme Court decision of December 19, 2011, Keishū Vol. 65, No. 9, p. 1380, the Winny case.) Three decisions have treated approximately "25%" as satisfying a "range that cannot be regarded as exceptional." (The Supreme Court's Winny decision, however, denied intent and upheld the acquittal entered by the court below, holding that "it cannot be found that the defendant recognized and accepted that the proportion of users using it for copyright infringement had … extended to a range that could not be regarded as exceptional, such as approximately 40%." In civil proceedings, an injunction may be available for conduct after the defendant acquires the requisite knowledge, for example through service of the complaint, provided that the other requirements are also met.)

For use inventions, there is also a view that working of the invention is not limited to sales expressly presenting the use through labeling or promotion, but can arise from "the possibility that the product will

ultimately be administered to a certain proportion of the specified patient group.” The patentee advanced that argument in this case as well. If that view is assumed, an unresolved issue was what percentage of the products sold the seller must know will be used for the patented use before infringement arises: 100%, 99%, or a “range that cannot be regarded as exceptional” (approximately 25%?).

By contrast, this decision established an “exclusively” standard. If “exclusively” were interpreted quantitatively as 100%, even 1% use for another purpose would defeat the limitation. The decision, however, did not adopt such a numerical threshold. So-called off-label use—use of a drug for an indication or in a manner different from those approved, that is, use not stated in the labeling (package insert)—would thus appear not to infringe a use invention, unless there are circumstances such as promotion of that off-label use. (Nevertheless, “exclusively” does not mean 100%, so the proportion or amount “used for a use other than that of the use invention” that leads to non-satisfaction remains an unresolved issue.)

As to whether such a conclusion is appropriate, this decision holds that a ground for invalidity based on lack of novelty would exist if one “adopted the debtor’s view that manufacture and sale or similar acts concerning the creditor’s product infringe the patent because the product may ultimately be administered to a certain proportion of the specified patient group.”

However, on this approach, not only medical-use inventions but also selection inventions limiting the range of products to those with particularly high effects may face denial of novelty where the selected range had already been worked before filing, because they are not use inventions. Such an approach is not unreasonable, but it does not necessarily align with past practice in every respect. Further examination is therefore needed to seek a consistent understanding.

Furthermore, where inventive step is recognized because of an unpredictable remarkable effect, a question has been raised: does infringement arise only where the product is sold or otherwise dealt with while expressly presenting that effect, as with a so-called use invention, or does infringement arise irrespective of whether that effect is expressly presented? (Misao Shimizu, Hyakusen of Patent Cases, 5th ed., Case 69, “Inventive Step (5)—The Independent-Requirement Theory of Remarkable Effects [Shoe Press Belt Case].”)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93519.pdf

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米国の誘引侵害・寄与侵害等に関するＣＡＦＣ判決

2016.12 CAFC (843 F.3d 1315) Power Integrations v. Fairchild Semiconductor	誘引侵害には、＜１＞誘引者と直接侵害者（被誘引者）との間で意思疎通（successful communication）が必要である。＋＜２＞特許権侵害行為を放置するという不作為では足りず、第三者（直接侵害者（被誘引者））の実施行為に影響を与える積極的な行為（Affirmative act）が必要である。 ⇒米国にテクニカルサポートセンターを設置したことに加え、顧客が米国販売代理店を見つけることを可能にし、標準約款で米国特許の侵害に対するクレームから顧客を補償していた。⇒米国市場をターゲットとしたものであり、誘引侵害成立。271(b)	★
2018.11 CAFC (909 F.3d 398) Enplas Display v. Seoul Semiconductor	米国外でレンズ販売⇒照明装置に係る米国特許の誘引侵害成立。271(b) 被疑侵害者の世界市場シェアが５０％を有しており、被疑侵害者の顧客が米国でも最終製品（テレビ）を販売していることを知っていた以上、「specific intent to induce infringement」を認めた。	★
2015.05 CAFC (785 F.3d 625) Takeda v. West-Ward Pharm ⇒誘引侵害不成立 271(b)	被疑侵害者（製薬メーカー）が被疑侵害医薬品の侵害用途を知っていたとしても、そのラベルが曖昧で（vague）、必然的に医師が特許発明の用途で処方するわけではない場合には、誘引侵害の意図は認められない。271(b) Arthrocare v. Smith&Nephew 406 F.3d 1365 (Fed. Cir. 2005)事件では、ラベルが特許権侵害を「必然的に導く(necessarily lead)」ものであったから、事案が異なる。（一般論はその後も同じ。Sanofi v. Watson 875 F.3d 636 (Fed. Cir. 2017)）	★
2010.11 CAFC (633 F.3d 1042) AstraZeneca v. Apotex	特許発明は１日１回の処方。被告が承認を得たラベルには１日２回の処方と記載されていたが、喘息が安定したら服用量を徐々に減らすことが推奨されていた。被告医薬品は濃度 0.25mg と 0.5mg しかなかった。医師や患者がラベルの推奨通り服用量を減らすと１日１回服用する者も現れる。⇒治療方法の特許発明の誘引侵害成立。271(b) ⇒一定割合の直接侵害者を「necessarily lead」すれば足り、100%侵害用途で使われることは要件でない。何％で誘引侵害？	★
1998.08 CAFC (152 F.3d 1342) Johns Hopkins University v. Cellpro	医療機器の宣伝・広告で、誘引侵害成立。271(b) ⇒特許発明を知りながら、被告機器を使えば特許発明の純化率を実現できると唱っていた。 ≒CAFC 2020.10 Glaxosmithkline v. Teva（ラベルに特許用途が明記されていなかったが、同等品であると記載されていた。） ＝日本の知財高判平成 17 年(ネ)第 10125 号【シロスタゾール事件（職務発明の対価請求訴訟）】＜佐藤＞	○
2003.01 CAFC（316 F.3d 1348） Warner-Lambert v. Apotex	先行特許存続期間満了後の用途で FDA 承認（部分発作性てんかん）を得た後発品の一部が、特許の用途（神経変性疾患）に使われていた。⇒ＡＮＤＡ申請につき、271(e)(2)の特許権侵害不成立 ＜傍論＞特許発明用途の OFF LABEL USE に 2.1%（5000 万ドル）使われても、誘引侵害不成立。271(b) ⇒特に、製品に非侵害用途が相当程度ある場合、被告がその製品の一部のユーザーが特許を侵害している可能性があることを実際に知っていたとしても、侵害を誘引する意図（intent）を推論することはできない。gabapentin のように、ある製品に多くの用途があり、侵害する用途に用いられる製品販売が 46 件に 1 件以下である場合は、直接的な証拠がない限り、Apotex 社の意図（intent）を推論することも推論しないこともできない。	★ ★ ★
2003.03 CAFC（324 F.3d 1322） Allergan v. Alcon	特許発明とは別用途で FDA 承認（眼圧低下）を得た後発品の一部が、特許の用途（緑内障患者における神経保護効果）に使われていた。⇒ＡＮＤＡ申請につき、271(e)(2)の特許権侵害不成立 Warner-Lambert の先例に基づき、FDA に特許発明の用途で承認を求めていないことから、被告 Alcon 有利な略式判決。（多数意見は 271(b)の誘引侵害を検討していない。271(e)(2)をクリアしても、ANDA 承認後 271(b)が更に争われる。）	△
2024.10 CAFC Provisur Tech v. Weber	対象製品の設定変更により発明の技術的範囲に属する場合、理論上の可能性のみでは侵害とならず、現実に容易に構成可能（readily configurable）である必要がある。=Fantasy Sports Props. v. Sportsline.com, 287 F.3d 1108 (Fed. Cir. 2002). ⇒claim14 の機能（advance to fill）を有効化する設定画面への顧客のアクセスが制限されていた。侵害認容の地裁判決取消	★

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2010.11 CAFC（626 F.3d 1197） Finjan v. Secure Computing	記録媒体である製品に組み込まれたプロアクティブスキャン用のソフトウェアがロックされていた。 ①ユーザが鍵を購入すればロック解除できるから、物の発明は直接侵害成立。＜ACCO v. ABA, 501 F.3d 1307 (Fed Cir. 2007)の事案では問題となった特許の請求項が特定の構成（例：ロック装置のピンが所定のスロットに配置される）を要求しており、実際に侵害モードで使用されなければ直接侵害と認められないのに対し、Finjan の請求項は、プロアクティブスキャン機能が実行されるために特定の構成や「有効化」を要求しないから、その機能を実行するためのプログラムが存在していれば侵害と認めた。＞ ②方法の発明は、現実の実施が無いから非侵害。＜=Southwest Software v. Harlequin, 226 F.3f 1280 (Fed. Cir. 2000)＞	★

医薬用途発明に関する関連重要裁判例

令和４年 (行ケ) 第 10084 号 ＜本多＞	重症心不全の治療剤 *対象患者の相違点と用法容量の相違点を別個の相違点として容易想到性判断 OK *患者を限定したが、公知医薬も当該患者にも投与されていたから、容易想到	治療薬の用量を検討するに際しては、対象患者や治療の相違は当然に考慮に入れるべきものであり、治療薬に係る特許発明と引用発明の相違点を認定するに際し、対象患者や治療について相違点を認定したときに、用量についてこれら対象患者や治療を含めた相違点として重ねて認定する必要はないというべきである。したがって、本件審決が、前記の相違点１と区別して、トルバプタンの１日当たりの用量の点のみを相違点２として認定したことに誤りはない。… 本件特許発明は、ＮＹＨＡクラスＩＶの患者に入院下で経口にて投与開始される重症心不全の治療薬と特定されている点（相違点１）、及び活性成分の１日当たりの用量が０．３７１ｍｇ／ｋｇ以下の範囲と特定されている点（相違点２）で甲２発明と相違する。 しかしながら、相違点１について、本件優先日当時、利尿薬は急性心不全、慢性心不全、心不全の重症度を問わず広く用いられていた薬剤であり、トルバプタンと同じ作用機序の利尿薬がＮＹＨＡクラスＩＶの患者に投与されていたことからも、重症でないとは即断できない患者を含むＮＹＨＡクラスＩ～ＩＩＩの患者に有効である甲２発明のトルバプタンをＮＹＨＡクラスＩＶの患者の治療薬とすることには十分な動機付けがあり、その阻害要因があったともいえず、容易に想到し得たということができる。また、治療薬を投与する際に患者が入院下であるか否かという点は実質的な相違点とはいい難い。さらに、本件優先日当時のトルバプタンの使用態様から、これを経口投与とすることは当業者が適宜なし得た事項というべきである。相違点２についても、これは甲２発明の最小有効量である１日１回３０ｍｇとほぼ同一の用量であって、１日当たりの用量を０．３７１ｍｇ／ｋｇ以下の範囲とすることに臨界的意義があるとも言えず、甲２の記載及び技術常識を参酌して用量を上記範囲とするのは適宜なし得ることというべきである。… …利尿薬は、急性心不全と慢性心不全とを問わず、また重症と軽症～中等症とを問わず、心不全の症状の一つである体液貯留、うっ血、浮腫等を改善する治療薬として広く用いられており、さらに、上記主張の例は利尿薬とは異なる心不全治療薬が含まれているため、ＮＹＨＡクラスＩＶであることを理由に利尿薬の取扱いを異にすべき旨が記載されていると読み取ることはできない。加えて、本件特許の試験はＮＹＨＡクラスＩＩＩおよびＩＶの患者が混在した試験であり、ＮＹＨＡクラスＩＶの患者のみの死亡数は明らかになっていないのであるから、ＮＹＨＡクラスＩＶの患者に対する効果は不明である。	勝 有 △

東京地判 平成20年 （ワ） 第19874号	医療用器具 *薬事法上の添付文書で禁止された態様で使用された医療用器具について間接侵害が成立した事例 ⇒警告状のみでは、具体的な証拠がなく「知っていた」ことにならないと判断した *差し止め請求なし	…一般に，医療機器に係る添付文書の記載（薬事法６３条の２に基づくもの）は，医師が当該機器を使用する際の指針となるべきものであるから，添付文書の「使用上の注意」として，当該機器の特定の使用方法に危険性があるとして，その使用方法を禁止する注意書きが記載されている場合には，当該機器を使用する医師があえてそのような使用方法を用いることは，通常は考え難い事態であるということができる。 この点，被告製品の添付文書に，一体化同時穿刺の方法で被告製品を使用することには危険性があるため，そのような使用方法を禁止する旨の注意書きが記載されている…。 したがって，上記のような被告製品の添付文書の記載にもかかわらず，なお，医師らが被告製品を一体化同時穿刺の方法で使用することがあり得ることを，被告らにおいて認識していたものと認められるか否かという観点からの検討が必要となる。 …⑤被告らに対し，被告製品が一体化同時穿刺のできる構造であることを指摘し，本件特許に抵触する旨を警告する内容の本件通知書を送付した…。上記⑤の点については，…本件特許の特許権者のＸ１が，被告製品について一体化同時穿刺のできる構造である旨を主張していることが，被告らによって認識されたこと示す事情にすぎず，この時点において，Ｘ１から被告らに対して，上記主張を裏付ける具体的な証拠資料が示されていたとの事情も認められないから，本件通知書の送付を受けたことによって，直ちに被告らが…被告製品が一体化同時穿刺の方法で使用されるであろうことを具体的に認識し得たものと断ずることはできない。…被告らは，本件訴状及びこれとともに提出された書証の写しの送達を受けることによって，少なくとも被告製品を用いて一体化同時穿刺を行っている医師が存在することを疑わせるに足りる事実を認識した…。	勝有 ★ ★ ★
大阪地判 平成27年 （ワ） 第8974号 控訴審 平成31年 （ネ） 第10007号 も不可欠品の間接侵害成立	…異常発生時にラダー回路を表示する装置 *例外的とはいえない範囲の者が当該製品を特許権侵害に利用する蓋然性が高いことを認識・認容していれば足りる。 ⇒「約４分の１」で、102-2の間接侵害○	…特許法１０１条２号においては，「発明が特許発明であること」（主観的要件①）及び発明に係る特許権の直接侵害品の生産に用いる「物がその発明の実施に用いられること」（主観的要件②）を知りながら，その生産，譲渡等をすることが間接侵害の成立要件として規定されている。…主観的要件②について，部品等の生産，譲渡等をする者において，当該部品等の個々の生産，譲渡等の行為の際に，当該部品等が個々の譲渡先等で現実に特許発明の実施に用いられることの認識を必要とすると解するのでは，当該部品等の譲渡等により特許権侵害が惹起される蓋然性が高い状況が現実にあることを認識，認容している場合でも，個別の譲渡先等の用途を現実に認識していない限り特許権の効力が及ばないこととなり，直接侵害につながる蓋然性の高い予備的行為に特許権の効力を及ぼすとの特許法１０１条２号のそもそもの趣旨に沿わないと解される。以上を勘案すると，主観的要件②が認められるためには，当該部品等の性質，その客観的利用状況，提供方法等に照らし，当該部品等を購入等する者のうち例外的とはいえない範囲の者が当該製品を特許権侵害に利用する蓋然性が高い状況が現に存在し，部品等の生産，譲渡等をする者において，そのことを認識，認容していることを要し，またそれで足りると解するのが相当であり，このように解することは，「その物がその発明の実施に用いられることを知りながら」との文言に照らしても不合理な解釈ではない。…	勝有 ★
大阪地判 平成30年 （ワ） 第4851号	クランプ装置 *例外的とはいえない範囲の者が当該製品を特許権侵害に利用する蓋然性が高いことを認識・認容していれば足りる。 ⇒102-2の間接侵害○ *全部差し止めても、過剰差止めではない	被告製品群７及び８は，スイングクランプのほか，リンククランプ，リフトシリンダ，ワークサポートにも使用可能なものである…。しかし，特許法１０１条２号の趣旨に鑑みれば，発明に係る特許権の侵害品「の生産に用いる物…がその発明の実施に用いられること」とは，当該部品等の性質，その客観的利用状況，提供方法等に照らし，当該部品等を購入等する者のうち例外的とはいえない範囲の者が当該製品を特許権侵害に利用する蓋然性が高い状況が現に存在し，部品等の生産，譲渡等をする者において，そのことを認識，認容していることを要し，またそれで足りると解される。 本件においては，…被告製品群７及び８に属する製品がスイングクランプと組み合わせて販売される割合が大きいことに鑑みると，これを購入等する者のうち例外的とはいえない範囲の者が被告製品群７及び８を特許権侵害に利用する蓋然性が高い状況が現に存在するとともに，被告らはそのことを認識，認容していたものといえる。そうである以上，上記事情は本件における間接侵害の成立を妨げるものではない。… 被告らは，被告製品群７及び８につき差止を認めることは過剰差止として許されないなどと主張する。しかし，前記…のとおり，被告製品群７及び８については，これを購入等する者のうち例外的とはいえない範囲の者が特許権侵害に利用する蓋然性が高い状況が現に存在することなどから，その製造，販売等につき間接侵害が成立するのであるから，用途に係る限定を付すことなく差止請求を認めたとしても過剰とはいえない。	勝有 ★

English translation of the source figure | 1/2

U.S. CAFC Decisions on Inducement, Contributory Infringement, and Related Issues — 1

December 2016 — CAFC, 843 F.3d 1315
Power Integrations v. Fairchild Semiconductor ★
Inducement requires (1) successful communication between the inducer and direct infringer (induced party), plus (2) an affirmative act affecting the conduct of a third party (the direct infringer/induced party); mere inaction in leaving patent infringement unaddressed is insufficient.
A U.S. technical support center was established; customers were enabled to locate U.S. distributors; and indemnification clauses protected customers from U.S. patent infringement claims.
⇒ The U.S. market was targeted; inducement established, § 271(b).

November 2018 — CAFC, 909 F.3d 398
Enplas Display v. Seoul Semiconductor ★
Lens sales outside the United States ⇒ inducement of U.S. patents concerning lighting apparatus established, § 271(b).
The accused infringer held 50% of the global market and knew that its customers also sold the final products (televisions) in the United States; “specific intent to induce infringement” was found.

May 2015 — CAFC, 785 F.3d 625
Takeda v. West-Ward Pharm ★
⇒ Inducement not established, § 271(b).
Even if an accused pharmaceutical manufacturer knows of an infringing use of its drug, intent to induce is not found where the label is vague and physicians will not necessarily prescribe for the patented use.
Arthrocare v. Smith & Nephew, 406 F.3d 1365 (Fed. Cir. 2005), differed because the label necessarily led to infringement.
(The general proposition remained the same afterward: Sanofi v. Watson, 875 F.3d 636 (Fed. Cir. 2017).)

November 2010 — CAFC, 633 F.3d 1042
AstraZeneca v. Apotex ★
The patented invention prescribed once-daily administration. The approved label stated twice daily but recommended reducing the dose if asthma stabilized. The accused drug came only in 0.25 mg and 0.5 mg doses. Some physicians or patients would reduce the dose as recommended and use it once daily.
⇒ Inducement of the treatment-method patent established, § 271(b).
If the label “necessarily leads” a certain proportion of direct infringers, 100% infringing use is not required. What percentage suffices?

August 1998 — CAFC, 152 F.3d 1342
Johns Hopkins University v. Cellpro ○

Source: Hideki Takaishi, Ameblo, March 2025

U.S. CAFC Decisions on Inducement, Contributory Infringement, and Related Issues — 1

Promotion and advertising of medical equipment established inducement, § 271(b).
Knowing the patent, the seller stated that using the device could achieve the patented purification rate.
Cf. CAFC, October 2020, GlaxoSmithKline v. Teva (the label did not expressly state the patented use but described the product as equivalent).
Compare IP High Court, 2005 (Ne) 10125, Cilostazol (employee-invention compensation claim) (Sato).

January 2003 — CAFC, 316 F.3d 1348
Warner-Lambert v. Apotex ★★★
After the earlier patent expired, a generic drug approved by the FDA for one use (partial-onset seizures) could also be used for the patented use (neurodegenerative disease).
⇒ No infringement under § 271(e)(2) in relation to the ANDA.
Dictum: even 2.1% ($50 million) off-label use for the patented purpose did not establish inducement under § 271(b).
In particular, where substantial noninfringing uses exist, even actual knowledge that some users may infringe does not permit an inference of intent to induce infringement. Where, as with gabapentin, a product has many uses and no more than one in 46 sales is for an infringing use, Apotex's intent can neither be inferred nor presumed absent direct evidence.

March 2003 — CAFC, 324 F.3d 1322
Allergan v. Alcon △
A generic drug approved by the FDA for another use (reducing intraocular pressure) could also be used for the patented use (neuroprotection in glaucoma patients).
⇒ No infringement under § 271(e)(2) in relation to the ANDA.
Following Warner-Lambert, summary judgment favored Alcon because it had not sought FDA approval for the patented use.
(The majority did not examine inducement under § 271(b). Even if § 271(e)(2) is cleared, § 271(b) remains relevant after ANDA approval.)

October 2024 — CAFC
Provisur Tech v. Weber ★
Where changing a product's settings would bring it within the invention's technical scope, mere theoretical possibility is insufficient; the product must actually be “readily configurable.”
Fantasy Sports Props. v. Sportsline.com, 287 F.3d 1108 (Fed. Cir. 2002).
⇒ Customers' access to the settings screen enabling claim 14's “advance-to-fill” function was restricted.
The district court's infringement determination was reversed.

Source: Hideki Takaishi, Ameblo, March 2025

English translation of the source figure | 1/2

CAFC Decisions — 2 / Important Decisions on Medical-Use Inventions

November 2010 — CAFC, 626 F.3d 1197
Finjan v. Secure Computing ★

Software for proactive scanning incorporated into a product constituting a recording medium was locked.
① The user could unlock it by purchasing a key, so direct infringement of the product invention was established.
In ACCO v. ABA, 501 F.3d 1307 (Fed. Cir. 2007), the claims required a particular configuration (e.g., a lock-device pin positioned in a specified slot), and direct infringement required actual use in the infringing mode. By contrast, Finjan's claims did not require a particular configuration or “enablement” for proactive scanning. The existence of a program to perform that function sufficed for infringement.
② No infringement of the method invention because there was no actual performance.
Cf. Southwest Software v. Harlequin, 226 F.3d 1280 (Fed. Cir. 2000).

Important related decision on medical-use inventions
IP High Court, 2022 (Gyo-Ke) 10084 (Honda)
Method for Treating Severe Heart Failure — invalidation decision upheld; the patentee's action to cancel it was dismissed △

The differences concerning the target patients and the dosage regimen may be treated as separate differences when assessing obviousness.
The patients were limited, but the known drug was also administered to those patients, making the limitation obvious.

When considering the dosage of a therapeutic drug, the target patients and differences in treatment naturally must be considered. When identifying differences between a therapeutic-drug invention and a cited invention, however, if differences concerning the patients or treatment have already been identified,

Source: Hideki Takaishi, Ameblo, March 2025

English translation of the source figure | 2/2

CAFC Decisions — 2 / Important Decisions on Medical-Use Inventions

there is no need to identify the dosage difference again as overlapping with those differences. It was therefore not erroneous for the trial decision to identify the daily dose of tolvaptan alone as a difference separate from Difference 1. …

The patented invention differs from the Ko 2 invention in specifying a treatment for severe heart failure that is orally administered to hospitalized NYHA Class IV patients at initiation (Difference 1), and in limiting the daily dose of the active ingredient to 0.371 mg/kg or less (Difference 2).

As to Difference 1, at the priority date diuretics were widely known drugs regardless of acute or chronic heart failure or its severity. Diuretics of the same mechanism as tolvaptan were administered to NYHA Class IV patients. There was therefore ample motivation, without an inhibiting factor, to use the tolvaptan of the Ko 2 invention, effective for NYHA Classes I–III including patients who cannot immediately be described as non-severe, as a treatment for Class IV patients; this was readily conceivable. Whether patients are hospitalized when treatment is administered is hardly a substantive difference. Oral administration was also appropriately selectable in light of tolvaptan's use at the priority date. As to Difference 2, the amount is substantially the same as the minimum effective dose of 30 mg/day in Ko 2. No critical significance is shown for limiting the daily amount to 0.371 mg/kg or less, and that amount was appropriately selectable in light of Ko 2 and common general technical knowledge. …

Diuretics were widely used to improve fluid retention, congestion, and edema—symptoms of heart failure—regardless of whether the heart failure was acute or chronic, severe, mild, or moderate. The examples in the specification also include heart-failure treatment differing from diuretics, so they cannot be read as teaching that diuretics should be treated differently merely because a patient is in NYHA Class IV. Moreover, the patent's trial combined patients in Classes III and IV; mortality for Class IV patients alone was not clarified, so the effect on Class IV patients is unknown.

Source: Hideki Takaishi, Ameblo, March 2025

English translation of the source figure | 1/2

Japanese Decisions on Indirect Infringement and Knowledge

Tokyo District Court, 2008 (Wa) 19874
Medical instruments — patent holder prevailed ★★★

Indirect infringement involving medical devices used in a manner prohibited by package-insert warnings under pharmaceutical law.
A warning letter alone, without concrete evidence, was held insufficient to establish “knowing.”
No injunction sought.

“… Generally, statements in a medical-device package insert (under Article 63-2 of the Pharmaceutical Affairs Act) should guide physicians' use. Where the ‘Precautions for Use’ warn that a particular method is dangerous and prohibit it, physicians using the device would not ordinarily be expected to use that method.
The accused product's package insert warned that use by the integrated simultaneous-puncture method was dangerous and prohibited that method.
Accordingly, it is necessary to examine whether, despite those warnings, the defendants recognized that physicians might nonetheless use the accused product by that method. …
⑤ A notice was sent to the defendants pointing out that the accused product had a structure capable of integrated simultaneous puncture and warning that it infringed the patent. … This merely shows that the defendants recognized that X1, the patentee, asserted that the product had such a structure. There is no circumstance showing that X1 presented concrete supporting evidence at that point. Receipt of the notice therefore does not immediately establish specific awareness that the product would be used by the integrated simultaneous-puncture method. … By receiving the complaint and copies of the preparatory briefs submitted in this litigation, the defendants recognized facts sufficient at least to suspect the existence of physicians performing integrated simultaneous puncture with the accused product. …”

Osaka District Court, 2015 (Wa) 8974
IP High Court appeal, 2019 (Ne) 10007
Device displaying a ladder circuit upon an abnormality — patent holder prevailed ★★

The appeal also found the product indispensable and upheld indirect infringement.
Knowledge and acceptance of a high probability that a non-exceptional range of users will use the product for patent infringement suffice.
⇒ “Approximately one quarter” established indirect infringement under Article 101(ii).

“… Article 101(ii) of the Patent Act requires manufacture, transfer, or similar acts while knowing that ‘the

Source: Hideki Takaishi, Ameblo, March 2025

English translation of the source figure | 2/2

Japanese Decisions on Indirect Infringement and Knowledge

invention is patented' (subjective requirement ①) and that a product used to produce a directly infringing patented product 'is used to work that invention' (subjective requirement ②). ... Requiring awareness, at each production or transfer, that the particular component is actually used by the particular recipient to work the patent would mean that the patent right has no effect unless the seller knows each recipient's actual use, even if it recognizes and accepts that infringement is highly likely to occur through its transfers. This conflicts with Article 101(ii), which extends the patent's effect to preparatory conduct highly likely to lead to direct infringement. Subjective requirement ② should therefore be understood as requiring, and being satisfied by, an existing situation in which, considering the component's nature, customers' usage, and the manner of supply, a non-exceptional range of purchasers is highly likely to use it for patent infringement, with the producer or transferor recognizing and accepting that situation. This is not an unreasonable construction of the words 'knowing that the product is used to work the invention.' ..."

Osaka District Court, 2018 (Wa) 4851
Clamp device — patent holder prevailed ★

Knowledge and acceptance of a high probability that a non-exceptional range of users will use the product for infringement.
⇒ Indirect infringement under Article 101(ii).
An injunction against all relevant products is not excessive.

"Accused Product Groups 7 and 8 can also be used with link clamps, lift cylinders, and work supports, besides swing clamps. ... However, in light of the purpose of Article 101(ii), 'is used to work that invention' means that an existing situation makes it highly likely that a non-exceptional range of purchasers will use the components for patent infringement, taking account of their nature, customers' usage, and the manner of supply; the producer or transferor must recognize and accept that situation, and this is sufficient. ... Here, ... products in Groups 7 and 8 are often sold in combination with swing clamps. There is thus an existing high probability that a non-exceptional range of purchasers will use them for infringement, and the defendants recognized and accepted this. These circumstances therefore do not negate indirect infringement. ...
The defendants argue that enjoining Groups 7 and 8 is impermissible as excessive. But ... because the high probability of infringing use by a non-exceptional range of purchasers exists, indirect infringement occurs at the point of manufacture and sale. An injunction without a use limitation is therefore not excessive."

Source: Hideki Takaishi, Ameblo, March 2025

(Editor's transcription and correction of the figure above)

U.S. CAFC Decisions on Inducement, Contributory Infringement, and Related Issues — 1 December 2016 — Power Integrations v. Fairchild Semiconductor, 843 F.3d 1315 ★

Inducement requires successful communication between the inducer and a third-party direct infringer, resulting in actual inducement of direct infringement. An affirmative act encouraging the third party's infringing conduct is required; merely leaving infringement unaddressed is insufficient.

Fairchild established a U.S. technical support center, enabled customers to locate U.S. distributors, and indemnified customers against U.S. patent infringement claims. This and other evidence directed to the U.S. market could support a finding of inducement, so the court declined to enter JMOL of noninfringement. However, it vacated the inducement verdict because the jury had been erroneously instructed that actual inducement was unnecessary, leaving inducement for retrial. 35 U.S.C. § 271(b).

November 2018 — Enplas Display v. Seoul Semiconductor, 909 F.3d 398 ★

Sales of lenses outside the United States supported inducement of infringement of U.S. patents covering lighting apparatus. Enplas held a 50% worldwide market share and knew that its customers also sold the final products, televisions, in the United States. Together with its knowledge of the patents and infringing

activities, specifications recommending infringing configurations, and other evidence, this supported the jury's finding of specific intent to induce infringement. 35 U.S.C. § 271(b).

May 2015 — Takeda v. West-Ward Pharm., 785 F.3d 625 ★

Denial of a preliminary injunction was affirmed because a likelihood of success on induced infringement had not been established. Even where a pharmaceutical manufacturer knows of an infringing use, vague label language combined with speculation about physicians' prescribing behavior does not establish inducement. 35 U.S.C. § 271(b).

In Arthrocare v. Smith & Nephew, 406 F.3d 1365 (Fed. Cir. 2005), sales literature and operating instructions encouraged infringing use. The case Takeda distinguished because following the label necessarily led to infringement was AstraZeneca v. Apotex, discussed below. The general requirement of intent to induce remained the same in Sanofi v. Watson, 875 F.3d 636 (Fed. Cir. 2017).

November 2010 — AstraZeneca v. Apotex, 633 F.3d 1042 ★

The patented method required administration no more than once per day. The proposed generic label specified twice-daily dosing but recommended reducing the dose after asthma stabilized. Only 0.25 mg and 0.5 mg strengths were available, so some physicians or patients following the downward-titration instruction would arrive at once-daily dosing. A likelihood of success on induced infringement was established, and the preliminary injunction was affirmed. 35 U.S.C. § 271(b).

It is sufficient if the label necessarily leads some users to directly infringe; 100% infringing use is not required. What proportion suffices?

August 1998 — Johns Hopkins University v. CellPro, 152 F.3d 1342 ○

The district court found infringement and inducement based in part on promotion and advertising of medical equipment, and the CAFC affirmed the infringement determination. Knowing of the patent, the seller advertised that the device could achieve the patented purification rate. 35 U.S.C. § 271(b).

Compare GlaxoSmithKline v. Teva: the October 2020 opinion was withdrawn in February 2021 and replaced by the August 5, 2021 opinion. The later opinion sustained the inducement verdict based on evidence including instructions remaining in the partial label that encouraged the patented method and promotional materials.

Compare IP High Court, 2005 (Ne) 10125, Cilostazol (employee-invention compensation claim) (Sato).

January 2003 — Warner-Lambert v. Apotex, 316 F.3d 1348 ★★★

Apotex filed an ANDA to sell a generic after expiration of an earlier patent, for the FDA-approved use of treating partial-onset seizures. It did not seek approval for the separately patented use of treating neurodegenerative disease. The ANDA filing did not infringe under 35 U.S.C. § 271(e)(2).

(Obiter) Inducement was also rejected. The court considered Warner-Lambert's data that 2.1% of gabapentin prescriptions were for neurodegenerative disease and assumed, for argument's sake, its assertion that this represented $50 million. Those figures did not establish an intent to promote infringement. Particularly where substantial noninfringing uses exist, knowledge that some users may infringe does not by itself permit an inference of intent to induce. Where, as with gabapentin, a product has many uses and fewer than one in 46 sales are for an infringing use, the court could neither infer nor decline to infer Apotex's intent without direct evidence. 35 U.S.C. § 271(b).

March 2003 — Allergan v. Alcon, 324 F.3d 1322 △

Alcon and the other applicant filed ANDAs for the FDA-approved use of reducing intraocular pressure, rather than the patented use of neuroprotection in glaucoma patients. Although prescribing for the patented use was alleged to be possible, summary judgment of noninfringement under 35 U.S.C. § 271(e)(2) was affirmed under Warner-Lambert.

The majority did not decide inducement under § 271(b) on the facts of this case. Even where an ANDA filing does not infringe under § 271(e)(2), conduct after approval may separately give rise to liability under § 271(b).

October 2024 — Provisur Technologies v. Weber ★

Where changing a product's settings would satisfy the claim limitations, a theoretical possibility is insufficient; the product must be readily configurable to infringe. Fantasy Sports Props. v. Sportsline.com, 287 F.3d 1108 (Fed. Cir. 2002).

Customers could not access the screens needed to configure the advance-to-fill function of claim 14 of the '936 patent. The expert also failed to show that he had actually performed that configuration. The denial of JMOL of noninfringement of that claim was reversed.

CAFC Decisions — 2 / Important Decisions on Medical-Use Inventions

November 2010 — Finjan v. Secure Computing, 626 F.3d 1197 ★

Proactive-scanning software incorporated into the products was locked. (1) Users could unlock it by purchasing a key, so direct infringement of the system and storage-medium claims was established.

In ACCO v. ABA, 501 F.3d 1307 (Fed. Cir. 2007), the claims required a particular configuration, such as a lock-device pin positioned in a specified slot, and actual use in the infringing configuration was necessary for direct infringement. By contrast, Finjan's claims did not require a particular configuration or activation of the proactive-scanning function. The presence of the program for performing the function sufficed.

The method claims were not infringed because performance by the defendants in the United States was not proved. The evidence showed, at most, one test in Germany. See Southwest Software v. Harlequin, 226 F.3d 1280 (Fed. Cir. 2000).

Important Related Decision on Medical-Use Inventions

IP High Court, 2022 (Gyo-Ke) 10084 (Honda) — Method for Treating Severe Heart Failure and a Drug Therefor

Invalidity decision upheld; the patent proprietor's action to cancel it was dismissed. △

Differences in target patients and differences in dosage and administration may be treated separately when assessing obviousness. Although the patient group was limited, obviousness was found because, among other things, a known diuretic with the same mechanism had been administered to that group.

Excerpts from the Court's Reasoning

When considering a therapeutic drug's dosage, differences in target patients and treatment should naturally be taken into account. In identifying differences between a patented therapeutic-drug invention and a cited invention, once differences concerning target patients or treatment have been identified, there is no need to identify them again as part of a dosage difference encompassing those patients or treatment. Accordingly, the trial decision did not err in identifying only the daily dosage of tolvaptan as Difference 2, separately from Difference 1 described above. …

(Summary of the court's reasoning follows) The patented invention differs from the invention in Exhibit Ko 2 in being specified as a therapeutic agent for severe heart failure whose oral administration is initiated in hospitalized NYHA class IV patients (Difference 1), and in specifying the daily dosage of the active ingredient as within a range of 0.371 mg/kg or less (Difference 2).

However, regarding Difference 1, at the priority date diuretics were widely used regardless of acute or chronic heart failure or its severity. Diuretics with the same mechanism of action as tolvaptan were also administered to NYHA class IV patients. Thus, there was ample motivation to use the tolvaptan of the invention in Exhibit Ko 2, effective for NYHA class I–III patients, including patients who cannot immediately be regarded as nonsevere, to treat NYHA class IV patients. No inhibiting factor is identified,

and this could readily have been conceived. Further, whether the patient is hospitalized when the drug is administered can hardly be called a substantive difference. Moreover, given how tolvaptan was used at the priority date, oral administration was a matter that a person skilled in the art could appropriately adopt. Difference 2 likewise concerns a dosage substantially identical to the dose of 30 mg once daily used in the trial in Exhibit Ko 2. Setting the daily dosage within 0.371 mg/kg or less cannot be said to have critical significance, and adopting that range in light of Exhibit Ko 2 and common general technical knowledge was something that could appropriately be done. …

…Diuretics were widely used to treat fluid retention, congestion, edema and other symptoms of heart failure, regardless of whether it was acute or chronic, severe or mild-to-moderate. Furthermore, because the examples in the above argument include heart-failure treatments other than diuretics, they cannot be read as stating that diuretics should be treated differently because a patient is NYHA class IV. In addition, the trial in the patent included a mixture of NYHA class III and IV patients, and the number of deaths among class IV patients alone is not disclosed, so the effect on NYHA class IV patients is unknown.

Japanese Decisions on Indirect Infringement and Knowledge

Tokyo District Court, 2008 (Wa) 19874 — Medical Instruments; Right Holder Prevailed ★★★

Indirect infringement was found for medical instruments used in a manner prohibited by package-insert warnings under pharmaceutical law. A warning letter alone, without concrete supporting evidence, did not establish the required knowledge. No injunction was sought.

Excerpts from the Court's Reasoning

"Generally, statements in the package insert for a medical device (under Article 63-2 of the Pharmaceutical Affairs Act) should guide physicians' use of the device. Where the Precautions for Use warn that a particular method is dangerous and prohibit it, physicians using the device would not ordinarily be expected to adopt that method. The accused product's package insert warned that use by integrated simultaneous puncture was dangerous and prohibited it, as stated in (b)(c) above. Accordingly, it is necessary to examine whether, despite those warnings, the defendants recognized that physicians might nonetheless use the product by that method."

The notice identified the product's structure as allowing integrated simultaneous puncture and warned of patent infringement. The court stated: "With regard to point ⑤ above, this merely shows that the defendants recognized that X1, the patentee, was asserting that the product had such a structure. There is no circumstance showing that X1 presented concrete supporting evidence at that point. Receipt of the notice therefore does not immediately establish specific awareness that the product would be used by integrated simultaneous puncture despite the package-insert warning described in (b)(c) above. … By receiving the complaint and copies of the documentary evidence submitted with it, the defendants recognized facts sufficient at least to suspect that physicians were performing integrated simultaneous puncture with the accused product."

Osaka District Court, 2015 (Wa) 8974 — Device Displaying a Ladder Circuit upon an Abnormality; Right Holder Prevailed ★★

The IP High Court appeal, 2019 (Ne) 10007, also found the product indispensable and upheld indirect infringement. Recognition and acceptance of a high probability that a non-exceptional range of purchasers will use the product for patent infringement suffice. The court found indirect infringement under Article 101(ii), holding that the defendant's asserted proportion of approximately one quarter was not substantiated by evidence but, even if assumed, was not so small as to be "exceptional."

Excerpts from the Court's Reasoning

"Article 101(ii) requires production, transfer, or similar acts with knowledge that the invention is patented (subjective requirement (1)) and that the product used to produce a directly infringing patented product is used to work that invention (subjective requirement (2)). … On the other hand, as to subjective requirement (2), requiring awareness, at each individual production or transfer, that a particular recipient is actually using the component to work the invention would mean that the patent has no effect unless the supplier knows each recipient's actual use, even where the supplier recognizes and accepts an existing high probability that its transfers will cause infringement. This would conflict with the purpose of Article 101(ii), which extends the patent's effect to preparatory conduct highly likely to lead to direct infringement."

"Accordingly, subjective requirement (2) requires, and is satisfied by, an existing situation in which, considering the component's nature, its objective usage, and the manner of supply, a non-exceptional range of purchasers is highly likely to use it for patent infringement, and the producer or transferor recognizes and accepts that situation. This is not an unreasonable interpretation of the words 'knowing that the product is used to work that invention.' …"

Osaka District Court, 2018 (Wa) 4851 — Clamp Device; Right Holder Prevailed ★

Recognition and acceptance of a high probability of infringing use by a non-exceptional range of purchasers suffice for indirect infringement under Article 101(ii). An injunction covering all the relevant products was not excessive.

Excerpts from the Court's Reasoning

"Accused Product Groups 7 and 8 can also be used with link clamps, lift cylinders, and work supports, in addition to swing clamps (Exhibits Ko 6 and 10; Exhibits Otsu 4, 5, 9, and 10). However, in light of the purpose of Article 101(ii), the phrase concerning a product used to produce an infringing patented product being used to work the invention requires, and is satisfied by, an existing situation in which a non-exceptional range of purchasers is highly likely to use the component for patent infringement, considering its nature, objective usage, and manner of supply, with the producer or transferor recognizing and accepting that situation. Here, as stated in section 6 below, considering the large proportion of products in Groups 7 and 8 sold in combination with swing clamps, a high probability existed that a non-exceptional range of purchasers would use them for infringement, and the defendants recognized and accepted this. The stated circumstances therefore do not negate indirect infringement. …"

"The defendants argue that an injunction covering Groups 7 and 8 is impermissible as excessive. However, as stated in section 3(2) above, because there is an existing high probability of infringing use by a non-exceptional range of purchasers, among other circumstances, manufacture, sale, and similar acts constitute indirect infringement. An injunction without a restriction by use is therefore not excessive. The defendants' argument is rejected."

Tokyo District Court, 2024 (Yo) 30028 — Age-Related Macular Degeneration (Kokubu, Civil Division 29)

Original Ameblo publication: 2025-03-13

Article type: Case note

Categories: Patents, Unfair competition law

Topics: Patent linkage, False allegations, Injunctions

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Case information: 2024 (Yo) 30028

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12889767027-ja

Tokyo District Court, 2024 (Yo) 30028 — Age-Related Macular Degeneration (Kokubu, Civil Division 29)

(Issued around the same time as Tokyo District Court, 2024 (Yo) 30029 (Nakashima, Civil Division 40).)

⇒ Without deciding whether there was patent infringement, the court, in light of the circumstances, began with “negation of unlawfulness as a lawful act.” It adopted a framework under which, even where an act formally constitutes dissemination or communication of false facts, it is not unlawful as a lawful act contemplated by the patent linkage system if it is found appropriate in light of the purpose of providing pharmaceutical patent information under that system. It found appropriateness in this case.

(Source: Hikaru Takagi, Professor Emeritus, Kyoto University, “Injunctions Against Statements of Opinion by Patentees in the Patent Linkage System,” NBL No. 1285, p. 33.)

https://ameblo.jp/hideki-takaishi/entry-12889616530.html

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Two Judgments Specifying the End Date of an Injunction: Patent Expiration or the Expiration Date Before Extension

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Categories: Patents

Topics: Injunctions

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* Two judgments specifying the end date of an injunction

⇒ In the 4H-type single-crystal silicon carbide case, the injunction ran until the patent's expiration date. In the maxacalcitol case, although a five-year extension had been registered, the claim was limited to the expiration date before that extension, and the effect of the extension was not at issue.

* Could this reduce the value of the subject matter of the action and save filing-stamp fees!?

IP High Court, 2014 (Ne) 10082 — Method for Producing 4H-Type Single-Crystal Silicon Carbide (Takabe)

"Operative part … The appellee shall not, as against the appellant, import, sell, or display for sale the wafers listed in the attached list of products until December 8, 2015."

Tokyo District Court, 2013 (Wa) 4040 — Maxacalcitol (Shimasue)

"Operative part … Defendant DKSH shall not import or transfer the maxacalcitol active pharmaceutical ingredient listed in the attached List of Products 1 until September 3, 2017."

https://note.com/gaha9ben54/n/n873561e37716

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Contract — Tokyo District Court, 2023 (Wa) 70422: Copyright Assignment Without a Written Agreement (Sugiura)

Original Ameblo publication: 2025-03-15

Article type: Case note

Categories: Copyright

Topics: Contracts, Copyright assignments

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Case information: 2023 (Wa) 70422

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890018898-ja

Contract — Tokyo District Court, 2023 (Wa) 70422 (Sugiura)

* An assignment of copyright was found despite the absence of a written agreement.

“In light of the relationship between the plaintiff association and Plaintiff A, the absence of such documentation is not necessarily unnatural or unreasonable. For the same reason, even if the consideration paid was considerably low as consideration for an assignment of copyright, that does not necessarily constitute a circumstance suggesting that no assignment of copyright took place.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93296.pdf

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IP High Court, 2022 (Gyo-Ke) 10118 — Program: A Disclaimer Claim and Inventive Step (Honda)

Original Ameblo publication: 2025-03-17

Article type: Case note

Categories: Patents

Topics: Inventive step

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Case information: 2022 (Gyo-Ke) 10118

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890243998-ja

IP High Court, 2022 (Gyo-Ke) 10118 — Program (Honda)

Claim: "… a control device … wherein the device to be controlled has a speaker but is not a television …"

No particular technical significance was found in the fact that the device controlled in the cited invention was a television.

⇒ Inventive step: denied. (The tactic of excluding an essential part of the cited invention through a disclaimer claim failed.)

(Excerpt from the decision)

In technology for controlling electronic devices using wireless communication, the specific nature of the controlling device … and of the device to be controlled (for example, whether it is a television …) cannot be recognized as having particular technical significance. … Considering also that the technologies corresponding to the respective technologies cannot be found to exclude cases involving devices other than the specific devices described in each publication, … identifying the publicly known technology described in Exhibit Ko 4 without limiting the controlling device and the controlled device to particular devices (respectively, digital camera 3 and high-definition television 1) cannot be regarded as an unjustified abstraction or an excessive generalization to a broader concept. (Additionally, … the description in the application's specification is itself understood to presuppose that there is no difference in technical significance depending on whether the controlled device is a device with a speaker that is not a television, or is a television.) If the controlling device and the controlled device are not limited to particular devices, it is naturally also permissible to identify the publicly known technology in Exhibit Ko 4 without limiting the place of operation and the content of operations rendered ineffective to the particular place and particular content of the operations described. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92310.pdf

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Osaka District Court, 1998 (Wa) 12899 — Electric Pipe Bending Apparatus

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Article type: Case note
Categories: Patents
Topics: Doctrine of equivalents, Claim interpretation
First published on this website: 2026-10-16
Case information: 1998 (Wa) 12899
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12890374936.html
HP: https://www.takaishihideki.com/en/single-post/ameblo-12890374936-en
Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890374936-ja

Osaka District Court, 1998 (Wa) 12899 — Electric Pipe Bending Apparatus
* The defendant simultaneously sold an “electric straight-pipe bender,” a “bender shoe,” and a “bender guide.” Assembling the three infringed the patent.
⇒ Held to constitute direct infringement!!
* The court rejected the argument for a restrictive claim interpretation under the doctrine of estoppel and found literal satisfaction of the claim limitations.
Arguments that did not affect inventive step.
(Excerpt from the decision)
The portions of the plaintiff’s … statements in written opinions and other documents during prosecution of the patent application that concerned the pipe holder (…) asserted, in comparison with the publicly known technology cited in the notice of reasons for refusal or the decision of refusal, that the invention’s pipe-supporting parts were not at the starting point of bending but were distributed on both sides of it, avoiding undesirable lateral pressure from the outside of the bend. Apart from that, they merely described differences from the cited references in line with the wording of Claim 1 concerning the pipe-supporting member before the complete amendment at issue, and cannot be regarded as expressing an intention specifically to exclude other structures of pipe-supporting members. Moreover, through the complete amendment, the pipe-supporting member (pipe holder), originally described in the specification as “a pipe-supporting member having a straight-axis semicircular groove, connected to the matrix via a base plate and functioning as an auxiliary device freely rotatable about a pin mounted on the base plate so as to cooperate with the matrix and the auxiliary matrix during bending,” became “a pipe holder (…) provided on the outer peripheral portion of the rotary former, holding the pipe near the starting portion of bending, and keeping the pipe integral with the rotary former during rotation of the rotary former.” Accordingly, among the statements concerning the pipe-supporting member in the above written opinions and other documents, those relating to points changed by that amendment provide no basis for limiting the interpretation of the claims after amendment (…). The invention was patented as satisfying the patentability requirements notwithstanding the above changes concerning the pipe holder. The applicant’s statements about the pipe holder in written opinions and other documents during prosecution therefore cannot be regarded as a case in which the applicant made statements limiting the meaning of the claims in response to an examiner’s reasons for refusal or grounds of a patent opposition, those statements were accepted by an examiner or trial examiner, and a decision to grant a patent resulted.
Accordingly, the defendant’s argument for a restrictive interpretation under the doctrine of estoppel cannot be accepted.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12264.pdf
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IP High Court, 2023 (Gyo-Ke) 10011 — Device for Remote Operation of a Mobile Terminal (Miyasaka)

Original Ameblo publication: 2025-03-19

Article type: Case note

Categories: Patents

Topics: Inventive step

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Case information: 2023 (Gyo-Ke) 10011

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890499843-ja

IP High Court, 2023 (Gyo-Ke) 10011 — Device for Remote Operation of a Mobile Terminal (Miyasaka)

Claim: "… a display unit displaying images (excluding images captured by a camera) …"

"Nothing in the statements in Cited Reference 1 (Exhibit Ko 1) suggests that 'image capture,' that is, capturing images with a camera, is an essential feature of the cited invention."

⇒ Inventive step: denied. (The tactic of using a disclaimer claim to exclude a feature asserted to be essential to the cited invention failed.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92579.pdf

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Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12890499843.html

Three-Dimensional Trademark — IP High Court, 2024 (Gyo-Ke) 10047: Shin Godzilla (Miyasaka)

Original Ameblo publication: 2025-03-20

Article type: Case note

Categories: Trademarks

Topics: Distinctiveness, Well-known and famous marks

First published on this website: 2026-10-16

Case information: 2024 (Gyo-Ke) 10047

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12890680721.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12890680721-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890680721-ja

Trademark / Three-Dimensional Trademark / Article 3(2) — IP High Court, 2024 (Gyo-Ke) 10047 (Miyasaka)

* Article 3(2) applied to the three-dimensional trademark for a Shin Godzilla figurine.

(Excerpts from the decision)

The three-dimensional shape of Shin Godzilla differs in overall proportions from earlier Godzilla characters: the head is smaller, the thinness of the forelimbs (arms) is more pronounced, and the tail is thicker and longer. It also differs in that reddish coloring has been added, particularly from the back through the tail. As the defendant argues, it is therefore inappropriate to regard the two as identical (substantially identical). However, even if the direct object of “use” under Article 3(2) of the Trademark Act is limited to the three-dimensional shape of Shin Godzilla, when determining whether that use has resulted in “consumers being able to recognize the goods as pertaining to the business of a particular person,” nothing precludes consideration of the influence on consumer recognition of the entire “Godzilla” film series leading up to “Shin Godzilla.” Rather, such consideration is necessary.

…

The defendant criticizes each element of the plaintiff’s allegations and proof: there are few types of magazines featuring the goods bearing the mark; the audiences for the books and exhibitions with sales are limited; permanent installations of Godzilla statues are confined to four locations in Tokyo; and the survey contains no question about the relationship between the three-dimensional shape of the applied-for trademark and the plaintiff. However, these are merely minor issues in the face of the overwhelming recognition of the Godzilla character and cannot affect the finding in (2) above.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93479.pdf

Originally published: 2025-03-20

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12890680721.html

Figure caption: Annex 2 — Trademark at issue (Shin Godzilla).

別紙２　本願商標



IP High Court Grand Panel, 2023 (Ne) 10040 — Composition for Breast Augmentation

Original Ameblo publication: 2025-03-21

Article type: Case note

Categories: Patents

Topics: Claim interpretation, Working of inventions, Patent eligibility

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Case information: 2023 (Ne) 10040

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12890754477-ja

IP High Court Grand Panel, 2023 (Ne) 10040 — Composition for Breast Augmentation

Unlike the first-instance judgment, the court found that the appellee had prepared and administered a drug containing components ①, ②, and ③ simultaneously.

⇒ Claim limitations satisfied: the patentee won on reversal.

* The closely watched issue of whether separate administration of components ① and ②, on the one hand, and component ③, on the other, would also satisfy the claim thus disappeared….

The patented “composition for breast augmentation” is used for breast augmentation, and its purpose is considered primarily aesthetic.

⇒ In light of current social norms, it is not a “product used for the diagnosis, treatment, medical care, or prevention of human disease.”

⇒ It does not constitute an “invention of a medicine to be produced by mixing two or more medicines (products used for the diagnosis, treatment, medical care, or prevention of human disease)” under Article 69(3) of the Patent Act.

https://www.ip.courts.go.jp/vc-files/ip/2025/daigougi-5ne10040-n.pdf

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IP High Court, 2024 (Ra) 10002 — Jurisdiction over a Taiwanese Provider (Miyasaka)

Original Ameblo publication: 2025-03-23

Article type: Case note

Categories: Copyright

Topics: International jurisdiction, Disclosure of sender information

First published on this website: 2026-10-16

Case information: 2024 (Ra) 10002

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HP: https://www.takaishihideki.com/en/single-post/ameblo-12891046084-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891046084-ja

IP High Court, 2024 (Ra) 10002 (Miyasaka)

Immediate appeal against a decision dismissing an application for an order to disclose sender information.

A Taiwanese provider supplied services within Japan.

⇒ Japanese courts have jurisdiction!!

(The first-instance court had held that jurisdiction could not be found. Reversed!!)

(Excerpts from the decision)

1. Article 9(1)(iii) of the Provider Liability Limitation Act provides that, in addition to the cases listed in items (i) and (ii), Japanese courts have jurisdiction over an application for an order to disclose sender information where the respondent is a person conducting business in Japan and the application concerns that respondent's business in Japan. Considering the current internationalization of information distribution, appropriate measures are required to avoid obstacles to judicial relief against cross-border copyright infringement on the Internet. In view of the geographically and internationally open nature of Internet access services, it is inappropriate to determine formally and rigidly whether the business of a provider of such services is conducted "in Japan." Flexible interpretation and application reflecting actual usage and other circumstances are necessary. With these points in mind, the following specific examination is made.

2. Whether the respondent is a "person conducting business in Japan"

According to the case record, although the respondent is a corporation located in Taiwan and engaged in telecommunications, it provides international roaming services within Japan mainly for travelers from Taiwan, and sells SIM cards at Japanese airports and elsewhere for travelers from Japan to Taiwan. Accordingly, the respondent can be regarded as a "person conducting business in Japan."

3. Whether the "application concerns the respondent's business in Japan"

According to the case record, … Japanese-language content is present, and it is highly likely that the posts at issue were made using SIM cards supplied for Japanese users or other services the respondent offers to Japanese users. …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93389.pdf

Originally published: 2025-03-23

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891046084.html

IP High Court, 2024 (Ne) 10010 — Women’s Clothing: A Late Invalidity Defense (Nakadaira)

Original Ameblo publication: 2025-03-23

Article type: Case note

Categories: Patents

Topics: Litigation procedure, Inventive step

First published on this website: 2026-10-16

Case information: 2024 (Ne) 10010

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HP: https://www.takaishihideki.com/en/single-post/ameblo-12891046166-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891046166-ja

IP High Court, 2024 (Ne) 10010 — Women’s Clothing (Nakadaira)

*The new invalidity defense raised in the statement of reasons for appeal was found to have been submitted out of time, and the delay was found to be due to gross negligence. Nevertheless, because it would not delay completion of the proceedings in this case, the court considered its merits and rejected it. (New arguments on appeal require attention to the first-instance proceedings and the timing of submission.)

(Excerpts from the decision)

The appellant’s assertion of new grounds for invalidity in this court … was made in the statement of reasons for appeal. …

… After the court disclosed its preliminary view that the proceedings would move on to damages, … the examination of damages proceeded. … At the oral argument hearing, the appellant stated that it had no further allegations or evidence to present. Oral argument in the first instance was then closed and the first-instance judgment was rendered. … In view of this course of proceedings, the new grounds for invalidity asserted in this court constitute allegations and evidence submitted out of time, and the appellant was grossly negligent in submitting them late, so ordinarily their dismissal would be unavoidable. However, the appellee has, albeit in the alternative, responded to the grounds for invalidity submitted in this court, and oral argument in this court has closed without a rejoinder from the appellant. To this extent, it cannot be said that addressing them would delay the conclusion of the proceedings. The court therefore proceeds to examine them below. … The argument that inventive step is lacking is without merit.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93355.pdf

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Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891046166.html

IP High Court, 2024 (Ra) 10003 — Restricting Access to Settlement Terms and Litigation Records

Original Ameblo publication: 2025-03-24

Article type: Case note

Categories: Patents

Topics: Litigation procedure, Trade secrets

First published on this website: 2026-10-16

Case information: 2024 (Ra) 10003

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891140309.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891140309-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891140309-ja

IP High Court, 2024 (Ra) 10003
Immediate appeal against a decision dismissing an application to restrict inspection and similar access.
A settlement including a nondisclosure clause was reached in patent infringement litigation.
⇒ The defendant applied to restrict inspection of the settlement terms and portions of the preparatory briefs and documentary evidence.
⇒ The IP High Court held that the settlement terms, taken as an indivisible whole, constituted a trade secret and permitted restrictions on access to all of those terms.
(The first-instance decision had granted the application in full as to the portions of the preparatory briefs and documentary evidence covered by it, but had restricted access to only part of the settlement terms and dismissed the remainder of that application.)
(Excerpt from the decision: the section on the “relationship with the principle of open justice”)
… The plaintiff in the underlying action emphasizes in its opinion that Article 91 of the Code of Civil Procedure derives from the principle of open justice under Article 82 of the Constitution. The court therefore sets out its view on this point.
First, what Article 82(1) of the Constitution requires to be public are the “trials” and “judgments” of courts. “Trials” refers to oral argument in civil proceedings and trial proceedings in criminal cases; it does not automatically include the preparatory proceedings in which this settlement took place. It goes without saying that a settlement in litigation, unlike a “judgment,” is not something pronounced in open court.
In civil litigation, the principle of party disposition is adopted as a reflection of private autonomy, leaving the legal relationship constituting the subject matter of the action to the parties, and respect for the parties’ autonomous resolution is required. In the underlying action here, the plaintiff and the defendant (the appellant) chose final resolution through the nonpublic procedure of a settlement in litigation rather than through a judgment procedure subject to the requirement of publicity. They also agreed to a nondisclosure clause, seeking to prevent the release or leakage of information relating to the settlement terms. If, notwithstanding this, third parties could inspect the settlement terms through the procedure under Article 91(1) of the Code of Civil Procedure, that would clearly produce a result contrary to the intentions and expectations of the parties who decided on such a settlement. In such a case, an order restricting inspection and similar access to all of the settlement terms accords with the principle of party disposition, a basic principle of civil litigation, and the requirement to respect the parties’ autonomous resolution, and in no way conflicts with the principle of open justice.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93381.pdf
Originally published: 2025-03-24
Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891140309.html

Article — Scope of Review in Patent Trial-Decision Revocation Actions: Admissibility of New Arguments on Well-Known Technology — The Laser Processing Optical Apparatus Case (Peng Zhang, 2012)

Original Ameblo publication: 2025-03-25

Article type: Publication review

Categories: Patents

Topics: Litigation procedure, Cancellation of JPO decision, Examination and appeal practice

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891265447.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891265447-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891265447-ja

Article — “Scope of Review in Patent Trial-Decision Revocation Actions: Admissibility of New Arguments on Well-Known Technology — The Laser Processing Optical Apparatus Case” (Peng Zhang, Intellectual Property Law and Policy Journal, Vol. 38 (2012))

The Supreme Court’s January 24, 1980 judgment in the “Food Packaging Container” case held that, because judges do not possess knowledge equivalent to that of a person skilled in the art, new allegations and proof of publicly known technology are permissible to establish the common general technical knowledge underlying the trial decision.

⇒ The (lower) court may decide this in its discretion. (See footnote 31.)

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol38/38_4.pdf

Originally published: 2025-03-25

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891265447.html

JPO Status Report 2025

Original Ameblo publication: 2025-03-26

Article type: Reports and activities

Categories: Patents

Topics: Examination and appeal practice, Divisional applications

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891384718.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891384718-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891384718-ja

JPO Status Report 2025

The number of patent applications in Japan is recovering: 306,855 applications.

Appeals against examiners' decisions of refusal: approximately 20,000.

Requests for invalidation trials doubled to 186 (one person filed more than 50).

Operation of suspension of examination of divisional applications while the parent application is pending in appeal proceedings

Allowing applicants to consider how to handle a divisional application in light of the results of re-examination before appeal or the appeal proceedings for the parent application is expected to help them develop more efficient and effective filing strategies.

• Examination was suspended in 3,553 cases in 2024.

https://www.jpo.go.jp/resources/report/statusreport/2025/index.html

Originally published: 2025-03-26

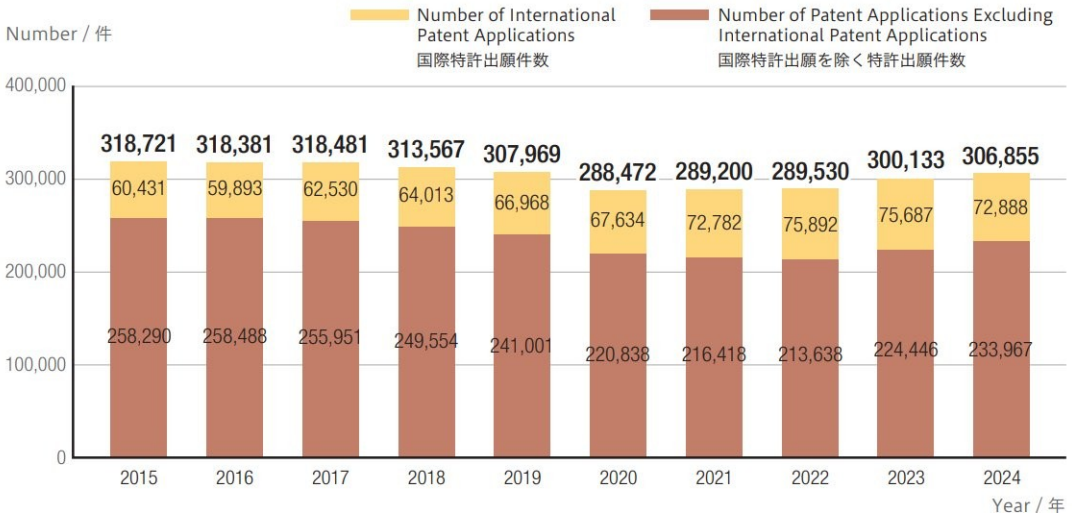
Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891384718.html

Trends in Intellectual Property in Japan
我が国の知財動向

❶ Patents / 特許

1 Number of Patent Applications / 特許出願件数

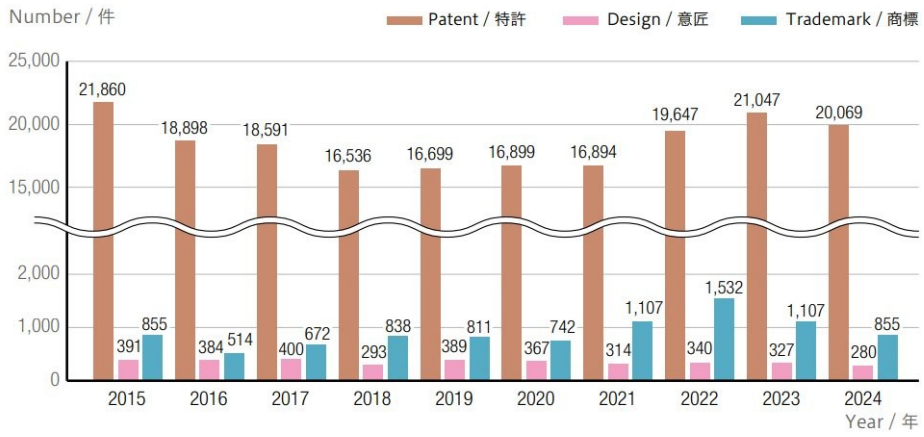
Figure 1-1-1 Number of Patent Applications / 特許出願件数



❺ Trials and Appeals / 審判

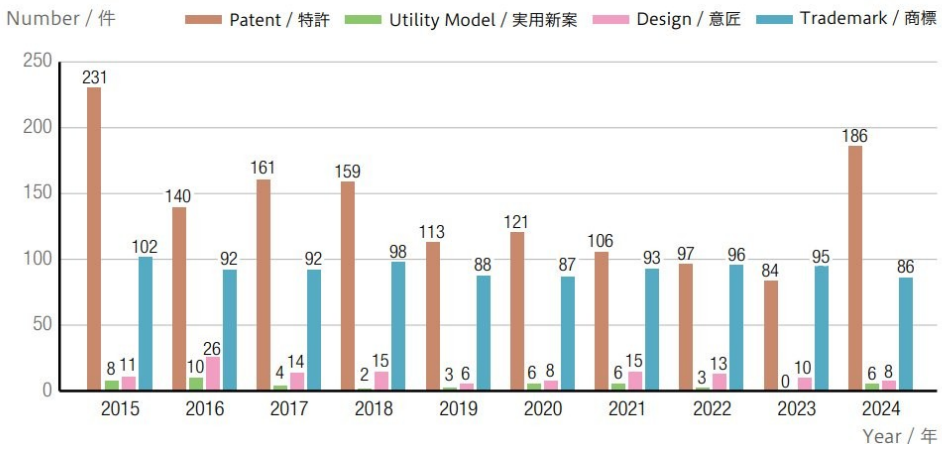
1 Statistics Related to Appeal against an Examiner's Decision of Refusal / 拒絶査定不服審判関連統計

Figure 1-1-31 Number of Requests for Appeal against an Examiner's Decision of Refusal
拒絶査定不服審判請求件数



② Number of Requests for Trial for Invalidation / 無効審判請求件数

Figure 1-1-34 Number of Requests for Trial for Invalidation / 無効審判請求件数



（iii）原出願が審判係属中の分割出願に対する審査中止の運用*14

2023年４月から、分割出願のうち、原出願の拒絶査定後、拒絶査定不服審判請求にあわせて出願されたものであって、申請がされた案件について、特許法第54条第１項を適用し、原出願の前置審査又は審判の結果が判明するまで当該分割出願の審査を中止する運用を開始している。出願人にとって、原出願の前置審査又は審判の結果を踏まえて分割出願の対応を検討できることは、より効率的かつ効果的な出願戦略の構築につながると期待されている。

また、2024年４月から、審査中止期間の終了前に、出願人側からの申請に基づき分割出願の審査を再開できる運用を開始した。

・2024年に審査を中止した件数は3,553件。

English translation of the source figure | 1/1

Suspension of Examination of Divisional Applications

(iii) Suspension of examination of divisional applications whose parent applications are pending in appeal proceedings (note 14)

Since April 2023, for divisional applications filed after refusal of the parent application, together with a request for an appeal against the examiner's decision of refusal, and for which a request has been made, Article 54(1) of the Patent Act has been applied to suspend examination of the divisional application until the outcome of re-examination before appeal or the appeal proceedings for the parent application is known. Enabling applicants to consider how to handle the divisional application in light of that outcome is expected to contribute to more efficient and effective filing strategies.

Since April 2024, a practice has also been introduced allowing examination of a divisional application to resume at the applicant's request before the suspension period ends.

• Examination was suspended in 3,553 cases in 2024.

Source: Hideki Takaishi, Ameblo, March 2025 | Figure 12891384718-image4

Copyright Article — Identifying the Author of a Compilation (Katsuyuki Izumi, 2013)

Original Ameblo publication: 2025-03-27

Article type: Publication review

Categories: Copyright

Topics: Creators and inventors, Copyrightability

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891500657.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891500657-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891500657-ja

Article / Copyright — “Identifying the Author of a Compilation” (Katsuyuki Izumi, Intellectual Property Law and Policy Journal, Vol. 42 (2013))

A compilation work = one “that is creative by reason of the selection or arrangement of its materials” (Article 12(1) of the Copyright Act).

Author of a compilation work = a person who was creatively and substantively involved in the selection or arrangement of the materials.

A person who decided the editorial policy can also be the author of a compilation work. (Tokyo District Court, September 17, 1980, “Chi no Sazamegoto” case.)

The person who commissioned creation of a work or supplied the original proposal can also be an author if that person substantively participated in its creation. (Osaka District Court, March 29, 1985, “Commercial Advertisement” case.)

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/52425/3/42_06.pdf

Originally published: 2025-03-27

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891500657.html

Trademark Appeal 2024-278 — “AONO” Does Not Fall Under Article 3(1)(iv)

Original Ameblo publication: 2025-03-28

Article type: Administrative decision note

Categories: Trademarks

Topics: Distinctiveness, Examination and appeal practice

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891634315.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891634315-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891634315-ja

Trademark / Trial Decision — Appeal 2024-278

Applied-for trademark: “AONO”

Does not fall under Article 3(1)(iv).

The surname “Aono” (青野) ranks 797th or 849th, with 20,000 people and 6,000 households.

⇒ Nationwide, the number cannot be regarded as particularly large.

https://www.jpo.go.jp/system/laws/rule/guideline/trademark/kijun/document/index/08_3-1-4.pdf

Originally published: 2025-03-28

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891634315.html

The JPO’s “Toward Strategic Intellectual Property Management” (2007)

Original Ameblo publication: 2025-03-29

Article type: Reports and activities

Categories: Patents

Topics: IP management, AI and intellectual property, Generative AI

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891783183.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891783183-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891783183-ja

While looking back through old materials, I found the JPO’s “Toward Strategic Intellectual Property Management” (2007).

I came across this heading:

“Propose research and development themes based on the ‘problem’ sections of other companies’ published patent applications.”

Was this a novel perspective in 2007?

Could we now conduct such research using generative AI?

https://dl.ndl.go.jp/view/prepareDownload?contentNo=1&itemId=info%3Andljp%2Fpid%2F1247684

Originally published: 2025-03-29

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891783183.html

Compilation Copyright — Legal Protection for Works Distributed in Parts over the Internet — The Daily Tear-Off Calendar Case (Takuto Hirasawa, 2009)

Original Ameblo publication: 2025-03-29

Article type: Publication review

Categories: Copyright

Topics: Moral rights

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891783270.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891783270-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891783270-ja

Article / Compilation Copyright — “Legal Protection for Works Distributed in Parts over the Internet — The Daily Tear-Off Calendar Case” (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 24 (2009))

* IP High Court judgment of June 23, 2008

The images were not distributed as a daily tear-off calendar. Instead, once a week, images for nearby dates were excerpted and distributed.

⇒ No infringement of the right to integrity of the compilation work.

Infringement of an “expectation right” was also denied.

* The appellate judgment treated the fact that the photographs constituting the materials had not themselves been altered as one reason for finding no infringement of the right to integrity of the compilation work.

Consent to alterations: the majority view is that it is “valid.”

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol24/24_9.pdf

Originally published: 2025-03-29

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891783270.html

Osaka District Court, 2022 (Wa) 3344 — Method for Producing a High-Purity PTH-Containing Lyophilized Preparation (Takemiya)

Original Ameblo publication: 2025-03-30

Article type: Case note

Categories: Patents

Topics: Claim interpretation, Inventive step, Novelty

First published on this website: 2026-10-16

Case information: 2022 (Wa) 3344

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12891909511.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12891909511-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12891909511-ja

Osaka District Court, 2022 (Wa) 3344 — Method for Producing a High-Purity PTH-Containing Lyophilized Preparation … (Takemiya)

① ★ “Suppressing contact with ozone at 0.1 ppm or less” in Claim Limitation 1C need only be achieved by some method. ⇒ Satisfied.

② ★ Inventive step affirmed on the basis that the purpose differs from the prior art (novelty was not at issue).

* If “suppressing contact with ozone at 0.1 ppm or less” in Claim Limitation 1C is treated as the purpose, and inventive step is upheld because that purpose is absent from the prior art, would it not be inequitable unless satisfaction of the claim is also treated similarly to a labeling-based approach, as with a use invention?

Cf. A comparative examination should be made with Tokyo District Court, 2024 (Yo) 30029, the Age-Related Macular Degeneration case (Presiding Judge Nakashima), which denied patent infringement by finding that the medical-use invention was not worked under an “exclusively” standard and that, on the patentee’s argument that a certain proportion sufficed, novelty would be lacking.

(Excerpts from the judgment)

(1) Satisfaction of Claim Limitation 1C

“Claim Limitation 1C merely specifies suppressing contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility. It does not limit the means to any particular method, and no other claim limitation of the invention contains such a restriction.

Moreover, the specification expressly states that the means for suppressing contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility are not particularly limited. … As examples, it describes suppressing the mobility or flow volume of air around the PTH peptide-containing solution … and replacing the atmosphere around the solution with an inert gas. …

In light of these claim limitations and the specification, the means for suppressing contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility are not limited in Invention 1; achieving that suppression by some method is sufficient. …

In the defendant's method, contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside the sterile injectable-drug manufacturing facility is suppressed during steps including the carrying-in step. The defendant's method therefore satisfies Claim Limitation 1C."

(2) Invalidity / lack of inventive step (novelty was not raised as an issue)

"Difference 1-3

Invention 1 is specified as a method characterized by suppressing contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility, whereas the invention in Exhibit Otsu 1 contains no statement that it is a method characterized by suppressing contact with ozone at 0.1 ppm or less contained in the air inside a sterile pharmaceutical manufacturing facility."

"The invention described in the Otsu 1 publication focuses on sterile transfer and cannot be found to have the purpose of suppressing oxidation of a drug. Certainly, as stated in the claims of that publication, the Otsu 1 invention uses a sterilized 'inert' protective gas (nitrogen), which has an oxidation-suppressing effect. However, this is understood to serve the purpose of transferring the drug in a sterile state. In light of the detailed description of the invention, it is difficult to find that a person skilled in the art would recognize a purpose of suppressing oxidation caused by contact with surrounding air. Even if, as the defendant argues, common general technical knowledge existed that an inert gas such as nitrogen is not a 'sterilized inert protective gas' unless sterilized, and that oxidation of a drug can be prevented by suppressing contact between the drug and surrounding air and filling with an inert gas, the Otsu 1 publication contains no specific statement intended to achieve an oxidation-suppressing effect. It cannot be found to disclose the technical concept of suppressing oxidation by suppressing contact between the drug solution and surrounding air.

Furthermore, … the example in the Otsu 1 publication concerns 'omeprazole sensitive to carbon dioxide.' Considering also that omeprazole is cited not as a drug requiring protection against oxidation but as an example of a drug in an unsealed container that is 'to be transferred in a sterile state,' a person skilled in the art would not be found to understand this as an example of a drug requiring suppression of oxidation caused by contact with surrounding air. Similarly, … the statement that 'Container 2 and its contents need not necessarily be pharmaceutical. Other types of containers filled with liquid or solid chemicals requiring hygienic or non-oxidizing transfer or storage conditions can also be treated by the method of the present invention' should be understood merely as indicating that other types of containers filled with non-pharmaceutical chemicals requiring hygienic or non-oxidizing transfer or similar handling can also be treated by the sterile-transfer method of the Otsu 1 invention.

Even considering the claims, the problems of the prior art, the objectives and effects of the invention, and the examples described in the Otsu 1 publication, the invention focuses on transferring a drug solution in a sterile state. It cannot be regarded as an invention suggesting suppression of oxidation caused by contact between the drug solution and surrounding air."

"The Otsu 1 invention aims to transfer a drug solution in a sterile state and cannot be found to aim at suppressing oxidation caused by contact between the drug solution and surrounding air during the carrying-in step (transport and carrying-in). Accordingly, the … argument premised on that purpose cannot be accepted. Likewise, the … argument that the structure itself inherently performs the function of suppressing contact between the drug and ozone contained in the air inside a sterile pharmaceutical manufacturing facility cannot be accepted. … The Otsu 1 publication contains no description or suggestion of oxidation of the drug solution by ozone. It does state that other types of containers filled with liquid or solid chemicals requiring non-oxidizing transfer or storage conditions can also be treated by the method of the invention. Nevertheless, even on the understanding of a person skilled in the art, this cannot be regarded as stating that the sterile-transfer method of the Otsu 1 invention can be used to prevent oxidation of a drug solution by ozone. Nor, even considering common general technical knowledge before the patent's priority date, can it

be said that a person skilled in the art applying the Otsu 1 invention to manufacture a PTH peptide lyophilized preparation would naturally understand and recognize that its structure also acts to suppress contact between the drug solution and ozone. Specifically, ③ even if it was common general technical knowledge that PTH peptides are readily oxidized …, those publications and other materials do not identify ozone as the cause of oxidation; and ④ even if it was common general technical knowledge that ozone oxidizes methionine and tryptophan …, Exhibit Otsu 10 concerns free amino acids in an environment with an ozone concentration of 1 ppm …, while Exhibit Otsu 11 concerns ranatensin peptide, which differs from PTH peptide in amino-acid sequence and peptide-chain length, under conditions in which the solvent is evaporated in air. These documents therefore do not establish that PTH peptide is oxidized by ozone contained in air. In the first place, … the invention arose not only from the prior-art problem that preparations containing PTH peptide must be particularly pure, but also from the inventors' finding that attempts to manufacture PTH peptide-containing lyophilized preparations industrially produced preparations containing PTH-related substances. The Otsu 1 publication contains no description or suggestion of that problem premised on industrial manufacture, and there are no materials establishing that this finding was common general technical knowledge before the patent's priority date. A person skilled in the art encountering the Otsu 1 publication would therefore not recognize the problem that PTH-related substances are generated during the carrying-in step for PTH-containing lyophilized preparations, and cannot be said to have motivation to suppress contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility. Accordingly, a person skilled in the art cannot be said, on the basis of the Otsu 1 invention and common general technical knowledge, to understand and recognize suppression of contact between the PTH peptide-containing solution and ozone at 0.1 ppm or less contained in the air inside a sterile injectable-drug manufacturing facility. …"

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93485.pdf

Originally published: 2025-03-30

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12891909511.html

Deletion of All Claims Is Permitted in the JPO’s Q&A

Original Ameblo publication: 2025-03-31

Article type: Legal and examination updates

Categories: Patents

Topics: Patent corrections, Examination and appeal practice, Divisional applications

First published on this website: 2026-10-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892033192.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12892033192-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12892033192-ja

A note, although this is hardly new.

Deletion of all claims is permitted in the JPO’s Q&A, and the Trial and Appeal Manual also treats such deletion as a restriction of the scope of claims. I should therefore keep it in mind as a last resort for satisfying the requirement of limiting reduction of claims in the parent-child-grandchild divisional-application problem.

(Note) Q20 of the JPO’s “Q&A on Correction Trials and Requests for Correction” (https://www.jpo.go.jp/faq/yokuaru/shinpan/document/index/03.pdf) answers that a correction deleting all claims is permitted, in the situation where the patentee’s own registered patent has given rise to a violation of Article 39 of the Patent Act. It concerns correction of a registered patent. Section 38-03 of the Trial and Appeal Manual treats deletion of claims, including deletion of all claims, as a restriction of the scope of claims, which is a permitted purpose of correction. The “limiting reduction of claims” requirement referred to above (限定的減縮) is a requirement under Article 17-2(5)(ii) of the Patent Act for amendments made after a final notice of reasons for refusal and in certain other situations.

https://www.jpo.go.jp/faq/yokuaru/shinpan/document/index/03.pdf

Originally published: 2025-03-31

Original Japanese post: https://ameblo.jp/hideki-takaishi/entry-12892033192.html

≪全請求項を削除する訂正≫

Ｑ２０．すでに登録されている自分の特許権により、特許法第３９条違反が発生しました。特許権を放棄しても先願の地位は残るためその違反を回避できません。そこで、その自分の特許権を削除することで回避したいのですが、全請求項を削除する訂正は認められますか。

Ａ２０．認められます。

English translation of the source figure | 1/1

Correction Deleting All Claims — JPO Q&A

Q20. My own already registered patent has caused a violation of Article 39 of the Patent Act. Even if I abandon that patent, its status as an earlier application remains, so the violation cannot be avoided. I therefore wish to eliminate the violation by deleting my own patent. Is a correction deleting all claims permitted?

A20. Yes, it is permitted.

Source: Hideki Takaishi, Ameblo, March 2025 | Figure 12892033192-image1

IP High Court, 2024 (Gyo-Ke) 10002 — Nonwoven Fabric for Civil Engineering Work (Shoji) — Motivation to change the specifications of a publicly worked product

Original Ameblo publication: 2025-04-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892137239.html

IP High Court, 2024 (Gyo-Ke) 10002 — Nonwoven Fabric for Civil Engineering Work (Shoji)

***Motivation exists to change the specifications of a publicly worked product.**

⇒ Inventive step: lacking

(Excerpts from the court's reasoning)

In the nonwoven fabric for civil engineering work of Cited Invention 1, increasing or decreasing the proportion of black fibers colored with carbon black to improve weather resistance, abrasion resistance and light shielding; prevent reflected light from hindering workers; prevent impairment of the landscape; and suitably adjust the clarity of the mottled pattern used to measure the fabric's elongation is merely a matter of design choice for a person skilled in the art. Moreover, as noted above, it was common general technical knowledge at the filing date that, in a nonwoven fabric for civil engineering work combining white fibers with black fibers colored with carbon black, increasing the proportion of black fibers darkens the mottled pattern, facilitating measurement of elongation based on distances between spots, and also improves weather resistance, abrasion resistance and light shielding and suppresses light reflection. Accordingly, there was motivation to increase the proportion of black fibers above 7.5%. …

Even if compliance with the specifications for the 800Z product is required to maintain its identity or quality, developing and manufacturing a new nonwoven fabric product for civil engineering work based on that product with some specifications changed is something naturally undertaken. The fact that the proportion of black fibers is set at a particular value in the 800Z specifications therefore does not establish an inhibiting factor against changing that value. Nor can the fact that the proportion of black fibers specified for the 800Z product is the single-digit figure of 5% be understood as an inhibiting factor against changing it to the double-digit figure of 10%.

Furthermore, …specifying a particular proportion or range for the black fibers is not found to have any particular technical significance, and there was motivation to increase the proportion of black fibers colored with carbon black. Accordingly, no inhibiting factor is found against changing the proportion of black fibers in Cited Invention 1 from the value stated in the above specifications.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93103.pdf

A Revised Edition of the “Trade Secret Management Guidelines” Has Been Published.

Original Ameblo publication: 2025-04-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892193335.html

A Revised Edition of the “Trade Secret Management Guidelines” Has Been Published.

Numerous criminal judgments are cited.

<Management as a Secret>

• Nagoya District Court, March 18, 2022 (2017 (Wa [criminal]) 427)

“Even for criminal measures, the requirements for qualifying as a trade secret are understood to be the same as the civil requirements, including in light of the history of the 2003 amendment to the Unfair Competition Prevention Act.”

For the non-public-knowledge requirement, where information consists of a combination of multiple items, the determination depends on whether it is generally available outside the holder's control, considering such matters as the ease of combination and the time, money and other costs needed to obtain it.

• IP High Court, 2020 (Ne) 10066

Management as a secret should be determined from an objective perspective, including recognizability by employees as a whole, and is not affected by what each individual employee actually understood.

• IP High Court, 2010 (Ne) 10039; Tokyo District Court, December 9, 2022, 2021 (Toku-Wa) 129

Regarding the nature of the information, if it is important to the trade-secret holder and it is obvious to employees that it naturally must be managed as secret, management making use of that employee awareness should be permitted.

• Fukuoka High Court, 2024 (U) 20

Limiting the persons who have contact with the medium does not require strictly examining each employee's business need before granting access. Even if access is broadly granted within a particular department for operational needs or similar reasons, it remains limited to specified employees.

<Usefulness>

• Tokyo District Court, 2021 (Toku-Wa) 129; Tokyo District Court, 2022 (Toku-Wa) 2148

If the information is used or utilized in the business activities of the enterprise holding the trade secret, the need to protect it as a trade secret can basically be affirmed. Unless protection is inappropriate, for example because the information is contrary to public policy or morals, the usefulness requirement is satisfied. The assessment of usefulness is not affected by whether the person who wrongfully acquired the information can put it to effective use.

• Yokohama District Court, July 7, 2021, 2018 (Wa [criminal]) 1931

The purpose of protecting trade secrets under the Unfair Competition Prevention Act is to protect the competitively advantageous position obtainable through legitimately held information in order to prevent unfair competition and maintain competitive order, not to protect special information possessing inventive step. Thus, to qualify as useful technical information, the information need not necessarily produce “unexpected, particularly superior functions and effects.”

<Not Publicly Known>

• Tokyo High Court, 2021 (U) 1407

Information need not produce “unexpected, particularly superior functions and effects” to qualify as not publicly known.

• Nagoya High Court, 2020 (U) 162

The court affirmed that the information was not publicly known because learning it by analyzing a commercially available product required employing a paint manufacturer's knowledge and obtaining cooperation from raw-material manufacturers, among other things, and still took a certain amount of time; it was not information that anyone could easily learn.

• Osaka District Court, 2014 (Wa) 11151 and 2013 (Wa) 13167

The court rejected non-public status because the types and mixing ratios of the alloys used in the plaintiff's products on the market could readily be determined using component analysis, a generally available technical means whose costs were not excessive.

★ 27th Unfair Competition Prevention Subcommittee

List of Main Revisions to the “Trade Secret Management Guidelines”

https://www.meti.go.jp/shingikai/sankoshin/chiteki_zaisan/fusei_kyoso/027.html

https://www.meti.go.jp/policy/economy/chizai/chiteki/guideline/r7ts.pdf

IP High Court, 2021 (Gyo-Ke) 10131 [Sheet-Affixed Structure] <Honda>

Original Ameblo publication: 2025-04-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892273816.html

2021 (Gyo-Ke) 10131 [Sheet-Affixed Structure] <Honda>

*In the primary reference, providing multiple locations has no particular technical significance.

⇒ A single location does not necessarily mean inferior fixing strength (adhesive strength); the desired fixing strength (adhesive strength) can … be provided by appropriately adjusting the size and other aspects of “PSA region 39.”

⇒ Can be appropriately selected

⇒ A matter of design choice

(Excerpt from the court's reasoning)

…Providing “PSA regions 39” at multiple locations in the invention in Exhibit Ko 3-1 is not found to have any particular technical significance. Furthermore, …having “PSA region 39” at “one location” does not necessarily mean lower fixing strength (adhesive strength) than having it at “multiple locations.” The desired fixing strength (adhesive strength) can … be provided by appropriately adjusting the size and other aspects of “PSA region 39” …. Accordingly, …the number of “PSA regions 39” is a matter of design choice that a person skilled in the art can appropriately select by adjusting various factors, including the material, size, weight and hardness of “laminate 30” and the material and size of “PSA region 39” ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91369.pdf

[U.S. Patents] Claim Differentiation and 35 U.S.C. § 112(d)

Original Ameblo publication: 2025-04-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892403149.html

[U.S. Patents] Claim Differentiation and 35 U.S.C. § 112(d)

2024.10 NexStep v. Comcast

The court rejected the claim-differentiation argument that the audio-output limitation in independent claim 4 required “VoIP” in claims 1 and 7 to encompass one-way communication. Claim 4 did not itself recite a VoIP limitation, and the claims also differed in other respects.

2005.07 CAFC en banc Phillips v. AWH Corp.

In claim construction, intrinsic evidence is more reliable than extrinsic evidence.

Dependent claim 2 and independent claim 17 specifically require the baffles to be oriented at an angle to the panel sections and to function to deflect projectiles. As a reason for not adopting the narrow construction, the court noted that, if the baffles of claim 1 were inherently angled, the other claims specifying that feature would be redundant of claim 1.

https://www.cafc.uscourts.gov/opinions-orders/22-1815.OPINION.10-24-2024_2408132.pdf

[U.S. Patents] UTTO v. Metrotech (October 2024, CAFC)

Original Ameblo publication: 2025-04-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892528928.html

[U.S. Patents] UTTO v. Metrotech (October 2024, CAFC)

Plural claim language is presumed to mean more than one, but the presumption is overcome if the specification indicates a different meaning.

⇒ The district court construed “group of buried asset data points” to require “two or more” data points. Noting statements in the specification such as “one or more,” the CAFC held that further examination was required, vacated the dismissal of the patent-infringement claim and remanded for further claim-construction proceedings. It did not decide whether the district court’s construction was correct or establish that the defendant’s product infringed.

https://www.cafc.uscourts.gov/opinions-orders/23-1435.OPINION.10-18-2024_2404584.pdf

IP High Court, 2022 (Gyo-Ke) 10039 [Reservation Support Method] <Honda>

Original Ameblo publication: 2025-04-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892910857.html

2022 (Gyo-Ke) 10039 [Reservation Support Method] <Honda>

*The court identified an “inherent requirement” argued by neither party and found motivation.

⇒ Inventive step: lacking

“To satisfy the inherent requirement, a person skilled in the art would naturally conceive of avoiding a situation in which one continues waiting a long time for a response from the first facility regarding reservation availability.”

(Excerpt from the court's reasoning)

The cited invention and the technology described in Cited Reference 2 belong to the same technical field of facility reservation methods in reservation systems covering multiple facilities. They also share the method of querying a first facility about reservation availability and, if a reply indicating unavailability is received from that facility, extracting other facilities similar to it. …In the cited invention, if the first facility does not send a response about reservation availability for a long time, there is a risk of failing to satisfy the inherent requirement of reserving a facility matching the user's desired conditions before the planned date, or date and time, of use. A person skilled in the art would naturally conceive of avoiding a situation in which one continues waiting a long time for the first facility's response in order to satisfy that inherent requirement. Thus, there is motivation to apply the timeout processing of the technology described in Cited Reference 2 to the cited invention. Applying that timeout processing to the cited invention would result in processing whereby, if no reply is received from the facility terminal within a preset waiting period during which a reply is validly accepted, one or more second facilities other than the first facility are extracted based on the reservation details, and information about those extracted second facilities is sent to the user terminal, just as when the reservation-registration result in the reservation-result information is NG. Accordingly, a person skilled in the art could readily have conceived of the configuration relating to Difference 3 by applying the technology described in Cited Reference 2 to the cited invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91648.pdf

IP High Court, 2017 (Gyo-Ke) 10167 [Laminated Film] <Mori>

Original Ameblo publication: 2025-04-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892910986.html

2017 (Gyo-Ke) 10167 [Laminated Film] <Mori>

*The scope of exclusion under Article 29-2 is broader than the scope that would not constitute added new matter based on the earlier application's specification.

⇒ Different from the generally stated purpose of Article 29-2 of the Patent Act!!

*The difference was that the earlier invention lacked the numerical thickness limitation “0.01–100 μm.”

(Excerpt from the court's reasoning)

The plaintiff argues that Article 29-2 of the Patent Act was established for convenience in examining later applications. Citing the Solder Resist Grand Panel judgment, the plaintiff further argues that its construction of “within the scope of matters described in the specification or drawings” was a determination of the general interpretation of that language in Article 17-2(3), and that, when interpreting “is identical to” the invention in the “specification, claims” “or drawings” under Article 29-2, a defining feature of a later invention can be said to fall within the technical matters derived by comprehensively considering all descriptions in the specification or drawings originally attached to the earlier application only where that feature is self-evident from the descriptions in the specification and other documents originally attached to the earlier application. …Even if the scope of “is identical to” under Article 29-2 … differs from the scope of permitted amendments under Article 17-2(3), this is the result of construing each provision according to its purpose, and no resulting difficulty is found. Thus, there is little reason to adopt the same interpretation as that governing permissible amendments under Article 17-2(3) when determining the requirements for exclusion of a later application by an earlier application under Article 29-2.

<Reference> Commentary on the Patent Act: “If all inventions described in the original specification and drawings—the maximum scope that can be incorporated into the claims by amendment—are given the effect of excluding later applications, the later application can be processed without waiting for either a request for examination or the examination of the earlier application ….”

⇒ According to the generally stated purpose of Article 29-2, the scope of the expanded earlier application is the same as the scope relevant to addition of new matter.

This judgment differs!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87782.pdf

IP High Court, 2014 (Gyo-Ke) 10097 [Flat Nonaqueous Electrolyte Secondary Battery] <Shimizu>

Original Ameblo publication: 2025-04-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12892911085.html

2014 (Gyo-Ke) 10097 [Flat Nonaqueous Electrolyte Secondary Battery] <Shimizu>

*At least five opposing faces are “tantamount to being described” in the earlier specification. +The number of layers is a matter of design choice.

⇒ Violation of the expanded-prior-application rule

(Excerpts from the court's reasoning)

Although the only number of opposing faces between the positive and negative electrode plates specifically stated in Exhibit Ko 1 … is three, the invention in Exhibit Ko 1 is not, in the first place, limited to three opposing faces. It seeks to enlarge the opposing area between the positive and negative electrode plates by stacking them, and it is also clear that increasing the number of stacked positive and negative electrode plates (that is, the number of their opposing faces) simply increases the opposing area proportionally. Thus, Exhibit Ko 1 can be regarded as tantamount to describing not only three opposing faces between the positive and negative electrode plates, but multiple faces, namely two or four or more. Accordingly, Exhibit Ko 1 is found also to describe at least five opposing faces between the active-material-containing layers of said positive and negative electrode plates facing each other through a separator. The number of stacked positive and negative electrode plates (that is, opposing faces) is merely a matter of design choice determined according to the required discharge-capacity level under heavy-load discharge.

…Difference A identified by the trial decision amounts to quantitative differences between the invention at issue and the invention in Exhibit Ko 1 concerning (1) the number of opposing faces and (2) the relative sizes of the opposing area and the gasket opening area. …Both inventions use, as an electrode group in a flat nonaqueous electrolyte secondary battery, a multilayer stack of positive electrode plates having active-material-containing layers on the surfaces of positive electrode constituents and negative electrode plates having active-material-containing layers on the surfaces of negative electrode constituents, with separators interposed, thereby increasing the sum of the opposing areas between the active-material-containing layers of the positive and negative electrode plates and increasing discharge capacity under heavy-load discharge. They thus share the same problem and means of solving it. …The fact that increasing the number of opposing faces beyond five produces little change in heavy-load discharge capacity, and sometimes diminishing capacity, may be unexpected. However, the invention at issue addresses the technical problem of increasing discharge capacity under heavy-load discharge and specifies a lower limit, not an upper limit, on the number of opposing faces. The failure of discharge capacity to increase proportionally with the number of opposing faces therefore cannot be regarded as a new effect of the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84668.pdf

[Trademark] Kobe District Court, 1995 (Wa) 661, “Chafukumame”

Original Ameblo publication: 2025-04-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893042443.html

[Trademark] Kobe District Court, 1995 (Wa) 661, “Chafukumame”

• A coined term

• General consumers encounter the name “Chafukumame” mostly through the plaintiff's and defendant's products.

• With two exceptions, the term “Chafukumame” appears in trade publications as the name of a particular product.

• As many as eight businesses used different names.

⇒ It has not become generic!!

IP High Court, 2016 (Gyo-Ke) 10146 [Method and Compositions for Preparing Antibodies and Antibody Derivatives with Low Core Fucosylation] <Shimizu>

Original Ameblo publication: 2025-04-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893172466.html

2016 (Gyo-Ke) 10146 [Method and Compositions for Preparing Antibodies and Antibody Derivatives with Low Core Fucosylation] <Shimizu>

*A substantial number of examples ⇒ Enablement requirement satisfied

(Excerpt from the court's reasoning)

Even if, as the plaintiff argues, differences in the chemical structures of fucose analogs produce different biological activities, the detailed description in the specification substantiates inhibition of core fucosylation for a substantial number of fucose analogs, and there is no apparent reason to deny this for the other fucose analogs recited in claim 1. It is therefore appropriate to find that the invention can be practiced across its entire scope.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86977.pdf

[Trademark] Osaka District Court, 2013 (Wa) 12788 <Tani> — Registered mark “Raisapo”

Original Ameblo publication: 2025-04-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893309858.html

[Trademark] Osaka District Court, 2013 (Wa) 12788 <Tani>

Registered mark: “Raisapo”

Defendant's mark: “Raisapo Ikeda”

⇒ An abbreviation of “Life Support Network Ikeda,” not trademark use under Article 2(3)(viii) of the Trademark Act.

+Not similar

(Excerpt from the court's reasoning)

In light of how the defendant's mark is actually used, persons viewing the website and encountering it are considered to recognize it as a whole, without extracting “Raisapo” alone, and, as described above, to understand it as referring to an organization based in Ikeda City whose purpose is to support people's daily lives. Consequently, there is no likelihood of misidentification or confusion with the plaintiff's mark consisting only of the characters “Raisapo,” and the two are not similar ….

[Editorial note: The original article image could not be retrieved.]

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84302.pdf

[Article/China and Trade Secrets] Trade Secret Protection in China: Focusing on Academic Views and Court Decisions concerning the Secret-Management Requirement

Original Ameblo publication: 2025-04-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893422734.html

[Article/China and Trade Secrets] Trade Secret Protection in China: Focusing on Academic Views and Court Decisions concerning the Secret-Management Requirement (Yang Jianjun, Intellectual Property Law and Policy Journal, Vol. 44 (2014))

China's “secret-management” requirement was lenient before 2007.

In 2007, the Supreme People’s Court issued a judicial interpretation requiring a finding that the rights holder has taken confidentiality measures where one of the following situations (1)–(7) applies and the measures are sufficient, under normal circumstances, to prevent leakage of the confidential information.

(1) Disclosure of confidential information is restricted, and its contents are communicated only to relevant personnel who need to know.

(2) Protective measures such as locking are applied to media containing confidential information.

(3) Confidentiality markings are placed on media containing confidential information.

(4) Passwords, codes or similar measures are used for confidential information.

(5) Confidentiality agreements are concluded.

(6) Visitor access to machinery, factories, workshops or other facilities involving secrets is restricted, or visitors are required to maintain confidentiality.

(7) Other reasonable measures are taken to ensure confidentiality.

*On September 12, 2020, the Supreme People's Court put into effect the “Provisions on Several Issues concerning the Application of Law in the Trial of Civil Cases Involving Infringement of Trade Secrets,” further developing rules on the elements of trade secrets and the determination of infringement.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2014/03/9290231d65e48330f62497347220ec30.pdf

IP High Court, 2023 (Ne) 10051 [High-Capacity Water Supply System] <Miyasaka>

Original Ameblo publication: 2025-04-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893590074.html

2023 (Ne) 10051 [High-Capacity Water Supply System] <Miyasaka>

In view of the wording “based on the remaining-fuel-level signal” in claim element C … the “remaining-fuel-level signal” is understood to be sent to the “automatic supply pump mechanism,” with that signal automatically providing on/off control of fuel supply and stopping.

⇒ Limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92694.pdf

[Article] Examining the Scope of New Evidence Admissible in Actions to Rescind Trial Decisions: A Classification of Court Decisions (Masanori Takahashi, 2014)

Original Ameblo publication: 2025-04-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893715540.html

[Article] Examining the Scope of New Evidence Admissible in Actions to Rescind Trial Decisions: A Classification of Court Decisions (Masanori Takahashi, Intellectual Property Law and Policy Journal, Vol. 44 (2014))

⇒ Of the five types, only (1), (2) and (5) permit submission of new evidence in an action to rescind a trial decision!!

Knitting Machine, Supreme Court (Grand Bench) judgment of March 10, 1976, Minshu Vol. 30, No. 2, p. 79 (The appeal trial proceedings under the former system correspond to present-day invalidation trial proceedings.)

"In an action to rescind a trial decision, a ground for invalidity based on comparison with publicly known facts that were not examined and determined in the appeal trial proceedings cannot be asserted as a reason for holding the trial decision unlawful or lawful."

(1) State-of-the-art type

Evidence to establish the state of the art for a person skilled in the art at the filing date is, in principle, admissible.

(2) Corroboration type

Evidence clarifying the meaning of technical matters determined in the trial is also, in principle, admissible.

(3) Essential-to-patentability type

Even if intended to corroborate technical matters examined in the trial, evidence concerning matters essential to patentability is inadmissible.

(4) Addition type

Evidence concerning technical matters not determined in the trial is inadmissible.

(5) Nontechnical type

Evidence concerning nontechnical matters among the issues to be examined is admissible.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2014/03/2f4ff70b709527ab2d6cc9f1dc07b39f.pdf

Tokyo District Court, 2012 (Wa) 12351 [Rice Cake] — <Damages> Article 102(2): 90% reduction for noncontribution

Original Ameblo publication: 2025-04-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893715653.html

Tokyo District Court, 2012 (Wa) 12351 [Rice Cake]

<Damages> Patent Act, Article 102(2): 90% reduction for noncontribution (10% contribution) Approximately ¥800 million awarded

(1) Significance of the invention (appearance of grilled rice cakes; suppression of excessive eruption during expansion)

(2) Advertising on the packaging of the defendant's products: indicating “slits made in the cut rice cakes”

(3) The defendant's securities reports and other materials described improved business performance attributable to adding the slits.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85042.pdf

[Article] Agreements Not to Exercise Authors' Moral Rights: A Law-and-Economics Analysis (Nobuko Kawashima, Intellectual Property Law and Policy Journal, Vol. 29 (2010))

Original Ameblo publication: 2025-04-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12893802585.html

[Article] Agreements Not to Exercise Authors' Moral Rights: A Law-and-Economics Analysis (Nobuko Kawashima, Intellectual Property Law and Policy Journal, Vol. 29 (2010))

Nonexercise agreement = an agreement by which an author undertakes not to exercise their own moral rights

Under Japanese law, an author’s moral rights are personal to the author and inalienable (Copyright Act, Article 59). After the author ceases to exist, Article 60 protects moral interests by prohibiting certain conduct; this does not mean that the moral rights themselves continue to subsist.

Recognizing authors' moral rights imposes verification costs on third parties as works circulate from one party to another, but benefits some stars because their works command a premium. (For the many other artists, this new burden worsens compensation and terms.)

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol29/29_7.pdf

[Article] Copyrightability of two-dimensional patterns — Appeal in the Futon Pattern case (Yuanjie Li, Intellectual Property Law and Policy Journal, Vol. 69, 2024)

Original Ameblo publication: 2025-04-15

Article type: Publication review

Category: Copyright

Topics: Copyrightability, Applied art

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HP: https://www.takaishihideki.com/en/single-post/ameblo-12893930031-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12893930031-ja

[Article] Copyrightability of two-dimensional patterns — Appeal in the Futon Pattern case (Yuanjie Li, Intellectual Property Law and Policy Journal, Vol. 69, 2024)

These three cases all denied copyrightability of utilitarian articles bearing two-dimensional patterns:

• Futon Pattern — Osaka High Court, 2022 (Ne) No. 745

• Saga Nishiki Fukuro-Obi — Kyoto District Court, 1985 (Wa) No. 1737

• Chamois — Osaka District Court, 2015 (Wa) No. 9648

In Chateau Katsunuma (IP High Court, 2013 (Ne) No. 10057), copyrightability of a picture on a signboard was denied.

Type 1: Simple patterns combining short text or basic geometric shapes. Copyrightability is often denied.

Type 2: Patterns containing elements depicting real objects with some abstraction. Copyrightability is often recognized.

Type 3: Patterns containing relatively detailed depictions of real objects. Copyrightability is strongly affirmed.

The article proposes a framework for assessing two-dimensional patterns through these three categories and compares its consistency with earlier decisions.

[My comments — Hideki Takaishi]

There are, however, many exceptions; the basis for classification may require further study.

Copyrightability was also denied in the Clock Original Drawing case (Osaka District Court, June 24, 2021). Recognition may be harder when a picture is created for a practical use.

By contrast, copyrightability was affirmed in two T-shirt Illustration cases. The Tokyo District Court’s April 20, 1981 judgment reasoned that expression was not constrained by the practical purpose of printing it on T-shirts. Its September 29, 2023 judgment reasoned that the aesthetic features could be perceived separately from the configuration relating to the practical function of clothing.

Might the result here have differed if the pattern had been created as a painting, rather than for a futon from the outset, and then used as a futon pattern after being presented as a painting? In this case, the design had been drawn and stored as a design proposal for fabric used in mass-produced clothing, and was subsequently selected and acquired for use on futons.

Original AMEBLO article (2025-04-15)

https://ameblo.jp/hideki-takaishi/entry-12893930031.html

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/93511/1/69_06_Ri.pdf

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English translations of the original image text

English key to the original illustrations

AMEBLO article • 15 April 2025

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1 **Figure 1 — Futon patterns**

Left: Plaintiff's pattern (the pattern at issue)
Centre: Defendant's pattern 1
Right: Defendant's pattern 2

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2 **Figure 27**

Left: Plaintiff's design
Right: Defendant's design

---

3 **Figure 28**

Left: Plaintiff's floral pattern
Right: Defendant's floral pattern

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4 **Signboard illustration**

Plaintiff's pattern
Text within the original sign: "Winery / Factory Tour" and "Château Katsunuma".

The original illustrations are retained for comparison. This image translates their Japanese labels.

Original images retained for comparison



原告絵柄
（本件絵柄）



被告絵柄 1



被告絵柄 2

【図 1】



原告図柄



被告図柄

【図 27】



原告花柄



被告花柄

【図 28】



原告絵柄

IP High Court, 2017 (Ne) 10068, “Random Packing” Case <Mori>

Original Ameblo publication: 2025-04-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12894063622.html

IP High Court, 2017 (Ne) 10068, “Random Packing” Case <Mori>

= First instance: Tokyo District Court, 2015 (Wa) 24688 <Shoji>

Comparison: Tokyo High Court, 2003 (Ne) 366, “PC Frame.” That judgment denied qualification as an indication of goods or business, while leaving room for protection after the effects of exclusivity conferred by intellectual property rights have dissipated.

Fifteen to thirty years had passed since expiration of the utility model rights, and third parties had ample opportunity to enter the market.

⇒ Product configuration qualifies as an “indication of goods or business.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87759.pdf

IP High Court, 2014 (Ne) 10080 [Method of Manufacturing Spinel-Type Lithium Manganate] <Shimizu>

Original Ameblo publication: 2025-04-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12894185703.html

IP High Court, 2014 (Ne) 10080 [Method of Manufacturing Spinel-Type Lithium Manganate] <Shimizu>

*A court decision holding a “disclaimer claim” to add new matter

“The specification contains no express description of spinel-type lithium manganate excluding forms ‘substantially containing sodium or potassium in the crystal structure,’ nor can this be said to be self-evident from the description in the specification; therefore, …”

I have the impression that individual patent requirements tend to be assessed more strictly in infringement actions than in actions to rescind trial decisions. Perhaps this is because a value judgment comes into play about whether it is appropriate to grant an injunction on this basis ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85824.pdf

[Article / Copyright] Copyrightability denied for makeup, hairstyling, and the selection and coordination of clothing and accessories in a fashion show, Parts 1–2 (Shun Hashiya, Vol. 47, 2015; Vol. 48, 2016)

Original Ameblo publication: 2025-04-18

Article type: Publication review

Category: Copyright

Topics: Copyrightability, Applied art

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12894521514.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12894521514-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12894521514-ja

[Article / Copyright] Copyrightability denied for makeup, hairstyling, and the selection and coordination of clothing and accessories in a fashion show, Parts 1–2 (Shun Hashiya, Vol. 47, 2015; Vol. 48, 2016)

IP High Court, August 28, 2014 (appeal); Tokyo District Court, July 19, 2013

Both courts rejected the claim that broadcasting portions of video footage of the fashion show infringed copyright or related rights. They denied copyrightability and qualification as protected performances for the models' movements and poses.

The appellate court categorically denied copyrightability of (1) makeup and hairstyles and (2)–(3) combinations of clothing, etc., applying the standards for applied art.

The first-instance court focused on how element (1), makeup and hairstyling, and element (7), background footage, appeared: the scenes were brief and strongly lit, preventing the details from being perceived; the background footage was also brief and blurred, making its specific content difficult to discern.

A related precedent is Setsugekka: Tokyo District Court, October 27, 1999, and Tokyo High Court, February 18, 2002. Copyright infringement was denied because the calligraphic work's creative expression —the shading and dryness of the ink and the vigor of the brushwork—was not reproduced in the captured image.

Original AMEBLO article (2025-04-18)

https://ameblo.jp/hideki-takaishi/entry-12894521514.html

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https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2016/10/be20ef6bd9b58f92369e3b79c97440fb.pdf

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English translations of the original image text

English translation of the original table

<table>
<tr><th></th><th>Subject matter</th><th>First instance</th><th>Appeal</th></tr>
<tr><td rowspan="6">Copyright-ability</td><td>① Makeup and hairstyle</td><td>Commonplace and lacking creativity. Both the makeup and hairstyles are commonplace; from a moving video lasting only a few seconds, no ingenuity in the details can be discerned.</td><td>Applied art lacking aesthetic characteristics independent of its practical purpose. The author, if any, would be the hair and makeup artist, not Plaintiff A.</td></tr>
<tr><td>②③ Combination of clothing and accessories</td><td>Commonplace.</td><td>Applied art lacking aesthetic characteristics independent of its practical purpose.</td></tr>
<tr><td>④⑤ Poses and choreography</td><td colspan="2">Not particularly novel.</td></tr>
<tr><td>⑥ Combination of the above [①–⑤]</td><td colspan="2">A combination of elements lacking creativity, with no new impression that could be described as an expression of the creator’s individuality.</td></tr>
<tr><td rowspan="2">⑦ Order of appearance and background images</td><td colspan="2">There is no creativity in the models’ order of appearance, and the videos each show a different order.</td></tr>
<tr><td>The photographs used as background images are blurred, and their specific content cannot be ascertained from a moving video lasting only a few seconds.</td><td>The photographers of the background photographs are unknown, and an assignment of copyright from the authors to the plaintiffs is not established. There is no creativity in the selection of photographs.</td></tr>
<tr><td>Performance</td><td>Direction of choreography
Models’ poses and movements
Fashion show as a whole</td><td colspan="2">Since ④⑤ above are not works protected by copyright, the direction of choreography and the models’ poses and movements do not constitute performing copyrighted works and therefore do not constitute performances. Nor does the fashion show as a whole fall within “acts that are not performances of works but have a nature of performing arts.”</td></tr>
</table>

(Editor's transcription and correction of the figure above)

Fashion Show Case: Summary of the Reasoning at First Instance and on Appeal

Subject matter	First instance	Appeal
Copyright infringement: ① Makeup and hairstyling	The makeup and hairstyles are commonplace and do not express the creator’s individuality. Even if details are creative, their ingenuity cannot be perceived in moving footage lasting only a few seconds; the broadcast does not make the creative expression perceptible.	Applied art lacking aesthetic features independent of its practical purpose. Even if copyrightable, the author would be the hair and makeup artist, rather than Plaintiff A.

Subject matter	First instance	Appeal
Copyright infringement: ②③ Selection and combination of clothing and accessories	Commonplace combinations lacking creativity.	Applied art lacking aesthetic features independent of its practical purpose.
Copyright infringement: ④⑤ Choreography of poses and movements to remove clothing	The poses and movements are not particularly novel for fashion-show models and do not express the creator’s individuality.	The poses and movements are not particularly novel for fashion-show models and do not express the creator’s individuality.
Copyright infringement: ⑥ Combination of ①–⑤	The individual elements lack creativity or their creative expression is not perceptible in the broadcast. Their combination creates no new impression expressing the creator’s individuality.	For each element, Plaintiff A is not established to be its author or copyrightability is absent. Their combination creates no new impression expressing the creator’s individuality.
Copyright infringement: ⑦ Models’ order of appearance	The order of appearance lacks creativity. The broadcast footage presents scenes in a different order from the show; even if the original order were creative, its creative expression is not conveyed by the broadcast.	The order of appearance lacks creativity. The broadcast footage presents scenes in a different order from the show; even if the original order were creative, its creative expression is not conveyed by the broadcast.
Copyright infringement: ⑦ Photographs in the background footage	The photographs are blurred, and their specific content cannot be perceived in moving footage lasting only a few seconds. The broadcast does not make the creative expression perceptible.	The photographers are unknown, and an assignment of copyright to the plaintiffs is not established. The selection of photographs also lacks creativity.
Performance: Direction of choreography; models’ poses and movements; the fashion show as a whole	Since ④⑤ are not copyrightable works, the models’ poses and movements do not constitute performing works and are not protected performances. Nor is the fashion show as a whole established to be an act that does not perform a work but nevertheless has the nature of performing arts.	Since ④⑤ are not copyrightable works, the models’ poses and movements do not constitute performing works and are not protected performances. Nor is the fashion show as a whole established to be an act that does not perform a work but nevertheless has the nature of performing arts.

Original images retained for comparison

<table>
<tr><th></th><th>事案</th><th>第一審</th><th>控訴審</th></tr>
<tr><td rowspan="6">著作物性</td><td>①化粧・髪型</td><td>一般的なもので創作性なし。
化粧・髪型自体いずれも一般的なもので、わずか数秒間の動きのある映像からは、細部の工夫は見て取れず。</td><td>応用美術であり実用目的を離れた美的特性なし。
著作者になれるのは、原告Ａではなく、ヘアメイク担当者。</td></tr>
<tr><td>②③衣装等の組み合わせ</td><td>ありふれたもの。</td><td>応用美術であり実用目的を離れた美的特性なし。</td></tr>
<tr><td>④⑤ポーズ・動作の振り付け</td><td colspan="2">特段目新しいものではない。</td></tr>
<tr><td>⑥上記［①～⑤］の組み合わせ</td><td colspan="2">創作性のないものの組み合わせであり、作成者の個性の表出というべき新たな印象もない。</td></tr>
<tr><td rowspan="2">⑦出演順序・背景映像</td><td colspan="2">モデルの出演順序に創作性はなく、映像はそれと順不同。</td></tr>
<tr><td>背景映像の写真はぼやけており、動きのあるわずか数秒間の映像からは具体的な内容は不明。</td><td>背景映像の写真は撮影者不明であり、原告らが著作権譲渡を受けているとは認められず。写真の選択にも創作性なし。</td></tr>
<tr><td>実演該当性</td><td>振り付けの演出
モデルのポーズ・動作
ファッションショー全体</td><td colspan="2">上記④⑤が著作物でない以上、振り付けの演出やモデルのポーズ・動作は著作物を演ずることに当たらず、実演には当たらない。ファッションショー全体は、「著作物を演じないが芸能的な性質を有するもの」にも当たらない。</td></tr>
</table>

[Article / Copyright] Including tweets in a book held to be lawful quotation under Copyright Act Article 32(1) — #KuToo case (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 66, 2022)

Original Ameblo publication: 2025-04-20

Article type: Publication review

Category: Copyright

Topics: Quotation, Moral rights, Defamation

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Case information: Tokyo District Court, 2020 (Wa) No. 19351

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12895471779-ja

[Article / Copyright] Including tweets in a book held to be lawful quotation under Copyright Act Article 32(1) — #KuToo case (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 66, 2022)

Tokyo District Court, 2020 (Wa) No. 19351

The tweet's '#kutoo' was reproduced in the book as '#KuToo.' This was a typographical error: it neither defeated the quotation exception nor infringed the right of integrity.

(Excerpt, translated)

Even if expressions such as 'a strange person' and 'suddenly glitches on Twitter' offended the plaintiff's feelings of personal honor, these statements may be understood as conveying the following point: although the movement concerned women's footwear, the tweet criticized it by citing the extreme and unrelated example of men going to work in swimming trunks, and its point—including its use of 'conversely'—departed from ordinary perceptions and was difficult to understand.

Even if some expressions offended the plaintiff's feelings of personal honor, they did not constitute insults exceeding socially acceptable limits. No tort was established.

The article examines numerous decisions on the framework for lawful quotation. It further analyzes the framework through the subordinate relationship of the quoted work to the quoting work, conformity with fair practice, and whether the extent is justified by the purpose of quotation.

Original AMEBLO article (2025-04-20)

https://ameblo.jp/hideki-takaishi/entry-12895471779.html

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2023/01/a3e282d83467198b837c5deee97e9e97.pdf

LinkedIn

https://www.linkedin.com/feed/update/urn:li:activity:7516365067999744000/

English translations of the original image text

Figure 1. Frameworks for assessing Article 32(1) in decisions after the Art Appraisal Report case[10]

English translation

Framework	Quotation rejected	Quotation accepted	Total	Decisions
Comprehensive assessment standard	3	2	5	New Okayama Internationalization Promotion Plan pamphlet (accepted); Art Appraisal Report II (accepted); Fūsui Kō (sender information disclosure) (rejected); Okinawa Urizun no Ame, first instance (rejected); same case, appeal (rejected)
Two requirements	0	1	1	Penguin Parade (sender information disclosure) (accepted)
Subordinate relationship rejected without stating the two requirements	5	0	5	Website post (sender information disclosure) (rejected); Ameba blog (sender information disclosure) (rejected); Flavor Liquid (sender information disclosure) (rejected); Yū Kurokku (sender information disclosure) (rejected); Twitter screenshot post (sender information disclosure) (rejected). Note: Includes decisions rejecting the justified-extent requirement because no subordinate relationship was found.
Two requirements incorporated into the "quotation" requirement	1	1	2	#KuToo (accepted); Disciplinary Complaint, first instance (rejected)
Other	39	6	45	Decisions stating no requirements; decisions presenting the wording of Article 32(1) as the requirements; decisions rephrasing "to the extent justified by the purpose" as an extent reasonable in light of prevailing social norms; and others.
Total	48	10	58	

(Editor's transcription and correction of the figure above)

Figure 1. Frameworks for Assessing Article 32(1) in Decisions after the Art Appraisal Report Case[10]

English translation (numbers of decisions)

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Two requirements incorporated into the	1	1	2	#KuToo (accepted); Disciplinary Complaint, first instance (rejected)

Framework	Quotation rejected	Quotation accepted	Total	Decisions
"quotation" requirement				
Other	39	6	45	Decisions stating no requirements; decisions presenting the wording of Article 32(1) as the requirements; decisions rephrasing "to the extent justified by the purpose" as an extent reasonable in light of prevailing social norms; and others.
Total	**48**	**10**	**58**	

Figure 2. Reasons for denying application of Article 32(1)[11]

English translation

Requirement or relationship rejected	Number of decisions	Principal decisions
To the extent justified	13	
"To the extent justified" and "compatible with fair practice"	21	Fūsui Kō (sender information disclosure); Photograph of Soka Gakkai executives' meeting (sender information disclosure); Disciplinary Complaint, first instance.
"To the extent justified" and "quotation"	1	5channel article (sender information disclosure).
"To the extent justified," "compatible with fair practice," and "quotation"	1	Itchiku Tsujigahana.
"Purpose of quotation" and "to the extent justified"	1	Life and Opinions.
"Compatible with fair practice"	2	Okinawa Urizun no Ame, first instance; same case, appeal.
"Quotation"	3	
Subordinate relationship	2	Ameba blog (sender information disclosure); Yū Kurokku (sender information disclosure).
"Made public"	3	Disciplinary Complaint, appeal.
"Made public," "to the extent justified," and "compatible with fair practice"	1	Disciplinary Complaint, first instance.
Total	48	

Original images retained for comparison

図１　美術鑑定書以降における裁判例の32条１項の判断枠組み[10]

	引用否定	引用肯定	合計	判　　決
総合考慮型の規範	3	2	5	新おかやま国際化推進プランパンフレット（肯定）、美術鑑定書Ⅱ（肯定）、風水甲（発信者情報開示）（否定）、沖縄うりずんの雨一審（否定）、同控訴審（否定）
二要件	0	1	1	ペンギンパレード（発信者情報開示）（肯定）
二要件を提示せず主従関係を否定	5	0	5	ウェブサイト投稿記事（発信者情報開示）（否定）、Amebaブログ（発信者情報開示）（否定）、フレーバーリキッド（発信者情報開示）（否定）、ゆーくろっく（発信者情報開示）（否定）、ツイッタースクリーンショット投稿（発信者情報開示）（否定） ※主従関係を否定して正当な範囲要件を否定している裁判例含む
「引用」要件に二要件組み込み	1	1	2	＃KuToo（肯定）、懲戒請求書一審（否定）
その他	39	6	45	要件を提示しないもの、32条１項の文言を要件として提示するもの、「目的上正当な範囲内」を社会通念に照らして合理的な範囲内のものであると言い換えているもの等
合計	48	10	58	

図２　32条１項の適用を否定した裁判例が同項の適用を否定した理由[11]

	裁判例数	主な裁判例
「正当な範囲内」要件を否定	13	
「正当な範囲内」「公正な慣行に合致」要件を否定	21	風水甲（発信者情報開示）、創価学会幹部会写真掲載（発信者情報開示）、懲戒請求書一審
「正当な範囲内」「引用」要件を否定	1	５ちゃんねる記事（発信者情報開示）
「正当な範囲内」「公正な慣行に合致」「引用」要件を否定	1	一竹辻が花
「引用の目的」「正当な範囲内」を否定	1	生活と意見
「公正な慣行に合致」要件を否定	2	沖縄うりずんの雨一審、同控訴審
「引用」要件を否定	3	
主従関係を否定	2	Amebaブログ（発信者情報開示）、ゆーくろっく（発信者情報開示）
「公表された」要件を否定	3	懲戒請求書控訴審
「公表された」「正当な範囲内」「公正な慣行に合致」要件を否定	1	懲戒請求書一審
合　計	48	

[Article/Copyright] Ownership of Rights concerning Unknown Methods of Exploitation — The Kaiketsu Lion-Maru Case (Kazuhiro Ando, Intellectual Property Law and Policy Journal, Vol. 26, 2010)

Original Ameblo publication: 2025-04-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12895752550.html

[Article/Copyright] Ownership of Rights concerning Unknown Methods of Exploitation — The Kaiketsu Lion-Maru Case (Kazuhiro Ando, Intellectual Property Law and Policy Journal, Vol. 26, 2010)

*Tokyo High Court, 2002 (Ne) 5907 (Kaiketsu Lion-Maru case)

The court held that a contract assigning “broadcasting rights” for ¥10 million did not cover rights to broadcast by satellite, a method that had not yet entered practical use when the contract was concluded.

*Tokyo District Court, 2006 (Wa) 1769 (THE BOOM case)

The court held that an agreement to assign exclusively and without restriction all rights held in the master recordings also covered the phonogram producer’s “right to make transmittable,” which did not exist when the agreement was concluded.

⇒ As to the relationship with the Kaiketsu Lion-Maru case, that case concerned a partial assignment of copyright, not a comprehensive assignment of all rights, so the method and substance of interpreting the parties' intentions naturally differed.

*Tokyo District Court, 2006 (Wa) 8752 (HEAT WAVE case)

“Whether ‘all rights (including the plaintiffs’ neighboring rights)’ in Article 4 of the agreement include performers’ right to make transmittable should be determined in accordance with the method of contractual interpretation, by considering comprehensively … the relevant circumstances, including the adequacy of the consideration.”

⇒ The court held that it also included the “right to make transmittable,” which did not exist at the time of the contract.

https://eprints.lib.hokudai.ac.jp/repo/huscap/all/43627/26_257-291.pdf

[Article/Unfair Competition Prevention Act] Trends in Regulation of Dead Copies of Product Configuration — Evaluating Legislative Amendments and Case Law in Light of the Purpose of the System (Yoshiyuki Tamura, Intellectual Property Law and Policy Journal, Vol. 25, 2009)

Original Ameblo publication: 2025-04-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12895914689.html

[Article/Unfair Competition Prevention Act] Trends in Regulation of Dead Copies of Product Configuration — Evaluating Legislative Amendments and Case Law in Light of the Purpose of the System (Yoshiyuki Tamura, Intellectual Property Law and Policy Journal, Vol. 25, 2009)

*Tokyo District Court, November 27, 2002, [Belluna/Ryu Ryu] case

⇒ Clothing identical in configuration apart from having its sleeves cut off was held to fall under Article 2(1)(iii) of the Unfair Competition Prevention Act.

(1) “Ordinarily possessed configuration”

*Tokyo District Court, March 30, 2005, [Frilled Cut-and-Sewn Top] case

⇒ Applying the pre-2005 “ordinarily possessed configuration” provision, the district court denied protection because it considered the combination of existing, publicly known product configurations easy to produce. The appellate court reversed.

(2) Imitation of a part

*Tokyo District Court, May 24, 2005, [Footrest for Precast Manholes] case

⇒ Even a part is treated as equivalent to imitation of the whole if it can be traded as a standalone product.

— Osaka High Court, 2003 (Ne) 3575, [Sekisui House]. The article argues that, because the front of a house is particularly important, copying the front may be treated as copying the whole. The court considered the rear, sides and overall configuration as well as the front, and rejected substantial identity.

(3) Imitation of the interior

⇒ In the Drain Hose case (Osaka District Court, November 28, 1996) and the Small Shoulder Bag I case (Tokyo High Court, September 26, 2001), the two decisions discussed in the article excluded internal structures not observed in ordinary transactions from “product configuration.”

(4) Color, luster and texture

The 2005 amendment expressly included “color, luster and texture” in the definition of product configuration. In discussing the interpretation of that provision, the article refers to the NuBra case (Osaka High Court, April 19, 2006, 2005 (Ne) 2866), which denied protection because of differences in texture.

— Even after the amendment, the Osaka District Court, 2007 (Wa) 8262, [Cosmetic Container] case rejected substantial identity because of differences in luster and color.

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/43612/1/25_33-65.pdf

[Article/Portrait Rights] Copyrightability of Snapshot Portrait Photographs and Whether They May Be Freely Used: The Tokyo Outsiders Case (2010)

Original Ameblo publication: 2025-04-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12896288084.html

[Article/Portrait Rights] Copyrightability of Snapshot Portrait Photographs and Whether They May Be Freely Used: The Tokyo Outsiders Case (Atomu Takase, Intellectual Property Law and Policy Journal, Vol. 32 (2010))

*IP High Court, 2007 (Ne) 10003

A photograph taken by a former wife showing her husband and their child was used in a book describing the husband after the portion showing the child was cropped out.

⇒ Copyright infringement

Even everyday snapshots are copyrightable.

The copyright belongs to the former wife, who took the photograph.

Even assuming the defendants' account that the person who supplied the photograph had said it could be used freely, the court found negligence because they had made no effort to identify the copyright holder and obtain permission to publish it.

Because it was not a work that had been made public, it did not qualify as quotation.

Infringement of the right of attribution

Infringement of the right of integrity

⇒ Even an everyday snapshot may be protected if it is original. Being the subject of the photograph does not, by itself, entitle a person to use it freely.

Even when using a photograph of oneself, one should check the rights involved, obtain any necessary permission from the photographer or other rights holder, or use a self-taken photograph.

Cf. Cases in which "negligence" was rejected

• An academic book published following a proposal brought in by its creator (Medical Faculty Assistant Name Omission case: Chiba District Court, February 19, 1979; Tokyo High Court, September 10, 1980)

⇒ It would be harsh to require publishers to conduct a strict investigation into rights when publishing academic books with low profitability.

• A book on sports medicine (Guutara Kenkoho case: Tokyo District Court, May 31, 1995)

⇒ The infringer was a physician well known in Yamanashi Prefecture, and the defendant publisher was a small local publisher.

• A separate case in which the plaintiff's work had a certain print run and had been featured in magazines, but was not found to be a widely known book ("Konenki kara no Suteki Diet" case: Tokyo District Court, July 17, 1998).

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol32/32_8.pdf

IP High Court, 2022 (Gyo-Ke) 10084 [Therapeutic Agent for Severe Heart Failure] <Honda>

Original Ameblo publication: 2025-04-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12896667332.html

2022 (Gyo-Ke) 10084 [Therapeutic Agent for Severe Heart Failure] <Honda>

*It is permissible to assess obviousness by treating differences in target patients and differences in dosage and administration as separate differences.

*Although the patient group was limited, a known diuretic with the same mechanism of action had also been administered to that group. In light of this and the other evidence, the claimed patient selection and administration regimen were held obvious.

(Excerpts from the court's reasoning)

When considering a therapeutic drug's dosage, differences in target patients and treatment should naturally be taken into account. In identifying differences between a patented therapeutic-drug invention and a cited invention, once differences concerning target patients or treatment have been identified, there is no need to identify them again as part of a dosage difference encompassing those patients or treatment. Accordingly, the trial decision did not err in identifying only the daily dosage of tolvaptan as Difference 2, separately from Difference 1 described above. …

(Summary of the court’s reasoning follows) The patented invention differs from the invention in Exhibit Ko 2 in being specified as a therapeutic agent for severe heart failure whose oral administration is initiated in hospitalized NYHA class IV patients (Difference 1), and in specifying the daily dosage of the active ingredient as within a range of 0.371 mg/kg or less (Difference 2).

However, regarding Difference 1, at the priority date diuretics were widely used regardless of acute or chronic heart failure or its severity. Diuretics with the same mechanism of action as tolvaptan were also administered to NYHA class IV patients. Thus, there was ample motivation to use the tolvaptan of the invention in Exhibit Ko 2, effective for NYHA class I–III patients, including patients who cannot immediately be regarded as nonsevere, to treat NYHA class IV patients. No inhibiting factor is identified, and this could readily have been conceived. Further, whether the patient is hospitalized when the drug is administered can hardly be called a substantive difference. Moreover, given how tolvaptan was used at the priority date, oral administration was a matter that a person skilled in the art could appropriately adopt. Difference 2 likewise concerns a dosage substantially identical to the dose of 30 mg once daily used in the trial in Exhibit Ko 2. Setting the daily dosage within 0.371 mg/kg or less cannot be said to have critical significance, and adopting that range in light of Exhibit Ko 2 and common general technical knowledge was something that could appropriately be done. …

...Diuretics were widely used to treat fluid retention, congestion, edema and other symptoms of heart failure, regardless of whether it was acute or chronic, severe or mild-to-moderate. Furthermore, because the examples in the above argument include heart-failure treatments other than diuretics, they cannot be read as stating that diuretics should be treated differently because a patient is NYHA class IV. In addition, the trial in the patent included a mixture of NYHA class III and IV patients, and the number of deaths among class IV patients alone is not disclosed, so the effect on NYHA class IV patients is unknown.

https://t.co/rqqfJE7Sn3

IP High Court, 2018 (Gyo-Ke) 10094 [System for Characterizing a Stenosis in a Fluid-Filled Vessel] <Mori>

Original Ameblo publication: 2025-04-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12897171276.html

2018 (Gyo-Ke) 10094 [System for Characterizing a Stenosis in a Fluid-Filled Vessel] <Mori>

*Even if accurate measurement is not necessarily possible, this is not an issue of clarity (although enablement or support may be at issue)!!

[Claim 1] … A system … comprising a first measurement sensor … taking instantaneous pressure measurements at various locations along said vessel without maximal hyperemic conditions ….

(Excerpts from the court's reasoning)

In the claimed invention, “without maximal hyperemic conditions” means not being in a state in which blood flow has been maximally increased by administering a drug, and “instantaneous pressure measurements” means … measuring the value at an instant …. …Their meanings are unambiguously clear …. …

Certainly, …examining the blood-pressure ratio calculated from those measurements may not necessarily allow the presence or location of a stenosis in a vessel to be accurately identified. Even so, depending on the degree of stenosis and the measurement method, identifying its presence or location cannot be said to be wholly impossible, so the claimed invention cannot be regarded as entirely meaningless. Moreover, although the enablement requirement … or support requirement … might be at issue from that perspective, those matters were not examined in the trial and therefore cannot be examined in this litigation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88667.pdf

[Freedom to Choose One's Occupation] IP High Court, 2022 (Ne) 10059 <Honda>

Original Ameblo publication: 2025-04-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12897551043.html

[Freedom to Choose One's Occupation] 2022 (Ne) 10059 <Honda>

*Post-contract restrictions imposed by a talent agency were held contrary to public policy and morals!!

Former members of a band (the first-instance plaintiffs) alleged that, after their exclusive management agreement with their agency (the first-instance defendant company) ended, the agency obstructed their use of the band/group name and continuation of their activities.

1. Invalidity of the Noncompetition Clause

The court held invalid a clause that, for six months after termination, prohibited entering into performance-related contracts without the agency’s consent. The clause restricted the former members’ freedom to choose their occupation or conduct business, and the restriction lacked a rational basis, including in relation to the claimed recovery of upfront investment. The court therefore found it contrary to public policy and morals.

2. Rights in the Band Name

The court held that the members could exercise publicity rights in the band name, and denied the agency any authority after termination to exercise exclusive rights of use or performers’ moral rights (the right of attribution) in that name. It was also undisputed that the agency held no trademark rights in the band name when it made the notices and requests at issue.

3. Copyright in Photographs

The court also rejected the claim that copyright in the photograph at issue belonged to the agency, holding that the copyright belonged to C, the photographer.

4. Illegality of the Agency's Obstructive Acts

The agency's acts of obstructing the plaintiffs' activities through notices and requests containing false information constituted a tort.

5. Damages

¥990,000 for each of the four plaintiffs (¥3,960,000 in total), plus delay damages. Each award comprised ¥700,000 in pecuniary damages, ¥200,000 for emotional distress and ¥90,000 in attorney fees. Pecuniary loss was assessed at ¥884,288 per plaintiff, but recovery was limited to the ¥700,000 partial claim made by each.

(Excerpts from the court's reasoning)

The first-instance defendants argue that the clause was included to recover upfront investment. However, what appeals to the first-instance plaintiffs' consumers (their fans) is the plaintiffs' performances and the like, not those of other performers affiliated with the first-instance defendant company. Thus, restricting the plaintiffs' performance activities under the clause would not generate profits for the company and thereby achieve the purpose of recovering its upfront investment. There is no relationship between restricting the plaintiffs' activities under the clause and recovering the company's upfront investment. Further, even assuming that the company needed to recover upfront investment and that the plaintiffs bore some responsibility in that regard, a monetary resolution would be possible by such means as distributing profits generated by the plaintiffs' performance activities. That need therefore does not justify restricting the plaintiffs' activities after termination of the exclusive agreement. (In addition, by July 13, 2019, when the exclusive agreement was terminated by mutual consent, approximately nine years had elapsed since its conclusion on August 1, 2010, and approximately seven years even from July 2012, when all of the plaintiffs had joined the group. The agreement had also been renewed several times (Undisputed Facts (2)).

In these circumstances, the company would naturally be considered to have already recovered its upfront investment.)

Accordingly, without considering the remaining points, the restrictions imposed by the clause lack any rational basis. It is therefore appropriate to construe the clause as invalid for violating public policy and morals.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91677.pdf

[Copyright] IP High Court, 2021 (Ne) 10048 <Otaka>

Original Ameblo publication: 2025-04-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12897705229.html

[Copyright] 2021 (Ne) 10048 <Otaka>

*Copyright infringement (reproduction and adaptation rights) concerning a workbook explaining meeting methods was rejected.

The slogan “Meetings change. The company changes.” is not copyrightable.

“The commonalities between the overall structure of the plaintiff's workbook and that of the defendant's handout are the ideas themselves of what items to address in a meeting and in what order, not expression itself.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90658.pdf

[Unfair competition] IP High Court, 2019 (Ne) No. 10002 (Judge Otaka)

Original Ameblo publication: 2025-04-28

Article type: Case note

Categories: Unfair competition law

Topics: Indications of goods or business, Confusion

First published on this website: 2026-10-16

Case information: 2019 (Ne) No. 10002

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12898039255.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12898039255-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12898039255-ja

[Unfair competition] IP High Court, 2019 (Ne) No. 10002 (Judge Otaka)

A violation of Article 2(1)(i) of the Unfair Competition Prevention Act was found for products whose customers were healthcare professionals.

Although many cases find that healthcare professionals will not be confused, confusion was found here because the products were consumables sold through online shops.

The first-instance judgment, 2018 (Wa) No. 13381 (Judge Yamada), also recognized a well-known indication of goods or business and similarity, but denied confusion. The appellate court found confusion and granted an injunction against transfer and related acts, together with disposal of the products.

1. Well-known indication of goods or business

The product had distinctive features differentiating it from others of the same kind and had been sold for 34 years.

2. Similarity

‘Differences in the colors of the lettering, graduations, etc. on the drainage and suction bottles are differences within the same blue color family. Viewed as a whole, they are merely differences in detail.’

3. Confusion

‘Both products are consumable medical devices with the same sales channels. If healthcare professionals encounter the defendant’s product shape, which extremely closely resembles the plaintiff’s, through product images in medical-equipment catalogs or online shops, they may mistakenly believe that the products originate from the same source. The appellee’s sale of the defendant’s products is therefore found to constitute conduct causing confusion with the plaintiff’s products.’

Original AMEBLO article (2025-04-28)

https://ameblo.jp/hideki-takaishi/entry-12898039255.html

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88902.pdf

LinkedIn

https://www.linkedin.com/feed/update/urn:li:activity:7516366546873540608/

English key to the product photographs

AMEBLO article • 28 April 2025

Photograph 1 — Front view

Left: Plaintiff’s product
Right: Defendant’s product

Measurements shown in the original photograph:

Plaintiff: ① 130 mm; ② 59 mm; ③ 183 mm; ④ 69 mm; ⑤ 50 mm.

Defendant: ① 130 mm; ② 59 mm; ③ 183 mm; ④ 70 mm; ⑤ 50 mm.

Photograph 2 — Bottom view

Left: Plaintiff’s product
Right: Defendant’s product

Measurements shown in the original photograph:

Plaintiff: ⑥ 59 mm; ⑦ 60 mm; ⑧ 35 mm.

Defendant: ⑥ 60 mm; ⑦ 60 mm; ⑧ 35 mm.

Visible Japanese product labels

排液ボトル — Drainage bottle

吸引ボトル — Suction bottle

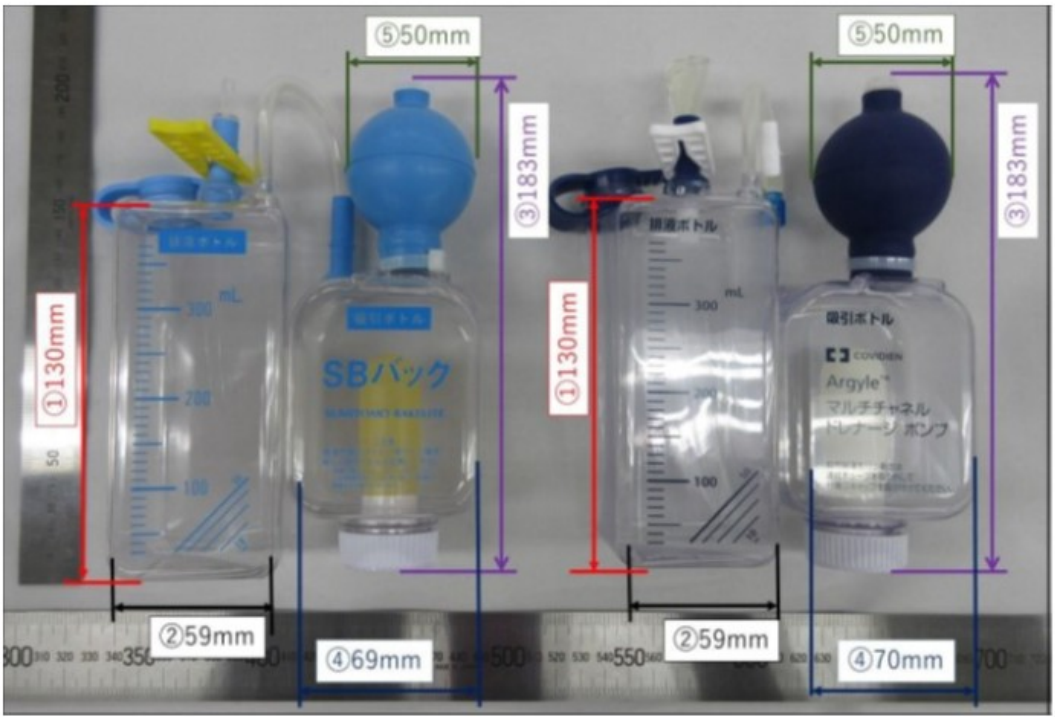
SBバック — product name “SB Back” as written on the bottle

マルチチャネル ドレナージ ポンプ — Multichannel drainage pump

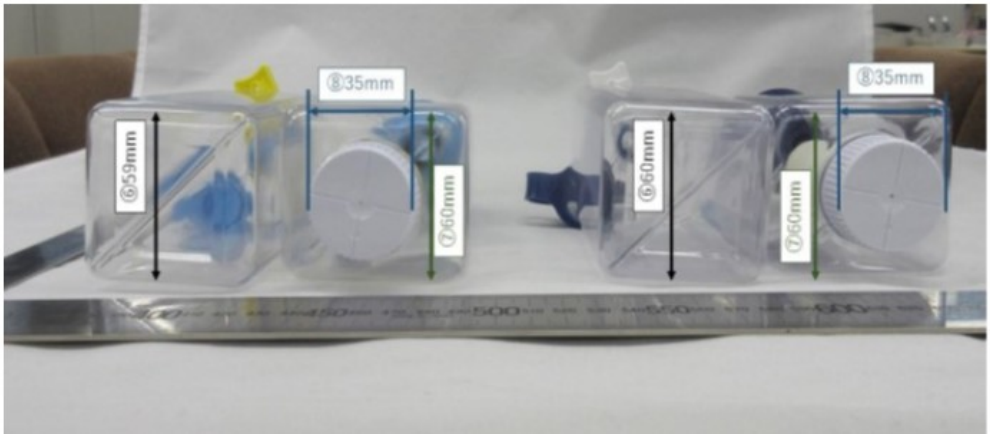
Original photographs, product lettering, shapes and measurement marks are retained for comparison.

Original images retained for comparison

（左：原告商品、右：被告商品）



底面 （左：原告商品、右：被告商品）



[Unfair Competition Prevention Act/Trade Secrets] IP High Court, 2017 (Ne) 10076 <Takabe>

Original Ameblo publication: 2025-04-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12898624499.html

[Unfair Competition Prevention Act/Trade Secrets] 2017 (Ne) 10076 <Takabe>

⇒ Although the documents were marked “Confidential,” a duty of care to investigate wrongful disclosure or similar acts (gross negligence) was rejected.

“It cannot be said that the appellee could have known that a confidentiality agreement existed between the appellant and its business partner or that the documents were covered by that agreement. The numbers of short lamps stated in the documents cannot be regarded as information whose mere disclosure to the appellee would cause the appellant serious disadvantage. Nor does it appear that, when acquiring the documents, the appellee encountered any facts apart from the ‘Confidential’ markings that should have raised suspicion that the information was secret. In light of these circumstances, the ‘Confidential’ markings on the documents cannot immediately be said to indicate that they were subject to a duty of confidentiality. Accordingly, those markings alone do not establish that, when acquiring the documents, the appellee had a transactional duty of care to entertain serious doubts about wrongful disclosure or similar acts and investigate and verify the matter. The appellant's argument cannot be accepted.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87414.pdf

[Contract] Tokyo District Court, 2023 (Wa) 70722 <Nakashima>

Original Ameblo publication: 2025-05-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12899005669.html

[Contract] 2023 (Wa) 70722 <Nakashima>

"Termination by agreement during the contract term" in an exclusive management agreement does not mean waiver of the right to terminate under Civil Code Article 651(1).

Even assuming that "the plaintiffs were negotiating with other agents during the contract term," that would not justify restricting exercise of the right to terminate a mandate agreement.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93212.pdf

⇒ Termination of the contract between the couple YouTubers and the talent management company was confirmed.

[Civil Code/Tort] IP High Court, 2018 (Ne) 10089 <Takabe>

Original Ameblo publication: 2025-05-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12899374323.html

[Civil Code/Tort] 2018 (Ne) 10089 <Takabe>

*A seller of predesigned houses sold its own buildings to customers solicited at showgrounds for the appellant's products.

⇒ Tort established (¥1 million in damages per building)

(Excerpt from the court's reasoning)

In the Bigfoot business, customers who visited showgrounds or requested materials were registered in a database and, even if an immediate sale was not possible, were called “stock customers” and cultivated …. The stored customer information had pecuniary value in containing the possibility of future sales of Bigfoot products. From this standpoint, the appellees' sales of their own buildings to those customers reduced or eliminated that possibility and must be regarded as having caused pecuniary damage to the appellant.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88974.pdf

[Trademark/Non-Use Cancellation] IP High Court, 2020 (Gyo-Ke) 10114 <Otaka>

Original Ameblo publication: 2025-05-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12899720600.html

[Trademark/Non-Use Cancellation] 2020 (Gyo-Ke) 10114 <Otaka>

Settlement agreement: “Do not interfere with the plaintiffs' trade-name and trademark rights protected by other registrations by Boast or the plaintiff worldwide.”

⇒ A duty not to contest is owed.

⇒ The successor's request for a trial to cancel the trademark registration violates the principle of good faith.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90916.pdf



Figure information: BOAST trademark, Registration No. 5674320. Application filed May 9, 2012; registered May 30, 2014. Designated goods: goods recorded in the trademark register in Classes 18 and 28.

[Article/Trademark] The Possibility of Trademark Parody under Japanese Law: The SHI-SA Case (Takuto Hirasawa, 2009)

Original Ameblo publication: 2025-05-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12900086657.html

[Article/Trademark] The Possibility of Trademark Parody under Japanese Law: The SHI-SA Case (Takuto Hirasawa, Intellectual Property Law and Policy Journal, Vol. 25 (2009))

Same animal species with a different pose: similar

— Dissimilar when stylized into a character giving a different impression

⇒ Dissimilarity may be found if the pronunciations differ.

*In the SHI-SA case: dissimilar

For parody marks too, it is sufficient to apply the ordinary interpretation of the Trademark Act and Unfair Competition Prevention Act, while taking care not to unduly expand the interpretations of confusion in a broad sense, dilution and tarnishment.

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/43618/1/25_235-300.pdf

X（原告）は、平成17年６月21日、特許庁に対し、下記商標（以下「本件商標」という。）を出願し、特許庁は平成19年４月13日に本件商標を登録した（第5040036号）。



これに対し、ドイツ連邦共和国のプーマ アーゲー ルドルフ ダスラー スポーツ（以下「プーマ社」という。）は、下記引用商標の商標権者である。



Figure information: X (the plaintiff) filed the SHI-SA mark on June 21, 2005, and it was registered on April 13, 2007 (Registration No. 5040036). The lower figure is the cited PUMA mark owned by Puma AG Rudolf Dassler Sport, Germany.

[Trademark] IP High Court, 2016 (Gyo-Ke) 10053 <Takabe>

Original Ameblo publication: 2025-05-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901068951.html

[Trademark] 2016 (Gyo-Ke) 10053 <Takabe>

*Taking advantage of the fact that the cited mark was unregistered, the applicant intended to free-ride on the business goodwill and customer appeal embodied in it to obtain an unfair profit, and also intended to harm the opponent through reduced DVD sales and the like.

⇒ Violation of Trademark Act Article 4(1)(xix)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86070.pdf



[Trademark] IP High Court, 2015 (Gyo-Ke) 10111 <Takabe>

Original Ameblo publication: 2025-05-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901069587.html

[Trademark] 2015 (Gyo-Ke) 10111 <Takabe>

The applied-for mark gives rise to the pronunciation “jee-el-el-see,” corresponding to the four letters G, L, L and C.

⇒ Dissimilar

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85484.pdf

【本願商標】



Upper figure: the applied-for mark, GLLC / Global Life Learning Center.

【引用商標１】 【引用商標２】 【引用商標３】



Cited marks, from left to right: (1) the GLC logo; (2) the GLC logo with the Japanese words 経営承継 (“business succession”); and (3) GLC in standard characters.

[Trademark/Management of Affairs without Mandate] IP High Court, 2018 (Ne) 10074 <Takabe>

Original Ameblo publication: 2025-05-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901070058.html

[Trademark/Management of Affairs without Mandate] 2018 (Ne) 10074 <Takabe>

The request for procedures to register transfer of the trademark rights acquired by the appellee was rejected, whether as restitution following rescission of the business-transfer agreement or as management of affairs without mandate.

1. Restitution Obligation upon Rescission of the Business-Transfer Agreement

The appellee independently applied for the trademark registration; it was not an object of the business-transfer agreement and is not subject to restitution.

2. Transfer of Rights Based on Management of Affairs without Mandate

The appellee's conduct cannot be evaluated as managing affairs for the appellant.

3. Trademark Similarity and the Availability of Remedies

Other trademark rights and remedies (claims for damages and requests for invalidation trials) exist.

4. Fairness and the Purpose of the Trademark Act

The Trademark Act has no provision corresponding to Patent Act Article 74, which permits registration of a transfer in cases of usurpation. Even to eliminate a situation in which similar marks remain separately owned, a claim for registration of a transfer without a substantive legal basis cannot be allowed.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88452.pdf



[Trademark] IP High Court, 2024 (Gyo-Ke) 10029 <Nakadaira>

Original Ameblo publication: 2025-05-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901314009.html

[Trademark] 2024 (Gyo-Ke) 10029 <Nakadaira>

Applied-for mark: “マーくん” (Mā-kun)

Cited mark: “Markun.”

⇒ Similar (violation of Article 4(1)(xi))

(Excerpt from the defendant's (JPO Commissioner's) arguments as recorded in the judgment)

“Given that both the applied-for mark and the cited mark are represented in standard characters, it is difficult to say that the difference in character types between them gives traders and consumers a strong impression as a conspicuous difference in appearance as an indication identifying source.” “Next, as to pronunciation, the pronunciation 'Mākun' arising from the applied-for mark and the pronunciation 'Mākun' arising from the cited mark are the same. As to concept, neither mark gives rise to a particular concept, so they cannot be compared conceptually.” “Although the two marks cannot be compared conceptually, it is difficult to say that consumers perceive the difference in appearance as a difference sufficient to outweigh the identity of pronunciation. When observed separately at different times and places, they are similar marks that are liable to be confused with one another.”

(Excerpt from the court's reasoning)

“Accordingly, since both the applied-for mark and the cited mark are represented in standard characters, it should be said that it is difficult to say that the above difference in character types between them gives traders and consumers a strong impression as a conspicuous difference in appearance as an indication identifying source.” “In pronunciation, the pronunciation 'Mākun' arising from the applied-for mark and the pronunciation 'Mākun' arising from the cited mark are the same.” “On the other hand, as to concept, neither mark gives rise to a particular concept, so they cannot be compared conceptually.” “Neither the applied-for mark nor the cited mark gives rise to a particular concept, and they cannot be compared conceptually (see (3) above); in addition, the difference in appearance cannot be said to give a strong impression as stated above (see (1) above). It is therefore difficult to say that consumers perceive these differences as differences sufficient to surpass the identity of pronunciation (see (2) above), and when observed separately at different times and places, the applied-for mark and the cited mark are found to be similar marks that are liable to be confused with one another.” “Accordingly, there is no error in the JPO decision's determination that the applied-for mark and the cited mark are similar.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93468.pdf

[Unfair Competition Prevention Act] IP High Court, 2024 (Ne) 10024 <Hibiku Shimizu>

Original Ameblo publication: 2025-05-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901551895.html

[Unfair Competition Prevention Act] 2024 (Ne) 10024 <Hibiku Shimizu>

Although the product contains nicotine at less than 1 ppm, the purpose is “to indicate that it does not contain an amount of nicotine that adversely affects the body and mind,” so indications such as “0 mg nicotine” do not “unfairly” stimulate consumer demand.

⇒ No violation of Article 2(1)(xx) of the Unfair Competition Prevention Act.

(Excerpt from the court's reasoning)

The plaintiff argues that analysis at a quantification limit of 0.1 ppm objectively detects nicotine in the product but not in other nontobacco heated sticks, whereas consumers encountering the indication perceive the product as containing no nicotine at all and as superior to other products. However, …the indication is found to be intended to show that the product does not contain an amount of nicotine that adversely affects the body and mind. Nontobacco heated-stick products in which nicotine was not detected by analysis at a quantification limit of 1 ppm (including the plaintiff's product) are all equivalent in the sense that none contains an amount of nicotine that adversely affects the body and mind. The indication is not intended to state the product's nicotine content with scientific precision. Even if there are further differences in nicotine content among nontobacco heated-stick products at a level undetectable by analysis with a quantification limit of 1 ppm, this does not make the indication one that causes consumers to perceive this product as “superior” to others. So long as the product meets that level, indications such as “zero nicotine” and “nicotine-free” are considered permissible under generally accepted social norms. The indication therefore cannot be said to “unfairly” stimulate consumer demand for the product, nor is it found to give the defendants an “unfair” competitive advantage.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93383.pdf

[Article] Comprehensive Survey of Civil Intellectual Property Judgments of District Courts Other Than Tokyo and Osaka (2020) (Kazuyuki Tanikawa, 2023)

Original Ameblo publication: 2025-05-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12901966593.html

[Article] Comprehensive Survey of Civil Intellectual Property Judgments of District Courts Other Than Tokyo and Osaka (2020) (Kazuyuki Tanikawa, Intellectual Property Law and Policy Journal, Vol. 68 (2023))

The proportion of intellectual property judgments of district courts outside Tokyo and Osaka published on the courts' website is extremely low: the cumulative publication rate for the five years from 2017 through 2021 was only 4.1%.

⇒ A detailed examination of 17 judgments, including unpublished judgments investigated through inspection of court records.

https://eprints.lib.hokudai.ac.jp/dspace/bitstream/2115/90487/1/68_01_Tanikawa.pdf

[Article] A Court Decision concerning Application of “Offers to Transfer (Including Offers for Sale)” to Cross-Border Conduct, the Scope of Damages and the Doctrine of Equivalents

Original Ameblo publication: 2025-05-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12902184065.html

[Article] A Court Decision concerning Application of “Offers to Transfer (Including Offers for Sale)” to Cross-Border Conduct, the Scope of Damages and the Doctrine of Equivalents: The First-Instance Judgment in the L-Glutamic Acid Manufacturing Method Case (Masabumi Suzuki, Intellectual Property Law and Policy Journal, Vol. 67 (2023))

*Trends concerning “offers to transfer (including offers for sale)” in the United States, United Kingdom and Germany

*They agree in treating this as an independent infringing act.

Regarding the locations of conduct that may be at issue in relation to the territoriality of patent systems, and the respective locations of “transfer (or sale)” and “the offer thereof”:

(1) In the United States, if the former is domestic, the latter need not be domestic.

(2) In the United Kingdom, both must be domestic. (A UK decision states that infringement is established when both the offer and the infringement occur during the patent term.)

(3) In Germany, the position has been that if the latter is domestic, the former may be domestic or overseas. In recent years, however, the view has gained strength that not only must the offer itself be made in Germany, but its subject must also have a connection with Germany. (In Germany, making an offer during the patent term that promises a transfer after the patent expires also constitutes infringement.)

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2023/03/66e559f4fcb1a95c0d6082cd7458cf65.pdf

IP High Court, 2015 (Gyo-Ke) 10127 [Laser Processing Apparatus] <Takabe>

Original Ameblo publication: 2025-05-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12902299027.html

2015 (Gyo-Ke) 10127 [Laser Processing Apparatus] <Takabe>

Difference 1: The plaintiff argued that there was no motivation to replace pressurized water with a gas having lower cooling capacity and that, if the pressure medium were replaced with gas while disregarding cooling capacity, there would no longer be a need to circulate it to cool the pressure medium, and hence no reason to provide a fluid discharge path separate from the fluid supply path. The court rejected that argument and held Difference 1 obvious.

Difference 4: “In the cited invention, it is itself unclear whether there is a difference in width (diameter) between the fluid discharge path and the fluid supply path.” +No motivation

⇒ Inventive step: satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85766.pdf

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*Difference 1 (whether the fluid is gas or water)

The court first addressed whether “Fluid” in the cited reference generally refers to a fluid encompassing both liquids and gases. The original reference was in German; while “Fluid” may be translated as “fluid,” the plaintiff argued that it could also mean a liquid, as in automotive terminology. Considering several English-German-Japanese and German-Japanese dictionaries and the publication of the corresponding Japanese application, the court found a sufficient possibility that “Fluid” in the cited reference was used as a broad concept encompassing liquids and gases.

The court further found that techniques using gas instead of liquid in mirrors whose curvature is varied to control the laser beam's focal position were shown in well-known references (such as References 1 and 3). Taking these matters together, it held that adopting gas rather than pressurized water in the cited invention was something a person skilled in the art could readily conceive. In other words, it affirmed obviousness for Difference 1 and, consistently with the trial decision's conclusion, found no inhibiting factor against the idea of substituting gas based on the cited reference.

*Difference 4 (making the fluid discharge path narrower than the supply path)

Making the gas discharge path narrower than the supply path allows the required pressure to be applied to the rear of the mirror with a small flow rate (specification [0031]). The specification also describes rapid curvature changes and high-speed control of the laser-beam diameter as effects of the apparatus as a whole. A shorter response time does not, however, necessarily follow merely from narrowing the discharge path.

By contrast, the cited invention presupposes circulation of pressurized water and contains no description of narrowing the discharge or supply pipes to generate pressure with a small amount of fluid. The court examined whether a person skilled in the art would derive from the cited invention the idea of “making the discharge path narrower than the supply path to raise pressure efficiently.”

+Examination of well-known technology

The trial decision had cited as well known a technique for raising pressure by restricting the discharge side in systems using gas. However, after examining the cited well-known references (such as References 10 and 11), the court held that they either concerned different technical fields or did not directly show “raising pressure by changing the relative widths of the supply and discharge paths.”

In particular, it held that Reference 11 (gas-replacement technology within a storage chamber) concerned a field entirely different from laser processing and gave no direct suggestion to apply “a configuration making the discharge path narrower than the supply path” to the invention at issue. It also explained that

References 7–9 taught that “the piping volume should be reduced because of the compressibility of gas,” but could not be said to suggest relative widths of the “discharge path” and “supply path.”

IP High Court, 2015 (Gyo-Ke) 10122 [System for Dermatological Treatment] <Takabe>

Original Ameblo publication: 2025-05-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12902639393.html

2015 (Gyo-Ke) 10122 [System for Dermatological Treatment] <Takabe>

"It is natural to understand the 'liquid water filter' of Cited Invention 2 identified by the trial decision as referring to the 'liquid water filter' in [0077], not including the suspension filter. And …the 'liquid water filter' cannot be said to cool the skin."

The trial decision concluded that combining Cited Invention 2 with Cited Invention 1 would allow a person skilled in the art readily to conceive of filtering light with a water filter while cooling the skin.

However, after examining the substantive function of the "liquid water filter" in Cited Invention 2, the court found that it adjusted the light spectrum using water as an absorbing medium and could also be used to cool apparatus components, but disclosed no configuration using that water to cool the skin.

In other words, even considering that Cited Reference 2 also described a different form, a suspension filter (an embodiment using frozen liquid), the court pointed out that its operating principle and purpose differed. Although it was found to cool the skin by cooling the waveguide until the liquid completely melted, it was a special configuration that, after melting, became a highly scattering plate and lost its filtering function. The court also distinguished the liquid water filter, which continuously functions as a filter, from the suspension filter, which functions as a filter only while frozen, and held that even combining the disclosure with Cited Invention 1 would not yield the claimed configuration in which the optical filter cools biological tissue.

The court held that replacing the optical filter formed by the prism and the like in Cited Invention 1 with the liquid water filter of Cited Reference 2 would still not yield a configuration using that water to cool the skin. It also rejected the defendant's proposed design modification: thickening the water layer to cool the skin would reduce light transmission and impair the apparatus's purpose and function, so such a modification could not readily be assumed feasible. Disposable light sources, the prism's spacing and contact functions, and more complex sealing structures may be technical issues to consider, but the court cannot be said to have held them to be reasons for affirming inventive step.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85871.pdf

Tokyo District Court, 2021 (Wa) 11507 [Compression Supporter] <Nakashima>

Original Ameblo publication: 2025-05-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12903070131.html

Tokyo District Court, 2021 (Wa) 11507 [Compression Supporter] <Nakashima>

*Includes a configuration that cannot solve the problem.

(And that configuration is the defendant's product.)

⇒ Support requirement: not satisfied

(The same structure as the second PCSK9 litigation)

(*The appellate judgment did not decide the support requirement.)

(Excerpt from the court's reasoning)

In the invention at issue, the method of “fixing a low-stretch material to the body” … is understood to encompass, in addition to a so-called separate-material attachment structure …, the integrally knitted/woven structure … adopted by Defendant Product 17 …. However, the specification and other documents contain no statement that a person skilled in the art could solve the invention's problem using a supporter with an integrally knitted/woven structure. On the contrary, paragraph [0002] expressly states that such a supporter cannot apply the necessary pressure to an arbitrary location on the knee joint and cannot solve the invention's problem. Accordingly, in light of the specification and other documents, it cannot be found that, even without a description or suggestion, a person skilled in the art would recognize from the common general technical knowledge at filing that a supporter with an integrally knitted/woven structure could solve the invention's problem.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91504.pdf

[Article/Unfair Competition Prevention Act] Usefulness and Non-Public Status of Trade Secrets: The Tin Alloy Composition Case (Chen Keyu, 2018)

Original Ameblo publication: 2025-05-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12903508011.html

[Article/Unfair Competition Prevention Act] Usefulness and Non-Public Status of Trade Secrets: The Tin Alloy Composition Case (Chen Keyu, Intellectual Property Law and Policy Journal, Vol. 52 (2018)）

There are two views of the test for “usefulness” of trade secrets: (1) it has only the limited meaning of excluding scandalous information and other information unrelated to incentives for development; and (2) it is a demanding requirement comparable to inventive step.

The Tokyo District Court, 2001 (Wa) 7445, [Crepe Mix Liquid] case and the Osaka District Court, 2014 (Wa) 11151, [Tin Alloy Composition] case (this case) denied usefulness because there was no additional effect over publicly known technology. The article characterizes these as cases denying usefulness to information that confers no competitive advantage, rather than as imposing a demanding requirement comparable to inventive step.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2019/01/26139757b3a2882c15acc0420875315f.pdf

[Article/Copyright] Scope of Protection for Works of Pictorial Expression: The Professor Illustration Case (Emi Tsubata, 2009)

Original Ameblo publication: 2025-05-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904118131.html

[Article/Copyright] Scope of Protection for Works of Pictorial Expression: The Professor Illustration Case (Emi Tsubata, Intellectual Property Law and Policy Journal, Vol. 24 (2009))

Tokyo District Court, 2006 (Wa) 16899

This judgment held that the shared portions lacked creativity.

— Considering how closely the two works resemble each other, and the particular circumstances that the defendant's video was originally an OEM version of the plaintiff's video but the defendant continued using the character after ending the OEM agreement, might infringement have been found?

(Excerpt from the court's reasoning)

“The feature of depicting a plump, elderly man wearing a mortarboard and gown and sporting a mustache or the like is merely an idea …. The remaining specific expressions identified as common to the plaintiff's and defendant's professor designs—approximately two-heads-tall proportions emphasizing the upper body including the head, with the lower body depicted as large shoes visible below the gown's hem; a bottom-heavy trapezoidal face with round cheeks, a centrally positioned nose and a Kaiser mustache extending from it; vertically elongated oval eyes approximately the same width as the nose, eyebrows immediately above both eyes, no depicted neck or ears, and hair bulging at the sides of the head—are extremely commonplace and cannot be regarded as creative expression. The two are identical only in ideas that are not expression or in portions lacking creativity in expression.”

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol24/24_3.pdf

原告博士絵柄1目録







Plaintiff's Professor Illustration 1: character images and video packaging.

被告博士絵柄１目録



Defendant’s Professor Illustration 1: character images and video packaging.

[Design] Tokyo District Court, 2021 (Wa) 30281 and Other Cases, “Protective Member and Push Handle” <Kokubu>

Original Ameblo publication: 2025-05-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904118561.html

[Design] Tokyo District Court, 2021 (Wa) 30281 and Other Cases, “Protective Member and Push Handle” <Kokubu>

Patent infringement found + design infringement found

⇒ Design infringement: a converted application and indirect infringement of a partial design (Design Act, Article 38(i)(a))!!

The defendants alleged invalidity, arguing among other things that the conversion to the design application was unlawful. However, the court held that the specification of the divisional application disclosed, for example, that the protective portion was disk-shaped and flat underneath, so identity was not negated.

(Excerpts from the court's reasoning)

The defendant's product is a handgrip attached to the upper end of a single pipe of a transport trolley, in which case it becomes the trolley's push handle together with that pipe. It is found that the product would not be attached to anything other than a trolley pipe and thereby acquire a function or use different from a push handle (entire purport of oral argument). Accordingly, the defendant's product is found to be an “article used exclusively for manufacturing” (Design Act, Article 38(i)(a)) a trolley push handle by being attached to the upper end of its pipe.

The defendants argue that their product is used for purposes other than push handles inserted into their trolleys, can be attached to pipes of various lengths, and therefore does not produce a fixed relationship between the grip length and the total pipe length as in the designs at issue. However, even if the product is attached to different types of trolley or pipe, it remains an “article used exclusively for manufacturing” a trolley push handle by attachment to the pipe's upper end. The defendants' argument therefore cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93266.pdf

[U.S. Patents] August 20, 2007, CAFC, Ian Frazer v. C. Richard Schlegel

Original Ameblo publication: 2025-05-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904234387.html

[U.S. Patents] August 20, 2007, CAFC, Ian Frazer v. C. Richard Schlegel

For an invention in an application claiming Paris Convention priority to which examples had been added, the court recognized the effect of priority and first-inventor status, prevailing over another person's application filed during the priority period.

— Valid priority requires satisfaction of the written-description and enablement requirements in the first paragraph of 35 U.S.C. § 112.

= Japan, 2023 (Gyo-Ke) 10057 <Honda>

(In contrast to the Artificial Nipple case)

https://jpaa-patent.info/patent/viewPdf/4455

[Article/Copyright] The Duty of Care Owed by a Party Commissioning Advertising Materials to Avoid Copyright Infringement (Hajime Moriwaki)

Original Ameblo publication: 2025-05-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904455057.html

[Article/Copyright] The Duty of Care Owed by a Party Commissioning Advertising Materials to Avoid Copyright Infringement (Hajime Moriwaki, Intellectual Property Management, Vol. 58, No. 11 (2008))

*Judgments holding that the commissioning party owed a high duty of care

⇒ “Negligence” established

Osaka District Court, 1997 (Wa) 3805: pharmaceutical company

Tokyo District Court, 1994 (Wa) 23092: Tokyo Metropolitan Government

Tokyo District Court, 2007 (Wa) 1126: shrine

*Judgments holding that the commissioning party did not owe a high duty of care

⇒ No “negligence”

Osaka District Court, 2003 (Wa) 2886: construction company

Osaka District Court, 2005 (Wa) 1311: coffee company

[Article/Trademark] The Meaning of “Goods” under the Trademark Act (Takuya Ueda, Theory and Practice of Intellectual Property Law, Vol. 3)

Original Ameblo publication: 2025-05-21

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904712939.html

[Article/Trademark] The Meaning of “Goods” under the Trademark Act (Takuya Ueda, Theory and Practice of Intellectual Property Law, Vol. 3)

*Novelty and promotional items

T-shirts in the BOSS case (Osaka District Court, August 26, 1987): if an article is not an independent product in itself but merely packaging or an advertising medium for another product, it is not “goods” under the Trademark Act.

Related example: ballpoint pens in the Hertz Rent-a-Car case (Tokyo High Court, February 27, 2001). The signs on the promotional items advertised car-rental services and did not function to identify the source of the promotional items themselves; use of the trademark for the designated goods was therefore denied.

= Origami paper in the Takeda Pharmaceutical case (Tokyo High Court, November 7, 1989)

*Pamphlets and admission tickets

The Shumi no Kai case (Tokyo District Court, March 2, 1961) and Mokuba Kikaku case (Yokohama District Court, Kawasaki Branch, April 28, 1988) held that pamphlets and admission tickets did not qualify as independently traded “printed matter” goods and therefore were not “goods” under the Trademark Act.

*Decisions are divided on whether food and beverages served inside an establishment constitute “goods.”

Chunagon case (Osaka District Court, December 25, 1986): trademark infringement rejected

Koraku case (Hiroshima High Court, Okayama Branch, June 18, 1986): trademark infringement affirmed

*Real estate: in the Village Hakusan case, the first-instance court found infringement because condominium units for sale constituted “goods” similar to the designated service of “buying and selling buildings.” The Tokyo High Court (September 28, 2000) found infringement on the ground that the signs were used for the service of buying and selling buildings.

[Copyright] IP High Court, 2010 (Ne) 10029 <Takizawa>

Original Ameblo publication: 2025-05-22

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12904952235.html

[Copyright] IP High Court, 2010 (Ne) 10029 <Takizawa>

A research report prepared under a joint-research agreement between a university and an outside organization qualified as a work made in the course of duties, with the university as author.

(1) Initiative of the corporation or other organization

The university concluded a joint-research agreement with Kitami City and others and was obliged to prepare the research report as part of its performance.

(2) Created in the course of duties

Through X's obligation to submit a research plan and the university's designation of the research purpose, content, location and other matters, the university was involved to some extent in the substantive content of the research, beyond ordinary labor management.

(3) Published by the corporation or other organization under its own name as author

The covers of the reports displayed names including “Kitami Institute of Technology Regional Joint Research Center,” and their tables of contents and main texts contained no indication of which author wrote which part. Although the appellant was named in the prefaces or other introductory sections as a research member or joint-research representative, the reports were held to have been published under the university's name as author.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-80576.pdf

[Article/Works Made in the Course of Duties] The Air-Conditioning Equipment Training Text Case (Shigeki Ishii, Patent, 2007)

Original Ameblo publication: 2025-05-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12905268870.html

[Article/Works Made in the Course of Duties] The Air-Conditioning Equipment Training Text Case (Shigeki Ishii, Patent, 2007)

The requirement of being “published under the name of the corporation or other organization” was found not to be satisfied!!

IP High Court, 2006 (Ne) 10027 [Air-Conditioning Equipment Training Text Case]

The notation “X, Head of the Instrumentation Systems Department, Tokyo Branch, Y1 Co., Ltd.” is understood as identifying X as the instructor and stating the instructor's title and company affiliation.

= Tokyo High Court, 2000 (Ne) 4816 [Esquisse Case]

“Under generally accepted social norms, ‘Waseda University D Laboratory’ merely identifies the affiliation of ‘D,’ which follows it. This notation cannot possibly be regarded as publication under Waseda University's name as author.”

https://www.jpaa.or.jp/old/activity/publication/patent/patent-library/patent-lib/200704/jpaapatent200704_106-112.pdf

[Copyright] IP High Court, 2005 (Ne) 10070 [Vibration Controller Program Case]

Original Ameblo publication: 2025-05-24

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12905536486.html

[Copyright] IP High Court, 2005 (Ne) 10070 [Vibration Controller Program Case]

*Despite Copyright Act Article 61(2), assignment of the adaptation right was recognized even though it was not specifically listed in the program-copyright assignment agreement!!

The arrangement presupposed that Y would take the lead in future improvements to the program, while X was positioned only as “contributing.”

Cf. The Memorial Tree case (Tokyo District Court, December 19, 2003), Political Economy Paper case (Tokyo District Court, January 18, 2007), and Space Battleship Yamato case (Tokyo District Court, December 27, 2006) all differed from this case: under the presumption in Copyright Act Article 61(2), the adaptation right and other relevant rights were held to have been retained by the assignor.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33474.pdf

[Article/Trade Secrets] Can a Company Enjoin an Employee’s Use or Disclosure of Trade Secrets the Employee Developed or Acquired Personally?

Original Ameblo publication: 2025-05-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12905722262.html

[Article/Trade Secrets] Can a Company Enjoin an Employee's Use or Disclosure of Trade Secrets the Employee Developed or Acquired Personally? (Asayo Ohyori, Theory and Practice of Intellectual Property Law, Vol. 3)

*Cases granting injunctions, and an interlocutory judgment finding trade-secret infringement (item 3)

(1) Sapporo District Court order, July 8, 1994: customer list

(2) Osaka District Court, December 22, 1998: technical guidance received at another company's research laboratory as part of the employee's work

(3) Tokyo District Court interlocutory judgment, December 26, 2002: list of dispatched staff (whether to grant an injunction, and its permissible scope, were left for further proceedings)

*Osaka District Court, August 28, 1997: use/disclosure for an improper purpose was rejected, but the determination assumed that the defendant's acts could fall within item (vii).

*Cases denying an injunction

(1) Tokyo District Court, November 30, 1998: the defendant knew the information thoroughly without needing to consult the customer list. Use rejected.

(2) Osaka District Court, 2002 (Wa) 3162: the defendant knew the addresses and other information without consulting the customer list. Use rejected.

Cf. Other cases concerning the requirement that information be “disclosed” to the recipient

(1) Tokyo District Court, 2001 (Wa) 5663 [Personal Importation of Viagra Case]: patient information obtained by the defendant in the course of duties as a physician was not a trade secret held by the plaintiff, who had commissioned the work.

(2) Tokyo High Court, 2002 (Ne) 1413 [At-Cost Sale Case]: wholesale prices are formed through negotiations between seller and buyer, so each independently acquires the information; it is not information “disclosed” to the recipient.

(3) Tokyo High Court order, March 31, 2003: credit-card application information was independently acquired by both the credit-card company and the points-card issuer, rather than being information “disclosed” to the recipient.

Articles, etc. (2003–June 2015) | Intellectual Property High Court

IP High Court, 2016 (Ne) 10047 [Electrical Connector Assembly] <Takabe>

Original Ameblo publication: 2025-05-26

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12906031295.html

2016 (Ne) 10047 [Electrical Connector Assembly] <Takabe>

*Determinations in the reasoning of a judgment in an action to rescind a trial decision do not bind the determination of the patent's technical scope in an infringement action. The patentee's counterarguments on invalidity do not necessarily bind the court's determination in an infringement action either.

(Excerpts from the court's reasoning)

…Determinations in the reasoning of a judgment in an action to rescind a trial decision concerning the same patent do not bind the determination of technical scope in an infringement action.

…When construing the technical scope of a patented invention, a party's arguments made in response to the opposing party's invalidity allegations do not necessarily bind the court. Further, the claims for Patented Invention 2 do not provide the limitation asserted by the appellant …. Nor are the problem and functions and effects of Patented Invention 2 such that they can be achieved only if, whenever the cable connector is tilted upward—that is, before reaching its final mated position—the rearmost position of the rear edge of the locking projection is always forward of the foremost position of the projection extending inward into the locking groove from its rear edge.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86212.pdf

IP High Court, 2016 (Ne) 10042 [Contact Terminal] <Takabe>

Original Ameblo publication: 2025-05-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12906556081.html

2016 (Ne) 10042 [Contact Terminal] <Takabe>

*Because the defendant’s product and the patented invention differed in their technical significance, the product did not literally satisfy the claim limitation “pressing member,” and infringement under the doctrine of equivalents was also denied.

(Excerpts from the court's reasoning)

The plunger pin has an inclined recess of substantially conical-surface shape in its large-diameter portion, and is designed to be urged by a coil spring into contact with the inner peripheral surface of the main casing at two locations, left and right. The top-shaped member is conductive, and is configured so that its spherical portion presses against the inclined recess in the plunger pin's large-diameter portion, contacting it at only one point and thereby tilting into contact with the casing's inner peripheral surface at two locations, left and right. The central axis of the top-shaped member and the deepest point of the bottom surface of the plunger pin are offset to ensure that the plunger pin and top-shaped member tilt and contact the casing.

Securing a total of four current paths in this manner reduces the electrical resistance of the defendant's product, reduces the likelihood that no path other than through the coil spring exists for current flowing through the product, and limits the amount of current flowing through the coil spring.

In addition, because the coil spring is coated with ●●●●●●●, there is no need to use an insulating ball.

By contrast, in the invention at issue, …(1) making the inclined recess substantially conical in shape allows the center of the pressing member's spherical portion, formed by a spherical surface, to be positioned stably on the inclined recess's central axis, thereby stabilizing the direction of the coil spring's biasing force transmitted to the plunger pin through the pressing member; and (2) offsetting the inclined recess's central axis from the plunger pin's central axis ensures that the coil spring urges the plunger pin in a direction at a small angle to the casing's central axis, reliably bringing the plunger pin's large-diameter portion into contact with the casing's tubular inner peripheral surface and allowing current to flow reliably into the casing.

Accordingly, the defendant's product and the invention at issue have different technical significance … in the contact between the pressing member and the plunger pin.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86215.pdf

[Trademark/Foreign Server] IP High Court, 2024 (Ne) 10031 <Hibiku Shimizu> — “Sushi Zanmai” Case

Original Ameblo publication: 2025-05-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12906944953.html

[Trademark/Foreign Server] 2024 (Ne) 10031 <Hibiku Shimizu>

“Sushi Zanmai” Case

⇒ Reversed: no trademark infringement

[Issue 1: Application of Trademark Act Article 2(3)(viii)]

At first instance, the defendant's webpages were found to be created mainly for Japan, were recognized as concerning services similar to food and beverage services, and were treated as advertising.

However, the IP High Court held that the website as a whole aimed to promote exports of food ingredients from Japan, and that the defendant's displayed indications were merely part of an introduction to its overseas-store business, not advertising directed to consumers in Japan.

[Issue 2: Trademark Use and Infringement of the Source-Indicating Function]

The IP High Court held that, even if the display were considered “advertising,” the defendant’s indications concerned overseas restaurants that did not provide services in Japan. The consequence of mistaking their source and receiving their services would occur abroad, so the source-indicating function of the plaintiff’s marks in Japan was not impaired.

[Issue 3: Territoriality and Consistency with the Joint Recommendation]

The IP High Court also held that, in light of trademark independence under the Paris Convention and the principle of territoriality, it would be inappropriate to use Japanese trademark rights to restrict lawful use of marks registered abroad to identify the designated services in those countries, where the use at issue did not impair the marks’ source-indicating or related functions in Japan.

It also concluded, in light of the Joint Recommendation, that there was no trademark use because no commercial effect in Japan was recognized.

*Regarding the Joint Recommendation:

Concerning the “factors for determining commercial effect” listed in Article 3(1) of the Joint Recommendation, the IP High Court

held that, comprehensively considering that “the sushi restaurants do not provide services in Japan and there are no circumstances indicating that they have undertaken plans to do so (subparagraph (a)); the webpages do not display the restaurants' prices in Japanese currency (subparagraph (c)(ii)) or contact methods in Japan (subparagraph (d)(ii)); and, as noted above, the webpages themselves are intended to advertise the service of exporting food ingredients from Japan, with the defendant's indications used in the context of introducing restaurant chains that use the exported ingredients abroad,” even taking into account that “the webpages are written in Japanese (subparagraph (d)(iv)) and do not explicitly state the absence of an intention to provide the restaurants' services to customers in Japan (subparagraph (b)(ii)),” “the use of the defendant's indications on the webpages cannot be said to have a commercial effect in Japan and thus does not constitute use as trademarks in Japan.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93478.pdf

Tokyo District Court, 2002 (Wa) 23687 [Telephone Card] <Iimura>

Original Ameblo publication: 2025-05-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12907044334.html

Tokyo District Court, 2002 (Wa) 23687 [Telephone Card] <Iimura>

*The rights holder's arguments during prosecution of the parent of a divisional application were considered in construing the claim language.

*Consistent with Osaka District Court, 2005 (Wa) 12207.

“If an applicant intentionally deletes a portion of the original specification and drawings of the parent application by amendment, it is impermissible, in making a divisional application, to expand the device to encompass matters already deleted.”

(Excerpts from the court's reasoning)

The device at issue was the subject of a divisional application filed from the parent application after its original specification and drawings had been amended and the application published for opposition.

Where the parent application's original specification or drawings have thus been amended and published for opposition before the divisional filing, the device in the divisional application must be one described both in the original specification or drawings of the parent application and in its amended published specification or drawings.

Accordingly, it is natural that determining the “scope of utility model registration claims” in the divisional application also requires construction taking the parent application's prosecution history into account.

In particular, if the applicant intentionally deletes a portion of the original specification and drawings of the parent application by amendment, it is impermissible, in making a divisional application, to expand the device to encompass matters already deleted. The “scope of utility model registration claims” in the divisional application must therefore also be construed consistently with that principle.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11371.pdf

Tokyo High Court, 1999 (Ne) 3800 [Underarm Sweat-Absorbing Pad]

Original Ameblo publication: 2025-05-31

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12907233624.html

Tokyo High Court, 1999 (Ne) 3800 [Underarm Sweat-Absorbing Pad]

*The determination in the reasoning of another final judgment concerning the same utility model registration is to be respected.

*The argument that this was correction of a typographical error was rejected, and intentional exclusion was found.

Cf. 2016 (Ne) 10047 [Electrical Connector Assembly] <Takabe>

*Determinations in the reasoning of a judgment in an action to rescind a trial decision do not bind the determination of the patent's technical scope in an infringement action. The patentee's counterarguments on invalidity do not necessarily bind the court's determination in an infringement action either.

(Excerpts from the court's reasoning)

In this litigation, the appellant alleges infringement of its utility model right by the appellee on the premise that “small curvature” in the specification means “small radius of curvature.” However, this premise is substantially the same issue examined in the other litigation. The appellant's argument therefore seeks precisely to revive and contest a matter that should have been settled when the other litigation became final. Although it does not conflict with res judicata, it seeks to leave unresolved a matter intended to be resolved by a final judgment and plainly gravely harms legal stability. In such circumstances, absent special circumstances such as an error objectively obvious on its face or grounds sufficient to warrant retrial of the other litigation, it is appropriate to respect the determination in the final judgment's reasoning. Reopening the dispute must be regarded as impermissible under the principle of good faith. …

The plaintiff argues that “small curvature,” which plainly has technical significance in the device at issue, is technically equivalent to “small radius of curvature,” which has the opposite meaning. Ultimately, that argument can stand only on the premise that “small curvature” in the specification is an obvious typographical error for “small radius of curvature.” However, as explained in I above, “small curvature” cannot be construed as such an obvious error. The plaintiff's argument is therefore plainly without merit, without any need to consider the remaining points.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13457.pdf

平成28年（ネ）第10047号＜高部＞	電気コネクタ組立体*無効論における特許権者の反論、審決取消訴訟の判断は、侵害訴訟の裁判所を拘束しない。	…同一特許に係る審決取消請求事件の判決の理由中の判断は，侵害訴訟における技術的範囲の確定に対して拘束力を持つものではない。…特許発明の技術的範囲を解釈するについて，相手方の無効主張に対する反論として述べた当事者の主張は，必ずしも裁判所の判断を拘束するものではない。そして，本件特許発明２に係る特許請求の範囲には，控訴人が主張するような限定は規定されていないし，…本件特許発明２の課題及び作用効果は，ロック突部の突部後縁の最後方位置が，ケーブルコネクタが上向き傾斜姿勢にあるとき，すなわち，コネクタ嵌合終了姿勢に至る前は，常にロック溝部の溝部後縁から溝内方に突出する突出部の最前方位置よりも前方に位置しているのでなければ奏し得ないというものではない。	★

English Translation of the Source Figure — Electrical Connector Assembly

2016 (Ne) 10047 (Takabe). A patentee’s rebuttal of an invalidity argument does not necessarily bind claim construction. Reasoning in a judgment in an action to cancel a JPO trial decision does not bind the determination of technical scope in an infringement action. ★

“A determination in the reasoning of a judgment in an action to cancel a JPO trial decision concerning the same patent does not bind the determination of the invention’s technical scope in an infringement action. … A party’s arguments, made in response to the opposing party’s invalidity arguments, do not necessarily bind the court’s interpretation of the technical scope of a patented invention. The claims for Patented

Invention 2 do not contain the limitation asserted by the appellant. … Nor is the problem addressed or the effect of Patented Invention 2 such that it can be achieved only if, while the cable connector is in an upwardly inclined position—before it reaches the final connector-mating position—the rearmost point of the rear edge of the locking projection always lies forward of the foremost point of the projection extending into the locking groove from its rear edge."

Osaka District Court, 2005 (Wa) 12207 [Goggles]

Original Ameblo publication: 2025-06-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12907494065.html

Osaka District Court, 2005 (Wa) 12207 [Goggles]

*The court considered the deletion of claims from the parent application after division, but found no intentional exclusion of the patented inventions at issue because the deleted claims were not shown to be identical to those inventions.

*Consistent with Tokyo District Court, 2002 (Wa) 23687.

“The plaintiff's deletion of claims 4 through 7 from the parent application does not establish that it intentionally excluded the patented inventions at issue.”

(Excerpt from the court's reasoning)

…The amendment concerned the parent application, not the patented inventions in the divisional application. As explained above, claims 4 through 7 of the parent application are not found to be identical to the patented inventions at issue. Thus, the plaintiff's deletion of those claims cannot be regarded as intentional exclusion of the patented inventions at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-34563.pdf

Kyoto District Court, 1996 (Wa) 1597 [Thermal Head]

Original Ameblo publication: 2025-06-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908157393.html

Kyoto District Court, 1996 (Wa) 1597 [Thermal Head]

*The patentee's arguments during prosecution of the parent of a divisional application were likewise not considered in construing the claim language.

“The prosecution history of the invention in the parent application may be considered only in exceptional circumstances where establishment of the patent right in the divisional application is closely related to the parent application, and reference to the parent's prosecution history clarifies the meaning of the specification or drawings attached to the parent application that already formed the basis for the divisional application at the time of division.”

(Excerpts from the court's reasoning)

Because the invention in the divisional application and the invention remaining in the parent after division are separate and independent, it is, as above, generally inappropriate to consider the parent invention's prosecution history in determining the technical scope of the divisional invention. (Statements made during prosecution of the parent invention cannot be regarded as statements about the divisional invention.)

However, the parent invention's prosecution history may be considered only in exceptional circumstances where establishment of the divisional patent right is closely related to the parent, and reference to the parent's prosecution history clarifies the meaning of the specification or drawings attached to the parent application that already formed the basis for the divisional application at the time of division. (In that situation, determining the meaning of the parent's pre-division specification also permits the meaning of the divisional invention described therein to be regarded as already clear at the time of division.)

http://imaokapat.biz/hanrei/jirei039-h8-1597.html

Tokyo District Court, 1995 (Wa) 23005 [Topical Antifungal Agent]

Original Ameblo publication: 2025-06-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908158008.html

Tokyo District Court, 1995 (Wa) 23005 [Topical Antifungal Agent]

*The contents of documents filed in the European application claiming priority from the Japanese application were also considered in construing the claim language.

= Osaka District Court, 1972 (Wa) 1526 [Chakku]

(Excerpts from the court's reasoning)

…Considering together the wording of the claims, the descriptions and examples in the detailed description, the plaintiff's arguments during prosecution of the patent application, the contents of its submissions to the European Patent Office, and other matters, the invention can be described as follows. It concerns a topical antifungal agent using miconazole or the like, known as antifungal agents. In light of the problem that directly adding miconazole or the like to a topical base using an ordinary formulation method causes crystals to precipitate and prevents the desired topical agent from being obtained, it employs the novel technical concept of using crotamiton or the like—known as an active ingredient of topical agents but not as a solvent for miconazole or the like—as such a solvent, and formulating that solution with a topical base to obtain a superior topical agent without crystal precipitation.

Accordingly, …“solution” in the claims should appropriately be construed as a solution having compound (I) as the solute and crotamiton or the like as the solvent.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13763.pdf

Shizuoka District Court, 1990 (Wa) 360 and 1992 (Wa) 524 [Alfacalcidol]

Original Ameblo publication: 2025-06-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908158087.html

Shizuoka District Court, 1990 (Wa) 360 and 1992 (Wa) 524 [Alfacalcidol]

*The court rejected the argument that the prosecution history of the corresponding German patent precluded explaining a difference in the melting point of the substance covered by the Japanese patent by differences in purity.

Cf. Tokyo District Court, 1995 (Wa) 23005 [Topical Antifungal Agent]; Osaka District Court, 1972 (Wa) 1526 [Chakku]

(Excerpt from the court's reasoning)

The defendants argue that because the German patent corresponding to the patented invention was granted with emphasis on the fact that the substance obtained by the method was pure, it is impermissible to explain a different melting point of the target substance of this patent, based on the same invention, by lower purity. However, in light of the principle of independence of patents in each country, that argument is plainly without merit.

https://www.jpaa.or.jp/old/activity/publication/patent/patent-library/patent-lib/200308/jpaapatent200308_077-090.pdf

Tokyo District Court, 2023 (Wa) 70178 [Zinc Acetate Hydrate Tablets and Method of Manufacturing Them] <Nakashima>

Original Ameblo publication: 2025-06-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908424986.html

2023 (Wa) 70178 [Zinc Acetate Hydrate Tablets and Method of Manufacturing Them] <Nakashima>

Even if the presumption under Patent Act Article 104 applied, it has been rebutted.

⇒ The court also stated the following as an alternative observation.

(Excerpts from the court's reasoning)

Even assuming that the defendant's pharmaceutical product were presumed under Patent Act Article 104 to have been produced by the manufacturing method of the invention, the explanation in 2 above shows that the presumption is rebutted …. …

It is appropriate to find that, before the priority date, the “product” produced by the invention was known to an extent that provided a person skilled in the art with a clue to how to manufacture it. Accordingly, the defendant's pharmaceutical product cannot be presumed under Patent Act Article 104 to have been produced by the manufacturing method of the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93476.pdf

[Article/Trademark] Trademark-Related Judgments in the Reiwa Era (Kentaro Hattori, Patent News, February 14, 2025)

Original Ameblo publication: 2025-06-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908597417.html

[Article/Trademark] Trademark-Related Judgments in the Reiwa Era (Kentaro Hattori, Patent News, February 14, 2025)

Civil litigation relating to trademarks, 2019–2024

• Of 92 district court cases, 31 resulted in dismissal on the merits or as inadmissible. (However, many concerned abuse of rights; few involved dissimilarity of marks.)

• Of 31 appeals, five resulted in reversals (four of those judgments found no abuse of rights).

Actions to rescind trial decisions

Of 229 cases, the trial decision was rescinded in 47.

Of these, eighteen concerned non-use cancellation and seven concerned Article 3.

https://sakurazakalaw.tokyo/topics/pdf/2025/238.pdf

IP High Court, 2010 (Gyo-Ke) 10121 [Natto Food] <Takizawa>

Original Ameblo publication: 2025-06-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12908866363.html

2010 (Gyo-Ke) 10121 [Natto Food] <Takizawa>

*Different standards apply to whether something is an “invention” eligible to serve as a cited invention and whether it is an “invention” when assessing patentability.

(Excerpts from the court's reasoning)

…It is assumed that there is no discrepancy between the applicant's original intention and the claim wording. Even if there is such a discrepancy, as noted above, it is properly a matter to be addressed on the applicant's own responsibility. The examiner therefore does not bear a duty to investigate whether such a discrepancy exists and, if it does, point out that defect or deficiency in the application. …

Identifying an “invention” in a cited invention for assessing inventive step requires, and is satisfied by, disclosure of the technical concept sufficiently to permit its practice, based on the state of the art at the filing date and to the extent necessary for comparison with the invention in the application and the like. In contrast, identifying the “invention” in an application for assessing patentability requires that it be constituted concretely and objectively enough for a person skilled in the art repeatedly and continuously to achieve the intended technical effect. Even if the two identifications of “invention” do not employ the same standard, that is natural given their different purposes and subjects, and cannot be called unreasonable.

Accordingly, although applying different standards to a particular applicant in comparable cases could violate the principle of equality, the plaintiff's arguments plainly do not establish that the defendant engaged in unequal treatment based on double standards.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81149.pdf

IP High Court, 2024 (Gyo-Ke) 10023 [Information Processing Terminal] <Hibiku Shimizu>

Original Ameblo publication: 2025-06-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12909092248.html

2024 (Gyo-Ke) 10023 [Information Processing Terminal] <Hibiku Shimizu>

*Claim wording was deleted, but the amendment was held not to add new matter.

(Excerpt from the court's reasoning)

Amendment 4 deletes “regardless of whether payment-related information is input” from the claimed invention. Literally, …because it deletes a limitation, there is room to interpret it as meaning that “an information processing terminal in which the presence or absence of ‘input of payment-related information’ is relevant to the mode at issue,” previously outside the claimed invention, now falls within the amended invention. However, the claimed invention addresses the difficulty of applying to nonpayment uses the prior-art configuration that performs processing and display prompting the user to read a payment card after the user inputs payment-related information …. It provides an information processing terminal applicable to nonpayment uses and capable of quickly reading required information from an information storage medium, whether contact or contactless …. This is also true of the amended invention. …It can hardly be considered a reasonable interpretation that the invention after amendment, including Amendment 4, encompasses within its technical scope these ‘information processing terminals in which the presence or absence of input of payment-related information is relevant to the mode at issue.’ Rather, construing the technical scopes of the original and amended inventions in light of the specification, it remains true both before and after amendment that ‘input of payment-related information’ is unnecessary to achieve the mode at issue. It is appropriate to understand the phrase ‘regardless of whether payment-related information is input’ as merely specifying applicability to nonpayment uses. Amendment 4 therefore does not cause the amended invention to encompass matters absent from the original invention. …Since Amendment 4 does not add new matter, …the amendment as a whole narrows the claims.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93556.pdf

Tokyo District Court, 2022 (Wa) 18332 [Method of Transmitting and Receiving Reference Signals in a Wireless Communication System] <Nakashima>

Original Ameblo publication: 2025-06-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12909308720.html

2022 (Wa) 18332 [Method of Transmitting and Receiving Reference Signals in a Wireless Communication System] <Nakashima>

*Not mandatory under the “standard” +Non-satisfaction was confirmed by materials submitted under a protective order.

The LTE standard provides that values such as NID_csh_DMRS are used when supplied by higher layers, and that ordinary cell IDs (such as NID_cell) are used when they are not supplied.

⇒ Whether a terminal is configured to support CoMP (coordinated transmission and reception among multiple base stations) is left to its particular implementation; the LTE standard does not make CoMP mandatory for terminals.

+Further, based on the defendant's evidence subject to the protective order (Exhibits Otsu 50–52) and the entire purport of the oral argument, the court inferred that the chipsets incorporated in the defendant's products did not generate or transmit reference signals using the parameters at issue and found no objective evidence to the contrary.

⇒ Limitation not satisfied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92805.pdf

Tokyo District Court, 2022 (Wa) 70139 and 2023 (Wa) 70009, “Claim for a Declaration of the Right to Obtain a Patent” <Nakashima>

Original Ameblo publication: 2025-06-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12909487358.html

2022 (Wa) 70139 and 2023 (Wa) 70009, “Claim for a Declaration of the Right to Obtain a Patent” <Nakashima>

An action seeking a declaration that the plaintiff held the right to obtain a patent for an invention in an international patent application deemed withdrawn because national-phase procedures were not completed in designated states was dismissed for lack of an interest in declaratory relief.

The court treated the right to obtain a patent arising under Japanese employee-invention law as distinct from the corresponding right under German law. Recognition of the former in Japan would not necessarily establish the latter in Germany. It therefore considered a German action to determine ownership under German law more effective and appropriate for resolving this dispute. This concerned the interest in obtaining declaratory relief in this case, not a general rule that Japanese judgments cannot be recognized in Germany.

(Excerpts from the court's reasoning)

“Under the principle of territoriality, the right to obtain a patent under Japan's employee-invention provisions and the right to obtain a patent under Germany's employee-invention provisions are different. Thus, even if the former is recognized in Japan, the latter is not necessarily recognized in Germany. …

Because the plaintiff can bring an action in a German court seeking a declaration of the right to obtain a patent under German employee-invention provisions, directly seeking a declaration of ownership of that right under German law in a German court, rather than seeking a declaration under Japanese law in a Japanese court, is a more effective and appropriate means of resolving the dispute.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92853.pdf

[Copyright] Tokyo District Court, 2023 (Wa) 70080, “Action for Disclosure of Sender Information” <Nakashima>

Original Ameblo publication: 2025-06-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12909727022.html

[Copyright] Tokyo District Court, 2023 (Wa) 70080, “Action for Disclosure of Sender Information” <Nakashima>

The plaintiff sought disclosure of sender information, alleging infringement of privacy and feelings of personal honor through posts about age and related matters, and infringement of copyright and the right of attribution through a separate post linking to an image.

⇒ The court rejected infringement of privacy because the age was already widely known and the legal interest in its nondisclosure did not outweigh the reasons for disclosure. It also held that statements such as “You're just creepy” and “Act your age!” were opinions and were not clearly insulting acts exceeding socially acceptable limits.

As to the image link, the court found that, under the circumstances of its display and the operations needed to reach the original image, transmission of the information did not directly cause copyright infringement. Infringement of the right of attribution was likewise not shown to be clear. It therefore dismissed the claim for disclosure of sender information.

(Excerpts from the court's reasoning)

Sending the URL in Post 2 caused a coarse, reduced-resolution version of the original image to be displayed. The original image, however, would not be seen unless a user viewing Post 2 clicked the URL and then clicked the same URL again, alongside which was a notice that it would take the user to another site.

The facts found above also establish that the original image merely showed the plaintiff's clothing and the like without showing the face, and that a thumbnail was already displayed in Post 2. In light of those facts, circumstances sufficient to find that a user viewing Post 2 would ordinarily deliberately click the URL and then click it again despite the notice of moving to another site cannot be recognized.

Under these circumstances, the sender's transmission of the URL cannot be found directly to cause infringement of the plaintiff's copyright through the circulation of information.

Accordingly, Post 2 cannot be found clearly to constitute the above-mentioned “infringement of rights.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92708.pdf

[Trademarks] Tokyo District Court, 2022 (Wa) No. 16062 — “仙修” (Judge Shibata)

Original Ameblo publication: 2025-06-12

Article type: Case note

Categories: Trademarks

Topics: Similarity of trademarks, Trademark infringement

First published on this website: 2026-10-16

Case information: 2022 (Wa) No. 16062

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12909987156.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12909987156-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12909987156-ja

[Trademarks] Tokyo District Court, 2022 (Wa) No. 16062 — “仙修” (Judge Shibata)

Registered mark: 仙脩

① Defendant's Mark 1 (仙修): similar

② Defendant's Mark 2 (仙修六神丸): similar

③ Defendant's Mark 3 (御所 [boxed separately] 仙修): similar

④ Defendant's Mark 4 (御所仙修): dissimilar

① 仙修 versus 仙脩

Both have two kanji, the first being the identical 仙. The second characters, 脩 and 修, differ in whether part of the lower portion resembles 月 or 彡; the remaining shapes closely resemble each other, as do the overall visual impressions. Both are pronounced “senshu.” Although 脩 originally means dried meat, it also largely encompasses meanings of 修. No conspicuous conceptual difference strongly suggesting distinct meanings to consumers was found. Overall similarity in appearance, pronunciation and concept was therefore established.

② 仙修六神丸

Of the five characters, 六神丸 has long denoted a traditional Chinese medicine/cardiotonic for palpitations and shortness of breath. It lacks inherent source-identifying force for consumers and is close to a generic name. Thus, 仙修 performs the strong source-identifying function. Comparing that portion with 仙脩 establishes similarity in appearance, pronunciation and concept as above; the mark as a whole was held similar.

③ 御所 (boxed separately) 仙修

The four characters comprise 御所 followed by 仙修. A space separates the two portions, and 御所 is boxed, visually dividing them. 仙修 can therefore also function independently as a source identifier. 御所 may be known as a place name in Nara, but it is unclear whether that meaning is immediately familiar nationwide; it may also be read “gosho,” meaning an imperial residence, and does not necessarily evoke one clear concept. The readily separable 仙修 portion resembles 仙脩, so this mark as a whole was also held similar.

④ 御所仙修

The characters run together without a space, and 御所 is not enclosed in a separate frame. Separate observation of the two portions is therefore not inevitable. 御所 also has some source-identifying function, and the whole forms a continuous pronunciation and appearance. Its appearance plainly differs from the two-character 仙脩, and “gose-senshu” or “gosho-senshu” sounds substantially different from “senshu.” On overall observation, the marks were held dissimilar. The court regarded 御所仙修 as a single, fully combined sign, not sufficiently similar to cause confusion with the registered mark.

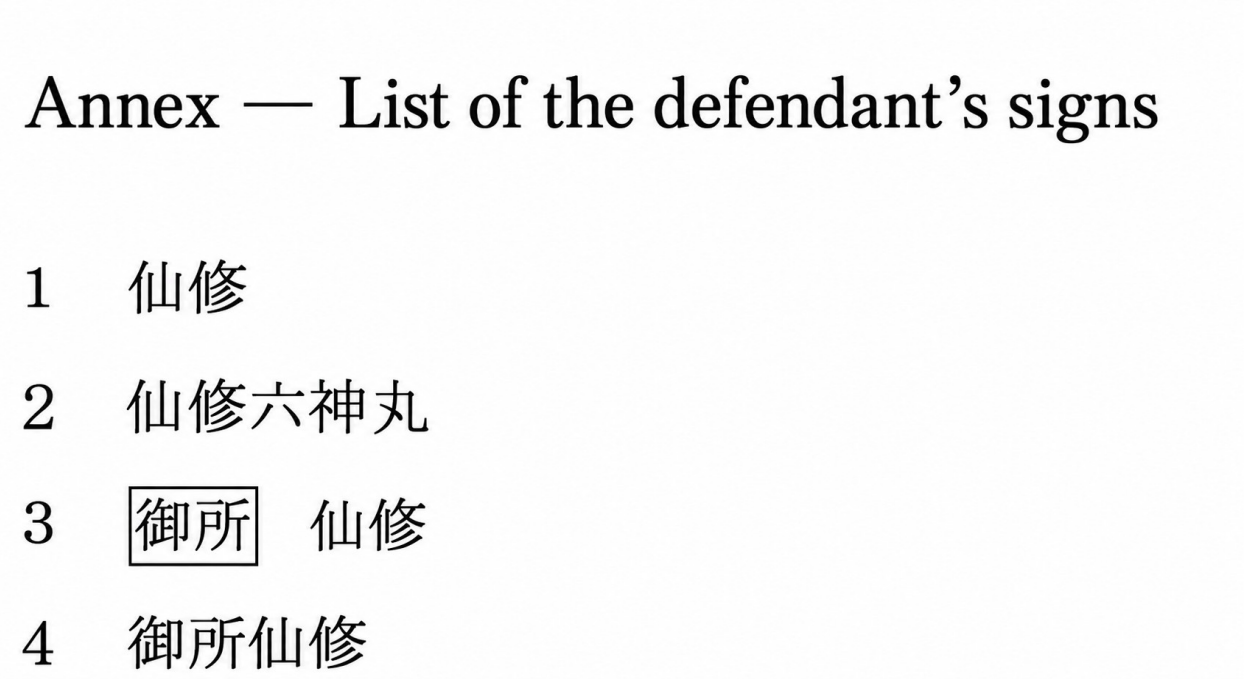
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92766.pdf

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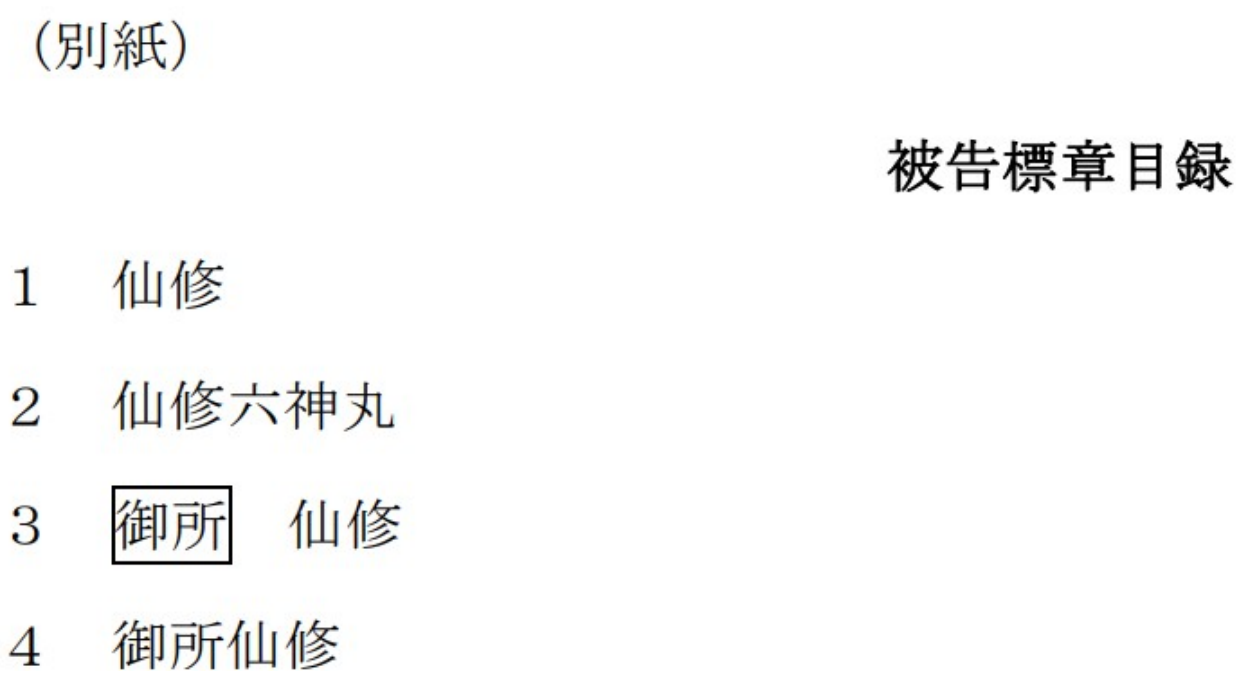
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Images from the original AMEBLO article

English translations of the original image text



Original images retained for comparison


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[Unfair Competition Prevention Act/Communication of False Facts] Osaka District Court, 2022 (Wa) 11394, “Shogi Game-Record Information” <Takemiya>

Original Ameblo publication: 2025-06-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12910186575.html

[Unfair Competition Prevention Act/Communication of False Facts] Osaka District Court, 2022 (Wa) 11394, “Shogi Game-Record Information” <Takemiya>

The information used in the videos about the shogi players’ moves and conduct was held to be publicly disclosed objective facts falling, in principle, within the sphere of free use.

Game records may include board diagrams and move sequences expressed through symbols. The information used here consisted of the moves and conduct of players in a broadcast game, including whether a player was thinking. The court did not conflate these objective facts with the concrete expressions, such as videos or text, that convey them, and proceeded on the undisputed premise that these videos did not infringe the defendant’s copyright.

The “Guidelines for Use of Game Records in the Osho Tournament” presented by the defendant were merely unilaterally established internal rules, not a legal basis for restricting third parties' free use of game-record information.

⇒ The plaintiff's video distribution did not infringe the defendant's copyright. The plaintiff's use of the game-record information fell within the scope of free use, and neither its means of acquisition nor manner of distribution was unlawful. The takedown request to the platform therefore constituted “communication of false facts.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92676.pdf

IP High Court, 2023 (Ne) 10093, “Copyright Owner of a Cinematographic Work” <Shoji>

Original Ameblo publication: 2025-06-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12910465129.html

2023 (Ne) 10093, “Copyright Owner of a Cinematographic Work” <Shoji>

*Note that even when the film producer acquires copyright under Copyright Act Article 29(1), the author still holds moral rights!!

The appellee published online an animated video (a cinematographic work) created by the appellant without indicating the author's name.

Because the appellant alone creatively contributed to the overall formation of the video, the appellant is its author.

On the other hand, the appellee was found to be the film producer because it intended to produce the video, held the legal rights and obligations concerning production, was responsible for the related income and expenditure, and bore the ultimate risk of covering production costs. Since the appellant had promised the appellee to participate in production, copyright (economic rights) belongs to the appellee under Copyright Act Article 29(1).

However, the appellant holds the right of attribution as an author's moral right, so that right (a moral right) was infringed.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92915.pdf

[Trademark] IP High Court, 2023 (Gyo-Ke) 10131, “hololive Indonesia” <Miyasaka>

Original Ameblo publication: 2025-06-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12910640633.html

[Trademark] 2023 (Gyo-Ke) 10131, “hololive Indonesia” <Miyasaka>

*“hololive Indonesia” violates Trademark Act Article 4(1)(xvi).

Within “hololive Indonesia,” “hololive” is a coined term capable of distinguishing goods and services, while “Indonesia” is widely known among Japanese consumers as referring to the Republic of Indonesia in Southeast Asia.

The application's designated goods and services span a wide range, including cosmetics, clothing and provision of food and beverages for general consumers, and many have no connection with Indonesia. If the mark is used for goods not produced or sold in Indonesia or services unrelated to Indonesia, the “Indonesia” portion may cause misunderstanding that the goods were produced or sold in Indonesia or that the services relate to Indonesia.

Even if the plaintiff argues that the mark is “the name of an Indonesia-based virtual idol group” and that fans are unlikely to be misled, consumers of the designated goods and services as a whole are not limited to the group's fans. Many will associate a mark displaying a country name with the goods' place of production or sale or a connection between the services and that country.

The plaintiff also relied on online subscriber numbers to argue that the mark was well known. The court observed that much of the content on the channels other than “hololive” was posted using Roman characters and that there was no evidence establishing how many subscribers were Japanese consumers. It therefore did not find the mark widely recognized among consumers in Japan.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92867.pdf

IP High Court, 2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Pile Sheet] <Hibiku Shimizu>

Original Ameblo publication: 2025-06-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12910812675.html

2023 (Gyo-Ke) 10034 [Method of Manufacturing a Raised-Pile Sheet] <Hibiku Shimizu>

B developed the imparting of raised-pile properties through steaming and drying, the characteristic part of the invention, so the defendant's application was a usurped application filed without the right to obtain a patent.

*In courtroom disputes over usurped applications, the results of witness examination have a major influence!!

(Excerpts from the court's reasoning)

…The changes in the allegations and statements greatly affect the very problem addressed by the invention, the need for it and its creative process. If A were truly the inventor, it would be hardly conceivable for those accounts to change in this manner merely through faulty recollection or the like.

Furthermore, …Shinei Senshoku initially outsourced the steaming process and performed it in-house from 2007 at the latest. The defendant's previous allegation that Shinei Senshoku formerly “did not perform a steaming process” therefore cannot be accepted as fact.

Moreover, the defendant's allegations would mean that Shinei Senshoku's former dyeing process did not include presetting. Yet A's account of trial and error concerning presetting was that he experimented with its position in the sequence, without explaining why presetting was introduced. This suggests that the presetting process already existed and A was experimenting solely with its order. Further, the conditions A described trying for steaming were “steam at 90°C for zero, thirty, sixty and 120 minutes,” which do not match the specification's description of “steaming at 95–110°C for two to three hours” ([0022]). In examination during the trial proceedings, A made statements premised on never having kept an invention notebook himself …. This must be regarded as wholly unnatural for an inventor supposedly engaged in repeated trial and error.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92893.pdf

[Article] The Scope of “Quality” in Acts Causing Misapprehension of Quality and the Like under the Unfair Competition Prevention Act (Michihiko Otsuka, Patent, 2025)

Original Ameblo publication: 2025-06-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12911048143.html

[Article] The Scope of “Quality” in Acts Causing Misapprehension of Quality and the Like under the Unfair Competition Prevention Act (Michihiko Otsuka, Patent, 2025, Vol. 78, No. 2)

Some court decisions have recognized dual-price displays as acts causing misapprehension of quality and the like.

Marking goods that do not embody a patented invention as patented constitutes a direct indication and an act causing misapprehension of quality and the like.

● Supreme Court decision of March 22, 1978, Keishu Vol. 32, No. 2, p. 316, “Special-Grade Sake Case”

Labeling sake as special grade without the required grade examination and certification, even if its quality is substantially no worse than special-grade sake, constitutes misrepresentation of quality and the like.

● Osaka District Court, January 31, 2017, “Toner Cartridge Case”

The court held: “Even if the defendant's goods merely lack designation by plaintiff Kyocera DS and objectively are no different in quality or content from the plaintiff's genuine goods, because the defendant lacks authority to make that designation, its designation indication may still properly be regarded as an indication ‘liable to cause misapprehension’ of quality and content.”

No court decision has been found holding that an indication of founding date or history constitutes an act causing misapprehension of quality and the like.

Where an indication of ranking accompanies a direct indication, it is sufficient to determine whether making that direct indication constitutes an act causing misapprehension of quality and the like.

https://jpaa-patent.info/patent/viewPdf/4609

[Article] Interpretation of Broad Patent Claims (Koichi Hirota, Patent, 2005, Vol. 58, No. 7)

Original Ameblo publication: 2025-06-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12911248954.html

[Article] Interpretation of Broad Patent Claims (Koichi Hirota, Patent, 2005, Vol. 58, No. 7)

— The “Holes” Theory —

“When comparing a selection invention with an earlier invention, conceptually the selection invention falls within the earlier invention's claims. However, it obtained a patent because it went beyond what the inventor of the earlier invention recognized as the invention. From the view that protection is limited to what the inventor recognized, the selection invention is separate and independent of the earlier invention, so on that view there is no dependent-invention relationship: it does not fall within the earlier invention's technical scope.”

“Regarding the recognition-limit theory, ‘It seeks to afford protection within what the inventor actually recognized; conversely, what the inventor did not recognize should not be protected … taking this view to its logical extreme severely limits the room for applying the doctrine of equivalents discussed below ….’”

https://www.jpaa.or.jp/old/activity/publication/patent/patent-library/patent-lib/200507/jpaapatent200507_021-033.pdf

[U.S. Patents] CloudofChange v. NCR (Fed. Cir. 2024)

Original Ameblo publication: 2025-06-19

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12911406750.html

[U.S. Patents] CloudofChange v. NCR (Fed. Cir. 2024)

The court examined in detail who constitutes the entity “using” a claimed system and whether the customers' acts could be attributed to defendant NCR (vicarious liability), and rejected direct infringement by the defendant.

⇒ For system claims, it is advisable to assert active inducement (35 U.S.C. § 271(b)) and contributory infringement (35 U.S.C. § 271(c)). (In this case, the plaintiff had abandoned inducement and contributory-infringement claims.)

1. The Entity Performing “Use”

Referring to Centillion, the court stated that the entity “using” a claimed system is the one that “control[s] the system as a whole and obtain[s] benefit from it.”

Here, “benefit” means not merely earning monetary revenue but enjoying the purpose and effect recited in the claims—that is, the essential advantages achieved by the invention.

Because the patent claims aim at constructing and editing POS terminals and using a system permitting repeated interaction with POS software over a network, the customers actually enjoy the system's intended purpose and effects.

2. Whether “Vicarious Liability” Is Established

For method claims, as stated in Akamai, even when a third party other than the accused infringer performs some of the steps, the accused infringer may be liable if it directs or controls that conduct or has a special relationship with the third party, such as agency or a contractual relationship.

However, the court pointed out that this case concerns system claims, where the central issue is to whom “use” is attributed, and the analysis differs from that for method claims.

The court applied Akamai’s vicarious-liability principles to this case. The district court’s error was not applying those principles to system claims as such, but conflating customers’ provision of an Internet connection with their “use” of the claimed system as a whole.

The approach in Akamai of examining and aggregating who performed each individual step of a method claim cannot simply be imported into the “use” analysis for a system claim.

For system claims, one must evaluate as a whole “who enjoys the invention's purpose and effects resulting from operation of all the system's constituent elements.”

For a system claim, the inquiry is whether the defendant directed or controlled the customer’s use of the entire claimed system. Here, a contractual obligation requiring the customer to supply an Internet connection did not establish NCR’s direction or control of that use.

https://patent-law.hatenablog.com/entry/2024/12/31/025010

[Article/Europe] After the Long-Awaited Decision: Are SEPs Now Worthless in Europe? (Christoph Rademacher, 2016)

Original Ameblo publication: 2025-06-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12911615875.html

[Article/Europe] After the Long-Awaited Decision: Are SEPs Now Worthless in Europe? (Christoph Rademacher, Intellectual Property Law and Policy Journal, Vol. 48 (2016))

As standardized technologies have spread, concerns have been raised that patentees may monopolize markets through SEPs.

Germany's “Orange-Book” judgment (2009) generally allowed patentees to seek injunctions against companies infringing SEPs, but subsequent European Commission policy emphasized the need to offer licenses on FRAND (fair, reasonable and nondiscriminatory) terms.

In 2013, the Huawei–ZTE litigation led to a referral to the CJEU.

The CJEU’s 2015 judgment addressed injunctions and product recalls sought by a dominant SEP holder that had committed to a standard-setting organisation to license on FRAND terms. It set out the following negotiation steps and related options under EU competition law.

(1) The patentee must notify the alleged infringer of the patent infringement.

(2) The alleged infringer must indicate willingness to obtain a license on FRAND terms.

(3) The patentee presents a specific licensing offer based on FRAND terms.

(4) If the alleged infringer objects to the terms, it must present a FRAND counteroffer.

(5) If the parties still cannot agree on FRAND terms after a counteroffer, they may, by common agreement, ask an independent third party to determine the royalty without delay. If the alleged infringer continues using the SEP after its counteroffer is rejected, it must also provide appropriate security and an account of past use.

The judgment clarified that seeking an injunction without complying with FRAND conditions may constitute an abuse of a dominant position. At the same time, deliberate “stalling tactics” in licensing negotiations are not permitted, and alleged infringers must respond promptly as well.

In the United States, contract law and equitable principles apply, while Japan regulates through the doctrine of abuse of rights. In Europe, by contrast, abuse of a dominant position under competition law provides the principal constraint.

Methods of calculating FRAND royalty rates are also discussed, including the equal allocation of value among standard-essential patents used by Japan's IP High Court and the classification approach proposed by the German judge Thomas Kühnen.

In conclusion, the CJEU judgment imposed certain procedural constraints on both patentees and alleged infringers in enforcing standard-essential patents in Europe.

However, many issues remain unresolved, and national courts' decisions will have a major impact on future practice.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2016/10/7af29f3dc5278332cbcb2e7c387bd816.pdf

IP High Court, 2022 (Ne) 10078 [Display Device Supportable with One Hand] <Kanno>

Original Ameblo publication: 2025-06-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12912148809.html

2022 (Ne) 10078 [Display Device Supportable with One Hand] <Kanno>

*Obviousness was found based on a shared technical field.

*The angle is a matter of design choice.

(Excerpt from the court's reasoning)

…The invention in Exhibit Otsu 1′ and the well-known technology both concern the technical field of small foldable electronic devices. Because they share that field, as explained in the original judgment incorporated with modifications …, a person skilled in the art could readily have conceived of adopting the well-known intermediate stopper in the invention in Exhibit Otsu 1′ to obtain the configuration relating to the difference at issue. In doing so, the angle at which the two display panels are fixed is a matter of design choice, and adjusting it to “a predetermined angle within the range of about 150 degrees to about 170 degrees” was also something a person skilled in the art could appropriately do ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91824.pdf

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10058 (Judge Hibiku Shimizu)

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HP: https://www.takaishihideki.com/en/single-post/ameblo-12912148937-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12912148937-ja

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10058 (Judge Hibiku Shimizu)

Three-dimensional shape of a support base for a dental model

→ Registration refused under Article 3(1)(iii); Article 3(2) not satisfied.

(Excerpt from the judgment, translated; portions omitted)

Of the shapes constituting the applied-for mark,

① A generally cuboid shape with a substantially oval top and a hollowed-out bottom, and

② regularly arranged holes, recesses and projections on its top and sides, are ordinary shapes for a support base. …

③ On the top, five holes are equally spaced in a central row. Sloping continuous projections lie inside both longitudinal edges, with several semicircular notches in their slopes (first characteristic shape). A row of small dotted projections lies between one continuous projection and the central holes (second characteristic shape). Both serve the product's function: connecting and securely fixing the support base to the dental-model fixing plate, which together form the working dental model, through insertion of dowel pins on the underside of the fixing plate and engagement with notches and projections, or increasing their connection strength.

The arrangement of the continuous projections inside both edges and the row of small projections also enhances aesthetic appeal. Many similar competing products have various irregularities, recesses and projections around the top holes and edges. The plaintiff's patent specification also describes a base with similar three-dimensional features and discloses that these projections and recesses assist connection and further increase the strength of the connection between the base and fixing plate.

In light of these facts, the shape, including its characteristic features, objectively falls within the foreseeable range of choices intended to serve function or aesthetics for similar goods under constraints arising from the goods' uses and nature. Since the mark includes no sign other than the product's three-dimensional shape, consumers would perceive it as consisting solely of an indication, in an ordinary manner, of the shape of the designated dental-model support base, without distinctiveness. …

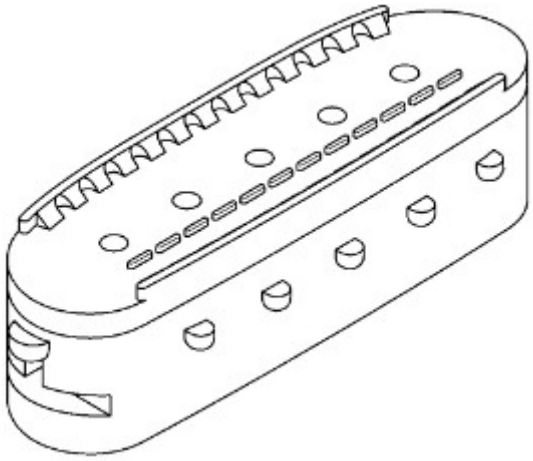
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Original images retained for comparison



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12912148937.html

[Article/Copyright] The Public’s Freedom to Use Accessible Works: The Working Vehicles Case — Maiko Murai

Original Ameblo publication: 2025-06-23

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12912149070.html

[Article/Copyright] The Public's Freedom to Use Accessible Works: The Working Vehicles Case (Maiko Murai, Intellectual Property Law and Policy Journal, Vol. 10 (2006))

*Tokyo District Court, 2001 (Wa) 56

A painter working mainly in outdoor painting alleged copyright infringement and infringement of the author's moral right of attribution after paintings created on the body of a municipal bus were included in a picture book published by the defendant publisher.

Although the municipal bus operated continuously on public roads and entered a garage at night, it was regarded as permanently located in outdoor places readily viewable by unspecified members of the public.

⇒ This falls under Copyright Act Article 46's case of “originals of artistic works permanently installed in outdoor places” and permits free use without the copyright owner's authorization.

The court also considered whether the use fell within Article 46(iv), “reproducing artistic works solely for the purpose of selling their reproductions, or selling those reproductions.” It held that it did not, because the defendant's picture book had the educational purpose of introducing young children to various vehicles traveling through town, rather than displaying the plaintiff's works primarily for appreciation or sales promotion.

Regarding the right of attribution, the court held that, given the purpose and manner of use, omitting the author's name was unlikely to harm the plaintiff's interests, and ultimately dismissed the plaintiff's claims.

The judgment is significant in recognizing paintings on moving bus bodies as “permanently installed” artistic works, broadly allowing freedom to use readily accessible works in public places while reaffirming Article 46(iv)'s exclusion from free use of reproductions made solely for the purpose of selling reproductions of the artistic works, and sales of those reproductions.

https://lex.juris.hokudai.ac.jp/coe/english/pressinfo/journal/vol_10/10_9.pdf

[U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC — Willfulness

Original Ameblo publication: 2025-06-25

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12912546111.html

[U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC

***Treatment of evidence concerning willful infringement**

35 U.S.C. § 298 provides that an infringer's failure to obtain advice of counsel concerning alleged patent infringement, or failure to present such advice to the court or jury, cannot be used to prove willful infringement.

(1) The CAFC held that the Provisur expert's testimony that "Weber did not ask a third party to evaluate the patents" failed to distinguish legal from non-legal services. Provisur could not circumvent § 298 by substituting advice from a third party for advice of counsel, and admitting that testimony violated § 298.

(2) The judgment held that mere awareness or monitoring of the patents was insufficient: proving willful infringement requires specific evidence showing the defendant's clear intent to engage in particular infringing conduct.

＝BASF Plant Sci., LP v. Commonwealth Sci. and Indus. Rsch. Org.（CAFC, March 15, 2022）

https://www.cafc.uscourts.gov/opinions-orders/23-1438.OPINION.10-2-2024_2394588.pdf

IP High Court, 2022 (Ne) 10055 [Specified Heat-Treated Meat Product] <Shoji>

Original Ameblo publication: 2025-06-27

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913024094.html

2022 (Ne) 10055 [Specified Heat-Treated Meat Product] <Shoji>

*The court rejected obviousness of directly applying the cited technology, which presupposed sufficient heating, to the specified heat-treated meat product at issue under different heating conditions, in light of technical differences concerning sterilization and related matters.

⇒ Inventive step: satisfied

(Excerpts from the court's reasoning)

Specified heat-treated meat products and heat-treated meat products differ not only in the heating temperature and time at the meat's center, but also completely in … the principle of color development. Producing a specified heat-treated meat product by changing the heating temperature and time of a heat-treated meat product therefore cannot be regarded as a matter of routine design.

In addition, heat-treated meat products heated to their centers for a sufficient time and adequately sterilized differ entirely in safety from specified heat-treated meat products deliberately not thoroughly heated and eaten as they are. A person skilled in the art would therefore not contemplate applying the technology of heat-treated meat products, whose safety is ensured both by thorough heating and by addition of nitrite during curing, to specified heat-treated meat products that are not thoroughly heated and in which bacteria may proliferate again.

Even if one did apply it, producing a specified heat-treated meat product would require major changes to specifications, such as control of heating temperature and time and whether to use a color-forming agent. Thus, a person skilled in the art encountering pastrami beef, a heat-treated meat product, would not thereby be motivated to apply the same manufacturing technology to make a specified heat-treated meat product.

Furthermore, even if consumers prefer to avoid color-forming agents, this concerns only their product choices when purchasing and does not provide a basis for applying the manufacturing technology as well.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92732.pdf

IP High Court, 2005 (Gyo-Ke) 10366 [Method of Manufacturing Bottles for Carbonated Beverages] <Tsukahara>

Original Ameblo publication: 2025-06-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913416981.html

2005 (Gyo-Ke) 10366 [Method of Manufacturing Bottles for Carbonated Beverages] <Tsukahara>

*In explaining its approach to the proceedings in this case, the court stated that, even if it found a difference obvious where the trial decision had found it nonobvious, there could be scope to uphold the decision rejecting invalidation if another difference not decided by the trial decision was nonobvious.

The court reassessed Difference 2, which the trial decision had found “nonobvious,” as “obvious,” and then itself examined Difference 1, on which the trial decision had reserved judgment, and found that “obvious” as well.

The reasoning suggests that if the court had found Difference 1 “nonobvious,” the conclusion itself (no ground for invalidity = rejection of the request) could have been maintained even with Difference 2 “obvious.”

In this case, however, Difference 1 was also found “obvious,” so the trial decision's conclusion lost its basis and was rescinded.

*Both parties' consent was obtained.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9349.pdf

[U.S.] Finjan v. Secure Computing <November 2010, CAFC>

Original Ameblo publication: 2025-06-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913417899.html

[U.S.] Finjan v. Secure Computing <November 2010, CAFC (626 F.3d 1197)>

Software for proactive scanning incorporated in a product constituting a recording medium was locked.

⇒ Product invention infringed; method invention not infringed.

(1) Because a user could unlock it by purchasing a key, direct infringement of the product invention was established.

*In ACCO v. ABA, 501 F.3d 1307 (Fed. Cir. 2007), the claims required a particular configuration (for example, locking-device pins positioned in particular slots), so direct infringement required actual use in an infringing mode. By contrast, Finjan's claims did not require a particular configuration or “activation” for the proactive-scanning function to operate; the presence of a program capable of performing that function was sufficient for infringement.

(2) No infringement of the method claims was established because there was no proof that the defendants actually practiced the claimed methods in the United States.

=Southwest Software v. Harlequin, 226 F.3d 1280 (Fed. Cir. 2000)

https://www.cafc.uscourts.gov/opinions-orders/09-1576.pdf

[U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC

Original Ameblo publication: 2025-06-29

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913418146.html

[U.S.] Provisur Tech v. Weber (October 2, 2024), CAFC

For a claim directed to capability, where changing an accused product’s settings would bring it within the claim’s scope, a theoretical possibility alone does not establish infringement; the product must be “readily configurable” to infringe.

=Fantasy Sports Props. v. Sportsline.com, 287 F.3d 1108 (Fed. Cir. 2002).

⇒ The accused product was sold in “retract-to-fill” mode, and customers' access to the settings screen needed to enable claim 14's function (“advance-to-fill”) was restricted.

⇒ The infringement judgment was reversed as to claim 14 of the patent at issue.

https://www.cafc.uscourts.gov/opinions-orders/23-1438.OPINION.10-2-2024_2394588.pdf

[Criminal/Unfair Competition Prevention Act/Trade Secrets] Acquittal: Nagoya District Court, March 18, 2022, 2017 (Wa) No. 427

Original Ameblo publication: 2025-06-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913607755.html

[Criminal/Unfair Competition Prevention Act/Trade Secrets] Acquittal: Nagoya District Court, March 18, 2022, 2017 (Wa) No. 427, “Magnetic Sensor Wire Alignment Process Case”

(1) “It amounts merely to selecting and combining commonplace methods and cannot be said to be not generally known or not readily ascertainable.”

⇒ Not “non-public”

(2) Even setting (1) aside, “the possibility remains that they believed it did not constitute a trade secret, and there were reasonable grounds for that belief.”

⇒ They cannot be held liable for an intentional offense.

(Excerpt from the court's reasoning)

The information the two defendants explained to e at the meeting concerned a process for aligning amorphous wire on a substrate, but differed significantly in important process steps from the structure of b's wire-alignment apparatus and the process of aligning amorphous wire on a substrate using that apparatus. Further, the portion corresponding to the process alleged by the prosecutor stripped away the devices for precisely arranging wires on a substrate in light of amorphous wire's characteristics, and was excessively abstracted and generalized. Even viewed as a unified series of steps, it amounted merely to selecting and combining commonplace methods and could not be said to be not generally known or not readily ascertainable. It therefore did not satisfy the non-public-status requirement among the three requirements for trade secrets (management as secret, usefulness and non-public status). Accordingly, the two defendants cannot be said to have disclosed b's trade secrets at the meeting. Furthermore, even adopting the view that their conduct objectively constituted disclosure of a trade secret (which is not this court's view), the possibility remains that they believed the information explained to e at the meeting did not constitute b's trade secrets, and reasonable grounds existed for that belief. In light of these and other circumstances, neither defendant can be held liable for an intentional offense. Both defendants are therefore acquitted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91195.pdf

Hideki Takaishi Article Collection

July–December 2025

English Edition

158 articles

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116 2025-11-13 [United States] LAB v. Qiagen (CAFC, August 13, 2025)

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118 2025-11-16 [Overview] Patent Examination Standards Working Group: Disclaimer amendments and AI-related examination issues (November 17, 2025)

119 2025-11-17 Tokyo District Court, 2023 (Wa) 70346 [Wireless scuff plate] <Nakashima>

120 2025-11-21 Osaka District Court, 2022 (Wa) 11025 [Porous air-permeable bag containing food for mites]

121 2025-11-23 [IP Practice Online] Current state, challenges, and responses in Customs' border enforcement against IP-infringing goods (Attorney Kei Iida)

122 2025-11-23 [IP Practice Online] Intellectual property rights and Customs procedures (Attorney Reiko Tonomura)

123 2025-11-25 Osaka District Court, 2022 (Wa) 9696 [Method for producing active GcMAF]

124 2025-11-25 [IP Practice Online] A surge during COVID-19! Online sales of counterfeits in Asia: Current situation and countermeasures (Patent attorney Tsuyoshi Masutani)

125 2025-11-27 Osaka District Court, 2023 (Wa) 10237 [Tool for slaughtering wild animals]

126 2025-11-27 [Unfair Competition / Trade Secrets] Osaka District Court, 2023 (Wa) 2681

127 2025-11-28 Tokyo District Court, 2024 (Wa) 70106 <Kokubu>

128 2025-11-29 [New on YouTube] May 28, 2025 (IP LAB)

129 2025-11-30 [IP Practice Online] An enjoyable discussion of patent claim interpretation (Attorney Masakazu Kobayashi)

130 2025-12-01 Tokyo District Court, 2023 (Wa) 70425 [Information Processing Apparatus] <Nakashima>

131 2025-12-02 [Contract] Osaka District Court, 2023 (Wa) 12021

132 2025-12-03 [Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2023 (Wa) 12731

133 2025-12-04 [Europe] CJEU Grand Chamber Judgment on Jurisdiction over Foreign Patent Infringement and Its Implications for the UPC (February 25, 2025), C-339/22

134 2025-12-05 [Copyright] Tokyo District Court, 2024 (Wa) 70126 <Nakashima>

135 2025-12-09 IP High Court Grand Panel, 2006 (Gyo-Ke) 10563 [Solder Resist]

136 2025-12-09 [IP Practice Online] Explanation of Patent Eligibility Issues in the United States and Practical Responses in Patent Prosecution (Japanese and U.S. Patent Attorney Shigeki Takeuchi)

137 2025-12-09 [IP Practice Online] Abductive Reasoning as an Axis of Logic and Thought in Patent Prosecution Practice —Focusing on Chemical Inventions (Patent Attorney Masanori Tomatsuri)

138 2025-12-09 [Copyright] Tokyo District Court, 2024 (Wa) 70189 <Nakashima>

139 2025-12-10 Tokyo District Court, 2022 (Wa) 70058 [Grapple Bucket Device] <Kokubu>

140 2025-12-11 <Study Group on Effective Disclosure and Governance of Intellectual Property Investment and Utilization Strategies (24th Meeting)>

141 2025-12-12 IP High Court, 2025 (Gyo-Ke) 10046 [Multifunctional Quantum Charge Ratio Flow Conversion Device] <Nakadaira>

142 2025-12-13 “Manual for Startups on Collaboration with Operating Companies” (INPIT)

143 2025-12-14 [IP Practice Online] Joint Reading Festival for “A Sham Selection of One Hundred Copyright Cases” (Subaru Tomori)

144 2025-12-15 Tokyo District Court, 2025 (Wa) 70002 [Nanocomposite Having Quantum Dots and Method for Manufacturing the Same] <Takahashi>

145 2025-12-16 IP High Court, 2025 (Ne) 10032 [Rod-Shaped Light] <Honda>

146 2025-12-17 IP High Court, 2024 (Gyo-Ke) 10012 [Enzyme-treated milk product] <Judge Hibiku Shimizu>

147 2025-12-18 IP High Court, 2024 (Gyo-Ke) 10076 [Fuel and Blending Combinations Thereof] <Judge Hibiku Shimizu>

148 2025-12-19 IP High Court, 2024 (Ne) 10069 [Toilet rolls, etc.] <Judge Nakadaira>

149 2025-12-22 Osaka District Court, 2022 (Wa) 8985 [Cross connector] <Judge Matsukawa>

150 2025-12-22 IP High Court, 2024 (Gyo-Ke) 10100 [Child safety seat for attachment to a vehicle seat] <Judge Nakadaira>

151 2025-12-22 IP High Court, 2024 (Gyo-Ke) 10085 [... Solar power self-consumption system] <Judge Nakadaira>

152 2025-12-23 IP High Court, 2024 (Gyo-Ke) 10081 [Pet matching system] <Judge Nakadaira>

153 2025-12-24 IP High Court, 2025 (Ne) 10042 [Fastening hardware] <Judge Hibiku Shimizu>

154 2025-12-25 Osaka District Court, 2024 (Wa) 6216 [Taxi dispatch management system] <Judge Matsuami>

155 2025-12-26 IP High Court, 2024 (Gyo-Ke) 10073 [Therapeutic agent inducing cytotoxicity] <Judge Masuda>

156 2025-12-27 Osaka District Court, 2024 (Wa) No. 7193 — Article transport equipment (Judge Matsuami)

157 2025-12-28 IP High Court, 2025 (Ne) 10025 [Spindle Motor] <Nakadaira> ⇒ Claim for Compensation for an Employee Invention

158 2025-12-30 IP High Court, 2025 (Ne) 10035 [Vehicle Guidance System] <Honda> (PXZ v. East Nippon Expressway Company Limited)

[Trademark] IP High Court, 2024 (Gyo-Ke) 10055, “Shifuku no Girisha” (Blissful Greece) <Hibiku Shimizu> (Plaintiff: Hellenic Republic)

Original Ameblo publication: 2025-07-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12913799847.html

[Trademark] IP High Court, 2024 (Gyo-Ke) 10055, “Shifuku no Girisha” (Blissful Greece) <Hibiku Shimizu> (Plaintiff: Hellenic Republic)

*“Shifuku no Girisha” (Blissful Greece) is not understood as being limited or specifically confined to “produced in Greece.”

⇒ No violation of Article 3(1)(iii) of the Trademark Act or the other provisions at issue.

(Translation of an excerpt from the court's reasoning)

The trademark at issue combines the words “shifuku no” (blissful) with “Girisha” (Greece), … and is found to convey a single coherent meaning along the lines of “Greece, a country of unsurpassed happiness.” It therefore calls to consumers' minds the country or region of Greece itself together with the positive image conveyed by “blissful,” and projects that image onto the designated goods at issue, namely yogurt. Unlike a trademark consisting solely of “Greece,” it does not descriptively indicate a place of production or sale. Rather, it merely uses an abstract image associated with the country or region of Greece to indicate that the goods are connected with Greece in some way. That connection is not confined to a place of production or sale, and the mark cannot be regarded as indicating “Greece” as the place of production or sale. Neither the actual circumstances of trade in yogurt, which encompasses the designated goods, nor the Internet search results for “Shifuku no Girisha” … provide sufficient evidence that “Shifuku no Girisha,” or similar signs combining words such as “blissful” with the name of a country or region, are generally used to indicate the place of production or sale or other characteristics of goods. The examples cited by the plaintiff, such as “Blissful Hawaii” and “Blissful America,” … are used in articles and advertisements introducing overseas travel or overseas real estate as expressions referring to the country or region itself, and are not examples of indications identifying the place of production of particular goods. Accordingly, the trademark at issue cannot be described as a “trademark consisting solely of a sign indicating, in a commonly used manner, the place of production, place of sale, or other characteristics of the goods.” …

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93616.pdf

[Trademark] IP High Court, 2024 (Gyo-Ke) 10066, “UNITED GOLD” Case <Nakadaira>

Original Ameblo publication: 2025-07-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914011169.html

[Trademark] IP High Court, 2024 (Gyo-Ke) 10066, “UNITED GOLD” Case <Nakadaira>

Trademark at issue: “UNITED GOLD”

Cited trademark: “UNITED／ユナイテッド” (“UNITED” and its katakana rendering “Yunaiteddo,” written on two lines)

*Because “UNITED” had weak distinctiveness in the fashion industry and related industries, “UNITED GOLD” is an inseparable whole.

⇒ Not similar.

(Translation of an excerpt from the court's reasoning)

… In the fashion industry handling clothing and accompanying personal accessories, and in the retail industries for those goods, the “UNITED” portion is found to have weak distinctiveness. Accordingly, because the “UNITED” portion of the trademark at issue is not found to possess any particular distinctiveness, it is appropriate to view the trademark at issue as a mark having the inseparable overall composition “UNITED GOLD.” It is not considered to be observed separately as “UNITED” and “GOLD”; therefore, it is appropriate to conclude that the pronunciation “Yunaiteddo” does not arise from the trademark at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93652.pdf

[Portrait Rights] IP High Court, 2023 (Ne) 10085 <Honda>

Original Ameblo publication: 2025-07-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914190373.html

[Portrait Rights] IP High Court, 2023 (Ne) 10085 <Honda>

The sale of videos recording martial-arts demonstrations does not exceed the legally tolerable limit and therefore does not infringe portrait rights.

—The appellant knew about the sale of the videos, entered into a contract, received an appearance fee, and had not protested.

*The issue was not whether consent existed, but whether the legally tolerable limit was exceeded.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92836.pdf

IP High Court, 2023 (Gyo-Ke) 10052 [Assist Device] <Miyasaka>

Original Ameblo publication: 2025-07-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914394858.html

IP High Court, 2023 (Gyo-Ke) 10052 [Assist Device] <Miyasaka>

Claim: "… the main bearing consists solely of one single-row rolling bearing (excluding cross-roller bearings), or …"

The description in Exhibit Ko 1 does not establish what type of bearing the "bearing" in the primary reference is.

⇒ Not specifically identified.

*(Commentary) "Addition versus substitution": If a particular configuration is found to be disclosed in the primary reference, the obviousness of "substitution" becomes the issue, and the hurdle for denying inventive step is high. If a particular configuration is found not to be disclosed in the primary reference, the obviousness of "addition" becomes the issue, so the hurdle for denying inventive step is lower.

(Summary of the reasons for the JPO's revocation decision) "As bearings, 'single-row rolling bearings' other than cross-roller bearings and 'plain bearings' are well-known configurations of machine elements."

(Excerpt from the court's reasoning)

"… what type of bearing the 'one bearing' is cannot but be said to be unclear from the description in Exhibit Ko 1." "For a person skilled in the art who came across the assist device of the Ko 1 Invention to measure the direction and magnitude of the load on the shaft in order to select an appropriate bearing and, based on the measurement results, to change the design to an optimal, inexpensive bearing from among the options of well-known bearings should be said to be no more than an exercise of the ordinary creative ability of a person skilled in the art." "Neither the revocation decision's determination nor this court's determination in item (b) above is based on the well-known nature of single-row rolling bearings as mere machine elements; rather, they set out reasoning focused on what main bearing would be selected for a reduction gear for an assist device in light of the differences between reduction gears for assist devices and reduction gears for industrial robots, and they fully take into account the premise of Feature A (the technical context) asserted by the plaintiff."

⇒ Inventive step denied.

https://www.youtube.com/watch?app=desktop&v=eUH8ktGmkjQ

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92825.pdf

[Claim for contractual penalties] Osaka District Court, 2023 (Wa) No. 829 (Judge Matsuami)

Original Ameblo publication: 2025-07-05

Article type: Case note

Categories: Trademarks, Unfair competition law, Other Japanese law

Topics: Trademark use, Trade secrets, Contracts

First published on this website: 2026-10-16

Case information: 2023 (Wa) No. 829

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914679709.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12914679709-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12914679709-ja

[Claim for contractual penalties] Osaka District Court, 2023 (Wa) No. 829 (Judge Matsuami)

The defendant had been a franchisee but terminated the contract and continued operating an English conversation school at the same location.

→ An employee of the plaintiff attended a consultation session and persistently requested a leaflet. The defendant distributed an old leaflet but explained that the school had closed as a Wam school.

→ This did not constitute trademark “use.”

The allegation of unlawful use of trade secrets was also rejected because the “learning instruction know-how” asserted by the plaintiff lacked specificity.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93290.pdf

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https://www.linkedin.com/feed/update/urn:li:activity:7514575475688607744/

Images from the original AMEBLO article

English translations of the original image text

English translation of the original image

Registration number:	No. 5935831
Filing date:	May 17, Heisei 28 (2016)
Registration date:	March 31, Heisei 29 (2017)
Service class:	Class 41
Designated services:	Teaching through individual instruction at a cram school
Trademark:	Wam
Text in the mark:	個別指導 (Individual instruction); ワム (Wamu); Wam; WHOLE ABILITY MAKING

English translation of the original image

Registration number: No. 5935831

Filing date: May 17, 2016

Registration date: March 31, 2017

Service class: Class 41

Designated services: Teaching through individual instruction at a cram school.

Trademark: the composite Wam mark shown in the original image.

Text in the mark: 個別指導 (individual instruction); ワム (Wamu, the Japanese phonetic rendering of Wam); Wam; WHOLE ABILITY MAKING.

Original images retained for comparison

登録番号	第５９３５８３１号
出願日	平成２８年５月１７日
登録日	平成２９年３月３１日
役務の区分	第４１類
指定役務	学習塾での個別指導による教授
商　標	

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12914679709.html

[South Korea] Patent Court, December 3, 2024 <2023 Na 10914>

Original Ameblo publication: 2025-07-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914775015.html

[South Korea] Patent Court, December 3, 2024 <2023 Na 10914>

Unless processing or assembly abroad is extremely minor or simple, domestic production of a semi-finished product does not constitute direct infringement.

⇒ Where production of components or a semi-finished product has reached a state in which the patented invention's functions and effects are achieved, domestic production is recognized (Supreme Court, 2019 Da 222782). In this case, however, the remaining mixing step was found not to be “extremely minor or simple,” and non-infringement was found.

(Note) The Patent Court’s judgment of December 3, 2024 (2023Na10914), citing the reasoning of Supreme Court judgment 2019Da222782, held that domestic production of the patented product is exceptionally recognized where all of the parts or components for working the patented invention are produced in Korea, or a semi-finished product that has completed most of the production stages and has all principal elements is produced there; they are to be exported to a single entity for final processing or assembly; that processing or assembly is extremely minor or simple; and the state in which the functions and effects can be achieved has been reached. In this case, the mixing step was not extremely minor or simple, and production of the individual conjugate solutions alone had not reached the state in which the functions and effects could be achieved. https://www.law.go.kr/LSW/precInfoP.do?precSeq=606645

★In the United States: CAFC, April 2001, Waymark v. Porta Systems

Under 35 U.S.C. § 271(f)(2), where components meeting the other statutory requirements are supplied from the United States with the intent that they be combined abroad, proof that assembly was actually completed abroad is not required.

⇒ In the case in which completion of the system was planned but it was not actually assembled, the court vacated the non-infringement determination based solely on the absence of actual assembly abroad and remanded the claim under that provision.

★Also in Japan: Osaka District Court, 2009 (Wa) 15096, “Heat-Treatment Furnace Equipped with an In-Furnace Heater …” Case

*Knock-down shipment after initial assembly (a method in which all components are assembled at the export destination) was held to constitute a transfer of the products.

(Translation of an excerpt from the court's reasoning)

For the defendant's products intended for overseas customers as well, the defendant manufactured or procured the necessary components in Japan … and completed the products to the stage of provisional assembly, at which it checked their operation; for some products, it even provisionally fired the furnace body. Although these products were subsequently returned to component form and exported, and some components were added when they were assembled overseas, those components were unrelated to the constituent requirements of the patented invention. Therefore, at the stage of provisional assembly in Japan, the defendant's products, although still work in progress, are found already to have been completed to the extent that they satisfied the constituent requirements of the patented invention. On that basis, the defendant can be said to have performed “production” (Article 2(3)(i) of the Patent Act), an act of working the patented invention, in Japan. …

The defendant's products were reportedly returned to component form after provisional assembly and operational checks, and then packed and exported. … Given that the products in their provisionally assembled state appear not to have been so large as to make transportation in that state impossible, their being provisionally assembled and then returned to component form is found to have been merely for convenience of transportation. …

Considering these matters together, the series of acts performed by the defendant in Japan in connection with the sale of the defendant's products can be regarded as “transfer” (Article 2(3)(i) of the Patent Act), an act of working the patented invention, notwithstanding the fact that the defendant's products were in component form before export.

https://www.hanketsu.jiii.or.jp/hanketsu/jsp/hatumeisi/news/201206news.pdf

[Trademarks] Cases Concerning Similarity of Marks with Reordered Kanji

Original Ameblo publication: 2025-07-07

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12914987745.html

[Trademarks] Cases Concerning Similarity of Marks with Reordered Kanji

Supreme Court, 1991 (O) No. 1805: “木林森” and “大森林” (original Japanese marks). The Court recognized the possibility of similarity and remanded the case; it did not finally determine that the marks were similar.

IP High Court, 2009 (Gyo-Ke) No. 10071: “肌優” and the cited mark featuring “優肌” (the same kanji in reverse order) were held similar.

The emphasis was on concept, rather than pronunciation.

A judicial decision holding that conceptual similarity should be assessed on the basis of the concept that naturally arises in light of customary practices in the field of the designated goods is the IP High Court's decision in 2014 (Gyo-Ke) 10180, the “Hakko Genmai Saishoku GABA” (Fermented Brown Rice Vegetable Diet GABA) Case.

https://www.juris.hokudai.ac.jp/riilp/wp-content/uploads/2017/06/0007b0bda631a0cf1391238f78c314fa.pdf

[Patents / Employee Inventions] Osaka District Court, 2020 (Wa) 12107

Original Ameblo publication: 2025-07-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12915224559.html

[Patents / Employee Inventions] Osaka District Court, 2020 (Wa) 12107

*Because making an orally disintegrating (OD) tablet was the characteristic part of the invention, the plaintiff, who was involved in that work, was an inventor.

Prior art existed in which formulations containing other ingredients had been converted into OD tablets. However, it did not concern the same ingredient as Invention 2 at issue, and there was no indication that the defendant had specifically considered converting its previously marketed product into OD tablets before the plaintiff's proposal. It therefore did not alter the finding that the plaintiff was an inventor.

(Translation of an excerpt from the court's reasoning)

The plaintiff recognized problems associated with taking the originator drug L capsules and similar products and investigated the greater demand for OD tablets than for capsules. The plaintiff then conceived the development of OD tablets, namely orally disintegrating tablets of ambroxol hydrochloride, investigated other companies' products and conducted technical studies, and proposed their development at a PJ meeting. … The plaintiff attended every PJ meeting up to the meeting to select the next development candidates, participated in preliminary feasibility experiments concerning conversion to OD tablets, gave a certain degree of concrete form to the feasibility of microparticle coating, and ultimately obtained formal development approval at that selection meeting.

Accordingly, the plaintiff … can be said to have conceived the characteristic part of Invention 2 at issue. The plaintiff is therefore found to be an inventor of Invention 2 on this basis alone.

In response, the defendant argues, among other things, that the defendant itself had already been selling an ambroxol hydrochloride capsule formulation; that the idea of changing its dosage form to OD tablets was easy to conceive; that this point cannot be called the characteristic part of the invention; and that conceiving it therefore does not make the plaintiff an inventor of Invention 2 at issue.

Although the prior art includes examples of conversion from capsules to OD tablets (such as Takepron), they do not concern ambroxol hydrochloride, the same ingredient as in Invention 2 at issue. Nor is there any indication that, before the plaintiff's proposal, the defendant had specifically considered improving the previously marketed product into OD tablets. Accordingly, the facts asserted by the defendant do not alter the above findings concerning the characteristic part or, on that basis, the plaintiff's inventorship, and the defendant's argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92388.pdf

Tokyo High Court, 1994 (Gyo-Ke) No. 243 — Buddhist altar (Judge Minoru Takeda)

Original Ameblo publication: 2025-07-09

Article type: Case note

Categories: Patents

Topics: Examination and appeal practice

First published on this website: 2026-10-16

Case information: Tokyo High Court, 1994 (Gyo-Ke) No. 243

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12915398538.html

HP: https://www.takaishihideki.com/en/single-post/ameblo-12915398538-en

Japanese version: https://www.takaishihideki.com/single-post/ameblo-12915398538-ja

Tokyo High Court, 1994 (Gyo-Ke) No. 243 — Buddhist altar (Judge Minoru Takeda)

*For applications filed on the same day (Article 39(2)), it is not enough that the other invention is identical when viewed from one invention. At the same time, viewed from the other invention, the first invention must also be regarded as identical!!

(The same as the Examination Guidelines.)

(Excerpt from the judgment, translated)

…In light of the purpose of Article 39(2) of the Patent Act, under which no applicant may obtain a patent for any of two or more inventions in applications filed on the same day if the applicants fail to reach an agreement, “the same invention” under that paragraph requires more than a finding of identity when one invention is compared with the other from only the first invention’s standpoint. The inventions must also be regarded as identical when the comparison is made from the other invention’s standpoint.

As for requirement b of the other application’s invention, …even if the “swing arm,” in terms of its actual function, corresponds to a subordinate concept of requirement D of the invention at issue, it specifies the means for folding and storing the altar doors structurally as a “swing arm” not specifically disclosed in the specification at issue. This clearly produces an effect absent from the invention at issue: …simplifying the means for opening, closing and storing the altar doors and improving assembly and workability….

Accordingly, requirement b includes a configuration producing an effect distinct from the invention at issue. Viewed from the other application’s invention, requirement b therefore cannot be understood from the requirements of the invention at issue, and cannot be said to coincide with its requirement D.

https://www.jpo.go.jp/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0400bm.pdf

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https://www.linkedin.com/feed/update/urn:li:activity:7514575834255380480/

Images from the original AMEBLO article

English translations of the original image text

English translation of the case table — 1/4

IP High Court, Heisei 22 (Gyo-Ke) No. 10379 — Judge Iimura
Slot machine
Standard for “the same invention” under Article 39(2), and its application.

“Regarding ‘the same invention’ under Article 39(2) of the Patent Act, where there are differences in the configurations of multiple inventions, if the configuration relating to the differences is assessed as making no technical contribution to solving the problem, those inventions should be construed as the same invention. However, where the configuration relating to the differences cannot be so assessed, they are not the same invention under Article 39(2) of the Patent Act.

In a pachinko gaming machine, the machine itself automatically stops at symbols corresponding to a winning flag determined in advance after a predetermined time. By contrast, in a rotary-reel gaming machine (slot machine), the player must press the stop button to stop the symbols, and the symbols at the time of stopping may vary depending on when the stop button is pressed. Therefore, upon notification of a big-bonus win, the player tries to align the big-bonus identification information, and a difference is recognized in the effect of giving that notification. In light of these facts, … the technology of notifying by sound that a big-bonus combination has been internally selected cannot be recognized as a configuration that can be assessed as making no technical contribution to solving the problem in the technical field of slot machines.”

Result markers in the source: Win / Valid / ○.

English translation of the case table — 2/4

IP High Court, Heisei 24 (Gyo-Ke) No. 10123 — Judge Iimura
Light-emitting diode
Application of “the same invention” under Article 39(2).

“… According to the description in the patent specification …, ‘improving the visual sensitivity of the light-emitting diode’ means bringing the emission wavelength of light-emitting elements having a blue emission color close to violet, with emission peaks near wavelengths of 430 nm and 370 nm, closer to wavelengths near 550 nm or 500 nm, where visual sensitivity reaches its peak. As stated above, ‘correcting the color of the light-emitting element’ in the seventh divisional application and ‘improving the visual sensitivity of the light-emitting diode’ in the patented invention at issue have different technical significance and differ substantially.”

Result markers in the source: Win / Valid / △.

English translation of the case table — 3/4

IP High Court, Heisei 25 (Gyo-Ke) No. 10282 — Judge Shimizu
Rice cake
Application of “the same invention” under Article 39(2).

“… According to the description in the patent specification …, the divisional invention … produces the effects of allowing cuts to be formed easily and being still more suitable for mass production, and can be said to have a certain degree of technical significance. On the other hand, patented invention 1 at issue, like the divisional invention, has cuts in the lateral surface constituting an upright side surface of a cut rice cake. However, although those cuts have ‘a length with the direction along the upright side surface as the circumferential direction,’ they may simply be ‘continuous all the way around in the circumferential direction to form a ring,’ or ‘formed on opposite side surfaces constituting upright side surfaces.’ They therefore differ from the cuts technically limited as in the divisional invention.”

Result markers in the source: Win / Valid / △.

English translation of the case table — 4/4

IP High Court, Heisei 29 (Gyo-Ke) No. 10159 — Judge Mori
Sheet cutter
Application of “the same invention” under Article 39(2).

(Divisional patent invention 2)

“Divisional patent invention 2 ... is recognized as having technical significance from the viewpoint of the effect of achieving simple and rapid cutting. On the other hand, patented invention 1 at issue has the first blade or the second blade protrude from the guide plate, but the operation in doing so is merely for the body to ‘move’ relative to the guide plate. This differs from an operation limited to ‘tilting,’ as in divisional patent invention 2.”

(Divisional patent invention 3)

“In divisional patent invention 3, the body is flat, in the same way as the guide plate. Although the divisional specification does not expressly describe the effect of making the body flat, a person skilled in the art can recognize effects such as improved grip resulting from the body being flat and having the same shape as the guide plate. Making the body flat is therefore recognized as having technical significance. On the other hand, patented invention 1 at issue has no particular limitation on the body’s shape and does not have a limited shape as in divisional patent invention 3, and therefore differs from divisional patent invention 3.”

Result markers in the source: Win / Valid / △.

English translation of the case table — 1/4

IP High Court, 2010 (Gyo-Ke) No. 10379 — Judge Iimura (飯村)

Slot machine

The test for “the same invention” under Article 39(2) and its application.

“Regarding ‘the same invention’ under Article 39(2) of the Patent Act, where the configurations of two or more inventions differ, the inventions should be construed as the same invention if the differing configuration is assessed as making no technical contribution to solving the problem. If the differing configuration cannot be assessed in that way, however, the inventions are not the same invention under Article 39(2) of the Patent Act. …

In a pachinko gaming machine, after a predetermined time, the machine itself automatically stops the symbols at those corresponding to the winning combination selected in advance by the winning flag. In contrast, in a reel-type gaming machine (slot machine), the player must press stop buttons to stop the symbols, and the symbols displayed when they stop can change depending on the timing of those button presses. When notified of a big-bonus win, the player therefore tries to align the big-bonus identifying symbols. Accordingly, the effects of providing that notification differ. In light of these facts, … the technology of using sound to notify the player that a big-bonus combination has won in the internal lottery cannot be regarded as a configuration making no technical contribution to solving the problem in the technical field of slot machines."

Result markers in the source: Win / Valid / ○.

English translation of the case table — 2/4

IP High Court, 2012 (Gyo-Ke) No. 10123 — Judge Iimura (飯村)

Light-emitting diode

Application of "the same invention" under Article 39(2).

"... From the statements in the patent specification …, 'improving the visual sensitivity of the light-emitting diode' is understood to mean shifting the emission wavelength of a light-emitting element that emits blue light close to violet, with emission peaks near 430 nm and 370 nm, toward approximately 550 nm or 500 nm, where visual sensitivity reaches its peak.

As explained above, 'correcting the color of the light-emitting element' in the invention of the seventh divisional application and 'improving the visual sensitivity of the light-emitting diode' in the patented invention at issue have different technical significance and are substantively different."

Result markers in the source: Win / Valid / △.

English translation of the case table — 3/4

IP High Court, 2013 (Gyo-Ke) No. 10282 — Judge Shimizu (清水)

Mochi (rice cake)

Application of "the same invention" under Article 39(2).

"... According to the statements in the patent specification …, the divisional invention … produces the effects of allowing the cuts to be formed easily and further improving suitability for mass production, and thus has a certain degree of technical significance.

On the other hand, invention 1 at issue, like the divisional invention, provides cuts in the peripheral side surfaces constituting the upright sides of a piece of cut mochi. Although those cuts 'have a length in the circumferential direction, with the direction along the upright sides taken as the circumferential direction,' they are merely 'continuous around the entire circumference to form a rectangular ring,' or 'formed on two opposing peripheral side surfaces constituting upright sides.' They therefore differ from the cuts that are technically limited as in the divisional invention."

Result markers in the source: Win / Valid / △.

English translation of the case table — 4/4

IP High Court, 2017 (Gyo-Ke) No. 10159 — Judge Mori (森)

Sheet cutter

Application of "the same invention" under Article 39(2).

"(Divisional patented invention 2) Divisional patented invention 2 … has technical significance in terms of producing the effect of achieving simple and rapid cutting. In contrast, although patented invention 1 at

issue causes the first blade or the second blade to project from the guide plate, this occurs through the body simply ‘moving’ relative to the guide plate. That operation differs from an operation limited to ‘tilting,’ as in divisional patented invention 2.

(Divisional patented invention 3) In divisional patented invention 3, the body is shaped like a flat plate, as is the guide plate. Although the divisional specification does not expressly describe the effects of giving the body that shape, a person skilled in the art can recognize effects such as improved ease of gripping that result from the body being shaped like a flat plate and having the same shape as the guide plate. Giving the body the shape of a flat plate therefore has technical significance. In contrast, patented invention 1 at issue does not particularly limit the shape of the body, and its shape is not limited as in divisional patented invention 3. It therefore differs from divisional patented invention 3.”

Result markers in the source: Win / Valid / △.

Original images retained for comparison

平成22年 （行ケ） 第10379号 ＜飯村＞	スロットマシン *39 条２項所定の 「同一の発明」の規範 ＋あてはめ	特許法３９条２項所定の「同一の発明」について，複数の発明相互の構成において相違部分がある場合に，その相違点に係る構成が，解決課題に対して，技術的な観点から何ら寄与しないと評価される場合には，複数の発明は，同一の発明と解すべきであるが，相違点に係る構成が，そのように評価されない場合には，特許法３９条２項所定の同一の発明とはいえない。… ぱちんこ遊技機では，ぱちんこ遊技機自体が所定時間後に自動的に事前に決定された当選フラグ役に対応した図柄で停止させる。これに対し，回胴式遊技機（スロットマシン）では，遊技者が停止ボタンを押して図柄を停止させる必要があり，停止ボタンを押すタイミングによって停止時の図柄が変化し得るから，遊技者はビッグボーナス当選の報知があるとビッグボーナス識別情報を揃えようと努力をするため，当該報知を行うことによる効果において，相違があると認められる。以上の事実に照らすならば，…ビッグボーナス役が内部当選していることを音で報知するとの技術が，スロットマシンの技術分野において，解決課題に対して，技術的な観点から何らの寄与をしないと評価されるような構成であると認めることができない。	勝 有 ○
平成24年 （行ケ） 第10123号 ＜飯村＞	発光ダイオード *39 条２項所定の 「同一の発明」の あてはめ	…特許明細書…の記載からすると，「発光ダイオードの視感度を良くする」とは，発光ピークが波長４３０ｎｍ付近及び３７０ｎｍ付近にある紫色に近い青色の発光色を有する発光素子の発光波長を，視感度が頂点に達する波長５５０ｎｍ付近又は５００ｎｍ付近に近づけることを意味すると認められる。以上のとおり，第７分割出願発明の「発光色素の色補正をする」ことと，本件特許発明の「発光ダイオードの視感度を良くする」こととは，技術的意義が異なり，実質的に相違する。	勝 有 △
平成25年 （行ケ） 第10282号 ＜清水＞	餅 *39 条２項所定の 「同一の発明」の あてはめ	…特許明細書…の記載によれば，分割発明は，…切り込みを簡単に形成でき，量産性に一層秀れるという作用効果を奏するものであり，一定程度の技術的意義を有するものといえる。一方，本件発明１は，分割発明と同様，切餅の立直側面である側周表面に切り込みを設けたものであるが，その切り込みは，「立直側面に沿う方向を周方向としてこの周方向に長さを有する」ものであるものの，単に，「周方向に一周連続させて角環状とした」もの，又は，「立直側面である側周表面の対向二側面に形成した」ものであり，分割発明のように技術的に限定された切り込みとは異なるものである。	勝 有 △
平成29年 （行ケ） 第10159号 ＜森＞	シートカッター *39 条２項所定の 「同一の発明」の あてはめ	（分割特許発明２）分割特許発明２は、…簡単かつ迅速な切断を実現するという作用効果の観点から，技術的意義があると認められる。他方，本件特許発明１は，第１の刃又は第２の刃をガイド板から出すものではあるが，その際の動作は，本体がガイド板に対して単に「動く」ことによるものであり，分割特許発明２のように「傾ける」に限定された動作とは異なるものである。 （分割特許発明３）分割特許発明３において，本体の形状はガイド板と同じく平板状である。そして，本体の形状を平板状とすることによる作用効果については，分割明細書に明示の記載はないが，当業者は，本体の形状が平板状であり，かつ，ガイド板と同じ形状であることに起因する把持性の向上等の作用効果を認識することができ，本体の形状を平板状とすることには，技術的意義があると認められる。他方，本件特許発明１は，本体の形状について格段の限定はなく，分割特許発明３のように限定された形状ではないから，分割特許発明３とは異なるものである。	勝 有 △

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12915398538.html

Tokyo High Court, 1998 (Gyo-Ke) No. 82 — Semiconductor device (Judge Shinohara)

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Tokyo High Court, 1998 (Gyo-Ke) No. 82 — Semiconductor device (Judge Shinohara)

TI v. Fujitsu

*The court found the inventions to be “the same” under Article 39(1) and upheld the JPO decision invalidating the patent.

(Excerpts from the judgment, translated; portions omitted)

…In light of the definition of the invention at issue, the “planar arrangement” in requirement e must be regarded as merely a summary statement that the semiconductor-device circuit composed of the preceding requirements is, as a result, “arranged essentially in a plane.” In that sense, it is equivalent to restating the other claim elements and has no particular technical significance….

Turning to the meaning of the “planar arrangement” in requirement e as a statement of this nature, … in the semiconductor device of the invention at issue, the multiple circuit elements are formed by P-N junctions between the diffusion regions and the body, or between the diffusion regions themselves, in a semiconductor wafer whose surface has been polished by lapping and in which diffusion regions have been formed. The surface on which the elements are formed therefore has little unevenness and is flat, resulting in an essentially planar arrangement. Further, the inert insulating material serving as the base for the conductive interconnection material is formed on the semiconductor wafer by vapor deposition, so its surface is plainly flat. Because the conductive interconnection material is deposited on that inert insulating material, it too may be regarded as flat. If the multiple circuit elements are arranged in a plane and the conductive interconnection material connecting them is also flat, the electronic circuit constituted by them is naturally arranged in a plane. …Accordingly, there is no error in the JPO decision’s finding that Difference ⑥ is not a substantive difference.

…Although it is acknowledged that differences in the wording of the claims in the respective specifications cause some differences in the scope covered by the invention at issue and the original invention, it cannot be said that a person skilled in the art, considering together the purposes, functions and effects, examples and other matters set out in the detailed descriptions, could perceive those differences in claim wording as differences in the technical ideas of the two inventions. The two inventions should therefore be understood as substantially the same invention, notwithstanding the differences in the wording of their claims.

Accordingly, there is no error in the JPO decision’s conclusion that the application at issue was ineligible for the benefit of Article 9(1) of the former Patent Act, that its filing date therefore could not be deemed to be the earlier date, and that the patent based on the application actually filed on December 21, 1971, was granted in violation of Article 39(1) of the Patent Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-12569.pdf

LinkedIn

https://www.linkedin.com/feed/update/urn:li:activity:7514576236069892096/

Images from the original AMEBLO article

English translations of the original image text

English translation of the case table — 1/2

Tokyo High Court, Heisei 10 (Gyo-Ke) No. 82 — Judge Shinohara
Semiconductor device — TI v. Fujitsu
Identity under Article 39(1) was recognized, and the JPO decision invalidating the patent was upheld.

"… In light of the definition of the gist of the invention at issue, the 'planar arrangement' in requirement e must be understood as merely a summary statement that the semiconductor-device circuit composed of the requirements described before it is, as a result, 'arranged substantially in a plane.' In that sense, it is equivalent to repeating the other constituent requirements and has no particular technical significance. …

When considering the meaning of 'planar arrangement' as a statement of that nature, … in the semiconductor device of the invention at issue, multiple circuit elements are formed by P–N junctions between diffusion regions and the body of a semiconductor wafer whose surface has been polished by lapping and in which diffusion regions have been formed, or between the diffusion regions themselves. The surface on which they are formed is therefore flat with little unevenness, resulting in a substantially flat arrangement. Also, the inactive insulating material serving as the base for the conductive material for circuit connection is formed on the semiconductor wafer by vapor deposition, so its surface is clearly flat. The conductive material for circuit connection is deposited on that inactive insulating material and may likewise be understood as flat. Thus, if the multiple circuit elements are arranged flat and the conductive material connecting them is also flat, the resulting electronic circuit is naturally arranged flat. … Accordingly, the trial decision was not erroneous in finding that difference (6) was not a substantial difference. …

Although the invention at issue and the original invention differ in their encompassing scope owing to differences in the wording of the claims, a person skilled in the art, considering together the purpose, effects, and examples described in the detailed description in the specifications, cannot readily regard those differences in claim wording as differences in the technical ideas of the two inventions. They should therefore be recognized as substantially the same invention notwithstanding the different claim wording. Accordingly, the trial decision was correct in denying retroactivity of the filing date because the application at issue could not benefit from former Patent Act Article 9(1), and in finding that the patent, filed on its actual filing date of December 21, Showa 46 (1971), violated Patent Act Article 39(1)."

Result markers in the source: Loss / Invalid / ○.

English translation of the case table — 2/2

Tokyo High Court, Heisei 6 (Gyo-Ke) No. 243 — Judge Minoru Takeda
Buddhist altar
Same-day applications under Article 39(2): It is insufficient that, viewed from one invention, it is the same as the other. At the same time, viewed from the other invention, it must also be regarded as the same as the first invention. (Same as the Examination Guidelines.)

"… Patent Act Article 39(2) provides that, for two or more inventions in applications filed on the same day, if agreement between the applicants is not reached, neither invention can receive a patent. In light of that purpose, 'the same invention' in that paragraph should be construed as requiring not only that one of the two or more inventions in same-day applications, viewed from its side, is the same as the other invention, but also that, viewed from the other invention's side, it is regarded as the same as the first invention.

As to requirement b of the same-day application invention, … even if the 'swing arm,' from the standpoint of its actual function, falls within a subordinate concept of requirement D of the invention at issue, it specifies the means for folding and storing the altar's doors as a 'swing arm' not specifically disclosed in the specification of the invention at issue. This … plainly produces effects absent from the invention at issue, namely simplifying the means for opening, closing, and storing the altar's doors and improving assembly and workability. …

Since requirement b of the same-day application invention … includes a configuration producing effects distinct from the invention at issue, when viewing the invention at issue from the same-day application invention, requirement b cannot be grasped from the requirements of the invention at issue. Requirement b therefore cannot be said to coincide with requirement D of the invention at issue."

Result markers in the source: Win / Valid / ○.

English translation of the case table — 1/2

Tokyo High Court, 1998 (Gyo-Ke) No. 82 — Judge Shinohara (篠原)

Semiconductor device — TI v. Fujitsu

Identity under Article 39(1) was recognized, and the JPO decision invalidating the patent was upheld.

"…In light of the definition of the invention at issue, the "planar arrangement" in requirement e must be regarded as merely a summary statement that the semiconductor-device circuit composed of the preceding requirements is, as a result, "arranged essentially in a plane." In that sense, it is equivalent to restating the other claim elements and has no particular technical significance….

Turning to the meaning of the “planar arrangement” in requirement e as a statement of this nature, … in the semiconductor device of the invention at issue, the multiple circuit elements are formed by P-N junctions between the diffusion regions and the body, or between the diffusion regions themselves, in a semiconductor wafer whose surface has been polished by lapping and in which diffusion regions have been formed. The surface on which the elements are formed therefore has little unevenness and is flat, resulting in an essentially planar arrangement. Further, the inert insulating material serving as the base for the conductive interconnection material is formed on the semiconductor wafer by vapor deposition, so its surface is plainly flat. Because the conductive interconnection material is deposited on that inert insulating material, it too may be regarded as flat. If the multiple circuit elements are arranged in a plane and the conductive interconnection material connecting them is also flat, the electronic circuit constituted by them is naturally arranged in a plane. …Accordingly, there is no error in the JPO decision’s finding that Difference ⑥ is not a substantive difference.

…Although it is acknowledged that differences in the wording of the claims in the respective specifications cause some differences in the scope covered by the invention at issue and the original invention, it cannot be said that a person skilled in the art, considering together the purposes, functions and effects, examples and other matters set out in the detailed descriptions, could perceive those differences in claim wording as differences in the technical ideas of the two inventions. The two inventions should therefore be understood as substantially the same invention, notwithstanding the differences in the wording of their claims.

Accordingly, there is no error in the JPO decision’s conclusion that the application at issue was ineligible for the benefit of Article 9(1) of the former Patent Act, that its filing date therefore could not be deemed to be the earlier date, and that the patent based on the application actually filed on December 21, 1971, was granted in violation of Article 39(1) of the Patent Act.”

Result markers in the source: Loss / Invalid / ○.

English translation of the case table — 2/2

Tokyo High Court, 1994 (Gyo-Ke) No. 243 — Judge Minoru Takeda (竹田稔)

Buddhist altar

Same-day applications under Article 39(2): it is insufficient that, viewed from one invention, it is the same as the other. At the same time, viewed from the other invention, it must also be regarded as the same as the first invention. (Same as the Examination Guidelines.)

“... Article 39(2) of the Patent Act provides that, for two or more inventions in applications filed on the same day, if agreement between the applicants is not reached, none of the inventions can receive a patent. In light of that purpose, ‘the same invention’ in that paragraph should be construed as requiring not only that one of the two or more inventions in same-day applications, viewed from its side, is the same as the other invention, but also that, viewed from the other invention’s side, it is regarded as the same as the first invention.

As to requirement b of the same-day application’s invention, … even if the ‘swing arm,’ from the standpoint of its actual function, falls within a subordinate concept of requirement D of the invention at issue, it specifies, in structural terms, the means for folding and storing the altar’s doors as a ‘swing arm’ not specifically disclosed in the specification of the invention at issue. This … plainly produces effects absent from the invention at issue, namely simplifying the means for opening, closing, and storing the altar’s doors and improving ease of assembly and workability. …

Since requirement b of the same-day application’s invention … includes a configuration producing effects distinct from the invention at issue, when viewing the invention at issue from the same-day application’s invention, requirement b cannot be understood from the requirements of the invention at issue. Requirement b therefore cannot be said to coincide with requirement D of the invention at issue.”

Result markers in the source: Win / Valid / ○.

Original images retained for comparison

平成10年 （行ケ） 第82号 ＜篠原＞	半導体装置 TI ｖ．富士通 *39 条の「同一」性を認めて、無効とした。	…本件発明の要旨の規定に即してみれば、要件eの「平面状配置」は、それに先立って記載されている各要件から構成された半導体装置の回路が、その結果として「本質的に平面状に配置され」ることになることを総括して表現したにすぎない記載であるといわざるを得ない。すなわち、そのような意味で、他の**構成要件**を重複記載したに等しく、特段の**技術的意義**を有しない…。 そして、そのような性質の記載として要件eの「平面状配置」が意味するところを検討するに、…本件発明の半導体装置において、複数の回路素子は、ラップ**加工**により表面が磨かれ拡散領域が形成された半導体薄板の拡散領域と本体との間、又は拡散領域自体の間のP–N接合によって形成されることから、それらが形成される面は凸凹が少ない平坦となり、結果として、本質的に平坦な配置となるものと考えられる。また、回路接続用導電物質の土台となる不活性絶縁物質が半導体薄板に蒸着により形成されることからその表面が平坦であることは明らかであるところ、回路接続用導電物質は、不活性絶縁物質上に被着されることから、これも平坦と解して差し支えない。そして、複数の回路素子が平坦に配置され、複数の回路素子間を接続する回路接続用導電物質も平坦であれば、それらによって構成される電子回路が平坦に配置されたことになるのは当然である。…したがって、相違点⑥が実質的な相違点ではないとした審決の判断に誤りはない。… 本件発明と原発明とは、明細書の特許**請求の範囲**の記載の差異によって、その包含する範囲に差異が生ずる点があることは認められるものの、当業者において、明細書の**発明の詳細な説明**に記載された発明の目的、作用効果、**実施**例の記載等を総合し、当該特許**請求の範囲**の記載の差異を両発明の**技術的思想**の差異として把握することができるものとは到底いい得ないものであって、両発明は、特許**請求の範囲**の記載の差異にかかわらず、**実質的に同一**の発明であるものと解するのが相当である。したがって、審決が、本件出願につき旧特許法**9条1項**の適用を受けることができないとして、その出願日の**遡及**を否定した上、現実の出願日である昭和46年12月21日の出願に係る本件特許は、特許法**39条1項**の規定に違反してされたものであるとしたことに誤りはない。	負 不 ○

平成6年 （行ケ） 第243号 〈竹田稔〉	仏壇 *同日出願(39 条２項)は、一方の側からみた場合に他方の発明と同一であるというだけでは足りず、同時に、他方の発明の側からみても、一方の側の発明と同一であるとみなされる関係にあることを要する（審査基準と同じ。）	…特許法３９条２項において、同日の出願に係る２以上の発明については、特許出願人間の協議が成立しなければ、一方のみならず、そのいずれについても特許を受けることができないとされている趣旨に鑑みるならば、同項における「同一の発明」とは、同日の出願に係る２以上の発明の一方の側からみた場合に、他方の発明と同一であるというだけでは足りず、同時に、他方の発明の側からみても、一方の側の発明と同一であるとみなされる関係にあることを要するものと解すべきである。 そして、同願発明のｂの要件については、…「揺動腕」が実際に果たす機能の面からみて、本件発明のＤの要件の下位概念に相当するものであるとしても、仏壇の扉体の折曲げ、収納手段を、その構造面から本件明細書に具体的に開示されていない「揺動腕」として特定したものであり、それにより…仏壇の扉体の開閉、収納手段を簡単に構成することができ、その組立性、作業性を向上させるという、本件発明…にはない作用効果を奏するものであることが明らかである…。 そうすると、同願発明のｂの要件は、…本件発明とは別個の作用効果を生じさせる構成を含むものである以上、同願発明から本件発明をみた場合においては、ｂの要件は、本件発明の要件から把握することができないものといわざるをえず、ｂの要件は、本件発明のＤの要件に一致するものとはいえないというべきである。	勝 有 ○

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12915605830.html

Tokyo District Court, 2022 (Wa) 70058 [Grapple Bucket Device] <Kokubu>

Original Ameblo publication: 2025-07-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12915886850.html

Tokyo District Court, 2022 (Wa) 70058 [Grapple Bucket Device] <Kokubu>

First requirement of the doctrine of equivalents: not satisfied.

*The analytical framework of the IP High Court Grand Panel judgment in the Maxacalcitol case.

⇒ A defendant seeking to defeat the first requirement of the doctrine of equivalents should confront the invention at issue with closely related prior art, argue that the problem described in the specification at issue is insufficiently stated, and steer the argument toward the proposition that the difference from that prior art is the essential part.

*The problem described in the specification at issue could be solved by the prior art.

⇒ The description of the problem is objectively insufficient in light of the prior art at the filing date, so extrinsic evidence may be considered.

⇒ The degree of the invention's contribution cannot be assessed as substantial.

⇒ The essential part of the invention cannot be identified at a higher level of abstraction, and is identified as substantially equivalent to the language of the claims.

⇒ The difference from the prior art is the essential part.

(Translation of an excerpt from the court's reasoning)

At the time the patent at issue was filed, the problem that, when timber gripped by a grapple bucket device was long, a worker had to use a cutting device such as a chainsaw to cut timber exceeding a certain length to a prescribed length could be solved by the prior art disclosed in the Exhibit Ko 27 reference. Thus, the problem described in the specification at issue as one that the prior art could not solve is found to be objectively insufficient in light of the prior art at the filing date. Accordingly, when identifying the characteristic part constituting the technical idea peculiar to the invention at issue and absent from the prior art, consideration of the technical matters described in the Exhibit Ko 27 reference should also be permitted.

… Before the patent at issue was filed, the Exhibit Ko 27 reference is found to have disclosed a traveling branch-cutting apparatus equipped with a bucket having a gripping unit attached to one side and a cutting device attached to the other. The difference between the invention at issue and the prior art is therefore found to lie only in the configuration of that cutting device, not in the fact that the device itself is a grapple bucket device capable of cutting material that it has gripped. Accordingly, because the degree of the invention's contribution relative to the prior art cannot be assessed as substantial, its essential part cannot be identified at a higher level of abstraction, and should be identified as substantially equivalent to the language of the claims.

Therefore, … it is appropriate to find that the characteristic part constituting the technical idea peculiar to the invention at issue and absent from the prior art is the adoption, for the cutting device provided on the grapple device, of the following configuration: a cutting blade located on either the outside or the inside of the bucket's side wall, pivoting in a direction along that side wall from a position away from the bucket's opening edge to a position along the bucket's side wall, and having a cutting edge on its side edge facing the opening-edge side of the bucket, the blade being pivotally supported at the base of the bucket opening; and a hydraulic cylinder connected to the pivot base of that cutting blade to pivot the blade. The cutting edge of

the cutting blade is positioned offset toward the blade's cutting direction relative to the line connecting the blade's pivot center and the hydraulic-cylinder connection point, and is curved in an arc backward relative to its direction of rotation in the cutting direction. By adopting this configuration, namely the configuration relating to constituent requirements C and D, a large value of the inclination angle θ at which the blade edge contacts the object is maintained even in portions far from the pivot center, thereby maintaining a draw-cutting action and achieving a smooth cutting effect.

… The essential part of the invention at issue is that, by adopting the configuration relating to constituent requirements C and D, a large value of the inclination angle θ at which the blade edge contacts the object is maintained even in portions far from the pivot center, thereby maintaining a draw-cutting action and achieving a smooth cutting effect. Consequently, the defendant's products cannot be found to possess the essential part of the invention at issue, and it cannot be said that the part in which the invention and the defendant's products differ is not the essential part of the invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93448.pdf

IP High Court, 2013 (Ne) 10007 [Agitation Granulation Apparatus] <Shitara>

Original Ameblo publication: 2025-07-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12916082794.html

IP High Court, 2013 (Ne) 10007 [Agitation Granulation Apparatus] <Shitara>

*For an agitation granulator sold by the defendant with a blade that did not satisfy all the relevant claim elements of the patented invention, the court held that, because a blade satisfying those claim elements was delivered on the same day, the two were sold as a single unit.

⇒ Direct infringement was found!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-84350.pdf

IP High Court, 2023 (Gyo-Ke) 10019 [Methods for Treating Atopic Dermatitis by Administering an IL-4R Antagonist] <Miyasaka>

Original Ameblo publication: 2025-07-13
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12916207396.html

IP High Court, 2023 (Gyo-Ke) 10019 [Methods for Treating Atopic Dermatitis by Administering an IL-4R Antagonist] <Miyasaka>

*Even though the cited invention had reached a Phase 2 clinical trial, the material cited in the judgment put the Phase 2 success rate for allergic diseases at only approximately 33%. A person skilled in the art therefore could not be said to understand that it was necessarily therapeutically effective without even seeing the Phase 2 results.

⇒ Inventive step affirmed.

[Difference] Corrected Invention 1 at issue is a pharmaceutical composition comprising a therapeutically effective amount of an anti-human IL-4R antibody or an antigen-binding fragment thereof, for use in a method of treating a patient with moderate-to-severe atopic dermatitis (AD) who does not respond adequately to treatment with topical corticosteroids or topical calcineurin inhibitors, whereas the cited invention is an investigational drug composition.

(Translation of an excerpt from the JPO decision as reproduced in the judgment. The court also rejected the challenge based on lack of inventive step.)

The trial in Exhibit Ko 1 is a Phase 2 clinical trial. It is common general technical knowledge that the preceding Phase 1 clinical trial ordinarily investigates the safety and pharmacokinetics of an investigational drug in a small number of healthy individuals, and that confirmation of efficacy in patients begins with Phase 2 clinical trials. According to Exhibit Ko 21 …, the probability of success in Phase 2 clinical trials is far lower than in any other phase and is approximately 33% for allergic diseases. In light of this, the mere fact that a Phase 2 clinical trial is being conducted does not mean that a person skilled in the art would understand that the investigational drug must be therapeutically effective without even examining the trial results.

Furthermore, examination of Exhibits Ko 2–6 reveals no evidence that, before the priority date of the patent at issue, an anti-human IL-4R antibody had been administered to patients with atopic dermatitis and had actually produced a therapeutic effect. In light of the common general technical knowledge at the priority date of the patent application concerning the roles of cytokines in the acute and chronic phases of atopic dermatitis, even if REGN668 (an anti-human IL-4R antibody), as used in Exhibit Ko 1, had the ability to block IL-4 and IL-13 activity, as did the antibody in Exhibit Ko 3, it cannot be said that a person skilled in the art could have conceived of using REGN668 (an anti-human IL-4R antibody) therapeutically effectively in the patients of the cited invention, who had suffered from chronic atopic dermatitis for at least three years and in whom production of interferon gamma and IL-12 was considered to predominate over IL-4, unlike the acute phase in which IL-4 predominates. Nor could improvement in clinical symptoms readily have been predicted in those circumstances.

Moreover, as described in Exhibit Ko 24 (Exhibit Otsu 4 in the trial proceedings), given the complexity of the immune pathways involved in atopic dermatitis, it is found difficult to predict, without awaiting clinical-trial results, that a therapeutic agent based on the particular mechanism of blocking IL-4 action—a mechanism with no track record of use in treating atopic dermatitis as of the priority date of the patent at issue—would have a therapeutic effect on moderate-to-severe atopic dermatitis. Accordingly, it cannot be said that a person skilled in the art could readily have arrived, from the descriptions in Exhibits Ko 1–6, at the cited invention having the configuration relating to the difference—namely a pharmaceutical composition comprising a therapeutically effective amount of an anti-human IL-4R antibody for use in a method of treating patients with moderate-to-severe atopic dermatitis who do not respond adequately to treatment with topical corticosteroids or topical calcineurin inhibitors—and actually producing, in patients falling within Corrected Invention 1 at issue, the improvement in clinical symptoms of atopic dermatitis demonstrated in the specification at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93292.pdf

IP High Court, 2023 (Gyo-Ke) 10090 [Fulvestrant Formulation] <Nakadaira>

Original Ameblo publication: 2025-07-14
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12916367152.html

IP High Court, 2023 (Gyo-Ke) 10090 [Fulvestrant Formulation] <Nakadaira>

*The journal Clinical Cancer Research published an experiment in which a composition identical to that of the patented invention was administered subcutaneously to mice as an adjunct to eliminate estrogen activity in an experiment testing a hypothesis (according to the plaintiff, the composition was supplied by the patentee). The court did not find it to be common general technical knowledge to administer that composition, unchanged, to humans by intramuscular injection.

⇒ Inventive step affirmed.

[Difference] Corrected Invention 1 is “a pharmaceutical formulation for administration to humans by intramuscular injection” and “a pharmaceutical formulation suitable for intramuscular injection,” whereas the Exhibit Ko 1 invention is an experimental composition, administered subcutaneously to ovariectomized tumor-bearing mice inoculated with breast cancer cells (MCF-7 cells) transfected with fibroblast growth factor (FGF), for verifying FGF autocrine activity as a mechanism of tamoxifen-resistant breast cancer.

(Translation of an excerpt from the court's reasoning)

(a) Common general technical knowledge I (concerning intramuscular injection of fulvestrant)

At the priority date at issue, pharmaceutical formulations containing fulvestrant were undergoing clinical trials and had not yet been approved in any country …. Thus, fulvestrant is not found to have been established as a breast cancer treatment. Accordingly, common general technical knowledge I (concerning intramuscular injection of fulvestrant) is not found to have existed.

Nevertheless, according to the results of pharmacokinetic studies (PK studies) and clinical trials concerning fulvestrant conducted at the priority date at issue …, there is room to say that it was common general technical knowledge at that date that fulvestrant was under investigation as a possible breast cancer treatment and was being administered by intramuscular injection in the trials. However, even if such common general technical knowledge existed, a person skilled in the art is not found to have readily recognized that the composition administered to mice as an antiestrogen in the Exhibit Ko 1 reference could immediately be used, with its composition unchanged, as a pharmaceutical formulation for administration to humans by intramuscular injection.

(b) Common general technical knowledge II (concerning subcutaneous injection in mice)

The references cited by the plaintiff … include statements that intramuscular injection is difficult in small laboratory animal species such as mice, and examples in which drugs administered intramuscularly to humans were administered subcutaneously in experiments using small laboratory animal species such as mice. However, they also contain descriptions of intramuscular injection in rats …. Even in light of these references, it cannot be found that common general technical knowledge II (concerning subcutaneous injection in mice), as asserted by the plaintiff, existed at the priority date at issue. Moreover, even if common general technical knowledge II existed, that would not mean there was common general technical knowledge that a drug injected subcutaneously in experiments using mice is always injected intramuscularly in humans. Furthermore, even if common general technical knowledge existed to the extent that “a pharmaceutical formulation administered intramuscularly to humans may be administered subcutaneously in experiments using mice,” it cannot be found to have been common general technical knowledge to inject humans intramuscularly with a drug having the same composition as a drug injected subcutaneously into mice. Still less could there be said to be motivation to inject humans intramuscularly with a drug having the same composition as the fulvestrant administered to mice in the Exhibit Ko 1 invention, where that fulvestrant was used as an adjunct to eliminate estrogen activity in an experiment intended to test a hypothesis.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93486.pdf

Tokyo High Court, 2003 (Gyo-Ke) 104 [New Medical Use of Tachykinin Antagonists]

Original Ameblo publication: 2025-07-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12916582613.html

Tokyo High Court, 2003 (Gyo-Ke) 104 [New Medical Use of Tachykinin Antagonists]

*The court found non-compliance with the disclosure requirements for Claims 1–7 and 9 because the medical use of substances other than those supported by the examples also required substantiation in the specification. Separately, it set aside the decision denying inventive step for Claim 8.

(Translation of an excerpt from the court's reasoning)

In the detailed description of the invention in the specification at issue, both NK1 receptor antagonistic activity and activity in treating emesis are found to have been confirmed only for the (2S,3S) enantiomer of the (±)-cis-3-(2-methoxybenzylamino)-2-phenylpiperidine identified in item (1) above. The position would be different if a person skilled in the art could objectively comprehend a correlation between NK1 receptor antagonistic activity and activity in treating emesis—for example, if the detailed description of the invention in the specification contained descriptions enabling confirmation that a sufficiently wide variety of structurally dissimilar substances having NK1 receptor antagonistic activity were effective in treating emesis. In the detailed description of the invention in the specification at issue, however, although it can be said to be substantiated that the NK1 receptor antagonist (2S,3S)-3-(2-methoxybenzylamino)-2-phenylpiperidine can be used to treat emesis, there is no description substantiating, in the first place, a correlation between NK1 receptor antagonistic activity and activity in treating emesis for other NK1 receptor antagonists. Accordingly, the detailed description of the invention cannot be found to describe antiemetic agents containing those other antagonists as active ingredients to an extent that would enable a person skilled in the art readily to work the invention ….

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10593.pdf

[Article / Unfair Competition Prevention Act, Article 2(1)(i)] Protection of product packaging consisting of weakly distinctive elements — Suntory Black Oolong Tea case (Yukari Hira, Intellectual Property Law and Policy Journal, Vol. 35 (2011))

Original Ameblo publication: 2025-07-16

Article type: Publication review

Categories: Unfair competition law

Topics: Indications of goods or business, Confusion

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Japanese version: https://www.takaishihideki.com/single-post/ameblo-12916747725-ja

[Article / Unfair Competition Prevention Act, Article 2(1)(i)] Protection of product packaging consisting of weakly distinctive elements — Suntory Black Oolong Tea case (Yukari Hira, Intellectual Property Law and Policy Journal, Vol. 35 (2011))

Even if weakly distinctive portions are similar to some extent, there is no similarity unless strongly distinctive portions are shared.

→ Nevertheless, even for commonplace, weakly distinctive indications, similarity exists if even portions whose adoption is not inevitable in relation to the goods bearing the indication coincide.

(For example, Product A in the Suntory Black Oolong Tea case and the Royal Milk Tea case.)

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol35/35_14.pdf

LinkedIn

https://www.linkedin.com/feed/update/urn:li:activity:7514576896983044097/

Images from the original AMEBLO article

English translations of the original image text

English key to the original product images

Image 1

Left caption: Plaintiff's product

Right caption: Defendants' product A

Legible Japanese text on the left product:
Suppresses the absorption of fat
Suntory
Black oolong tea.

Legible Japanese text on the right product:
Black oolong tea.
Contains oolong tea polyphenols.

Image 2

Left caption: Plaintiff's container

Right caption: Defendant's container

Large Japanese product name:
Milk tea.

Large product name (in English):
ROYAL MILK TEA

Smaller Japanese text:
Royal milk tea.

Original images retained for comparison



原告商品



被告ら商品Ａ



原告容器



被告容器

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12916747725.html

[Article / International Jurisdiction] A Case Recognizing Japanese International Jurisdiction Based on a Foreign Corporation's Website Displaying Products Allegedly Infringing a Patent and Circumstances Including the Corporation's Business Activities in Japan—The Motor Case (Zhang Peng, Intellectual Property Law and Policy Journal, Vol. 36 (2011))

Original Ameblo publication: 2025-07-17

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12916968725.html

[Article / International Jurisdiction] A Case Recognizing Japanese International Jurisdiction Based on a Foreign Corporation's Website Displaying Products Allegedly Infringing a Patent and Circumstances Including the Corporation's Business Activities in Japan—The Motor Case (Zhang Peng, Intellectual Property Law and Policy Journal, Vol. 36 (2011))

*IP High Court, 2010 (Ne) 10001

The decision showed that the Supreme Court's Tsuburaya Productions judgment extends to claims for an injunction based on patent rights and clarified the requirements.

The alleged infringer was a foreign company, but its website advertised that it served Japan, and it belonged to the Samsung Group.

⇒ Japan had jurisdiction.

Cf. Tokyo District Court, May 14, 2001, “Intraocular Pressure-Lowering Agent” Case: The court denied Japanese jurisdiction over the foreign parent company of the entity acting in Japan, reasoning that, so long as the corporate personality was not a mere shell, the defendant, which had no economic base in Japan, could not be compelled to defend the action.

Cf. Tokyo District Court, 2004 (Wa) 10667, “Data Transmission Method”: Japanese jurisdiction was recognized because sales activities were conducted with knowledge that the products would be transferred in Japan.

https://lex.juris.hokudai.ac.jp/gcoe/journal/IP_vol36/36_11.pdf

IP High Court, 2020 (Gyo-Ke) 10057 [Electric Bed] <Kanno>

Original Ameblo publication: 2025-07-18

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12917218930.html

IP High Court, 2020 (Gyo-Ke) 10057 [Electric Bed] <Kanno>

*Motivation to combine was rejected because the technical fields of the primary and secondary references were far removed from each other.

⇒ Inventive step affirmed.

(Translation of an excerpt from the court's reasoning)

The Exhibit Ko 1 invention concerns a medical bed 10 and addresses the problem of setting it at a preselected vertical height according to the patient's anticipated needs. It selects, as a lower intermediate position, “a convenient height for getting into and out of the bed 10” (that height is also one at which a caregiver's or patient's feet will not be trapped even if present …). In contrast, the Exhibit Ko 3 invention … concerns a vehicle convertible-top opening and closing device. In view of the risk of objects being caught when the top closes, it addresses the problem of providing a vehicle convertible-top opening and closing device that automatically pauses just before the top is fully closed, enabling safety to be reliably checked, and further addresses the problem of avoiding discomfort to the operator. The technical fields of the two inventions are far removed from each other, and they share only the abstracted problem of avoiding the risk of trapping an object. Extracting a common problem from different inventions in such different technical fields and seeking to apply concrete solutions suited to the characteristics of each field to the other requires particular ingenuity …. … There is no motivation to apply the Exhibit Ko 3 invention to the Exhibit Ko 1 invention ….

“The … invention-specifying matter ‘even if a caregiver's or patient's feet are present between the frame and the floor, they will not be trapped’ specifies the basis on which the height at which the frame stops is determined … and therefore does not make this a use invention ….”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90469.pdf

<Trial and Appeal Practitioners Study Group Report 2024> Case 1 (Mechanical) — IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System]

Original Ameblo publication: 2025-07-20

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12917659886.html

<Trial and Appeal Practitioners Study Group Report 2024> Case 1 (Mechanical)

IP High Court, 2022 (Gyo-Ke) 10007 [Heat Transport System]

•In practice, it is difficult to determine whether alternatives can be said to be “actually described in parallel.” … Moreover, depending on the state of the art, there may be cases in which it is permissible to extract one member from the description of a general formula in a cited reference ….

•It is understandable that, with a number of alternatives on the order of that in this case, they can be said to be “actually described in parallel,” whereas, when the number is enormous, a particular alternative cannot be extracted; nevertheless, the dividing line is unclear.

•The participants agreed that the judgment's finding of obviousness as a design modification or the adoption of a matter of design choice, even without particular motivation, was appropriate.

On the other hand, concern was also expressed that determining what constitutes a matter of design choice is not necessarily highly predictable.

When well-known technology is used as a secondary cited invention, it is the subject of application (combination), so motivation is naturally required. By contrast, when well-known technology is used as the basis for a design modification or the like, motivation is not necessarily required under the rule stated in this judgment.

•Regarding identification of the cited invention, the judgment states that configurations not essential to solving the problem need not be included in that identification. However, it is not necessarily clear how far descriptions in the specification and other documents may be extracted and identified in making a concrete finding.

Accordingly, care must be taken not to identify the invention in a manner that is merely convenient for the person making the finding.

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/02_machinery.pdf

Trial and Appeal Practitioners Study Group Report 2024 — Theme 2 (Chemistry 1)

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Trial and Appeal Practitioners Study Group Report 2024 — Theme 2 (Chemistry 1)

[Inventive step in parameter and numerically limited inventions]

When can a numerical range not expressly disclosed in a cited document be held readily conceivable?

• Commonality of the technical fields and problems of the invention at issue and the primary cited invention.

→ When preparing a specification, the problem considered by the inventor is not based on all prior art. In practice, the inventor sets the invention's problem by considering common general knowledge within the inventor's awareness and contributions or effects relative to documents found in a pre-filing search.

Accordingly, identifying the problem from the "Problem to be solved by the invention" sections of the specification at issue and the primary cited invention's specification also accords with actual practice.

Where the problem is merely common general knowledge, industry-association technical journals and standards are useful for showing that it is self-evident to a person skilled in the art.

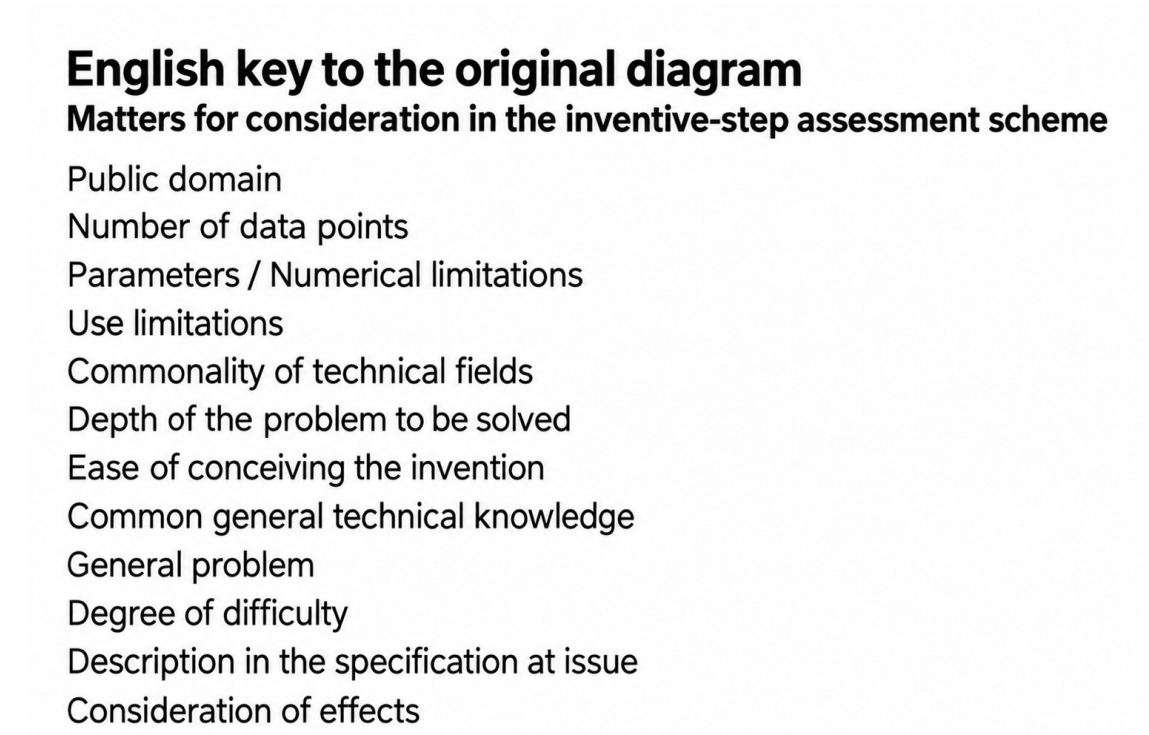
https://t.co/L8WFEh78VY

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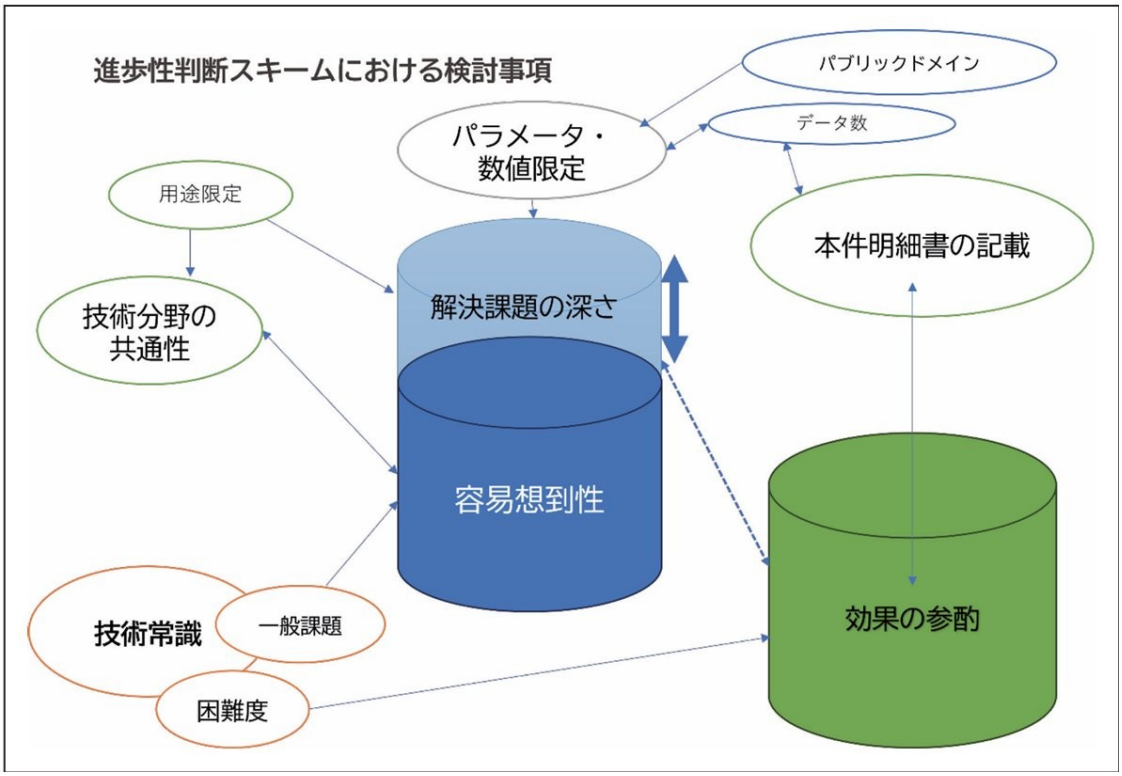
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Images from the original AMEBLO article

English translations of the original image text



Original images retained for comparison



Original AMEBLO article

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Trial and Appeal Practitioners Study Group Report 2024 — Case 2 (Chemistry 1)

[Matters equivalent to disclosure in the earlier application's specification; substantial identity]

IP High Court, 2014 (Gyo-Ke) No. 10097 — Flat nonaqueous-electrolyte secondary battery

• A "new effect" under the expanded prior-application rule need not be a "remarkable" or "advantageous" effect required for inventive step. Improvement in the degree of an effect suffices; the level may be lower than for inventive step.

• Regarding the relationship between disclaimer amendments commonly used to avoid lack of novelty and assessment of minor differences under the expanded prior-application rule, a participant questioned whether, following a disclaimer amendment, consideration extends to whether the excluded and remaining portions produce a new effect for this assessment.

(Excerpt from the judgment, translated)

…Difference A identified in the JPO decision is, in short, that the invention at issue and the invention in Exhibit Ko 1 differ quantitatively in ① the number of opposing faces and ② the relative sizes of the facing area of those faces and the gasket opening area. …Both inventions use, in a flat nonaqueous-electrolyte secondary battery, an electrode assembly in which positive electrode plates having an active-material-containing layer on the surface of the positive-electrode constituent material and negative electrode plates having an active-material-containing layer on the surface of the negative-electrode constituent material are stacked in multiple layers with separators between them. By increasing the sum of the facing areas between the active-material-containing layers of the positive and negative electrode plates, they enable an increase in discharge capacity under heavy load. They therefore share the same problem and means of solving it. …It may be unexpected that heavy-load discharge capacity shows little change, and in some cases gradually decreases, when the number of opposing faces exceeds five. However, the invention at issue addresses the technical problem of increasing discharge capacity under heavy load and specifies a lower limit, rather than an upper limit, for the number of opposing faces. The fact that discharge capacity does not increase in proportion to the number of opposing faces therefore cannot be regarded as a new effect of the invention at issue.

https://lnkd.in/gy6XwKQ7

Original article (2025-07-22):

https://lnkd.in/gk6TU9_G

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Trial and Appeal Practitioners Study Group Report 2024 — Theme 3 (Chemistry 2)

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Trial and Appeal Practitioners Study Group Report 2024 — Theme 3 (Chemistry 2)

[Consideration of experimental results submitted after filing: inventive step]

Regarding experimental results submitted after filing (post-filed data), the practice is established to a certain extent: consideration is permitted insofar as a person skilled in the art can infer the effect from the specification or drawings. As stated in the guidance, examiners should not consider an effect asserted and proved in written arguments, etc., if it is neither described in the specification nor inferable by a person skilled in the art from the specification or drawings.

Recently in Europe, in appeal proceedings concerning EP2484209 (insecticide compositions for controlling pests), the Enlarged Board of Appeal issued G 2/21 in response to questions referred by a Technical Board of Appeal. Regarding evidence submitted after the filing date in assessing inventive step, it held that:

① it cannot be disregarded solely because it was submitted later;

② a technical effect may be relied upon for inventive step if a person skilled in the art, bearing common general knowledge in mind and on the basis of the application as originally filed, can derive that effect as encompassed by its technical teaching and embodied by the same originally disclosed invention.

https://lnkd.in/gUY-9ycp

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https://lnkd.in/gqEKdc5Q

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/01_chemistry2.pdf

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Trial and Appeal Practitioners Study Group Report 2024 — Case 3 (Chemistry 2)

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514577641857814528-ja

Trial and Appeal Practitioners Study Group Report 2024 — Case 3 (Chemistry 2)

[Relationship between requirements for correction of medical-use inventions, particularly new matter, and the enablement and support requirements for the corrected invention]

IP High Court, 2020 (Gyo-Ke) No. 10135

Addition of new matter concerns “technical ideas disclosed by the specification or drawings.” This is consistent with the support-requirement inquiry that compares the claims with the detailed description and asks whether the claimed invention is an invention described in the detailed description.

Whether something is “substantially disclosed” is distinguished as an area to be assessed under the support requirement: whether it falls within the scope in which a person skilled in the art can recognize, from the detailed description, that the invention’s problem can be solved.

https://lnkd.in/gu4v-xHj

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https://lnkd.in/gsjKtCiU

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Trial and Appeal Practitioners Study Group Report 2024 — Theme 4 (Electrical 1)

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Topics: Patent eligibility, Examination and appeal practice

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514577716843782144-ja

Trial and Appeal Practitioners Study Group Report 2024 — Theme 4 (Electrical 1)

[Eligibility as an invention: human mental activities and artificial arrangements]

Whether something “as a whole” constitutes a creation of technical ideas utilizing the laws of nature involves the following factors:

(i) whether artificial arrangements or human mental activities themselves are recited in the claims;

(ii) whether technical means for solving the problem, namely the system specified in the invention, are identified;

(iii) whether the technical significance of the invention is directed toward artificial arrangements or human mental activities themselves.

https://lnkd.in/grfQp-u5

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https://lnkd.in/gY-zfh3E

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/01_electricity.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514577753027997696/

Trial and Appeal Practitioners Study Group Report 2024 — Case 4 (Electrical 1)

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Category: Patents
Topics: Inventive step, Doctrine of equivalents, Added matter, Divisional applications, Examination and appeal practice
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HP: https://www.takaishihideki.com/en/single-post/linkedin-7514577881134481408-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514577843465601024-ja

Trial and Appeal Practitioners Study Group Report 2024 — Case 4 (Electrical 1)

[Inventive step in business-related inventions]

IP High Court, 2022 (Gyo-Ke) No. 10039

The judgment recognized an “inherent requirement” concerning facility reservations without specifically identifying evidence. Some participants observed that, from the applicant’s perspective, recognition of this requirement and denial of inventive step without evidence made the judgment difficult to predict and felt harsh.

<How to describe problems and effects in the specification>

• In some cases, it may be effective to describe the problem in the main text of the specification while either stating it as abstractly as possible in the problem section or leaving that section unwritten.

• Conversely, describing individual relationships among problems, effects and technical means too specifically may prevent the patent’s scope from having breadth.

• If the doctrine of equivalents is contemplated, the problem section should also state: “The essence of this invention lies here.”

• Describing the problem too specifically in the problem section may result in a proposed divisional application being summarily rejected as adding new matter.

https://lnkd.in/gAeTma-5

Original article (2025-07-27):

https://lnkd.in/ggJesN-h

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/02_electricity.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514577881134481408/

Trial and Appeal Practitioners Study Group Report 2024 — Theme 5 (Designs)

Original Ameblo publication: 2025-07-27

Article type: Reports and activities

Category: Designs

Topics: Similarity of designs, Examination and appeal practice

First published on this site: 2026-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12919021887.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7514578819605827584-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514578410979921921-ja

Trial and Appeal Practitioners Study Group Report 2024 — Theme 5 (Designs)

[Similarity of designs: the person whose perspective governs]

Identifying the relevant person takes account of the nature, purpose and manner of use of the article embodying the design. If appearance determines an end consumer’s purchase, ordinary consumers are the relevant consumers. If shape derived from function determines purchasing, “experts,” in addition to ordinary consumers, may be the relevant consumers.

Ordinary consumers tend to emphasize the overall configuration and portions readily noticeable at a glance. Beyond the overall configuration, they tend to focus on the shape of portions important in deciding a purchase—those emphasized when selecting a design.

Experts tend to observe details, particularly portions related to function, functionally important portions and improvements.

*The study also considered whether the relevant person may differ between actions to rescind trial/appeal decisions and infringement litigation.

https://lnkd.in/gXApC5_J

Original article (2025-07-27):

https://lnkd.in/g9G5CNTp

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/01_design.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514578819605827584/

Trial and Appeal Practitioners Study Group Report 2024 — Theme 6 (Trademarks)

Original Ameblo publication: 2025-07-29

Article type: Reports and activities

Category: Trademarks

Topics: Similarity of trademarks, Distinctiveness, Examination and appeal practice

First published on this site: 2026-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12919433619.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7514579770139996160-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514579478090629120-ja

Trial and Appeal Practitioners Study Group Report 2024 — Theme 6 (Trademarks)

[Similarity of composite marks]

<Marks formed by adding other characters, etc., to an already registered mark>

• Whether the registered-mark portion is a dominant element is influenced by its recognition and actual trading conditions concerning meaning and usage. However, additions having no difference in the strength of distinctiveness are relatively uncommon; in practice, additions often indicate quality, etc., and therefore differ in distinctiveness.

• Of two components, the one having relatively stronger distinguishing function may be extracted as the dominant element.

• For an applied-for mark “A+B,” even if added “B” is strongly distinctive, existing registered/cited mark “A” was itself registered because it is distinctive. In principle, both “B” and the portion “A” corresponding to the existing registered mark are separately extracted for comparison.

• If the applied-for mark is “A” and the cited mark is “A′+B,” the applicant for the cited mark considered the combination distinctive. In principle, it should not have the power to prevent registration of “A.”

• If the applied-for mark is “A+B” and the cited mark is “A′,” an element has been added to an existing mark, and there are many cases in which similarity should be favored.

• If both the registered mark and the added characters have weak distinctiveness, they may form a coined term with a different meaning. Traders and consumers may also perceive and remember the whole as inseparable. One view was that, unless the mark is well known or famous, registration could be allowed on the basis that the marks are dissimilar. (Tokyo High Court, 2000 (Gyo-Ke) No. 301 — “ロマンティック北街道” (“Romantic Kita-kaido”) held that a person selecting such a weak mark as its own trademark must tolerate the word being used in this manner as part of another person’s trademark.)

https://lnkd.in/gveUz7DN

Original article (2025-07-29):

https://lnkd.in/gABx3anQ

https://www.jpo.go.jp/resources/shingikai/kenkyukai/sinposei_kentoukai/document/2024_houkokusyo/01_trademark.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514579770139996160/

Images from the original AMEBLO article

English translations of the original image text

English key to the four original trademark comparisons

(1) Reference judgment 1: IP High Court, November 30, Reiwa 5 (2023), Reiwa 5 (Gyo-Ke) No. 10063, “Yū / VENTURE” case

Trademark applied for	Similarity or dissimilarity	Cited trademark
VENTURE (standard characters) Class 25: Clothing, etc.	Dissimilar	Yū / VENTURE Class 25: Clothing

(2) Reference judgment 2: IP High Court, February 22, Reiwa 3 (2021), Reiwa 2 (Gyo-Ke) No. 10088, “Hōmuzu-kun” case

Trademark applied for	Similarity or dissimilarity	Cited trademark
Hōmuzu-kun Services in Classes 35 and 41, etc.	Similar	Hōmuzu-kun / Earthquake Resistance Forum Services in Classes 35 and 41

(3) Reference judgment 3: IP High Court, February 22, Reiwa 3 (2021), Reiwa 2 (Gyo-Ke) No. 10104, “Shun / JAPAN SHuN” case

Trademark applied for	Similarity or dissimilarity	Cited trademark
Shun / JAPAN SHuN Goods in Class 21	Similar	Ichiba 365 / Shun / SYUN RAKU ZEN Services in Class 35 (retail services, etc.)

(4) Reference judgment 4: IP High Court, September 12, Reiwa 1 (2019), Heisei 31 (Gyo-Ke) No. 10020, “SIGNATURE” case

Trademark applied for	Similarity or dissimilarity	Cited trademark
SIGNATURE (illustrated mark) Class 34: Tobacco, etc.	Similar	SIGNATURE (standard characters) Class 34: Tobacco

English key to the four original trademark comparisons

(1) Reference judgment 1: IP High Court, November 30, 2023, 2023 (Gyo-Ke) No. 10063, “遊 / VENTURE” case.

Trademark applied for: VENTURE (standard characters). Class 25: Clothing, etc.

Similarity or dissimilarity: Dissimilar.

Cited trademark: 遊 (Yū) / VENTURE, as illustrated in the original. Class 25: Clothing.

(2) Reference judgment 2: IP High Court, February 22, 2021, 2020 (Gyo-Ke) No. 10088, “ホームズくん” case.

Trademark applied for: ホームズくん (Hōmuzu-kun). Services in Classes 35 and 41, etc.

Similarity or dissimilarity: Similar.

Cited trademark: the illustrated mark containing ホームズ君 (Hōmuzu-kun) and 耐震フォーラム (Earthquake Resistance Forum), with a detective-like character and house framework. Services in Classes 35 and 41.

(3) Reference judgment 3: IP High Court, February 22, 2021, 2020 (Gyo-Ke) No. 10104, “旬 / JAPAN SHuN” case.

Trademark applied for: the illustrated mark containing 旬 (Shun), JAPAN and stylized SHUN. Goods in Class 21.

Similarity or dissimilarity: Similar.

Cited trademark: the illustrated mark containing 市場 365 (Ichiba 365), 旬 (Shun), and SYUN RAKU ZEN. Services in Class 35 (retail services, etc.).

(4) Reference judgment 4: IP High Court, September 12, 2019, 2019 (Gyo-Ke) No. 10020, “SIGNATURE” case.

Trademark applied for: the illustrated mark containing SIGNATURE, NO. 555 and STATE EXPRESS, with a crest and circular design. Class 34: Tobacco, etc.

Similarity or dissimilarity: Similar.

Cited trademark: SIGNATURE (standard characters). Class 34: Tobacco.

Original images retained for comparison

（1）参考判決①：知財高判令和５年１１月３０日(令和５年(行ケ)第１００６３号、「遊＼ＶＥＮＴＵＲＥ」事件)

本願商標	類否	引用商標
ＶＥＮＴＵＲＥ (標準文字) 第２５類　被服等	非類似	遊 VENTURE 第２５類　被服

（2）参考判決②:知財高判令和３年２月２２日(令和２年(行ケ)第１００８８号､「ホームズくん」事件)

本願商標	類否	引用商標
ホームズくん 第３５類及び第４１類の役務等	類似	ホームズ君 耐震フォーラム 第３５類及び第４１類の役務

（3）参考判決③：知財高判令和３年２月２２日(令和２年(行ケ)第１０１０４号、「旬　ＪＡＰＡＮ＼ＳＨｕＮ」事件)

本願商標	類否	引用商標
JAPAN SHUN 第２１類の商品	類似	市場365 旬 SYUN RAKU ZEN 第３５類の役務(小売等役務)

（4）参考判決④：知財高判令和元年９月１２日(平成３１年(行ケ)第１００２０号、「ＳＩＧＮＡＴＵＲＥ」事件)

本願商標	類否	引用商標
 第３４類　たばこ等	類似	ＳＩＧＮＡＴＵＲＥ (標準文字) 第３４類　たばこ

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12919433619.html

Trial and Appeal Practitioners Study Group Report 2024 — Case 6 (Trademarks)

Original Ameblo publication: 2025-07-30
Article type: Reports and activities
Category: Trademarks
Topics: Distinctiveness, Examination and appeal practice
First published on this site: 2026-10-11
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12919634690.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7514580134021152768-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514579945453473792-ja

Trial and Appeal Practitioners Study Group Report 2024 — Case 6 (Trademarks)

[Application of Article 3(1)(iv) of the Trademark Act to a mark combining a common surname and a customary name]

IP High Court, 2023 (Gyo-Ke) No. 10031 — Ikegami Seimensho

Where a meaning other than a surname is better known and the word is ordinarily perceived in that other sense, such circumstances may affect whether it is a “common surname.”

As to how the number of people bearing the surname may be considered, most participants acknowledged the rationality of a numerical criterion to ensure objectivity, while considering it difficult to draw a line at a specific number.

A surname forming a mark may be “common” even if relatively few people bear it:

① where it is the surname of a historical or fictional person;

② where it is concentrated in a particular region.

Regarding the provision applicable to composite marks combining a common surname with a customary industry name, some decisions differ from this judgment and apply item (vi) when refusing registration (IP High Court, March 11, 2024 — Tanaka Hashiten).

https://lnkd.in/gsDfQ_bC

Original article (2025-07-30):

https://lnkd.in/ghexMKCW

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514580134021152768/

[US patents] CAFC, January 2025 — Honeywell v. 3G Licensing

Original Ameblo publication: 2025-07-31

Article type: Case note

Category: United States

Topics: Inventive step, Motivation and teaching away

First published on this site: 2026-10-11

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12919845909.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7514580408639008768-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7514580275985661952-ja

[US patents] CAFC, January 2025 — Honeywell v. 3G Licensing

When assessing obviousness, the motivation to modify the primary cited invention need not be identical to the motivation the patentee had in the past.

When establishing obviousness, a particular combination with the primary cited invention need not be its preferred or most preferred combination.

https://lnkd.in/g84mfXNG

Original article (2025-07-31):

https://lnkd.in/gSMuQN6t

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514580408639008768/

Tokyo District Court, 2023 (Wa) No. 70178 — Zinc acetate hydrate tablets (Judge Nakashima)

Original Ameblo publication: 2025-08-01

Article type: Case note

Category: Patents

Topics: Claim interpretation, Numerical limitations and parameters

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12920092315.html

HP: https://www.takaishihideki.com/en/single-post/tokyo-district-court-reiwa-5-wa-no-70178-zinc-acetate-hydrate-tablets-judge-nakajima

Japanese version: https://www.takaishihideki.com/single-post/東京地判令和５年-ワ-70178【酢酸亜鉛水和物錠】-中島

Tokyo District Court, 2023 (Wa) No. 70178 — Zinc acetate hydrate tablets (Judge Nakashima)

*The claim was held not to be satisfied unless the temperature remained within the numerical range until the end of the drying process.

(Excerpt from the judgment, translated)

The marketing approval document for the defendant’s pharmaceutical product states that “the product temperature at the drying endpoint shall be no higher than <50°C>.” Each manufacturing instruction and record for that product instructs that drying end at a product temperature of 41.0°C or higher. It is therefore recognized that, in the defendant’s method, the product temperature reaches 41°C or higher in the “step of drying to obtain granules.” The “step of drying to obtain granules” means the entire drying process. Accordingly, the defendant’s method cannot be said to satisfy the limitation that “the product temperature is below 40°C” in the “step of drying to obtain granules.”

https://t.co/b8MGhLV40w

Original article (2025-08-01):

https://lnkd.in/ghH3aD25

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514133989939503104/

[India] Syngenta Limited v. Controller of Patents and Designs, 471/2022 (Division Bench of the Delhi High Court, October 13, 2023)

Original Ameblo publication: 2025-08-02

Article type: Case note

Category: Other foreign jurisdictions

Topics: Divisional applications, Disclosure in the parent application, Claims

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12920306893.html

HP: https://www.takaishihideki.com/en/single-post/india-syngenta-v-controller-patent-office-471-202-division-bench-of-the-delhi-high-court-oct

Japanese version: https://www.takaishihideki.com/single-post/【インド】syngenta-v-controller-特許庁-471-202（2023年10月13日デリー高裁合議審）

[India] Syngenta Limited v. Controller of Patents and Designs, 471/2022 (Division Bench of the Delhi High Court, October 13, 2023)

*A Delhi High Court judgment that relaxed the requirements for divisional applications!

Before this judgment, the practice was that an invention disclosed only in the parent application’s specification, but not in its claims, could not be made the subject of a divisional application.

→ The judgment held that a divisional application could be filed for an invention disclosed only in the parent application’s specification, even if it was not recited in the parent application’s claims.

*The practice became consistent with that of Japan, the United States, Europe and other jurisdictions.

https://lnkd.in/g3G-_ZkX

Original article (2025-08-02):

https://lnkd.in/gTfbYHKj

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514134378524991489/

[Copyright] Osaka District Court, 2019 (Wa) No. 10940

Original Ameblo publication: 2025-08-05

Article type: Case note

Category: Copyright

Topics: Damages

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12920901156.html

HP: https://www.takaishihideki.com/en/single-post/copyright-osaka-district-court-reiwa-1-wa-no-10940

Japanese version: https://www.takaishihideki.com/single-post/【著作権】大阪地判令和１年-ワ-10940

[Copyright] Osaka District Court, 2019 (Wa) No. 10940

The court affirmed the copyrightability of the program, taking into account the volume of its source code.

*Where the source code and the functions contained in it are extensive, creativity is recognized unless there are special circumstances (Tokyo District Court, January 28, 2011, New Masuda-ashi case).

There was an implied license for the acts of reproduction and modification.

→ Infringement of copyright (the right of reproduction) and moral rights (the right of integrity) was denied.

On the other hand, infringement of the right of attribution was found with respect to the defendant’s display of only its own company name on the program’s startup and version screens and its removal of the plaintiff’s name.

→ The court awarded total damages of JPY 110,000, comprising JPY 100,000 in compensation for non-pecuniary harm and JPY 10,000 for attorney’s fees.

*On appeal (IP High Court, 2024 (Ne) Nos. 10017 and 10036, November 21, 2024), total damages were reduced to JPY 55,000, comprising JPY 50,000 in compensation for non-pecuniary harm and JPY 5,000 for attorney’s fees, because some of the programs had not been “offered or presented to the public.”

https://lnkd.in/g2jBaeFY

Original article (2025-08-05):

https://lnkd.in/gS6TFPZS

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514134915005747201/

Text to Enter in “Customize ChatGPT”

Original Ameblo publication: 2025-08-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12920940421.html

When researching judicial decisions, prior art for invalidity arguments, or other facts, the following text can be entered in “Customize ChatGPT” to request exact quotations and summaries and to reduce the risk of hallucinations.

“I am not asking ChatGPT to invent anything or to tell me what it thinks I want to hear. I am asking for answers to the questions entered in the prompt. In your answer, always cite the links on which you rely and always quote the text on which you rely in quotation marks. When quoting, reproduce the text exactly as it is, without changing a single character. The output I seek is accurate quotation; paraphrasing for readability or summarizing is completely prohibited. Do not create text under any circumstances; quote the text in quotation marks. After completing the quotation without changing a single character, also summarize the content that you quoted in quotation marks. If there is nothing corresponding to the question, I want an answer saying that there is nothing, so never introduce a judgment that does not exist. If you introduce something nonexistent, my delivered report will contain falsehoods, which is what causes me the greatest difficulty. Thank you. temperature=0 Above all, hallucinations cause me the greatest difficulty, so if the answer you are looking for is not there, please honestly answer that it was not there. Thank you.”

[China] Requirements when further limiting an independent claim while amending an original dependent claim into an independent claim

Original Ameblo publication: 2025-08-06
Article type: Case note
Category: China
Topics: Claim amendments, Further limitations, Making dependent claims independent
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12921151409.html
HP: https://www.takaishihideki.com/en/single-post/china-requirements-when-further-limiting-an-independent-claim-while-amending-an-original-dependent
Japanese version: https://www.takaishihideki.com/single-post/【中国】独立請求項に対して更なる限定を行うと共に、元の従属請求項を独立請求項に補正する場合の要件

[China] Requirements when further limiting an independent claim while amending an original dependent claim into an independent claim

<Supreme People's Court, (2021) Zui Gao Fa Zhi Xing Zhong No. 556 (December 12, 2023)>

The patentee further limited the independent claim and rewrote original dependent Claim 3 as new independent Claim 4.

Because the substantive content and scope of protection of new Claim 4 and original Claim 3 are exactly the same, amended Claim 4 is original Claim 3; it was not obtained by combining original Claims 1 and 3. New Claim 4 is subject to examination.

<Key points of the holdings (2023)>

In patent-right confirmation proceedings, whether an amendment to a claim constitutes a "further limitation" should be assessed solely by determining whether the amended claim fully includes all technical features of the claim before amendment, whether the amended claim adds technical features compared with the claim before amendment, and whether those added technical features are recited in other claims of the original claim set.

As a general rule, an amendment that "further limits" a claim should be confined to responding to grounds for invalidation. An amendment made under the guise of remedying the deficiencies alleged in those grounds, but which in substance optimizes claim drafting rather than responding to those grounds, may be rejected.

In this case, incorporating the technical features of original Claims 2, 4, 6 and 7 into original Claim 1 constitutes a "further limitation." In these circumstances, rewriting original Claim 3 as new independent Claim 4 is permissible because it changes the form of drafting without altering the substantive content or scope of protection and does not substantively reconstruct the claims.

https://t.co/J2U55kop1j

Original article (2025-08-06):

https://lnkd.in/gZig7S2H

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514137631983775744/

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10038

Original Ameblo publication: 2025-08-07
Article type: Case note
Category: Trademarks
Topics: Distinctiveness, Examination and appeal practice
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12921367606.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-reiwa-6-gyo-ke-no-10038
Japanese version: https://www.takaishihideki.com/single-post/【商標】令和６年-行ケ-10038

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10038

Applied-for mark: “新生甘酒” (Shinsei amazake)

→ No distinctiveness (contrary to Article 3(1)(iii) of the Trademark Act).

1. If understood as “新生” + “甘酒”

It could ordinarily be used for amazake whose ingredients, manufacturing method or other aspects have been changed.

2. If understood as “新” + “生甘酒”

It could ordinarily be used for new “生甘酒” (unheated amazake).

(Excerpts from the judgment, translated; portions omitted)

1. Both “新生” and “甘酒” are common dictionary words. In light of the actual trade circumstances concerning “新生” that existed at the time of the trial decision, the applied-for mark is recognized as a name generally referring to amazake whose content has been renewed by changing its ingredients, manufacturing method or other aspects. It could ordinarily be used to describe such amazake. When used for the designated goods, traders and consumers would generally recognize it as indicating the quality of the goods. [...]

2. If “新生甘酒” is understood as combining “新” and “生甘酒,” consumers and others encountering it on the designated goods would recognize it as a name generally referring to unheated amazake manufactured that year, or new amazake whose manufacturing method or characteristics differ from previous products. “新” is a common word listed in dictionaries, and the trade circumstances described above establish the practice of placing it before words indicating beverages or food products. “生甘酒” was also used in trade to mean “amazake manufactured without heat treatment.” Accordingly, the combined term “新生甘酒” could ordinarily be used to describe unheated amazake manufactured that year, or new amazake whose manufacturing method or characteristics differ from previous products. …

https://t.co/rEibmTw6FV

Original article (2025-08-07):

https://lnkd.in/gjdSJFcX

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514137870853586944/

[Trademarks] IP High Court, 2023 (Gyo-Ke) No. 10117 — “Besurikai Tokyo TMS Clinic” (Judge Honda)

Original Ameblo publication: 2025-08-07
Article type: Case note
Category: Trademarks
Topics: Composite trademarks, Dominant elements, Distinctiveness, Trademark similarity
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12921368060.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-reiwa-5-gyo-ke-no-10117-besurikai-tokyo-tms-clinic-judge-honda
Japanese version: https://www.takaishihideki.com/single-post/【商標】令和５年-行ケ-10117『ベスリ会-東京 tms クリニック』事件-本多

[Trademarks] IP High Court, 2023 (Gyo-Ke) No. 10117 — “Besurikai Tokyo TMS Clinic” (Judge Honda)

Applied-for mark: “ベスリ会 東京 TMS クリニック”

Cited mark: “東京 TMS クリニック”

*“ベスリ会,” the name of a medical corporation, has a source-identifying function, but “東京 TMS クリニック” can be extracted as the dominant element.

(Excerpts from the judgment, translated; portions omitted)

The term “TMS” is not recognized as immediately calling to mind “transcranial magnetic stimulation” or “TMS treatment” as a treatment for depression. The textual portion “東京 TMS クリニック,” taken as a whole, functions as a source identifier representing the name of the clinic that provides the services. [...]

The textual portion “ベスリ会,” which indicates the medical corporation’s name, is not devoid of a source-identifying function. However, considering actual trade circumstances in which a medical corporation’s name and a medical institution’s name are used together, its source-identifying function must be regarded as relatively weak within the applied-for mark as a whole, which combines it with “東京 TMS クリニック.”

Even where pronunciations and concepts functioning as source identifiers arise from multiple parts of a composite mark, [...] a particular part may be extracted as its dominant element where, for example, that part gives traders and consumers a strong and dominant impression as an identifier of the source of services. Accordingly, even if “ベスリ会” has a source-identifying function, this does not prevent extraction of “東京 TMS クリニック” as the dominant element of the applied-for mark. [...]

https://lnkd.in/gFj8qivP

Original article (2025-08-07):

https://lnkd.in/g_mEw7ZA

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[United States] CAFC, August 2, 2023 — Realtime Data v. Array Networks

Original Ameblo publication: 2025-08-07

Article type: Case note

Category: United States

Topics: Patent eligibility, Alice decision, Abstract ideas

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12921368250.html

HP: https://www.takaishihideki.com/en/single-post/united-states-cafc-august-2-2023-realtime-data-v-array-network

Japanese version: https://www.takaishihideki.com/single-post/【米国】cafc-2023-8-2-realtime-data-v-array-network

[United States] CAFC, August 2, 2023 — Realtime Data v. Array Networks

[Alice, step one] → Directed to an abstract idea

The claims do not clearly define a particular technology for performing data compression; they merely state results abstractly.

[Alice, step two] → No inventive concept

The specification does not show a particular use of a processor or differences from the prior art.

Data compression itself has long been well known. Even when the elements and procedures recited in the claims are combined, no technical feature beyond an abstract idea implemented by a general-purpose computer can be found.

https://lnkd.in/g-akJbS5

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https://lnkd.in/gAJzsvMM

Originally posted on LinkedIn:
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IP High Court, 2020 (Gyo-Ke) No. 10094 — Agent for suppressing recurrence of reflux esophagitis (Judge Mori)

Original Ameblo publication: 2025-08-14
Article type: Case note
Category: Patents
Topics: Inventive step
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922879943.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-2-gyo-ke-no-10094-agent-for-suppressing-recurrence-of-reflux-esophagitis-judge-mori
Japanese version: https://www.takaishihideki.com/single-post/令和２年-行ケ-10094【逆流性食道炎の再発抑制剤】-森

IP High Court, 2020 (Gyo-Ke) No. 10094 — Agent for suppressing recurrence of reflux esophagitis (Judge Mori)

*Common general knowledge at the priority date: completion of a phase II clinical trial led to denial of inventive step.

Phase I clinical trial: safety trial

Phase II clinical trial: efficacy trial with a small number of participants

Phase III clinical trial: efficacy trial with a large number of participants

<Difference>

Invention 1 is an “agent for suppressing recurrence of proton-pump-inhibitor-resistant reflux esophagitis,” containing “rabeprazole sodium” as its active ingredient and administered “for maintenance therapy.” By contrast, the Exhibit Ko 1 invention is “rabeprazole sodium (E3810) used in a phase III clinical trial to examine efficacy and safety” “in maintenance therapy for patients with PPI-resistant reflux esophagitis.”

(Excerpts from the judgment, translated; portions omitted)

…In light of common general knowledge concerning safety, the tolerability of long-term administration of 20 mg of rabeprazole sodium once daily in maintenance therapy was clear to a person skilled in the art at the priority date. …Considering also that no safety difference was thought to exist between twice-daily and once-daily administration, …no circumstance indicating an obstacle from the perspective of clinical safety to administration of “10 mg per dose twice daily” for “four weeks or more” is apparent. The guidelines in Exhibits Ko 42 and Ko 44 do describe concerns about the safety of long-term PPI administration. However, they state, for example, that “a direct causal relationship between any of these concerns and PPI administration cannot be said to be clear” (Exhibit Ko 42), and therefore do not alter the above conclusion. Nor do the warnings in the package inserts for the respective PPIs in Exhibits Ko 23 and Ko 29–31 alter that conclusion: they merely contain general statements about adverse reactions and similar matters ordinarily included in drug package inserts. …Accordingly, a person skilled in the art could readily have conceived of using the rabeprazole sodium of the invention in Exhibit Ko 1 as a recurrence-suppressing agent administered during maintenance therapy for patients with PPI-resistant reflux esophagitis and of adopting the features of Invention 1 at issue relating to Difference 1. …

The plaintiff relies on the 2017 judgment (2016 (Gyo-Ke) No. 10107). However, that judgment addressed “novelty,” not “inventive step,” and plainly concerned a different case.

https://lnkd.in/gEsY9TJV

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https://lnkd.in/gz8sAyqr

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[Trademarks / Similarity] Tokyo High Court, 2000 (Ne) No. 6252

Original Ameblo publication: 2025-08-14
Article type: Case note
Category: Trademarks
Topics: Similarity of trademarks, Distinctiveness
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880039.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-similarity-tokyo-high-court-heisei-12-ne-no-6252
Japanese version: https://www.takaishihideki.com/single-post/【商標-類否】東京高判平成 12 年-ネ-6252

[Trademarks / Similarity] Tokyo High Court, 2000 (Ne) No. 6252

*During prosecution, the applicant emphasized the distinctive spelling “BeaR.”

→ Dissimilar to “bear.”

(Excerpts from the judgment, translated; portions omitted)

Even if “BeaR” in the registered mark is understood as the English word “bear,” it is established, as noted above, that numerous marks giving rise to concepts and pronunciations associated with “bear” (the animal) have been registered as independent trademarks and are actually used in the field of the designated goods. In light of these circumstances, in the market for clothing and the other designated goods, it is difficult to distinguish one trader’s goods from another’s solely by the pronunciation “bear” or the concept of a bear. It accords with experience that traders and consumers instead distinguish the various “bear” marks by differences in the words, devices and other elements added to “bear” and similar terms.

The applicant’s arguments in the above written opinion responding to the notice of reasons for refusal should be understood as expressing its recognition of the general trade circumstances that marks containing “bear” or similar terms are not distinguished merely by the pronunciation “bear” and the concept of the animal. In the case of the registered mark, as emphasized in that written opinion, the distinctive spelling “BeaR,” particularly the emphasis created by the capital final “R,” should be understood as the feature distinguishing it from the ordinary word “bear” (the animal).

In other words, among the many registered and actually used marks associated with “bear,” this mark should be understood as being perceived and conceptualized as the distinctive “bear with a capital final R,” and as exercising distinctiveness in that form.

If the mark is viewed as a coined word with “e” and “a” between “B” and “R,” it is not similar to the appellant’s sign in pronunciation or concept. [...]

https://lnkd.in/gbm6VVSB

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https://lnkd.in/gc6kZ7B5

Originally posted on LinkedIn:
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[Trademarks / Cancellation for non-use] IP High Court, 2010 (Gyo-Ke) No. 10083 — “ECOPAC”

Original Ameblo publication: 2025-08-14
Article type: Case note
Category: Trademarks
Topics: Cancellation for non-use, Prosecution history estoppel, Identity under accepted social standards
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880119.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-cancellation-for-non-use-heisei-22-gyo-ke-no-10083-ecopac
Japanese version: https://www.takaishihideki.com/single-post/【商標-不使用取消】平成 22 年-行ケ-10083『ecopac』事件

[Trademarks / Cancellation for non-use] IP High Court, 2010 (Gyo-Ke) No. 10083 — “ECOPAC”

*Prosecution history estoppel prevents an argument that the registered mark conveys the concept of “environmentally friendly packaging.”

→ The registered mark “ECOPAC” is not equivalent to “エコパック.”

→ Cancellation for non-use.

(Excerpts from the judgment, translated; portions omitted)

At present, the mark in actual use, “エコパック,” conveys the concept of “economical and environmentally conscious packaging containers.” Further, because the registered mark “ECOPAC” has the pronunciation “ekopakku,” even taking into account that the English words meaning “packaging containers” are “package” and “pack,” there is room to construe that traders and consumers would associate the constituent part “ECO” of the registered mark with “ECO,” an abbreviation of “ecology,” and would further associate “PAC” with “pack,” meaning “packaging containers,” thus understanding the registered mark to convey the concept of “economical and environmentally conscious packaging containers.” …

However, in the course of prosecution of the registered mark, the plaintiff repeatedly argued that the mark had a distinctive composition and consisted of a coined term that gave rise only to the pronunciation “ekopakku,” corresponding to its constituent letters, and did not give rise to any particular concept; following an appeal against a decision of refusal, the mark was allowed for registration. In particular, in proceedings on an opposition to registration, the opponent argued that the mark “ECOPAC” suggested a compound of “ecology” and “package” and, in relation to the designated goods, would be recognized solely as a generic term indicating “packaging containers giving full consideration to environmental protection” or as a representation of the quality of such containers. In response, the plaintiff asserted that the registered mark was not divisible into “ECO” and “PAC”; that, even if the components were considered separately, there was no general ordinary commercial use of “ECO” as an abbreviation indicating “ecology”; that the foreign-language words ordinarily adopted in trade to designate “packaging containers” were “package” and “pack,” which differed in their letter composition from “PAC” in the registered mark; and that the continuously joined expression “ECOPAC” did not designate “packaging containers giving full consideration to environmental protection,” but would be understood by traders and consumers as a coined word created by the plaintiff and incapable of giving rise to any particular concept. The plaintiff made these assertions. The Japan Patent Office accepted the plaintiff’s contentions, allowed registration of the mark, and subsequently decided that the registration should be maintained.

Consequently, even taking into account that the points disputed in the appeal against refusal and similar proceedings did not necessarily coincide with the grounds for rescission at issue in this lawsuit, and that social awareness of environmental protection had increased by the present time compared with the time of the application for registration in 1988 and the appeal decision in 1997 when assessing whether the registered mark and the mark in actual use are identical according to accepted social standards, the plaintiff itself had clearly maintained in prosecution that “PAC” differed in composition from the foreign-language word denoting “packaging containers”; that the continuously joined registered mark “ECOPAC” did not signify “packaging containers giving full consideration to environmental protection”; and that traders and consumers would perceive and understand it as a coined term created by the plaintiff that gave rise to no particular concept. In these circumstances, the plaintiff cannot reverse its prior position in this case and contend that the registered mark conveys the concept of “environmentally friendly packaging,” since that would violate the principle of estoppel. Accordingly, the plaintiff’s contention that the registered mark and the mark in actual use are identical according to accepted social standards, on the premise that their pronunciation and concept are identical, cannot be accepted.

https://lnkd.in/gz5sjFi5

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https://lnkd.in/gtyC6vbc

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514139093472141312/

[Trademarks] Trial decision, Appeal against refusal No. 2023-10504

Original Ameblo publication: 2025-08-14

Article type: Administrative decision note

Category: Trademarks

Topics: Examination and appeal practice, Distinctiveness

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880245.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-trial-decision-appeal-against-refusal-no-2023-10504

Japanese version: https://www.takaishihideki.com/single-post/【商標】審決・不服 2023-10504

[Trademarks] Trial decision, Appeal against refusal No. 2023-10504

Applied-for mark: “完全” (complete)

→ No distinctiveness (contrary to Article 3(1)(vi) of the Trademark Act).

(Excerpt from the trial decision, translated)

Even if the applied-for mark, consisting of the characters “完全,” is used for the designated goods or services, traders and consumers encountering it would understand that “everything is present” or “nothing is lacking” in the goods or services. They would merely recognize it as advertising language succinctly expressing the characteristics, advantages or features of the designated goods or services, and would not recognize it as a sign indicating their source or distinguishing one trader’s goods or services from another’s. [...]

https://lnkd.in/gdNdC8eW

Original article (2025-08-14):

https://lnkd.in/gGMYJHhB

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[Trademarks] Osaka District Court, 2022 (Wa) No. 9818 — “熱中対策応急キット” (Heatstroke countermeasure emergency kit) (Judge Takemiya)

Original Ameblo publication: 2025-08-14
Article type: Case note
Category: Trademarks
Topics: Distinctiveness
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880338.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-osaka-district-court-reiwa-4-wa-no-9818-熱中対策応急キット-heatstroke-countermeasure-em
Japanese version: https://www.takaishihideki.com/single-post/【商標】大阪地判令和４年-ワ-9818『熱中対策応急キット』事件-武宮

[Trademarks] Osaka District Court, 2022 (Wa) No. 9818 — “熱中対策応急キット” (Heatstroke countermeasure emergency kit) (Judge Takemiya)

*At the date of the registration decision, “熱中対策” was understood to mean “heatstroke countermeasures.”

→ No distinctiveness (contrary to Article 3(1)(iii) of the Trademark Act).

(Excerpt from the judgment, translated)

At the date of the registration decision, “熱中対策” was also generally understood to mean “heatstroke countermeasures.” “熱中対策応急キット” was generally recognized as meaning a set of articles used for heatstroke countermeasures or first aid, or goods containing such articles. [...]

When the registered mark “熱中対策応急キット” was used for such goods, it was generally recognized by traders or consumers as indicating their intended use.

https://lnkd.in/g926qiDd

Original article (2025-08-14):

https://lnkd.in/g7HbWd2d

Originally posted on LinkedIn:
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[Trademarks / Cancellation for non-use] IP High Court, 2024 (Gyo-Ke) No. 10054

Original Ameblo publication: 2025-08-14

Article type: Case note

Category: Trademarks

Topics: Cancellation for non-use, General retail services, Trademark use

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880456.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-cancellation-for-non-use-reiwa-6-gyo-ke-no-10054

Japanese version: https://www.takaishihideki.com/single-post/【商標-不使用取消】令和６年-行ケ-10054

[Trademarks / Cancellation for non-use] IP High Court, 2024 (Gyo-Ke) No. 10054

“General retail and similar services” means “a case where clothing, food and beverages, and household goods are handled at a single establishment, each on a substantial scale and on a continuing basis.”

→ The sales volume and revenue for food and beverages were small compared with those for clothing and household goods.

The plaintiff’s store could not be recognized as continuously handling clothing, food and beverages, and household goods, each on a substantial scale, at a single establishment.

→ Cancellation for non-use.

https://lnkd.in/ggZE3paH

Original article (2025-08-14):

https://lnkd.in/gaePf_Dm

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514139970987626496/

[Unfair Competition / Indication of goods or business] Tokyo District Court, 2023 (Wa) No. 70036 — Catheter connector (Judge Kokubu)

Original Ameblo publication: 2025-08-14

Article type: Case note

Category: Unfair competition law

Topics: Indication of goods or business, Product configuration, Distinctiveness, Well-known status, Confusion, Injunction

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12922880680.html

HP: https://www.takaishihideki.com/en/single-post/unfair-competition-indication-of-goods-or-business-tokyo-district-court-reiwa-5-wa-no-70036

Japanese version: https://www.takaishihideki.com/single-post/【不競法-商品等表示】東京地判令和５年-ワ-70036『カテーテル用コネクター』-國分

[Unfair Competition / Indication of goods or business] Tokyo District Court, 2023 (Wa) No. 70036 — Catheter connector (Judge Kokubu)

The court recognized dimensions compared with similar products as an “indication of goods or business.”

→ Injunction granted!

*It is unusual for a likelihood of confusion to be found where the consumers are medical professionals.

[Subsequent appeal] In its judgment of July 16, 2025, 2025 (Ne) No. 10012, the IP High Court recognized the plaintiff’s product shape as a well-known indication of goods or business, but found that the defendant’s product shape was not similar. It reversed the portions of the first-instance judgment adverse to the defendant and dismissed the corresponding claims.

(Excerpts from the first-instance judgment, translated; portions omitted)

1. Distinctive features

[...] The plaintiff’s Y-connector was the only two-valve Y-connector having an overall length of approximately 88 mm and approximate proportions of 4:1:2:1 for the overall length, thumbwheel, main branch and rotator. It cannot be regarded as commonplace.

Accordingly, in Feature (e), the plaintiff’s Y-connector has an objectively conspicuous feature distinguishing it from other goods of the same kind. [...]

[...] Features (a) and (c) can be said to arise from an unavoidable configuration for which there is no choice of another form to achieve the product’s technical function and utility. As for the other features, however, there are multiple alternatives, and they cannot be said to arise from such an unavoidable configuration.

2. Well-known status

[...] Since 2008, the plaintiff’s Y-connectors had achieved shares of 50% or more in both sales volume and sales value in the PTCA market where Y-connectors are used. In 2022, those shares reached 70% by volume and approximately 80% by value. [...]

Because the plaintiff had exclusively used the form of its Y-connector for a long period, by around 2008 it had become widely recognized among its consumers, principally physicians and other medical professionals, as indicating the plaintiff as its source; it had acquired well-known status.

3. Similarity

The plaintiff's and defendant's Y-connectors share their overall length (87.99 mm for the plaintiff's and 87.80 mm for the defendant's), a cylindrical screw, an overall construction of transparent material, and an opener colored in a warm color. [...] Their overall dimensional proportions are also very similar. Particularly because their dimensions and colors are similar, their appearance gives consumers, principally physicians and other medical professionals, the impression that the two indications are similar overall.

Additional translation of the complete passages quoted in the Japanese edition (ellipses correspond to those in the Japanese text):

1. Distinctive characteristics: The two-valve Y-connectors sold in Japan before the plaintiff's product was launched and still being sold are Abbott's Y-connector and Merit Medical's Y-connector. These goods must naturally be taken into account as other products of the same kind when examining the distinctiveness of the plaintiff's Y-connector. …

Excluding short-size versions, two-valve Y-connectors range in overall length from 72 mm to 78.99 mm; some short-type versions have an overall length of 58 mm. Among the two-valve Y-connectors other than the plaintiff's, excluding the defendant's, even the Kaneka Y-connector, which is closest in overall length to the plaintiff's Y-connector, measures approximately 82 mm, a difference of approximately 6 mm. Whereas the plaintiff's Y-connector has a thumbwheel length of 27.90 mm (screw length 16.04 mm), the Kaneka Y-connector has a thumbwheel length of 33.88 mm (screw length 22.22 mm), according to the attached Comparison of Two-Valve Connectors and the evidence (Defendant's Exhibit Otsu 24). Apart from the defendant's Y-connector, there was no product whose form exhibited approximately the same proportions among overall length, thumbwheel, main branch and rotator as the plaintiff's Y-connector.

Consequently, the plaintiff's Y-connector was the only two-valve Y-connector having an overall length of approximately 88 mm and approximate proportions of 4:1:2:1 among its overall length, thumbwheel, main branch and rotator. Its form cannot be described as commonplace. The plaintiff's Y-connector thus possessed, in respect of Feature (e), an objectively conspicuous feature distinguishing it from other goods of the same kind. … Features (a) and (c) can be said to arise from an unavoidable configuration for which there is no choice of another form to achieve the product's technical function and utility. As for the other features, however, there are multiple alternatives, and they cannot be said to arise from such an unavoidable configuration.

2. Well-known status: The plaintiff continued advertising at trade fairs and conducting sales activities aimed at physicians, thereby increasing sales. In the PTCA market where Y-connectors are used, Y-connectors manufactured by the plaintiff had achieved market shares of 50% or more in both sales volume and sales value since 2008. By 2022, the market share had reached 70% by volume and approximately 80% by value. Approximately 70% of the Y-connectors sold by the plaintiff were the plaintiff's product, in which an OKAY II-type Y-connector was selected and combined with accessories. Although market data confined to two-valve Y-connectors did not exist, it could be inferred that the plaintiff's share of the two-valve Y-connector market was even higher than its share of the overall Y-connector market. In light of these circumstances, the form of the plaintiff's Y-connector had acquired well-known status by around 2008: through its longstanding exclusive use by the plaintiff, it had become widely recognized by its consumers, principally physicians and other healthcare professionals, as indicating the plaintiff as its source.

3. Similarity: The plaintiff's and defendant's Y-connectors share an overall length of 87.99 mm and 87.80 mm, respectively; the cylindrical shape of their screws; their manufacture entirely from transparent components; and openers colored in warm hues. … Their overall dimensional ratios are also very similar. In particular, because their dimensions and colors are similar, their appearance gives consumers, principally physicians and other healthcare professionals, the impression that the two indications are similar overall.

https://lnkd.in/gn3jKwvU

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https://lnkd.in/g57DZdB4

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[Trademarks] Tokyo High Court, 1979 (Ne) No. 1097

Original Ameblo publication: 2025-08-16

Article type: Case note

Category: Trademarks

Topics: False indication of registered trademark status, Marking before registration, Trademark Act Article 74

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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12923468365.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-tokyo-high-court-showa-54-ne-no-1097

Japanese version: https://www.takaishihideki.com/single-post/【商標】東京高判昭和 54 年-ネ-1097

[Trademarks] Tokyo High Court, 1979 (Ne) No. 1097

Even where an applicant has received a decision to register the mark and paid the registration fee, and only registration remains, the court held that using the indication “registered trademark” before registration violates Article 74(i) of the Trademark Act and may constitute the offense of false indication under Article 80.

https://lnkd.in/gfX_M-BB

Original article (2025-08-16):

https://lnkd.in/gceEuWyi

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514140269827514368/

[Designs] A case recognizing indirect infringement of a partial design

Original Ameblo publication: 2025-08-16
Article type: Case note
Category: Designs
Topics: Indirect infringement, Partial designs
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12923469325.html
HP: https://www.takaishihideki.com/en/single-post/designs-a-case-recognizing-indirect-infringement-of-a-partial-design
Japanese version: https://www.takaishihideki.com/single-post/【意匠】部分意匠の間接侵害が認められた事例

[Designs] A case recognizing indirect infringement of a partial design

Tokyo District Court, 2021 (Wa) No. 30281 — Hand-pushing member for a transport cart (Judge Kokubu)

1. Comparison of the articles

“The articles relating to the registered designs and the article relating to the defendant’s design are attached to a transport cart and used to protect the hand holding the grip from surrounding objects. Their purpose and function are the same.”

2. Comparison of the shapes

“There is no publicly known design combining the shape of the grip and that of the protective portion of Registered Design 1 as viewed obliquely from above. [...]

[...] The common features of Registered Design 1 and Defendant’s Design 1′ [...] produce an aesthetic impression approximately resembling an inverted letter ‘T’ when viewed from the front. Although the surface of the grip in Registered Design 1 is smooth, whereas Defendant’s Design 1′ has nine annular ridges at equal intervals around the grip, and this is a difference concerning an essential part, the unevenness is not substantial. It cannot be assessed as a difference sufficient to outweigh the aesthetic impression of an approximately inverted ‘T’ produced by Defendant’s Design 1′.”

3. Requirements for indirect infringement

“The defendant’s product is not attached to anything other than the single pipe of a transport cart and does not acquire a function or purpose different from that of a hand-pushing member (entire import of the oral argument). Accordingly, the defendant’s product, which is attached to the upper end of the transport cart’s single pipe, is an article ‘used exclusively for manufacturing’ the hand-pushing member of a transport cart (Design Act, Article 38(i)(a)).”

https://lnkd.in/gSEHixRU

Original article (2025-08-16):

https://lnkd.in/grSG63Ac

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514141120642310144/

[Trademarks / False marking] Osaka High Court, 1991 (Ne) No. 1003 — Choco Krispies

Original Ameblo publication: 2025-08-17
Article type: Case note
Category: Trademarks
Topics: False trademark marking, Well-known status, Protection under unfair competition law
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12923668454.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-false-marking-osaka-high-court-heisei-3-ne-no-1003-choco-krispies
Japanese version: https://www.takaishihideki.com/single-post/【商標-虚偽表示】大阪高判平成３年-ネ-1003（チョコクリスピー事件）

[Trademarks / False marking] Osaka High Court, 1991 (Ne) No. 1003 — Choco Krispies

The appellant argued that Kellogg's continued use of "クリスピー(R)" on packaging after registration of the Japanese-character mark "クリスピー" had expired falsely suggested registration, contrary to Article 74(i) of the Trademark Act. It argued that a party making such false indications should not receive protection under the Trademark Act or the Unfair Competition Prevention Act.
→ The court recognized that the act itself violated Article 74(i) and was subject to criminal penalties. However, the existence of a criminal penalty did not automatically require refusal of civil protection based on the trademark right. In particular, the claim was based on the Latin-letter mark "KRISPIES," which differed from the Japanese-character indication "クリスピー(R)" at issue. The existence of false marking could not defeat the claim based on the trademark right.
(Excerpt from the judgment, translated)
"3. The new issue on appeal: whether a person who made false indications contrary to Article 74(i) of the Trademark Act can receive protection under the Unfair Competition Prevention Act
As stated above, appellee Kellogg Japan continued to state on its product packaging that the Japanese-character mark "クリスピー" was a registered trademark even after its registration as an associated trademark had expired on August 1, 1984, in violation of Article 74(i) of the Trademark Act. The appellant argues that, even if marks such as "チョコクリスピー" used by Kellogg Japan are well known, that recognition was acquired by improper means and should therefore not receive protection under the Unfair Competition Prevention Act.
However, as already stated, the imposition of criminal penalties as a sanction for that violation does not itself mean that the person's rights are denied civil protection. Moreover, 'チョコクリスピー' became well known as Kellogg Japan's mark through its advertising and sales activities as found above, not through the false indications. The appellant's argument therefore cannot be accepted."
https://lnkd.in/gGS3X3YQ
Original article (2025-08-17):
https://lnkd.in/gnKgKWgk
Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514141335524659200/

[Copyright] Osaka High Court, 2007 (Ne) No. 713 — Peter Rabbit

Original Ameblo publication: 2025-08-18
Article type: Case note
Category: Copyright
Topics: Injunctions
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12923801690.html
HP: https://www.takaishihideki.com/en/single-post/copyright-osaka-high-court-heisei-19-ne-no-713-peter-rabbit
Japanese version: https://www.takaishihideki.com/single-post/【著作権】大阪高判平成 19 年（ネ）713（ピーターラビット事件）

[Copyright] Osaka High Court, 2007 (Ne) No. 713 — Peter Rabbit

Manufacturer X planned to sell towels using parts of illustrations from picture books whose copyright term had expired. Against Y, the company managing copyright in the picture books, X alleged that Y had its licensees use indications suggesting that copyright still existed, thereby misleading consumers into believing that copyright continued to subsist in Japan (the defendant's indications). X argued that this constituted unfair competition misleading consumers about the quality or content of licensed goods and about the quality or content of services relating to merchandising licensing.

→ The court upheld the dismissal of X's unfair-competition claims and dismissed X's appeal. The goods bearing the defendant's indications on reproductions of the works covered by the injunction claim were diverse, but X had not specifically identified, alleged and proved which goods used those indications. Whether an indication "misleads" consumers about the "quality" or "content" of "goods" must be determined by examining the specific content of specific goods, and the conclusion may differ for each product. Without allegations and proof identifying specific goods, X's case was insufficient.

The first-instance judgment also granted X's claim for a declaration that Y had no right, based on copyright in the original illustrations, to obtain an injunction against X. That part of the judgment was likewise upheld through dismissal of Y's incidental appeal.

Copyright notices after expiration of copyright

Displaying patent, utility model or design rights that do not actually exist on products is considered likely to constitute unfair competition in many cases. Such indications often mislead consumers about the quality or content of the products by suggesting that they possess superior technology or design of a kind granted a patent, utility model registration or design registration.

https://lnkd.in/gccb-jUq

Original article (2025-08-18):

https://lnkd.in/gcn5kf59

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514141490315460608/

Supreme Court, 1992 (O) No. 1491 — Earth belt

Original Ameblo publication: 2025-08-19

Article type: Case note

Category: Patents

Topics: Damages

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924007350.html

HP: https://www.takaishihideki.com/en/single-post/supreme-court-heisei-4-o-no-1491-earth-belt

Japanese version: https://www.takaishihideki.com/single-post/最判平成4-オ-1491【アースベルト事件】

Supreme Court, 1992 (O) No. 1491 — Earth belt

Where a party acquired well-known status for its product indication through a series of acts contrary to accepted principles of morality, including placing “PAT,” which could be confused with a patent marking, on products and displaying the same letters in advertisements—acts falling under Articles 188 and 198 of the Patent Act and Article 1(1)(v) of the then-applicable Unfair Competition Prevention Act—it cannot claim damages or publication of an apology under the Unfair Competition Prevention Act against a person using a similar product indication.

The Supreme Court affirmed the judgment below (Sendai High Court, February 12, 1992), which so held.

https://lnkd.in/gFps_QTp

Original article (2025-08-19):

https://lnkd.in/g7ijKRY6

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514141694406135808/

IP High Court, 2022 (Ne) No. 10070 — Image display method (Judge Kanno)

Original Ameblo publication: 2025-08-20

Article type: Case note

Category: Patents

Topics: Inventive step, Motivation and teaching away

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924117876.html

HP: https://www.takaishihideki.com/en/single-post/reiwa-4-ne-no-10070-image-display-method-judge-kanno

Japanese version: https://www.takaishihideki.com/single-post/令和４年-ネ-10070【画像表示方法】-菅野

IP High Court, 2022 (Ne) No. 10070 — Image display method (Judge Kanno)

*The court found the invention readily conceivable on the basis of its “advantages”!

→ Inventive step denied.

(Excerpt from the judgment, translated)

[...] Adopting a Web browser in place of a Web client and implementing dynamic-display processing in JavaScript is recognized as readily conceivable by a person skilled in the art in view of its advantages. If JavaScript is written directly in HTML, the Web browser cannot execute that JavaScript before receiving the HTML. Accordingly, it is sufficient—and necessary—to perform the step of identifying the map using JavaScript written directly in the HTML after receiving the HTML. Changes of the order of the steps relating to transmission and reception of HTML and identification of map data, deletion of unnecessary steps and addition of necessary steps, to the extent ordinarily required to deal with such inevitable consequences, are merely within the scope of ordinary creativity of a person skilled in the art. The need for such modifications does not constitute an impediment to making those modifications. [...]

https://lnkd.in/gbgUiGtX

Original article (2025-08-20):

https://lnkd.in/gy22saqM

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514142467533942784/

IP High Court, 2024 (Gyo-Ke) No. 10050 — Information processing apparatus (Judge Miyasaka)

Original Ameblo publication: 2025-08-21

Article type: Case note

Category: Patents

Topics: Eligibility as an invention

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924420776.html

HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-no-10050-information-processing-apparatus-judge-miyasaka

Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10050【情報処理装置】事件-宮坂

IP High Court, 2024 (Gyo-Ke) No. 10050 — Information processing apparatus (Judge Miyasaka)

*The computations performed by each processing unit contribute to solving the invention’s problem.

→ Qualifies as an “invention.”

(Excerpt from the judgment, translated)

“The patented invention [...] is understood to be implemented by loading a computer program into a computer and operating the computer in accordance with that program. The fund-related computation and optimization performed by each unit are specifically identified. The combination of those units specifically indicates the method, sequence and other aspects of operation of an information processing apparatus for determining the contents of fund products. This serves as the means of solving the patented invention’s problem [...] of providing investors with fund products whose investment targets offer favorable investment returns, supply-demand balance and trading-price stability, and which can realize the profits and losses desired by investors. It can therefore be recognized as an ‘invention.’”

https://lnkd.in/gyRd-RgJ

Original article (2025-08-21):

https://lnkd.in/gpRnhHHr

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514142639626194944/

IP High Court, 2024 (Gyo-Ke) No. 10049 — Vehicle (Judge Nakadaira)

Original Ameblo publication: 2025-08-22
Article type: Case note
Category: Patents
Topics: Inventive step, Motivation and teaching away, Examination and appeal practice
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924573237.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-no-10049-information-processing-apparatus-judge-miyasaka
Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10049【情報処理装置】-宮坂

IP High Court, 2024 (Gyo-Ke) No. 10049 — Vehicle (Judge Nakadaira)

*The trial decision did not state the reasons for its obviousness determination.

→ The JPO decision was set aside because its obviousness determination was erroneous.

(Summary of the court's reasoning, translated)

<Whether it was readily conceivable to make the vehicle of the cited invention a vehicle configured to turn in a leaning posture>

…Even assuming that "vehicles configured to turn in a leaning posture and their energy storage devices are generally small," a small energy storage device (battery), even if it has a small total amount of electrical energy available for supply, does not necessarily supply low electrical power at a particular point in time. The cited document shows that the cited invention addresses the problem of the small amount of power that a battery can supply when its temperature is low. However, the evidence is insufficient to establish that vehicles configured to turn in a leaning posture generally face the problem of low power available from their energy storage devices (batteries). Accordingly, the problem addressed by the cited invention cannot be said to be common to the problems generally faced by such vehicles, and no motivation for a person skilled in the art to make the vehicle of the cited invention a "vehicle configured to turn in a leaning posture" can be found on the basis of a common problem.…

<Whether it was readily conceivable to make the vehicle of the cited invention a drone>

…The drone of the amended invention is an aircraft with rotary wings and flies through the atmosphere by rotating those wings. By contrast, the vehicle of the cited invention travels by transmitting power to the road surface through its drive wheels; it is therefore a vehicle with wheels that travels over land by rotating them. Thus, the vehicle of the cited invention, which travels over land by rotating its wheels, and the drone of the amended invention, which flies through the atmosphere by rotating its rotary wings, differ fundamentally in their structure and mode of movement.

https://lnkd.in/gbgaW8cB

Original article (2025-08-22):

https://lnkd.in/gGR5yMiE

Originally posted on LinkedIn:

https://www.linkedin.com/feed/update/urn:li:activity:7514142804613459969/

IP High Court, 2013 (Gyo-Ke) No. 10266 — Transparent film (Judge Ishii)

Original Ameblo publication: 2025-08-23
Article type: Case note
Category: Patents
Topics: Inventive step, Patent corrections, Added matter
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924742751.html
HP: https://www.takaishihideki.com/en/single-post/heisei-25-gyo-ke-no-10266-transparent-film-judge-ishii
Japanese version: https://www.takaishihideki.com/single-post/平成 25 年-行ケ-10266【透明フィルム】-石井

IP High Court, 2013 (Gyo-Ke) No. 10266 — Transparent film (Judge Ishii)

*In this case, the correction introducing a disclaimer was held not to introduce new technical matter because it limited the types of metal oxides without changing the technical content of “metal oxides” used as acid acceptors.

→ Correction requirements satisfied, but inventive step denied after correction.

(Excerpts from the judgment, translated; portions omitted)

[...] The metal oxides used as acid acceptors in Invention 1 include any type possessing that function. The correction excludes certain specifically listed metal oxides from those having that property. There is no circumstance changing the technical content of “metal oxides” used as acid-acceptor particles before and after correction, such as a particular acid-accepting property possessed only by the excluded oxides or only by the remaining oxides. The correction therefore limits the types of metal oxides recited in the claims compared with before correction and does not introduce new technical matter. [...]

Since a solar-cell encapsulating film is a member in contact with equipment suggested in Ko 1, a person skilled in the art reading Ko 1 could readily have conceived of making the film of Invention Ko 1 crosslinked and transparent and using it as a solar-cell encapsulating film. [...] The invention could readily have been conceived by a person skilled in the art based on Invention Ko 1 and well-known technology.

https://lnkd.in/g4ftHvzX

Original article (2025-08-23):

https://lnkd.in/ga5dE_8N

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514142980996427776/

IP High Court, 2021 (Gyo-Ke) No. 10116 — Game program (Judge Honda)

Original Ameblo publication: 2025-08-24

Article type: Case note

Category: Patents

Topics: Inventive step, Technical fields, Well-known art

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12924832106.html

HP: https://www.takaishihideki.com/en/single-post/reiwa-3-gyo-ke-no-10116-game-program-judge-honda

Japanese version: https://www.takaishihideki.com/single-post/令和３年-行ケ-10116【ゲームプログラム】-本多

IP High Court, 2021 (Gyo-Ke) No. 10116 — Game program (Judge Honda)

*The court recognized identity of technical fields at a broader conceptual level.

(Excerpt from the judgment, translated)

The plaintiff argues that a person skilled in the gaming field would not apply the matters described in Ko 2 and Otsu 3 and 4, whose technical fields are unrelated, to the cited invention. However, [...] the well-known matters and commercial practices are widely recognized in the product-sales industry (Ko 2) and the marketing industry (Otsu 3 and 4). They do not concern particular technical features or similar matters that should be applied only within a specific technical field, such as gaming, narrower than those industries, as the plaintiff argues.

https://lnkd.in/gYgYmF2P

Original article (2025-08-24):

https://lnkd.in/giCqQBG7

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514143127356710912/

Osaka High Court, 2011 (Ne) No. 2651 — Unfair Competition Prevention Act

Original Ameblo publication: 2025-08-25

Article type: Case note

Category: Unfair competition law

Topics: Litigation procedure

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12925133538.html

HP: https://www.takaishihideki.com/en/single-post/osaka-high-court-heisei-23-ne-no-2651-unfair-competition-prevention-act

Japanese version: https://www.takaishihideki.com/single-post/大阪高判平成23年-ネ-2651-不正競争防止法

Osaka High Court, 2011 (Ne) No. 2651 — Unfair Competition Prevention Act

*An image displayed by the Wayback Machine can change when the linked content changes. (This concern does not apply to content other than links.)

(Excerpt from the judgment, translated)

Internet Archive is a US-based organization whose purposes include supporting the preservation of electronic materials and building an Internet library for researchers and historians. It operates a web-archiving service called the Wayback Machine, which collects and archives web pages and is said to enable viewing information as it existed when collected. [...]

For images in the Wayback Machine’s archive, in some cases only the image URL is preserved, while in others both the URL and the image itself are preserved. In the former case, the image URL links to data outside the archive, and that external data is displayed in the archive. Accordingly, even after archiving, changes to the linked external data will also change the image displayed in the archive.

https://lnkd.in/geM59vxH

Original article (2025-08-25):

https://lnkd.in/gGsJpyzk

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514143729734148096/

Osaka High Court, 1999 (Ne) No. 18 — Method of attaching a filter to an exhaust outlet

Original Ameblo publication: 2025-08-26

Article type: Case note

Category: Patents

Topics: Indirect infringement

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12925359455.html

HP: https://www.takaishihideki.com/en/single-post/osaka-high-court-heisei-11-ne-no-18-method-of-attaching-a-filter-to-an-exhaust-outlet

Japanese version: https://www.takaishihideki.com/single-post/大阪高判平成 11 年-ネ-18【排気口へのフィルター取付け方法】

Osaka High Court, 1999 (Ne) No. 18 — Method of attaching a filter to an exhaust outlet

*For a product sold as a set, the “exclusively” requirement is assessed for the set as a whole.

(Excerpt from the judgment, translated)

Product 1 is sold as an integrated set comprising a range-hood filter and a magnet-containing case with a protrusion, together with installation instructions. Purchasers of such sets buy them to use the components together, rather than to use each component separately.

Accordingly, in examining whether a set is an article “used exclusively for working” the invention—whether it has other uses—the economic, commercial and practical possibilities of using the set as a whole should be considered. Even if the filter and the magnet-containing case with a protrusion can each be used independently, no use of the entire set other than working Invention ① can be contemplated. Product 1 is therefore an article used exclusively for working Invention ①.

https://lnkd.in/gRuaGK2m

Original article (2025-08-26):

https://lnkd.in/gWfp9a6x

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514143962002112512/

Tokyo District Court, 2004 (Wa) No. 10431 — Design infringement litigation

Original Ameblo publication: 2025-08-27

Article type: Case note

Category: Designs

Topics: Litigation procedure

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12925645984.html

HP: https://www.takaishihideki.com/en/single-post/heisei-16-wa-no-10431-design-infringement-litigation

Japanese version: https://www.takaishihideki.com/single-post/平成 16 年-ワ-10431-意匠権侵害訴訟

Tokyo District Court, 2004 (Wa) No. 10431 — Design infringement litigation

*The court recognized the reliability of the contents and dates shown by the Wayback Machine records submitted as evidence in this case.

(Excerpt from the judgment, translated)

The US nonprofit Internet Archive began collecting the worldwide Web in 1996 and made its archive publicly available through the Wayback Machine in 2001, by which time it comprised a vast collection of 100 terabytes and more than 16 million sites. WIPO's guidelines governing international searches and international preliminary examination under the PCT identify the archive as one means of determining the publication date of information published on a website. Moreover, [...] the defendant's website as of December 9, 2003, added "Design registration applied for" to photographs of Defendant's Products 1 and 2, whereas the website as of February 27, 2003, did not. This is consistent with the application history of the design right, for which the application was filed on May 22, 2003. These facts establish that the collected contents and dates indicated by the archive are sufficiently reliable.

https://lnkd.in/gBAuqduq

Original article (2025-08-27):

https://lnkd.in/ge84YQsF

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514144117853995008/

Intellectual Property High Court (Grand Panel), 2023 (Ne) No. 10040 — Composition for promoting an increase in subcutaneous adipose tissue (Judge Honda)

Original Ameblo publication: 2025-08-28

Article type: Case note

Category: Patents

Topics: Claim interpretation

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12925792805.html

HP: https://www.takaishihideki.com/en/single-post/intellectual-property-high-court-grand-panel-reiwa-5-ne-no-10040-composition-for-promoting-a

Japanese version: https://www.takaishihideki.com/single-post/知財高判-大合議-令和５年-ネ-10040【皮下脂肪組織増加促進用組成物】-本多

Intellectual Property High Court (Grand Panel), 2023 (Ne) No. 10040 — Composition for promoting an increase in subcutaneous adipose tissue (Judge Honda)

*Where consideration is received, the act generally does not constitute experimentation or research under Article 69(1) of the Patent Act.

Unlike the judgment below, the court found that the appellee had prepared and administered a formulation containing components ①, ② and ③ simultaneously.

→ Claim satisfied; the patentee won on appeal.

*The issue that had attracted attention—whether separate administration of components ① and ②, and component ③, would satisfy the claim—thus disappeared.

The patented “composition for breast augmentation” is used for breast augmentation, whose purpose is primarily aesthetic.

→ Under current social conventions, it is not a substance used for the diagnosis, therapy, treatment or prevention of human disease.

→ It does not fall within an invention of a medicine to be manufactured by mixing two or more medicines (substances used for the diagnosis, therapy, treatment or prevention of human disease) under Article 69(3).

(Excerpts from the judgment, translated; portions omitted)

The purpose of Article 69(1) of the Act is understood to be to balance the interests of patentees and the general public from the standpoint of industrial policy: working a patented invention for experimentation or research ordinarily does not harm the patentee’s economic interests, whereas extending the effects of a patent right to such experiments would instead hinder technological progress and impair industrial development.

Here, a patentee has the exclusive right to work the patented invention in the course of business (the main text of Article 68 of the Act). Working a patented invention in exchange for consideration harms the patentee’s economic interests. In light of the purpose of Article 69(1)—to balance the interests of patentees and the general public—such conduct should therefore be understood not to constitute “working a patented invention for experimental or research purposes,” even if a research purpose coexists, unless special circumstances exist.

Applying this to the present case, …the appellee…is found to have provided the surgery at issue in exchange for payments from customers and to have manufactured (produced), for use in that surgery, a composition falling within the technical scope of the patented invention.… Although discounts were often applied to the amounts the appellee received from customers as payment for the surgery, the amounts of those discounts were not uniform. There were cases with no discount even during the monitoring period asserted by the appellee…and cases with substantial discounts even after that period. At least, it cannot be said that, because the surgery was performed during the monitoring period, it was provided for an amount so low that it did not in substance constitute consideration. Accordingly, the special circumstances referred to above cannot be found, and the appellee's working of the invention should not be regarded as "working a patented invention for experimental or research purposes."

https://lnkd.in/gyZnAYGx

Original article (2025-08-28):

https://lnkd.in/gjNvHnG3

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514144287769587712/

[New YouTube video] Inventive step — expanded version

Original Ameblo publication: 2025-08-31

Article type: Lectures and videos

Category: Patents

Topics: Inventive step

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12926534264.html

HP: https://www.takaishihideki.com/en/single-post/new-youtube-video-inventive-step-expanded-version

Japanese version: https://www.takaishihideki.com/single-post/【新着 youtube 動画】進歩性（拡張版）

[New YouTube video] Inventive step — expanded version

This video introduces recent decisions concerning inventive step added to the fourth edition of the Encyclopedia of Patent Court Decisions.

It is an edited recording of my lecture at Chizai LAB on July 30, 2025.

As with other topics, I discuss the issues in greater depth in live sessions.

https://lnkd.in/gcWChG85

Original article (2025-08-31):

https://lnkd.in/gJU7aCGi

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514144538727227392/

IP High Court, 2013 (Ne) No. 10007 — Stirring and granulating apparatus (Judge Shitara)

Original Ameblo publication: 2025-08-31

Article type: Case note

Category: Patents

Topics: Indirect infringement, Claim interpretation

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12926534612.html

HP: https://www.takaishihideki.com/en/single-post/heisei-25-ne-no-10007-stirring-and-granulating-apparatus-judge-shitara

Japanese version: https://www.takaishihideki.com/single-post/平成 25 年-ネ-10007【攪拌造粒装置】-設樂

IP High Court, 2013 (Ne) No. 10007 — Stirring and granulating apparatus (Judge Shitara)

*Two products delivered on the same day were found to have been sold as an integrated unit.

→ Direct infringement established!

(Appellant's contentions reproduced in the judgment, translated; portions omitted—not the court's findings)

The appellee's products…sold to Freund and displayed at the exhibition either had stirring blades satisfying Element D of the patented invention (such blades are referred to below as "GM blades") installed from the outset or were intended to have them installed, and were sold as integrated units with…GM blades (the HSM blades in the attached list were the former product name for GM blades) and…GM blades, respectively. Even if…the products could not be regarded as having been sold as integrated units with the respective GM blades, and…sales of those products did not infringe the patent right, …the GM blades are used exclusively in stirring granulators manufactured by the appellee, so their transfer constitutes indirect infringement of the patent right (Patent Act, Article 101(i)).

Court's own findings (translation of Section IV, "The Court's Findings"):

The Court determines that the appellee's products satisfy all the limitations of the patented invention and therefore fall within its technical scope, and that the patent should not be invalidated in a patent invalidation trial. Accordingly, the appellant's claim for damages for infringement of the patent right is well founded to the extent stated in the main text of the judgment. However, the appellant's remaining claims based on violation of the Unfair Competition Prevention Act, copyright infringement, and breach of the basic agreement are all without merit. The reasons are set out below.

https://lnkd.in/gstgffPg

Original article (2025-08-31):

https://lnkd.in/gxWX-jeU

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7514144712438603776/

Tokyo District Court, 2020 (Wa) No. 4331 — Heated aerosol-generating device (Judge Nakashima)

Original Ameblo publication: 2025-09-01
Article type: Case note
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12926708559.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7513747031136448512-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513746680962289664-ja

Tokyo District Court, 2020 (Wa) No. 4331 — Heated aerosol-generating device (Judge Nakashima)

*Embodiments that cannot solve the problem are not included within the scope of the claims.

→ Support requirement satisfied.

(Excerpt from the judgment, translated)

…Even for other durations, it can be understood that the problems addressed by the claimed inventions can be solved by appropriately setting the other conditions, taking into account the common general technical knowledge at the filing date. The defendants point out that the inventions also encompass a first temperature of 360°C, a second temperature of 359°C and a third temperature of 360°C, or a heating duration of one second at each stage. However, a person skilled in the art would readily understand that conditions such as the first to third temperatures and the duration of heating at each stage should be appropriately set “so that aerosol is delivered more evenly during heating of the substrate” (…).

It cannot be said that a person skilled in the art, assuming numerical values such as those asserted by the defendants, would recognize that the claims include embodiments incapable of solving the problems addressed by the inventions.

https://lnkd.in/gRJR-VUy

Original article (2025-09-01):

https://lnkd.in/gVMrbM9n

Identical repost (2025-09-04):

https://lnkd.in/gkVT3dpy

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513747031136448512/

IP High Court, 2023 (Gyo-Ke) No. 10098 — Laundry detergent composition (Judge Shoji)

Original Ameblo publication: 2025-09-02

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12926905349.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513747245503037441-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513747137831104514-ja

IP High Court, 2023 (Gyo-Ke) No. 10098 — Laundry detergent composition (Judge Shoji)

*Even an effect rated “3” constitutes a certain degree of effect.

→ Support requirement satisfied.

(Excerpt from the judgment, translated)

Even if the odor-prevention effect of an embodiment corresponding to an example was rated “3: a somewhat strong unpleasant odor is perceived,” the results of the odor-prevention-effect evaluation establish that a certain odor-prevention effect was obtained. …Accordingly, although the effects of the claimed inventions cannot be described as unpredictable and remarkable…, as regards compliance with the support requirement, in light of the detailed description in the specification, Invention 1 falls within a scope in which a person skilled in the art can sufficiently recognize that…the problem can be solved….

https://lnkd.in/gky2nw3u

Original article (2025-09-02):

https://lnkd.in/gmw6nn2v

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513747245503037441/

IP High Court, 2019 (Gyo-Ke) No. 10103 — Support structure for a concrete foundation (Judge Mori)

Original Ameblo publication: 2025-09-03

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12927251556.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513747706968895488-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513747399119626240-ja

IP High Court, 2019 (Gyo-Ke) No. 10103 — Support structure for a concrete foundation (Judge Mori)

*The court defined the problem at a less demanding level.

→ Support requirement satisfied.

(Excerpt from the judgment, translated)

The plaintiff argues that the problem addressed by the invention is “to prevent damage to the pile head even when excessive bearing pressure acts on it”…. However,…whether the invention achieves the effect of preventing damage to the pile head is assessed by comparing the use of pile-head concrete with a design strength higher than that of the foundation concrete against cases without such concrete, when the design strength is set after considering various factors for a particular construction project. The effect is that damage to the pile head becomes less likely than when the claimed configuration is not adopted. The plaintiff’s argument is therefore unfounded.

https://lnkd.in/g6qP2AmB

Original article (2025-09-03):

https://lnkd.in/gRYaesAB

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513747706968895488/

[United States] Incyte v. Sun Pharm (Federal Circuit, May 2025)

Original Ameblo publication: 2025-09-05

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12927732477.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513748084523266048-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513747861986177024-ja

[United States] Incyte v. Sun Pharm (Federal Circuit, May 2025)

A preliminary injunction requires a likelihood of success on the merits, a likelihood of irreparable harm, a favorable balance of equities, and consistency with the public interest; irreparable harm alone is not sufficient.

Even economic harm may qualify if it cannot readily be compensated as quantifiable monetary damages.

→ In this case, Incyte's product remained at an early stage of development and could not be launched before patent expiry, so Sun's head start was inevitable. There was no non-speculative evidence of irreparable harm, and the preliminary injunction was reversed.

https://lnkd.in/gDYFKXgw

Original article (2025-09-05):

https://lnkd.in/gtzaRDCZ

https://note.com/tskomatani/n/n01fbb5e4acec

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513748084523266048/

IP High Court, 2019 (Gyo-Ke) No. 10055 — Mechanical fastener (Judge Otaka)

Original Ameblo publication: 2025-09-05
Article type: Case note
Category: Patents
Topics: Inventive step, Numerical limitations and parameters
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12927733987.html
HP: https://www.takaishihideki.com/en/single-post/heisei-31-gyo-ke-no-10055-mechanical-fastener-judge-otaka
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513748208679018496-ja

IP High Court, 2019 (Gyo-Ke) No. 10055 — Mechanical fastener (Judge Otaka)

*The ordinarily expected basis-weight range calculated on the basis of the cited reference and other relevant material was approximately 19.9 to 42.7 g/m², overlapping the amended invention's range of 25 to 75 g/m².

→ Taking into account the motivation to make the sheet thinner and other circumstances, the court held it obvious to select a value within the amended invention's numerical range.

(Excerpt from the judgment, translated)

A person skilled in the art reading the cited reference would, if selecting smaller values within the respective preferred ranges for the thickness of base sheet 2 and the height of male engagement portions 3 based on the motivation to reduce the thickness of male-side sheet material 1, naturally also consider selecting smaller values within the preferred numerical ranges disclosed in the cited reference for dimensions other than the height of male engagement portions 3, the number of male engagement portions 3 per unit area, and similar parameters. There would therefore be no particular difficulty in appropriately selecting any basis weight for male-side sheet material 1 within the range of approximately 19.9–42.7 g/m². Accordingly, a person skilled in the art would readily arrive at setting the basis weight of male-side sheet material 1 in the cited invention to a value within the range of the amended invention relating to Difference 3 ("25 grams per square meter to 75 grams per square meter")….

https://lnkd.in/gWbHNC86

Original article (2025-09-05):

https://lnkd.in/gJs8Xv52

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513748486371049472/

[Unfair competition / Misleading representations of quality] IP High Court, 2023 (Ne) No. 10061 — “High-penetration nanoe” (Judge Nakadaira)

Original Ameblo publication: 2025-09-08

Article type: Case note

Category: Unfair competition law

Topics: Misleading quality indication, Litigation procedure, Damages, Injunctions

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12928568577.html

HP: https://www.takaishihideki.com/en/single-post/unfair-competition-misleading-representations-of-quality-reiwa-5-ne-no-10061-high-penetrat

Japanese version: https://www.takaishihideki.com/single-post/【不競法-品質誤認表示】令和５年-ネ-10061「高浸透ナノイー」事件-中平

[Unfair competition / Misleading representations of quality] IP High Court, 2023 (Ne) No. 10061 — “High-penetration nanoe” (Judge Nakadaira)

*The party bringing the action bears the burden of pleading and proving that a representation is misleading as to quality.

→ A representation based on a reasonable scientific foundation is not misleading as to quality merely because it is not strictly accurate.

(Excerpt from the court-published case summary, translated)

When a party brings an action for damages or an injunction under the Unfair Competition Prevention Act, alleging that another party’s representations constitute misleading representations of quality under Article 2(1)(xx), the burden of pleading and proving this rests with the party bringing the action (the first-instance plaintiff). However, if a representation leads consumers to believe that it is based on specific tests or similar evidence, the absence of supporting materials means that it should be regarded as misleading as to quality. Accordingly, if the party making the representation (the first-instance defendant) does not submit supporting materials, there may be grounds for finding that the first-instance plaintiff has successfully pleaded and proved its allegation. In this case, Y submitted experimental reports and other materials, and X submitted results of verification tests conducted at the time of filing the action and at the appeal stage. Whether Y’s representations are misleading as to quality will therefore be examined in light of these materials.

Y’s representations appeared on its website and in catalogs to describe the benefits of using the appellee’s products and encourage purchases by ordinary consumers. These benefits arise from functions invisible to users. There is no uniquely prescribed method for measuring their degree, which may also vary substantially with conditions such as the environment, manner of use and individual differences. The representations also include a notice that results vary by individual. Ordinary consumers viewing such representations would understand the specific numerical values and experimental results as indicating the degree of benefit and the existence of supporting scientific evidence, and would not be especially concerned with whether they are strictly accurate. Given the content and nature of Y’s representations, a lack of strict accuracy does not immediately make them misleading as to quality. If they are found to rest on a reasonable scientific foundation, they cannot be regarded as misleading representations of quality.

https://lnkd.in/g9jbJ3ve

Original article (2025-09-08):

https://lnkd.in/gGgaC86m

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513748756098465792/

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10061 — “CONART” (Judge Honda)

Original Ameblo publication: 2025-09-08
Article type: Case note
Category: Trademarks
Topics: Examination and appeal practice, Contracts
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12928568723.html
HP: https://www.takaishihideki.com/en/single-post/trademarks-reiwa-6-gyo-ke-no-10061-conart-judge-honda
Japanese version: https://www.takaishihideki.com/single-post/【商標】令和６年-行ケ-10061「conart」事件-本多

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10061 — “CONART” (Judge Honda)

*Take care with jointly owned trademarks!

The trademarks were jointly owned by the plaintiff, Raffles Properties Incorporated, and Raffles Co., Ltd. in Japan.

The JPO decision found that only Japan Raffles had entered into the license agreement with the non-exclusive licensee, and that the co-owner’s consent had not been established.

The court found that the plaintiff had entrusted management of the trademark rights to Raffles Co., Ltd. in Japan and had consented to the grant of a non-exclusive license to A-style. It found not only that the CONART logo used was identical, in terms of generally accepted social norms, to Trademark C, but also that the “CONART LOGO” indication in the brochure was identical in that sense to Trademarks A and B. The court therefore set aside all three JPO decisions canceling Trademarks A, B and C for non-use.

(Summary of the judgment, translated)

Although the plaintiff was not a party to the license agreement between Raffles and A-style, the agreement expressly stated that the plaintiff had entrusted management of its Japanese trademark rights to Raffles and that Raffles was contracting pursuant to that entrustment. In addition, statements by the plaintiff’s representative and other materials indicate that the agreements had been concluded solely by Raffles’ representative with the plaintiff’s consent, and nothing in their contents is particularly implausible. Furthermore, 50% of the amounts recognized as royalties under the license agreement were recorded as accounts payable in the financial statements and remitted overseas to the plaintiff.

(Excerpt from the judgment, translated)

These circumstances establish that the plaintiff authorized the grant of the license when Raffles entered into the agreement with A-style. It can readily be found that Raffles granted A-style a non-exclusive trademark license with the consent of the plaintiff, the co-owner of the trademark rights (Trademark Act Article 35; Patent Act Article 73(3)).

https://lnkd.in/gXSnEQtr

Figures: see the original article.

Original article (2025-09-08):

https://lnkd.in/gF-r6CnU

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513749020268490753/

Images from the original AMEBLO article
English translations of the original image text

English key to the original trademark image

Top left:
Trademark A at issue

The Japanese phonetic text
in Trademark A reads “Konāto.”

Top right:
Trademark B at issue

Bottom left:
Trademark C at issue

Bottom right:
Mark used (CONART logo)

Original images retained for comparison



【本件商標 A】



【本件商標 B】



【本件商標 C】



【使用標章（コナート・ロゴ）】

Original AMEBLO article
https://ameblo.jp/hideki-takaishi/entry-12928568723.html

[Trademarks / Similarity] IP High Court, 2024 (Gyo-Ke) No. 10091 — “Connect One” (Judge Hibiku Shimizu)

Original Ameblo publication: 2025-09-09

Article type: Case note

Category: Trademarks

Topics: Similarity of trademarks

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12928814900.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-similarity-reiwa-6-gyo-ke-no-10091-connect-one-judge-shimizu

Japanese version: https://www.takaishihideki.com/single-post/【商標-類比】令和６年-行ケ-10091「コネクトワン」事件-清水響

[Trademarks / Similarity] IP High Court, 2024 (Gyo-Ke) No. 10091 — “Connect One” (Judge Hibiku Shimizu)

The applied-for mark was held similar to the cited “コネクトワン” (Connect One) mark in standard characters.

The applicant argued that its mark was pronounced “Connect Dot One.” However, where two or more pronunciations arise from a single mark, similarity is not negated if one pronunciation is identical to that of the other mark. (Supreme Court, 1962 (O) No. 953)

https://lnkd.in/gKu96BJJ

Figures: see the original article.

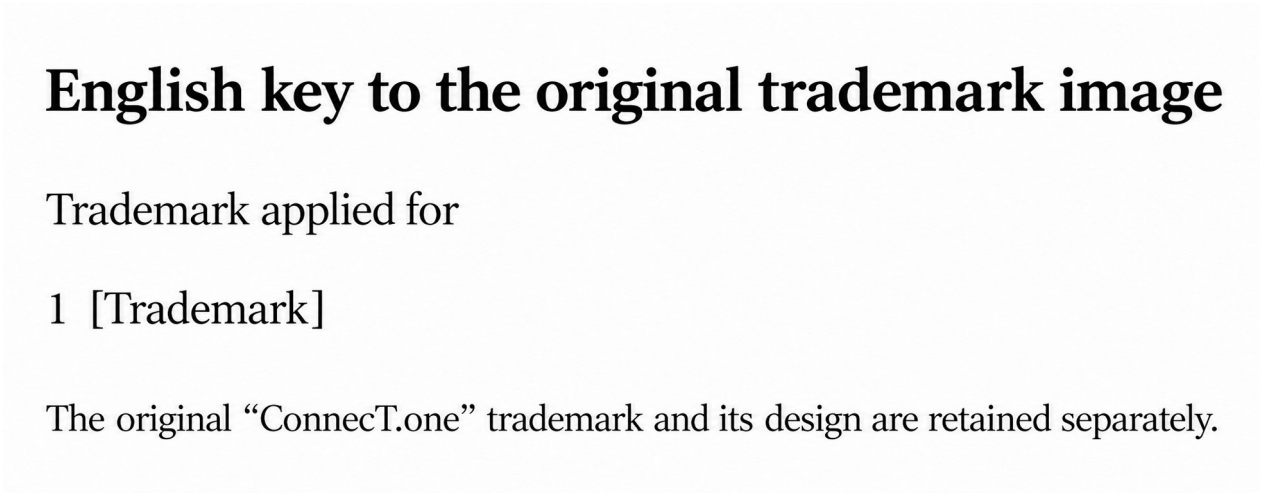
Original article (2025-09-09):

https://lnkd.in/gXVa59iW

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513749289588756480/

Images from the original AMEBLO article

English translations of the original image text



Original images retained for comparison

本　願　商　標

1 【商標】



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12928814900.html

[Trademarks / JPO decision] Opposition No. 2023-900278

Original Ameblo publication: 2025-09-10

Article type: Administrative decision note

Category: Trademarks

Topics: Similarity of trademarks, Examination and appeal practice

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12928976505.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-jpo-decision-opposition-no-2023-900278

Japanese version: https://www.takaishihideki.com/single-post/【商標（審決）】異議 2023-900278

[Trademarks / JPO decision] Opposition No. 2023-900278

Although “UNIQLO” is well known, it is dissimilar to “UNIPRO,” and there is no likelihood of confusion in the broader sense (a mistaken belief that the goods originate from an undertaking economically or organizationally connected with the UNIQLO business).

“There is no risk of confusion in appearance or pronunciation, and no comparison can be made in concept.”

→ Dissimilar.

https://lnkd.in/g4Kw2P3x

Figures: see the original article.

Original article (2025-09-10):

https://lnkd.in/gc7MpP_5

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513749477279854592/

Images from the original AMEBLO article

English translations of the original image text

English translation of the original comparison

Registered trademark at issue

Trademark Registration No. 6746724

UNI PRO (illustrated mark)

Designated goods: Class 28 — Toys for pets; sporting articles.

Cited trademarks

1. Trademark Registration No. 5548834

   UNI QLO (illustrated mark)

   Designated goods include Class 28 “toys for pets; sporting articles.”

2. Trademark Registration No. 5283441

   UNIQLO (standard characters)

   Designated goods include Class 28 “sporting articles; toys for pets.”

Original images retained for comparison

本件登録商標	引用商標
登録第 6746724 号商標  （指定商品：28 類　ペット用おもちゃ，運動用具）	1．登録第 5548834 号商標 （指定商品に：第 28 類「愛玩動物用おもちゃ，運動用具」を含む） 2．登録第 5283441 号商標「UNIQLO(標準文字)」 （指定商品に第 28 類「運動用具，愛玩動物用おもちゃ」を含む。）

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12928976505.html

Tokyo District Court, 2023 (Wa) No. 70114 — Motorcycle brake control device (Judge Shibata)

Original Ameblo publication: 2025-09-11
Article type: Case note
Category: Patents
Topics: Support requirement
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12929322305.html
HP: https://www.takaishihideki.com/en/single-post/tokyo-district-court-reiwa-5-wa-no-70114-motorcycle-brake-control-device-judge-shibata
Japanese version: https://www.takaishihideki.com/single-post/東京地判令和５年-ワ-70114【自動二輪車のブレーキ制御装置】-柴田

Tokyo District Court, 2023 (Wa) No. 70114 — Motorcycle brake control device (Judge Shibata)

*An error in the detailed description of the invention.

The argument that it was an obvious clerical error was rejected.

→ Support requirement not satisfied.

(Excerpt from the judgment, translated)

A person skilled in the art would recognize that there is some error because the terms in Formula A have different dimensions. However, the plaintiff's proposed correction is not the only way to resolve that dimensional inconsistency, and there is insufficient evidence that, from Formula A and other information, a skilled person would understand that changing it to Formula A′ is the only solution. Moreover, successively correcting the specification's passages concerning Formula A to make them consistent with that correction would render previously unproblematic passages unintelligible or inconsistent. In these circumstances, the specification does not establish that Formula A can be understood as a clerical error for Formula A′. The plaintiff's argument, premised on that understanding, therefore lacks its premise. …None of the claimed inventions can be regarded as an invention described in the specification, and all are found to fail the support requirement.

https://lnkd.in/guU5pMaS

Original article (2025-09-11):

https://lnkd.in/gS3TpH_F

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513749817760772096/

IP High Court, 2021 (Gyo-Ke) No. 10094 — PCSK9 (second litigation) (Judge Kanno)

Original Ameblo publication: 2025-09-12
Article type: Case note
Category: Patents
Topics: Support requirement
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12929609789.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-3-gyo-ke-no-10094-pcsk9-second-litigation-judge-kanno
Japanese version: https://www.takaishihideki.com/single-post/令和３年-行ケ-10094-菅野-【pcsk9（二次訴訟）】

IP High Court, 2021 (Gyo-Ke) No. 10094 — PCSK9 (second litigation) (Judge Kanno)

*It was successfully proved that the technical significance asserted by the patentee did not hold!

→ Support requirement not satisfied.

(Excerpt from the judgment, translated)

…The technical significance of the invention lies in identifying that an antibody competing with antibody 31H4 has the functional properties of an antibody that neutralizes binding between PCSK9 and the LDLR protein through the same mechanism as antibody 31H4…. In the absence of any particular explanation of a mechanism supporting the proposition that all such antibodies exhibit functional properties similar to antibody 31H4, it cannot be said that an “antibody that competes with antibody 31H4 for binding to PCSK9” in the claimed invention “exhibits similar functional properties” to antibody 31H4….

A person skilled in the art would have difficulty understanding that an antibody competing with antibody 31H4 is necessarily a binding-neutralizing antibody.

…Dr. B expressed the opinion that “it is certainly incorrect to say that all antibodies…competing with antibody 31H4 would neutralize binding.” …For these reasons, neither Invention 1 nor Invention 5 satisfies the support requirement…

https://lnkd.in/gXa4cdJj

Original article (2025-09-12):

https://lnkd.in/gaPYnprA

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513750058597511169/

IP High Court, 2005 (Gyo-Ke) No. 10645 — Method for inspecting sealed packages (Judge Tsukahara)

Original Ameblo publication: 2025-09-13
Article type: Case note
Category: Patents
Topics: Clarity, Enablement, Examination and appeal practice
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12929865873.html
HP: https://www.takaishihideki.com/en/single-post/heisei-17-gyo-ke-no-10645-method-for-inspecting-sealed-packages-judge-tsukahara
Japanese version: https://www.takaishihideki.com/single-post/平成 17 年-行ケ-10645【密封包装物の検査方法】-塚原

IP High Court, 2005 (Gyo-Ke) No. 10645 — Method for inspecting sealed packages (Judge Tsukahara)
*The mechanism described in the claims and specification contradicts the laws of physics.
→ Clarity and enablement requirements not satisfied.
(JPO decision's reasoning quoted in the judgment, followed below by the court's own findings; translated)
The JPO decision's findings on violations of Patent Act Article 36(4) and (6)…
Paragraph [0008] states: "Thus, when electrode 4 from the voltage output terminal of high-voltage power supply 6 is brought into contact with or proximity to side portion 31 of sealed package 3, electrically conductive contents 1 within sealed package 3 become charged by the negative or positive potential of the high voltage (0.6 kV–30 kV) applied to electrode 4, generating negative (−) ions or positive (+) ions." Figure 1 depicts only negative (−) ions as having been generated throughout the contents, but it is unclear how these "negative (−) ions or positive (+) ions" have been generated, and a person skilled in the art cannot readily carry this out. Specifically, if there is no closed circuit and no displacement current flows, or if charge does not travel through side portion 31 of sealed package 3, it is unclear where the charge for generating the negative (−) ions or positive (+) ions is supplied from. If negative (−) ions or positive (+) ions are said to be generated in the contents without charge being supplied from outside the contents, this is contrary to the law of conservation of charge.
…
The court's findings
…
"Bringing…a single electrode 4 into contact with or close to side portion 31 of sealed package 3…to charge contents 1 inside the package through electrically insulating film 2," as recited in the claimed invention, contradicts conservation of charge and cannot be achieved by anyone. Such an invention must therefore be regarded as unclear. Moreover, the detailed description in the application is not sufficiently clear and complete to enable a person skilled in the art to carry out the invention….
https://lnkd.in/gDNE3ceH
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33052.pdf
Original article (2025-09-13):
https://lnkd.in/gJwAZpft
Identical repost (2025-09-14):
https://lnkd.in/gxHyxSDd
Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513750277490143232/

Tokyo High Court, 2003 (Gyo-Ke) No. 166 — …Topical agent for treating atopic dermatitis (Judge Tsukahara)

Original Ameblo publication: 2025-09-15
Article type: Case note
Category: Patents
Topics: Patent eligibility
First published on this site: 2026-10-10
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12930258763.html
HP: https://www.takaishihideki.com/en/single-post/tokyo-high-court-heisei-15-gyo-ke-no-166-topical-agent-for-treating-atopic-dermatitis-judge
Japanese version: https://www.takaishihideki.com/single-post/東京高判平成15年-行ケ-166-塚原-【-アトピー性皮膚炎治療用の外用剤】

Tokyo High Court, 2003 (Gyo-Ke) No. 166 — …Topical agent for treating atopic dermatitis (Judge Tsukahara)

*The invention was held to be incomplete because there was insufficient evidence to establish that the clinical trial described in the specification had been conducted, that the drugs described had been used, and that the results had been accurately stated, and the intended technical effect therefore could not be inferred.

(Note) The judgment did not find that the description of the clinical trial in the specification was false. It stated that, even if there was no proof that steroids had been mixed in, the description of the clinical trial would not thereby be established as true, and that, ultimately, the defendant, having itself discarded the most probative evidence, must naturally bear the resulting difficulty of proof. The court set aside the JPO decision. https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9822.pdf

→ Not an “invention” eligible for a patent.

(Excerpt from the judgment, translated)

Although the specification…reports the clinical trial results, there is insufficient evidence to establish (i) that the trial was actually conducted, (ii) that the agents used in it were in fact…the topical ointment and cream, or (iii) that the results were accurately recorded in the specification. Nor does examination of the defendant’s arguments concerning evidence other than the trial provide sufficient grounds to find that the agents have a therapeutic effect. It therefore cannot be inferred that the technical content (technical means) of the alleged invention can achieve its intended technical effect. The alleged invention is thus incomplete as an invention and does not constitute an “invention” within the opening clause of Patent Act Article 29(1), and cannot be patented….

https://lnkd.in/gzhFJ4Pt

Original article (2025-09-15):

https://lnkd.in/gG3Gqutt

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513750683670441984/

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10071 — “Taishoken” (Judge Miyasaka)

Original Ameblo publication: 2025-09-16

Article type: Case note

Category: Trademarks

Topics: Cancellation for non-use, Non-exclusive trademark licenses, Implied consent and license agreements

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12930601260.html

HP: https://www.takaishihideki.com/en/single-post/trademarks-reiwa-6-gyo-ke-no-10071-taishoken-judge-miyasaka

Japanese version: https://www.takaishihideki.com/single-post/【商標】令和６年-行ケ-10071『大勝軒』事件-宮坂

[Trademarks] IP High Court, 2024 (Gyo-Ke) No. 10071 — “Taishoken” (Judge Miyasaka)

*An implied agreement granting a non-exclusive trademark license requires objectively verifiable, clear and affirmative intent to confer a right, going beyond mere acquiescence.

→ The court set aside the JPO decision rejecting the request for cancellation for non-use.

(Excerpt from the judgment, translated)

Even if a trademark owner has shown tolerance of a third party’s use of a mark identical to the registered mark, an implied agreement granting a royalty-free non-exclusive license should not readily be inferred from that alone. A non-exclusive license is a right to use the registered mark for the designated goods or services (Trademark Act Article 31(2)). It may be transferred with the trademark owner’s consent or through inheritance or other general succession (paragraph 3), and, if registered, it may be asserted against persons subsequently acquiring the trademark right or an exclusive license relating to that right (paragraph 4). Given this proprietary character, establishing an implied agreement to grant a non-exclusive license requires objectively verifiable, clear and affirmative intent to confer a right, beyond mere “acquiescence.”

https://t.co/mCgbAeBll2

Figures: see the original article.

Original article (2025-09-16):

https://lnkd.in/g6UfY-sN

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513750926042689537/

Images from the original AMEBLO article

English translations of the original image text

English translation of the original image

Trademark at issue

The defendant is the holder of the trademark right for the registered trademark below (Registration No. 3105120; hereinafter referred to as the “trademark at issue”).

- **Composition:** consisting of the Japanese characters “大勝軒” (Taishōken), written horizontally (see the original image).
- **Designated services:** Class 42 “Provision of Chinese cuisine”
- **Filing date:** September 30, Heisei 4 (1992)
- **Registration date:** December 26, Heisei 7 (1995)

The original Japanese-character trademark is retained separately.

English translation of the original image

Trademark at issue

The defendant holds the trademark right for the registered trademark shown below (Registration No. 3105120; the “trademark at issue”).

Composition: As shown below, consisting of the Japanese characters “大勝軒” (Taishōken), written horizontally.

Designated services: Class 42 — “Provision of Chinese cuisine”

Application date: September 30, 1992

Registration date: December 26, 1995

The original Japanese-character trademark is retained separately.

Original images retained for comparison

本件商標

被告は、下記登録商標（登録第３１０５１２０号、以下「本件商標」という。）の商標権者である。

・構成：下記のとおり（「大勝軒」の文字を横書きしてなる。）

・指定役務：第４２類「中華料理の提供」

・登録出願：平成４年９月３０日

・設定登録：平成７年１２月２６日



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12930601260.html

[Unfair competition] Osaka High Court, 2024 (Ne) No. 1775 — “Wam”

Original Ameblo publication: 2025-09-17

Article type: Case note

Category: Unfair competition law

Topics: Termination of contract, Return of documents, Unfair competition law

First published on this site: 2026-10-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12930738515.html

HP: https://www.takaishihideki.com/en/single-post/unfair-competition-osaka-high-court-reiwa-6-ne-no-1775-wam

Japanese version: https://www.takaishihideki.com/single-post/【不競法】大阪高判令和６年-ネ-1775『wam』事件

[Unfair competition] Osaka High Court, 2024 (Ne) No. 1775 — “Wam”

*Only the claim for return of the manuals was upheld.

→ Completion of the litigation also conclusively determines the obligation to return the manuals. Keeping them for litigation purposes does not excuse that obligation.

(Excerpt from the judgment, translated)

The agreement provides, as an effect of termination, that “the appellee must immediately return to the appellant the originals and copies of equipment, manuals, other materials, documents, etc. lent or supplied under the agreement, or take measures such as destroying them in accordance with the appellant’s instructions”…. Since the agreement…has terminated, the appellee must immediately return to the appellant the existing copy of Item 1, which forms part of the manuals and related materials.

The appellee disputes the return obligation under that provision on the ground that Item 1 is retained for litigation purposes. However, when the judgment becomes final—that is, when the litigation ends—the obligation to return the manuals under the provision will also be conclusively determined. Retention for litigation purposes therefore cannot excuse that obligation.

https://lnkd.in/g3SnEm64

Original article (2025-09-17):

https://lnkd.in/g3e-e2Fg

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513751146935558144/

[Trademarks / JPO decision] Appeal No. 2024-5257

Original Ameblo publication: 2025-09-19

Type: Administrative decision note

Category: Trademarks

Topics: Trademark similarity

First published on this site: 2026-10-09

Case / source information: Appeal No. 2024-5257

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12931260967.html

HP: https://www.takaishihideki.com/en/single-post/jpo-appeal-2024-5257-1

Japanese version: https://www.takaishihideki.com/single-post/jpo-appeal-2024-5257

[Trademarks / JPO decision] Appeal No. 2024-5257

*The applied-for mark, which added “The” to the cited mark and used a stylized design, was held dissimilar.

(Excerpt from the decision, translated)

A. The applied-for mark

As shown in Appendix 1, the mark consists of a device on the left, prominently large lettering “THE CLASSICA” to its right, and smaller lettering “omotesando” below. The components are spaced apart and differ in form (device versus letters and differences in letter size), giving a visually separate and independent impression.

The device does not appear to depict any specific object and gives rise to no independent pronunciation or concept.

“omotesando” is the romanized spelling of Omotesando, meaning “the main approach to Meiji Shrine; also, the surrounding area” (Kojien, 7th ed., Iwanami Shoten), and indicates a place where services are provided. Together with its small, subsidiary presentation on a separate line, this means it produces no pronunciation or concept as an independent indication of origin.

By contrast, the prominently large “THE CLASSICA” lettering is presented as a coherent whole in the same typeface, with the initial letters of “THE” and “CLASSICA” slightly larger and the other letters of equal size. Its pronunciation, “Za Kurashika,” can naturally be spoken as a continuous expression.

“THE” is the English definite article. “CLASSICA” is an Italian word meaning, among other things, a traditional sporting event (Italian–Japanese Dictionary, 2nd ed., Shogakukan), but it cannot be said to be generally well known in Japan and would be perceived as a coined term without a specific meaning. The combination as a whole is not an established dictionary word and does not immediately suggest any particular meaning in relation to the designated services, so it too is perceived as a coined expression.

Given this configuration and pronunciation, the lettering should be understood and perceived as an indivisible whole, rather than as something in which attention would focus particularly on “CLASSICA” alone.

Accordingly, “THE CLASSICA” gives traders and consumers a strong and dominant impression as an indication of the origin of the services, while the other components produce no pronunciation or concept as indications of origin. It is therefore permissible to separate and extract that lettering as the essential part and compare it with another person’s mark in assessing similarity of the marks themselves.

Thus, the applied-for mark produces the pronunciation “Za Kurashika” corresponding to its dominant element, and no specific concept.

B. Cited Mark 1

As shown in Appendix 2, Cited Mark 1 consists of “クラシカ” and “CLASSICA” in two ordinary lines. The upper katakana lettering would naturally be understood as indicating the pronunciation of the lower Roman lettering.

“CLASSICA” should be perceived as a coined term with no specific meaning.

Accordingly, Cited Mark 1 produces the pronunciation “Kurashika” and no specific concept.

C. Similarity between the applied-for mark and Cited Mark 1

Comparing the applied-for mark and its dominant element with Cited Mark 1, there are clear differences in appearance, including the presence or absence of the device and the constituent lettering, making them readily distinguishable.

Their pronunciations differ in the number and identity of their sounds and can readily be distinguished aurally.

Neither gives rise to a specific concept, so no conceptual comparison is possible.

Even though they cannot be compared conceptually, they can readily be distinguished visually and aurally. The two marks should therefore be regarded as dissimilar.

Figures: see the original article.

Original article (2025-09-19):

https://lnkd.in/gWsC-8km

Originally posted on LinkedIn:

Part 1: https://www.linkedin.com/feed/update/urn:li:activity:7513751385255911425/

Part 2: https://www.linkedin.com/feed/update/urn:li:activity:7513751532719464448/

Images from the original AMEBLO article

English translations of the original image text

English key to the original trademark image

Annex 1 — Trademark applied for

(For the colors, see the original.)

THE CLASSICA

omotesando

with a fan-shaped device on the left (see the original).

Annex 2 — Cited trademark 1

CLASSICA

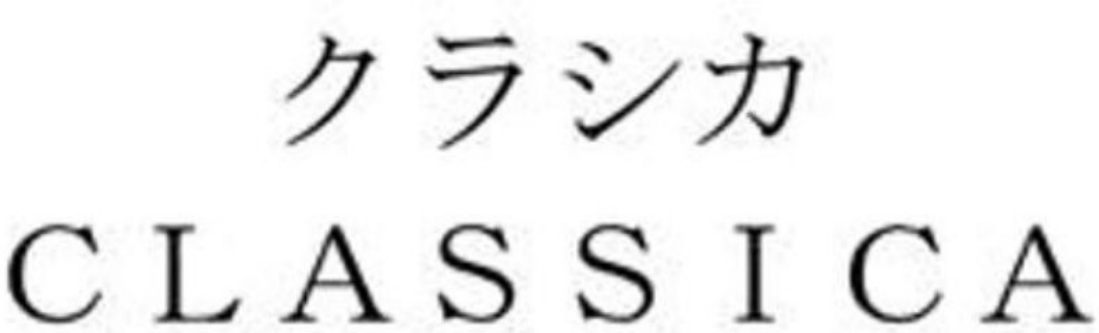
The Japanese phonetic text reads “Kurashika.”

Original images retained for comparison

別掲１　本願商標（色彩は原本参照。）



別掲２　引用商標１



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12931260967.html

[Trademarks / JPO decision] Appeal No. 2024-11680

Original Ameblo publication: 2025-09-21

Type: Administrative decision note

Category: Trademarks

Topics: Trademark similarity

First published on this site: 2026-10-09

Case / source information: Appeal No. 2024-11680 / Appeal No. 2024-10278 / Appeal No. 2024-10716

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12931916110.html

HP: https://www.takaishihideki.com/en/single-post/jpo-appeal-2024-11680-1

Japanese version: https://www.takaishihideki.com/single-post/jpo-appeal-2024-11680

[Trademarks / JPO decision] Appeal No. 2024-11680

*Applied-for mark: “SENJYU”; cited mark: “千寿” (Senju).

→ Dissimilar.

Note: The appellant sells products including “Kubota Senju.”

*Appeal No. 2024-10278

Applied-for mark: “MANJYU”; cited mark: “万寿” (Manju).

→ Dissimilar.

*Appeal No. 2024-10716

Applied-for mark: “HAKUJYU”; cited mark: “白寿” (Hakuju).

→ Dissimilar.

(Excerpt from the decision, translated)

(1) The applied-for mark

The mark consists of “SENJYU” in standard characters. It is not an established word listed in dictionaries.

“JYU” does not follow the romanization generally used in Japan (see the Agency for Cultural Affairs, “Romanization: Tables 1 and 2,” https://lnkd.in/gvK4eB6P). However, the configuration produces the pronunciation “Senju.”

“SENJYU” should therefore be perceived as a coined term conveying no specific meaning. The mark produces the pronunciation “Senju” corresponding to its lettering, but no particular concept.

(2) The cited mark

As shown in the appendix, the cited mark consists of “千寿” written horizontally in a Gothic-style typeface.

Although it is not an established dictionary word, as the examiner explained and the appellant acknowledged in its grounds of appeal, the meanings and actual usage of the constituent characters “千” (thousand) and “寿” (longevity), among other factors, can suggest a meaning roughly equivalent to “living a long life.”

The expression may be read “Senju,” following examples such as “万寿,” read “Manju” or “Banju,” and “米寿,” read “Beiju.”

Accordingly, the cited mark produces the pronunciation “Senju” and may convey the concept of “living a long life.”

(3) Similarity between the marks

In appearance, the scripts and numbers of characters differ, and the marks can immediately be understood as expressing different terms. They can therefore be clearly distinguished visually. It is true that in trade, the characters in a mark are commonly converted into another script while retaining the same pronunciation. However, as explained in (1), under romanization generally used in Japan, the sound “ju” is spelled “ju” in Hepburn romanization or “zyu” in Kunrei-shiki. The applied-for mark therefore cannot immediately be regarded as a romanization of a Japanese word pronounced “Senju.” It is not merely a conversion of the cited mark’s “千寿” into Roman letters; it is properly regarded as a different mark.

The marks have the same pronunciation, “Senju.”

Conceptually, the applied-for mark has no specific concept, whereas the cited mark may convey “living a long life,” so they are not likely to be confused in this respect.

Although identical in pronunciation, the marks are clearly distinguishable in appearance and are not likely to be confused conceptually. There is no evidence that traders and consumers identify the designated goods and their origin exclusively by pronunciation, or that distinctiveness through pronunciation outweighs that through appearance and concept. Considering their overall impressions and the memories they leave, the marks should be regarded as dissimilar, with no likelihood of confusion as to the origin of the goods.

Figures: see the original article.

Original article (2025-09-21):

https://lnkd.in/gNicMDgp

Originally posted on LinkedIn:

Part 1: https://www.linkedin.com/feed/update/urn:li:activity:7513751892469051393/

Part 2: https://www.linkedin.com/feed/update/urn:li:activity:7513752212238499840/

Images from the original AMEBLO article

English translations of the original image text



Original images retained for comparison

別掲　引用商標



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12931916110.html

[Trademarks / JPO decision] Appeal No. 2024-7278

Original Ameblo publication: 2025-09-22

Type: Administrative decision note

Category: Trademarks

Topics: Trademark similarity

First published on this site: 2026-10-09

Case / source information: Appeal No. 2024-7278

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12932196169.html

HP: https://www.takaishihideki.com/en/single-post/jpo-appeal-2024-7278-1

Japanese version: https://www.takaishihideki.com/single-post/jpo-appeal-2024-7278

[Trademarks / JPO decision] Appeal No. 2024-7278

*The applied-for mark “CONNECT,” consisting of a figure and lettering, was held dissimilar to the cited mark “&connect.”

(Excerpt from the decision, translated)

(1) The applied-for mark

As shown in Appendix 1, the mark consists of a device above the lettering “COnnECT” (with the inside of the “O” colored yellow).

The device and lettering do not overlap and are spaced apart, so they are observed as visually separate. The device does not immediately suggest any specific object, and no conceptual connection with the lettering can be found. It is therefore difficult to regard the components as so inseparably combined that observing them separately would be unnatural in trade. Rather, each can function as an essential part identifying the goods and services of one undertaking as distinct from those of others.

The mark therefore produces the pronunciation “Konekuto” from its lettering, one of its dominant elements, and concepts such as “join” or “connect” (Basic Genius English–Japanese Dictionary, 2nd ed., Taishukan Shoten).

(2) The cited mark

As shown in Appendix 3, the cited mark consists of “&connect” written horizontally with letters of the same size aligned along the bottom. Although “&” is slightly stylized in white within a black square, it is placed close to “connect,” and the mark is perceived and understood as an indivisible whole.

“&connect” is not an established dictionary expression and does not immediately suggest any particular meaning in relation to the designated services, so it is perceived as a coined term.

Accordingly, the cited mark produces only the pronunciation “Ando Konekuto” and no specific concept.

(3) Similarity between the marks

Comparing the applied-for mark and its dominant element with the cited mark, there are clear differences in appearance, including the presence or absence of the device and the constituent lettering, making them readily distinguishable.

The pronunciation “Konekuto” of the applied-for mark and “Ando Konekuto” of the cited mark differ in the number and identity of their sounds and are readily distinguishable aurally.

Conceptually, the applied-for mark conveys ideas such as “join” or “connect,” whereas the cited mark has no specific concept. They are therefore not likely to be confused conceptually.

Accordingly, the two marks should be regarded as dissimilar, with no risk of confusion in appearance, pronunciation or concept.

Figures: see the original article.

Original article (2025-09-22):

https://lnkd.in/gU3J5a3T

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513752517005123584/

Images from the original AMEBLO article

English translations of the original image text

English key to the original image

Annex 1 — Trademark applied for

(For the colors, see the original.)

CONNECT logo — see the original image.

Annex 2 — Designated goods and designated services of the trademark applied for

The lines below reproduce the visible fragments. Text beyond the right edge of the source image is unavailable.

Class 20:
“Packaging containers made of wood, bamboo or plastic; lids made of plastic and wood; biologically derived [text cut off]”
“plastic lids”

Class 35:
“Benefits provided to customers in the course of retail or wholesale business involving plastic packaging containers [text cut off]”
“[text cut off] provision of benefits to customers in the course of business; plastic lids made using biologically derived organic raw materials [text cut off]”

Annex 3 — Cited trademark

&connect logo — see the original image.

Trademark illustrations and designated goods and services

Annex 1 — Trademark applied for

CONNECT logo (see the original image for the design and colors).

Annex 2 — Designated goods and services of the trademark applied for

Class 20: “Packaging containers made of wood, bamboo or plastic; lids made of plastic and wood; biologically derived …”; “… plastic lids”.

Class 35: “Benefits provided to customers in the course of retail or wholesale business involving plastic packaging containers …”; “… provision of benefits to customers in the course of business; plastic lids made using biologically derived organic raw materials …”.

Annex 3 — Cited trademark

&connect logo (see the original image).

Original images retained for comparison

別掲１　本願商標（色彩は原本参照。）



別掲２　本願商標の指定商品及び指定役務
第２０類「木製・竹製又はプラスチック製の包装用容器，プラスチック製及び木製のふた，生物由プラスチック製ふた」
第３５類「プラスチック製の包装用容器の小売又は卸売の業務において行われる顧客に対する便益務において行われる顧客に対する便益の提供，生物由来の有機系原料を使用したプラスチック製ふ

別掲３　引用商標



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12932196169.html

[Designs] IP High Court, 2024 (Gyo-Ke) No. 10034 — Beverage in a container (Judge Nakadaira)

Original Ameblo publication: 2025-09-25
Type: Case note
Category: Designs
Topics: Dynamic designs
First published on this site: 2026-10-09
Case / source information: IP High Court, 2024 (Gyo-Ke) No. 10034
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12933291107.html
HP: https://www.takaishihideki.com/en/single-post/beverage-dynamic-design-10019-1
Japanese version: https://www.takaishihideki.com/single-post/beverage-dynamic-design-10019

[Designs] IP High Court, 2024 (Gyo-Ke) No. 10034 — Beverage in a container (Judge Nakadaira)

*The design was excluded from protection as a dynamic design because its manner of change lacked a certain regularity and its changing shape was not steady.

(Excerpt from the judgment, translated)

A dynamic design concerns an applied-for design whose constituent shape or other features change while it remains a “design” under Design Act Article 2(1). It treats the entire process, including the states before and after the change, as one dynamic shape or configuration and protects it as a single design. It therefore requires a definite form and other characteristics enabling the whole, including intermediate shapes throughout the change, to be understood as the shape or configuration of one article.

Specifically,…in every state before, during and after the change, the shape must satisfy the requirements for an article under the Design Act: as an attribute of the article, a certain shape must exist for a certain period; it must have a definite form whose boundaries can be identified as the basis for recognizing the shape; and its manner of change must have a certain regularity or its changing shape must be steady.

In the application at issue,…plan views 1–3 after opening the lid show changes in the foam. The width of the band of bubbles around the can’s edge is not uniform, and its outline is an irregular circle. During the process, the bubble band becomes wider in some places but disappears or narrows in others. After the white central area disappears and small clusters of white bubbles become irregularly scattered, the diameter of the annular shape gradually decreases. However, the rate at which the outline contracts varies by location. The shape becomes irregular rather than circular before reaching a two-tier truncated-cone shape. This formation and disappearance of bubbles cannot be regarded as having a certain shape for a certain period with identifiable boundaries, as required for a design or dynamic design. Nor can the manner of change be regarded as having a certain regularity or the changing shape as being steady.

https://lnkd.in/g--uJgD5

Original article (2025-09-25):

https://lnkd.in/g7HkPkiy

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513752706507980800/

IP High Court, 2024 (Gyo-Ke) No. 10019 — Laminate of a polyester resin composition (Judge Miyasaka)

Original Ameblo publication: 2025-09-26
Type: Case note
Category: Patents
Topics: Inventive step, Motivation and teaching away
First published on this site: 2026-10-09
Case / source information: IP High Court, 2024 (Gyo-Ke) No. 10019
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12933462150.html
HP: https://www.takaishihideki.com/en/single-post/polyester-laminate-10019-1
Japanese version: https://www.takaishihideki.com/single-post/polyester-laminate-10019

IP High Court, 2024 (Gyo-Ke) No. 10019 — Laminate of a polyester resin composition (Judge Miyasaka)

*The court recognized a general problem without requiring documentary evidence.

→ Inventive step denied.

(Excerpt from the patent cancellation decision, translated)

At the filing date, curbing depletion of petroleum resources and increases in atmospheric carbon dioxide, a cause of global warming, were general problems requiring no documentary citation. To address them, there was motivation to reduce polyethylene terephthalate made from petroleum-derived raw materials and replace it with polyethylene terephthalate made from biologically derived biomass materials. …A person skilled in the art could readily have adopted the matters disclosed in Cited Reference 5.

https://lnkd.in/gxWbFv26

Original article (2025-09-26):

https://lnkd.in/g5yfJ5Wp

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513753085509414912/

Osaka District Court, 2022 (Wa) No. 11025 — Mite-trapping mat (Judge Matsuami)

Original Ameblo publication: 2025-09-27
Type: Case note
Category: Patents
Topics: Claim construction, Doctrine of equivalents
First published on this site: 2026-10-09
Case / source information: Osaka District Court, 2022 (Wa) No. 11025
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12933926529.html
HP: https://www.takaishihideki.com/en/single-post/mite-trapping-mat-11025-1
Japanese version: https://www.takaishihideki.com/single-post/mite-trapping-mat-11025

Osaka District Court, 2022 (Wa) No. 11025 — Mite-trapping mat (Judge Matsuami)

*A “porous air-permeable bag” must have a structure that retains its contents inside and prevents their dispersal.

→ Claim limitation not met.

(Excerpt from the judgment, translated)

<No literal infringement>

Both the dictionary meaning and the specification support construing the “porous air-permeable bag” in limitation A-3 as requiring, at a minimum, a structure capable of retaining its contents inside and preventing their dispersal. In the accused products sold by the defendants, however, the mite attractant is merely sandwiched between two layers of nonwoven fabric, gauze or similar material and can spill out around their edges. The structure therefore cannot be found capable of retaining the attractant inside.

<No infringement under the doctrine of equivalents>

By storing mite bait in a “porous air-permeable bag” that holds it without spillage, the invention achieves both high adhesive strength of the adhesive tape and a reduction in the number of constituent materials. A bag structure is therefore an essential element. The accused products instead sandwich the mite attractant between two sheets of nonwoven fabric or gauze from which it can spill. Their difference from the invention is not merely in a non-essential part, nor can the substituted structure be said to produce the same function and effect.

https://lnkd.in/gQrZFwjK

Original article (2025-09-27):

https://lnkd.in/gZpUsTZM

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513753328133189632/

IP High Court, 2024 (Ne) No. 10019 — Rolling device (Judge Miyasaka)

Original Ameblo publication: 2025-09-28
Type: Case note
Category: Patents
Topics: Claim construction
First published on this site: 2026-10-09
Case / source information: IP High Court, 2024 (Ne) No. 10019 / Tokyo District Court, 2022 (Wa) No. 18830
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12934177102.html
HP: https://www.takaishihideki.com/en/single-post/rolling-device-10019-1
Japanese version: https://www.takaishihideki.com/single-post/rolling-device-10019

IP High Court, 2024 (Ne) No. 10019 — Rolling device (Judge Miyasaka)

*The appellate court rejected the narrow construction adopted below (Tokyo District Court, 2022 (Wa) No. 18830), but found that another claim limitation was not met.

[Invention 1 (Claim 4)] …forming, in part of the rolling path, an unloaded region in which the rolling element contacts only one of the raceway grooves, …

(Excerpt from the judgment, translated)

The appellee's products are angular-contact ball bearings used with preload that elastically deforms the balls and inner and outer rings, eliminating gaps between the balls and the inner- and outer-ring raceway grooves. Accordingly, the products do not have "a rolling element contacting only one of the raceway grooves" and cannot be said to "form an unloaded region."

https://lnkd.in/gu73ryeW

Original article (2025-09-28):

https://lnkd.in/gfYc79aS

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513753623277957121/

[Trademarks / Article 4(1)(vii)] IP High Court, 2023 (Gyo-Ke) No. 10128 — “MARK GONZALES” (Judge Honda)

Original Ameblo publication: 2025-09-29

Type: Case note

Category: Trademarks

Topics: Public order and morality

First published on this site: 2026-10-09

Case / source information: IP High Court, 2023 (Gyo-Ke) No. 10128

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12934409176.html

HP: https://www.takaishihideki.com/en/single-post/mark-gonzales-10128-1

Japanese version: https://www.takaishihideki.com/single-post/mark-gonzales-10128

[Trademarks / Article 4(1)(vii)] IP High Court, 2023 (Gyo-Ke) No. 10128 — “MARK GONZALES” (Judge Honda)

From 2020, as termination of the license approached, the plaintiff filed numerous applications in Japan, South Korea, China, Taiwan and elsewhere for marks containing the angel design, the defendant’s name and “(what it isNt).” After the license ended, it continued developing its own brand while sending warnings that obstructed the defendant’s new licensing business.

The court found that the plaintiff intended improperly to use its trademark rights, including by seeking injunctions, to obstruct or prevent persons other than the plaintiff and its affiliates from selling the relevant goods. It held that the applications for Marks A–C disrupted the fair trademark order.

→ Trademark Act Article 4(1)(vii) applied.

(Excerpt from the judgment, translated)

Around 2014, the defendant sought termination of the license agreement with the Sakura Group. By around 2020, the defendant had made clear that it did not intend to continue the licensing business with that group after termination and requested return of all trademark rights. In response, the plaintiff obtained transfers of the rights to Marks D–G from the Sakura Group and, from around 2020, the final stage of the license agreement, filed numerous applications in Japan, South Korea, China, Taiwan and elsewhere for marks including “Mark Gonzales,” “(what it isNt)” and the angel design. Even after January 1, 2022, when the license agreement had clearly ended, the plaintiff continued selling products bearing “Mark Gonzales” and the angel design through licensees. However,…the plaintiff cannot be said to have acquired copyright in Angel Designs 1 and 2 or the signature under the MPSA agreement, and the license agreement effectively included a novation of the MPSA agreement’s terms. Even assuming that the MPSA agreement remains valid, it permits only reproduction of the cover art on T-shirts and similar items and use of the defendant’s and others’ names for promotion of the album. The plaintiff’s current “(what it isNt)” brand development exceeds both the album-promotion purpose and the scope of reproducing the cover art. Moreover, after termination of the license agreement, the plaintiff attempted to block the defendant’s brand development by sending warning letters to the defendant’s own Japanese sublicensees and retailers.

These actions since 2020 establish that, when applying for Marks A–C…, the plaintiff fully knew that the dispute had become overt and that it would lose the ability to use Angel Designs 1 and 2 and the defendant’s name after the license ended. Nevertheless, it had the improper purpose and intent of using the resulting trademark rights to obstruct and prevent sales by persons other than the plaintiff and its associates, including by seeking injunctions against the defendant’s own sales in Japan of goods bearing the angel designs or “Mark Gonzales.”

Accordingly, even under Japan’s first-to-file trademark system, these applications for Marks A–C contradict the purpose of the Trademark Act: to protect trademarks, maintain the business reputation of those using them, contribute to industrial development and protect consumers’ interests (Article 1). They disrupt the fair trademark order and are also impermissible as a matter of reason in light of sound legal sentiment. Marks A–C therefore fall within Article 4(1)(vii) as trademarks likely to harm public policy or accepted principles of morality.

https://lnkd.in/g-_e5WXg

Original article (2025-09-29):

https://lnkd.in/gdX7t72Y

Originally posted on LinkedIn:

Part 1: https://www.linkedin.com/feed/update/urn:li:activity:7513753852769316864/

Part 2: https://www.linkedin.com/feed/update/urn:li:activity:7513753959652794368/

IP High Court, 2013 (Ne) 10035 [Method for Manufacturing a Rotary Toothbrush] (Appeal) <Shitara>

Original Ameblo publication: 2025-10-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12935168850.html

IP High Court, 2013 (Ne) 10035 [Method for Manufacturing a Rotary Toothbrush] (Appeal) <Shitara>

*Although the manufacturing method contains a temporal sequence, satisfaction of the claim was recognized flexibly with respect to that sequence.

[Claim 2] (A) … (B) … a first step of causing a group of filaments to project outward by a fixed amount from an insertion hole provided in a base; (C) a second step of blowing air into the center of the projecting ends of that group of filaments to spread the group radially; (D) a third step of fusion-bonding the central portion of the group of filaments while fixing the spread group to the base; and (E) a fourth step of cutting out the center of the fusion-bonded central portion; (F) a method for manufacturing an individual brush unit of a rotary brush, comprising these steps.

(Translation of an excerpt from the court's reasoning)

... “Cutting out the center of the fusion-bonded central portion” in constituent requirement E also encompasses a process in which, after the “fusion-bonding” process has begun and the “melting” stage has taken place—that is, after the molten filaments have become adherent to one another—the “cutting-out” process begins; the process then enters the “bonding” stage, namely the solidification stage; and the “cutting-out” process ends after sufficient time has elapsed for “fusion-bonding” (solidification) ordinarily to be considered complete ….

... As to the temporal relationship between “fusion-bonding” and “cutting-out” as well, the claim also encompasses a process in which, after the “fusion-bonding” process has begun and the “melting” stage has taken place—that is, after the molten filaments have become adherent to one another—the “cutting-out” process begins; the process then enters the “bonding” stage, namely the solidification stage; and the “cutting-out” process ends after sufficient time has elapsed for “fusion-bonding” (solidification) ordinarily to be considered complete ….

IP High Court, 2024 (Ne) 10041 [Receiving Device] <Masuda>

Original Ameblo publication: 2025-10-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12935558409.html

IP High Court, 2024 (Ne) 10041 [Receiving Device] <Masuda>

*The reference to another subcombination in this claim does not limit the structure or function of the claimed receiving device.

⇒ Not a matter specifying the invention (lack of inventive step).

[Claim 5] (Invention at issue)

A receiving device characterized by having an RFID interface for transmitting and receiving to and from the mobile telephone recited in Claim 4; transmission means for transmitting to that mobile telephone a request for the transmission of individual information; and determination means for determining whether individual information received from that mobile telephone is the requested individual information; and performing processing with that mobile telephone when the determination information received by the determination means is determined to be the requested individual information.

(Translation of an excerpt from the court's reasoning)

The corrected invention at issue is an invention of a “receiving device” in an invention of an overall apparatus consisting of a mobile terminal and a receiving device, namely an individual-information system; it is a so-called subcombination invention.

In a subcombination invention, it is necessary to ascertain what significance matters concerning another subcombination recited in the claim have in specifying the claimed invention from the standpoint of shape, structure, components, composition, operation, function, nature, characteristics, acts or actions, intended use, and the like (hereinafter “structure, functions, etc.”), and thereby delineate the technical scope of the invention. If matters concerning another subcombination specify only the apparatus of that other subcombination and do not specify any structure, functions, etc. of the apparatus recited in the claim, those matters concerning the other subcombination can be said to have no significance in specifying the claimed invention.

Turning to the corrected invention at issue, it is identified as an invention concerning a receiving device having an RFID interface for transmitting and receiving to and from the mobile telephone recited in Claim 4 (constituent requirement J′). The mobile telephone recited in Claim 4 is specified not only by that claim but also by Claims 1 and 3.

However, the descriptions in Claims 1, 3, and 4 all specify the structure, functions, etc. of the mobile telephone, not the structure, functions, etc. of the “receiving device.”

Accordingly, the matter “the mobile telephone recited in Claim 4,” which concerns another subcombination in the corrected invention at issue, can be said to have no significance in specifying the corrected invention at issue, which is an invention of a “receiving device.”

Therefore, in identifying the gist of the corrected invention at issue, it is appropriate to exclude the matter “(the mobile telephone) recited in Claim 4.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94075.pdf

[United States] Maquet Cardiovascular LLC v. Abiomed Inc. (CAFC, March 21, 2025)

Original Ameblo publication: 2025-10-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12935785438.html

[United States] Maquet Cardiovascular LLC v. Abiomed Inc. (CAFC, March 21, 2025)

Applying prosecution disclaimer across a patent family requires consideration of whether the relevant claim limitations are shared. Any disclaimer must also meet the strict standard of a clear and unmistakable disavowal.

Here, the applicant's silence in response to the examiner's statements in the notice of allowance did not constitute a clear and unmistakable disavowal of claim scope.

⇒ No prosecution disclaimer was established on the prosecution history at issue.

Statements made during IPR (inter partes review) proceedings must also meet the “clear and unmistakable” standard.

https://t.co/9FRkmDupkR

[United States] In re Riggs (March 2025, CAFC)

Original Ameblo publication: 2025-10-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12935951373.html

[United States] In re Riggs (March 2025, CAFC)

Even where priority is claimed to a provisional application, not all disclosed subject matter is entitled to the earlier filing date. Only the specific subject matter supported by the provisional application qualifies for that earlier date.

⇒ When the provisional filing date is used as the reference's effective date, it is necessary to check whether each element relied on for the rejection is supported by the provisional application.

https://ameblo.jp/pa-sigetty/entry-12891377482.html

[United States] Sigray v. Carl Zeiss (CAFC, May 2025)

Original Ameblo publication: 2025-10-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12936014207.html

[United States] Sigray v. Carl Zeiss (CAFC, May 2025)

<Novelty>

Novelty may be denied even if a feature is not recognized as existing in the reference, is present only in a minute amount, or is regarded as unnecessary.

Teaching away is irrelevant to novelty.

⇒ Because the beam in the reference was not perfectly parallel, it necessarily diverged, resulting in projection magnification greater than 1×; novelty was therefore denied.

https://ameblo.jp/pa-sigetty/entry-12907025913.html

[United States] IQRIS Techs v. Point Blank (CAFC, March 2025)

Original Ameblo publication: 2025-10-06

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12936302933.html

[United States] IQRIS Techs v. Point Blank (CAFC, March 2025)

*The district court's summary judgment of non-infringement was vacated and the case remanded.

(1) The claim language provides only that the pull cord is “connected to at least one releasable hook and actuates that hook to release the engagement”; it does not limit who pulls it or how it is pulled. In other words, “pull cord” amounts only to a functional description of “a cord that actuates a releasable hook when pulled,” and a limitation requiring “direct pulling” cannot be read from the language.

(2) The claim language specifies only the pull cord's function (actuating the hook), not its structure (whether it has a handle). The specification's drawings consistently depict a gripping portion, such as a spherical bead, attached to the end of the pull cord and do not suggest that adding a gripping portion negates its character as a pull cord.

https://t.co/ih0TFcO7Vc

[Trademark] IP High Court, 2023 (Gyo-Ke) 10087, “Sankin Kogyo” Case <Hibiku Shimizu>

Original Ameblo publication: 2025-10-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12937191760.html

[Trademark] IP High Court, 2023 (Gyo-Ke) 10087, “Sankin Kogyo” Case <Hibiku Shimizu>

The “Sankin” portion of the trademark at issue, “Sankin Kogyo” (standard characters), was widely known as indicating the goods of another company (the plaintiff's Japanese subsidiary).

The “三金” portion can be assessed separately.

⇒ The “三金” portion and the cited mark, which displays “Ｓａｎｋｉｎ” and “サンキン” on two lines, differ in appearance but have the same pronunciation. The trademark at issue is similar to the cited mark overall. Article 4(1)(xi) applies to the pharmaceutical and other relevant goods and denture-processing services. Article 4(1)(xv) applies to the metalworking and other relevant services because there is a likelihood of confusion.

https://tmfesta.com/2024/08/%E5%B7%A5%E8%97%A4%E8%8E%9E%E5%8F%B8%E3%81%AE%E6%B3%A8%E7%9B%AE%E8%A3%81%E5%88%A4%EF%BC%9A%E7%B5%90%E5%90%88%E5%95%86%E6%A8%99%E3%81%AE%E9%A1%9E%E5%90%A6%E5%88%A4%E6%96%AD%E7%AD%89%E3%81%AB%E8%AA%A4/

[United States] Sierra Wireless v. Sisvel (CAFC, March 2025)

Original Ameblo publication: 2025-10-08

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12937340264.html

[United States] Sierra Wireless v. Sisvel (CAFC, March 2025)

The PTAB's decision in an IPR finding lack of novelty and obviousness was overturned.

The CAFC construed the plain and unambiguous claim language to require both “process [c] (stopping the timer if previously unreceived data is received while the timer is running)” and “process [d] (transmitting a status report containing a positive acknowledgment of received data after the timer expires)” to be performed where their respective preconditions apply. It therefore rejected the PTAB’s conclusion that disclosure of only one of processes [c] and [d] in the prior art would suffice.

https://ameblo.jp/pa-sigetty/entry-12889614242.html

[China / Copyright] Guangzhou Internet Court, February 8, 2024

Original Ameblo publication: 2025-10-10

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12937698361.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513390791478853632-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513390688059957249-ja

[China / Copyright] Guangzhou Internet Court, February 8, 2024

Case No. (2024) Yue 0192 Min Chu 113

The “Ultraman” case

Images generated by entering “Ultraman” as a generative-AI keyword resembled Ultraman.

⇒ The generative-AI service provider was held liable.

<Operative part of the judgment, translated>

... The defendant must cease infringing copyright in the Ultraman series of works and take appropriate technical measures to prevent images infringing the plaintiff's copyright from being generated during users' normal use of the service.

Plus damages of RMB 10,000.

<Reasons>

1. Lack of complaint and reporting functions.

2. Insufficient warnings about potential risks.

3. Breach of the obligation to clearly identify AI-generated content where it may cause public confusion or misidentification.

Cf. Japan's “Chupa Chups” case (trademark rights).

https://lnkd.in/geZdr42q

https://t.co/G0SGfNDRBd

Original article (2025-10-10):

https://lnkd.in/gadarjX2

https://www.irify.jp/press/240220.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513390791478853632/

[Trademarks] IP High Court, 2024 (Gyo-Ke) 10032 <Judge Miyasaka>

Original Ameblo publication: 2025-10-12

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12938059665.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513415458100772864-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513415365901680640-ja

[Trademarks] IP High Court, 2024 (Gyo-Ke) 10032 <Judge Miyasaka>

* Contrary to Article 4(1)(xi) of the Trademark Act: the marks are similar and likely to cause confusion as to the source of the services.

(Excerpt from the judgment, translated)

In appearance, the textual portion constituting the dominant element of the applied-for mark and the upper textual portion constituting the dominant element of cited mark 2 differ in the initial lowercase “i” versus uppercase “I,” and in the use of katakana versus Roman letters. However, considering the widespread understanding of English in Japan and of “デンタルクリニック” and “DENTAL CLINIC” as referring to a dental clinic, those differences cannot be said to give traders and consumers a strong impression of a conspicuous visual distinction as indicators of source.

In pronunciation, both yield “Ai Dentaru Kurinikku” and are identical.

In concept, neither gives rise to any specific concept, so the two cannot be compared conceptually.

https://lnkd.in/g5-37a8n

Figures: see the original article.

Original article (2025-10-12):

https://lnkd.in/gZ8hPdmA

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513415458100772864/

Images from the original AMEBLO article

English translations of the original image text

English key to the two original images

Image 1

Annex 1 — Trademark applied for
Text in the trademark: i Dental Clinic
The Japanese phonetic text above “i” reads “Ai.”

Image 2

Text in the upper trademark: Ai Dental Clinic

Cited trademark 2
Trademark Registration No. 5490040
Filing date: July 24, Heisei 23 (2011)
Registration date: April 27, Heisei 24 (2012)
Designated services: Class 44 — dentistry; provision of medical information; health examinations; dispensing medicines; rental of medical apparatus and instruments; dietary and nutritional guidance; medical services.

Composition of the registered trademark

Page 23

Text in the lower trademark: I DENTAL CLINIC

English slogan in both marks: Wonderful Smile For Everyone

English key to the two original images

Image 1

Annex 1 — Trademark applied for

Text in the trademark: i デンタルクリニック (i Dental Clinic)

The Japanese phonetic text above “i” is “アイ” (Ai).

Image 2

Text in the upper trademark: アイ デンタルクリニック (Ai Dental Clinic)

Cited trademark 2

Trademark Registration No. 5490040

Filing date: July 24, 2011

Registration date: April 27, 2012

Designated services: Class 44 — dentistry; provision of medical information; health examinations; dispensing medicines; rental of medical apparatus and instruments; dietary and nutritional guidance; medical services.

Composition of the registered trademark

Page 23

Text in the lower trademark: I DENTAL CLINIC

English slogan in both marks: Wonderful Smile For Everyone

Original images retained for comparison

別紙１　本願商標







引用商標２

登録第５４９００４０号商標

出願日　平成２３年７月２４日

登録日　平成２４年４月２７日

指定商品　第４４類「歯科医業，医療情報の提供，健康診具の貸与，栄養の指導，医業」

登録商標の構成

23



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12938059665.html

[Trademarks] IP High Court, 2024 (Gyo-Ke) 10007, “Jimny Fan” <Judge Miyasaka>

Original Ameblo publication: 2025-10-13

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12938232793.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513415678138265600-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513415587394494464-ja

[Trademarks] IP High Court, 2024 (Gyo-Ke) 10007, “Jimny Fan” <Judge Miyasaka>

* The mark cannot be assessed by separating its components. The concepts differ. Distinct market spheres have been established.

⇒ The marks are dissimilar.

(Excerpt from the judgment, translated)

The designated goods of the applied-for mark, as amended, are the extremely niche goods in Class 16, “information magazines concerning parts and accessories used to modify off-road vehicles.” As found above regarding actual trade conditions, no automobile manufacturer, including Suzuki, publishes such magazines itself or through affiliated dealers. Nor is it plausible that traders and consumers encountering the amended goods bearing the applied-for mark would perceive an automobile manufacturer, including Suzuki, or an affiliated dealer as the publisher (or a possible publisher).

Moreover, although Suzuki was fully aware that the plaintiff had published the magazine under the same title as the applied-for mark for over ten years, it had never sent the plaintiff a warning or complaint alleging confusion with the Jimny mark. Instead, it supported publication, including by paying the plaintiff to place advertisements for the Jimny in the magazine. ...

Suzuki's business under the Jimny mark may include related merchandise and ancillary services as well as the off-road vehicle itself. In practice, however, the business of providing “information magazines concerning parts and accessories used to modify off-road vehicles” is conducted by third parties with no direct connection to Suzuki or its affiliated dealers. Distinct market spheres that do not conflict with Suzuki's business have therefore been established.

https://lnkd.in/gHSGvRw6

Figures: see the original article.

Original article (2025-10-13):

https://lnkd.in/gDRVM7j4

https://note.com/gaha9ben54/n/n7cb1c4f9bf63

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513415678138265600/

Images from the original AMEBLO article

English translations of the original image text

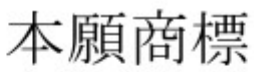
Image 1 — Trademark applied for
Jimny Fan
The Japanese phonetic text reads “Jimunī Fan.”

Image 2 — Cited trademark
1. Cited trademark 1 (Exhibit Ko 8)
Jimny

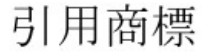
Image 3 — Comparison table

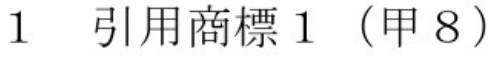
	Pronunciation	Concept
Trademark applied for	Jimunī Fan	An enthusiast of Suzuki's off-road vehicle Jimny
Cited trademark 1	Jimunī	The name of Suzuki's off-road vehicle
Cited trademark 2	Jimunī	The name of Suzuki's off-road vehicle

Original images retained for comparison











	称　呼	観　念
本願商標	ジムニーファン	スズキ社のオフロード車ジムニーの愛好者
引用商標１	ジムニー	スズキ社のオフロード車の名称
引用商標２	ジムニー	スズキ社のオフロード車の名称

Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12938232793.html

IP High Court, 2024 (Gyo-Ke) 10016 [Undried tea paste] <Judge Nakadaira>

Original Ameblo publication: 2025-10-14

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12938437788.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513415880572084224-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513415778080141312-ja

IP High Court, 2024 (Gyo-Ke) 10016 [Undried tea paste] <Judge Nakadaira>

The decision dismissed a request for retrial of a JPO decision upholding refusal. Although the original decision had not yet become final when retrial was requested, it had become final by the time the decision dismissing that request was issued. The defect arising from the original decision's lack of finality at the time of the request had therefore been cured by the time the dismissal decision was issued.

⇒ The request for retrial could not be dismissed on that ground.

The JPO decision was set aside.

Original article (2025-10-14):

https://lnkd.in/g6kYCnXk

https://ameblo.jp/hideki-takaishi/entry-12938437788.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513415880572084224/

[Copyright / Trade secrets] Osaka District Court, 2020 (Wa) 1539 <Judge Takemiya>

Original Ameblo publication: 2025-10-16

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12938856667.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513416117407719424-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513416000617316353-ja

[Copyright / Trade secrets] Osaka District Court, 2020 (Wa) 1539 <Judge Takemiya>

Even taking into account the importance of the plaintiff's source code, the requirement that information be managed as secret was not satisfied.

Other source code was not submitted because the defendant stated that it did not possess it, and the relevant allegations were not proven.

The modification and deletion of source code for the defendant's products did not constitute obstruction of proof.

https://lnkd.in/gZHnX8np

Original article (2025-10-16):

https://lnkd.in/gyQhQUBh

https://ipforce.jp/Hanketsu/jiken/no/14425

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513416117407719424/

[Unfair Competition Prevention Act] Tokyo District Court, 2023 (Wa) 70513, the “Karate dojo” case <Judge Nakashima>

Original Ameblo publication: 2025-10-16

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12938913611.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513416373658886145-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513416207610507264-ja

[Unfair Competition Prevention Act] Tokyo District Court, 2023 (Wa) 70513, the “Karate dojo” case <Judge Nakashima>

Although the plaintiff's name was not stated, a person acquainted with the plaintiff, or aware that the plaintiff was the owner of the dojo in question, could identify the “dojo owner” in the post as the plaintiff when reading it in the ordinary way.

⇒ Defamation was established.

https://lnkd.in/ga7dKtCr

Original article (2025-10-16):

https://lnkd.in/garx5Y9Z

https://note.com/chosakuken/n/nb150d3957258

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513416373658886145/

[Trademarks / Contracts] Osaka District Court, 2022 (Wa) 7393, “MICHEL JURDAIN” <Judge Takemiya>

Original Ameblo publication: 2025-10-18
Article type: Case note
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12939274105.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7513416996949172224-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513416876903899136-ja

[Trademarks / Contracts] Osaka District Court, 2022 (Wa) 7393, “MICHEL JURDAIN” <Judge Takemiya>

* The injunction claim was partly granted!!

* The bankruptcy trustee's understanding in separate bankruptcy proceedings was rejected.

<Operative part of the judgment, translated>

“The defendants shall not affix any of the marks listed in Schedule 2 to watches, their packaging boxes, or hang tags; or transfer, display for transfer, possess, export, import, or offer through telecommunications networks watches bearing those marks or watches whose packaging boxes or hang tags bear those marks (excluding watches with the product numbers listed in Schedule 7, the list of defendant products manufactured by other companies, that do not have packaging boxes or hang tags bearing those marks).”

An exclusive contractual license to use the trademark, without creation of a statutory exclusive right to use, had been granted.

⇒ Claims for royalties for January and February 2018 had been waived, so termination for nonpayment was not established. The bankruptcy trustee's assessment was not based on a detailed investigation and did not establish the absence of a license.

For products made by other companies, the defendant obtained them in unmarked boxes, then made its own boxes bearing similar marks and sold the products in those boxes. The contract prohibited repackaging; doing so without authority infringed the trademark rights.

(Excerpt from the judgment, translated)

The plaintiffs point out that Elim Trading did not pay royalties for January and February 2018 and that its trustee in separate bankruptcy proceedings proceeded on the premise that Elim Trading had no license as of January 18, 2018.

However, Andrews waived the claims for those royalties (Exhibit Otsu 16). It cannot therefore be found that the licensing agreement had been terminated for their nonpayment.

It is true that the trustee's first report on key aspects of the administration, dated May 28, 2018, stated that Elim Trading transferred the defendant products to defendant Marushu around the end of January, and Marushu unilaterally valued them at 50% of book value and offset that amount against its trade receivables. The trustee regarded this as payment in kind but did not treat it as subject to avoidance, considering the difficulty of selling the goods because of the trademark-license issue (Exhibit Ko 14). However, the trustee had not investigated the contractual relationship between Elim Trading and Andrews in detail. A purchaser of movable property had merely said, upon appraisal, that a license was needed. The trustee's assessment therefore does not, in itself, establish that Elim Trading had not been granted a license.

Original article (2025-10-18):

https://lnkd.in/g9nU-HeU

https://ameblo.jp/hideki-takaishi/entry-12939274105.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513416996949172224/

[Unfair Competition Prevention Act / Contracts] Osaka District Court, 2023 (Wa) 886 <Judge Takemiya>

Original Ameblo publication: 2025-10-19
Article type: Case note
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12939458003.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7513417362101084161-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513417095313977344-ja

[Unfair Competition Prevention Act / Contracts] Osaka District Court, 2023 (Wa) 886 <Judge Takemiya>

* The contractual warranty was held to cover only the goods sold, not finished products incorporating those goods.

(Summary of the judgment, translated)

Article 6(1) of the basic agreement for purchasing components provides that the defendant warrants legal compliance, quality, and other matters concerning the “Products” it sells to the plaintiff (LED boards and other components of a chlorine-dioxide-generating unit).

Article 6(2) provides that the plaintiff warrants representations concerning products it makes incorporating that unit, excluding the Products themselves.

Article 19 expressly provides that the plaintiff is responsible for promoting the finished products and for complying with the Act against Unjustifiable Premiums and Misleading Representations and other laws.

Given this wording and structure, the defendant's warranty is confined to the Products themselves and does not extend to representations on the retail packaging and elsewhere for the finished products sold by the plaintiff (the Cleverin products at issue).

Even if that packaging carried representations misleading consumers about quality in violation of that Act, the plaintiff bears contractual responsibility; the defendant has no warranty obligation.

The plaintiff argued that the defendant was responsible for the representations because it gave detailed instructions and supplied the core components. However, it was not established that the defendant took the lead in determining the design in a relationship that bound the plaintiff to follow it. Although the defendant made suggestions and supplied materials, the plaintiff prepared the original designs and made the final decisions. The plaintiff was therefore responsible for the representations.

The plaintiff's proposed interpretation that “the defendant warrants the portions of the representations concerning the Products” also cannot be adopted. Even if the finished-product packaging includes an explanation of the Products, that does not make it a representation for the Products themselves, nor can the defendant be said to have been responsible for making it.

Original article (2025-10-19):

https://lnkd.in/gXRnJ5eX

https://ameblo.jp/hideki-takaishi/entry-12939458003.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513417362101084161/

Tokyo District Court, 2023 (Wa) 70393 [Foldable and stowable temporary protective fence] <Judge Nakashima>

Original Ameblo publication: 2025-10-20

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12939664008.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513417723817930752-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513417554057510913-ja

Tokyo District Court, 2023 (Wa) 70393 [Foldable and stowable temporary protective fence] <Judge Nakashima>

* The problem was to reduce weight and make the structure more compact.

⇒ A “pivoting plate-shaped member” is a thin, plate-like member and does not include a circular pipe or rectangular tube.

(Excerpt from the judgment, translated)

Considering the term “plate-shaped” in the “pivoting plate-shaped member” recited in the claim elements, that member solves the problems addressed by the inventions by making the pivoting member plate-shaped and thereby reducing its thickness in the transverse direction of the base frame (H-section steel). It is therefore properly construed as a thin, plate-like member that does not include a circular pipe or rectangular tube.

The defendant's product uses a rectangular tube as the structure corresponding to the “pivoting plate-shaped member.” It therefore cannot be found to satisfy that element.

Figures: see the original article.

Original article (2025-10-20):

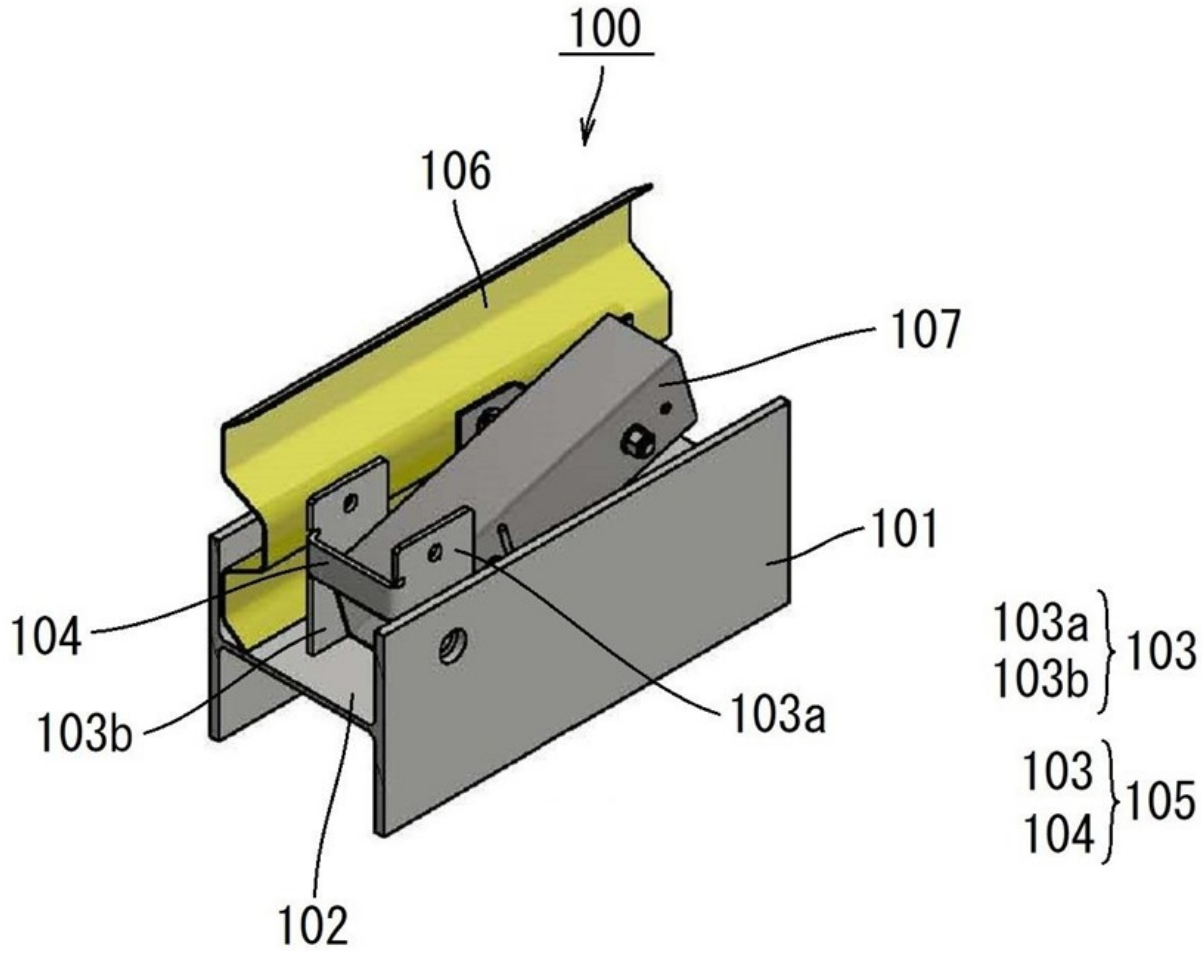
https://lnkd.in/g7s2xMKn

https://ameblo.jp/hideki-takaishi/entry-12939664008.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513417723817930752/

Images from the original AMEBLO article

Original images retained for comparison



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12939664008.html

[Copyright / Quotation] Tokyo District Court, 2023 (Wa) 70388 <Judge Nakashima>

Original Ameblo publication: 2025-10-21

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12939868238.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513418111178457088-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513417920920629250-ja

[Copyright / Quotation] Tokyo District Court, 2023 (Wa) 70388 <Judge Nakashima>

An SNS post describing a “most vicious tag team.”

⇒ Permissible quotation was established.

1. Purpose of use

The defendant used an article in the Seikyo Shimbun, to which the defendant subscribed, to criticize Soka Gakkai. The critical purpose was clear, and a connection between the article and the criticism was recognized.

2. Method and manner

Only one image, showing a single photograph together with the article, was taken and posted. This was not indiscriminate, comprehensive reproduction. The article and criticism corresponded in each post.

3. Nature of the work

The photographs published in the Seikyo Shimbun were news photographs depicting meetings, people and similar subjects, and their compositions were generally commonplace. The posted images were coarse and omitted fine details. The court therefore held that, even if the original photographs contained creative expression, only a very small part of that expression had been reproduced.

4. Form of use

The posted photographs were coarse and unclear, with details difficult to distinguish. They were not independently suitable for appreciation, and the likelihood of secondary use was low.

5. Effect on the copyright holder

No loss of economic benefit to the plaintiff from the posts was established. The photographs were not made available in high resolution for third-party use.

6. Identification of the source

The defendant indicated the source by expressly mentioning “Seikyo Shimbun” or including those words in the photographed image. Ordinary readers could sufficiently identify the source.

Japan Uni Copyright Center / Full judgment, September 26, 2024

https://lnkd.in/g5nwdsy8

Figures: see the original article.

Original article (2025-10-21):

https://lnkd.in/g2P8kEEq

https://jucc.sakura.ne.jp/precedent/precedent-2024-09-26.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513418111178457088/

Images from the original AMEBLO article

English translations of the original image text

5 URL (omitted)

Date and time of post: March 16, Heisei 31 (2019), 6:34 a.m.

Account name: @B

Text:

Today’s “Suntetsu”

“3·16,” which engraves the spirit of mentor and disciple. Those who live by their vows are strong! Young people, now is the time to rise.

“3·16,” which engraves the spirit of mentor and disciple? A strange newspaper that gives greater coverage to the cornerstone-laying ceremony for the “World Seikyo Center” than to vows.

Legible newspaper headings:

Soka Gakkai — Cornerstone-laying ceremony for the “World Seikyo Center”

President Harada, General Director Hasegawa and others attend

The newspaper headquarters that undertakes the battle of words for justice
[text cut off]

3·16 “Kosen-rufu Commemorative Day”

A message from Ikeda Sensei; the youth division pledges to carry on
[text cut off]

Toward opening in November of this year

Annex — List of posted articles

1 URL (omitted)

Date and time of post: October 22, Heisei 30 (2018), 8:11 a.m.

Account name: @B

Text:

The most vicious tag team

(Editor's transcription and correction of the figure above)

5 URL (omitted)

Date and time of post: March 16, 2019, 6:34 a.m.

Account name: @B

Text:

Today’s “Suntetsu”

“3·16,” which engraves the spirit of mentor and disciple. Those who live by their vows are strong! Young people, now is the time to rise.

“3·16,” which engraves the spirit of mentor and disciple? A strange newspaper that gives greater coverage to the cornerstone-laying ceremony for the “World Seikyo Center” than to vows.

Legible newspaper headings:

Soka Gakkai — Cornerstone-laying ceremony for the “World Seikyo Center”

President Harada, General Director Hasegawa and others attend

The newspaper headquarters that undertakes the battle of words for justice …

3·16 “Kosen-rufu Commemorative Day”

A message from Ikeda Sensei; the youth division pledges to carry on …

Toward opening in November of this year

Annex — List of posted articles

1　URL (omitted)

Date and time of post: October 22, 2018, 8:11 p.m.

Account name: @B

Text:

The most vicious tag team

Original images retained for comparison

5　URL　　（省略）

投稿日時　　平成31年3月16日　午前6:34

アカウント名　　@B

本文

今日の「寸鉄」

師弟の魂刻む「3・16」。誓願に生きる人は強し！青年よ立ち上がる時は今

師弟の魂刻む「3・16」？誓願より「世界聖教会館」定礎式の扱いが大きい不思議な新聞



別紙

投 稿 記 事 目 録

1　URL　　（省略）

投稿日時　　平成30年10月22日　午前8:11

アカウント名　　@B

本文

最凶タッグ



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12939868238.html

IP High Court, 2023 (Gyo-Ke) 10100 [Gas-scrubber fluid purification apparatus] <Judge Hibiku Shimizu>

Original Ameblo publication: 2025-10-23

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12940386808.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513418760431607809-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513418313813618688-ja

IP High Court, 2023 (Gyo-Ke) 10100 [Gas-scrubber fluid purification apparatus] <Judge Hibiku Shimizu>

The technical significance of the inventions lies in purifying scrubber fluid with a disk-stack centrifuge to reduce maintenance burdens and waste volume, and in reducing problems such as buildup and clogging by circulating the fluid through a buffer tank. The court noted that the specification did not explain the technical significance of the buffer tank being “independent of the exhaust gas conduit.”

By contrast, there was no motivation in the cited invention to provide a “buffer tank” separately from the “gas scrubber.”

⇒ Inventive step upheld.

Original article (2025-10-23):

https://lnkd.in/gvxH2VGY

https://ameblo.jp/hideki-takaishi/entry-12940386808.html

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513418760431607809/

IP High Court, 2024 (Gyo-Ke) 10014 [Acceleration recovery generator] <Judge Miyasaka>

Original Ameblo publication: 2025-10-24

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12940647277.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513419341078401025-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513418920406556672-ja

IP High Court, 2024 (Gyo-Ke) 10014 [Acceleration recovery generator] <Judge Miyasaka>

[Outline of the configuration of Claim 1]

A motor drives a weight at the end of an arm through: (1) acceleration → (2) high-speed rotation on the front side → (3) deceleration (recovering “surplus energy” through regenerative braking) → (4) low-speed rotation on the rear side.

⇒ The angular velocity in (2) is the “rated operating angular velocity.” The difference in centrifugal force between (2) and (4) provides propulsion, while (3) generates electricity.

The applicant argued, among other things, that “classical mechanics is flawed” and that “a unidirectional force F can be generated with constant power consumption.” On that premise, the applicant treated consumed energy E1 as a linear function of t and kinetic energy E2 as a quadratic function of t, so that E2 would exceed E1. The court held, however, that generating a constant force F requires E1 also to increase as a quadratic function of t. The premise was therefore incorrect, and the claimed invention violated the law of conservation of energy.

⇒ The claimed subject matter did not qualify as an invention, and the enablement requirement was not satisfied.

https://lnkd.in/gWesxspA

Original article (2025-10-24):

https://lnkd.in/gttmFzxp

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93413.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513419341078401025/

[Article / Contracts] Examination of provisions in joint patent application agreements between universities and companies (Minoru Tokita, Intellectual Property Management, Vol. 75, No. 5, 2025)

Original Ameblo publication: 2025-10-31

Article type: Publication review

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12942204974.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513419858278031360-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513419555235434496-ja

[Article / Contracts] Examination of provisions in joint patent application agreements between universities and companies (Minoru Tokita, Intellectual Property Management, Vol. 75, No. 5, 2025)

The obligation to notify the other party of improvement inventions should apply only where at least one inventor is shared with the original invention, and only until publication.

Profits should be allocated to the university only after they exceed half of the filing and related costs borne by the company.

The party abandoning its rights should bear the costs of abandonment.

https://lnkd.in/g9ZBXupT

Original article (2025-10-31):

https://lnkd.in/gjQEj3Au

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513419858278031360/

[Article / Contracts] Agreements concerning the handling of joint applications, etc. (Katsumi Sakurai, Intellectual Property Management, Vol. 61, No. 2, 2011)

Original Ameblo publication: 2025-11-01

Article type: Publication review

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12942513778.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513028316359139329-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513027684252151808-ja

[Article / Contracts] Agreements concerning the handling of joint applications, etc. (Katsumi Sakurai, Intellectual Property Management, Vol. 61, No. 2, 2011)

Points to check

• Existing agreements

• Commencement of the agreement

• Licensing to third parties

• Subcontracting

• Divisional applications, conversion of applications, and foreign applications

Compensation to universities for non-working (the corporate perspective)

Commercialization risk

Corporate efforts beyond the particular project

A product cannot be made viable by that patent alone

* This article was written by someone from a company, and its corporate perspective is informative.

https://lnkd.in/gnVd-ahk

Original article (2025-11-01):

https://lnkd.in/gxQhgFCQ

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513028316359139329/

[IP Practice Online] A compass for succeeding in future markets: How to turn IP landscaping into a management tool (Hiroshi Hirose, patent attorney, Ebara Corporation)

Original Ameblo publication: 2025-11-03

Article type: Lectures and videos

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12942839535.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513028759889985536-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513028596878204928-ja

[IP Practice Online] “A compass for succeeding in future markets: How to turn IP landscaping into a management tool” (Hiroshi Hirose, patent attorney, Ebara Corporation)

* A must-watch video that examines, from an internal corporate perspective and with consultants' roles also in mind, the approach to involving the IP department efficiently in management strategy that Mr. Akutsu of Shimadzu discussed at the end of his presentation!!

IP departments should make use of their unique strengths: (1) the ability to understand technological trends chronologically, (2) the ability to give concrete form to abstract concepts, and (3) knowledge of contractual matters.

New business proposals must go beyond technical ideas to flesh out business viability and market potential, bringing them to a level capable of persuading those with approval authority.

In organizational terms, a top-down approach from management is ideal. Even without it, however, bottom-up success is possible by establishing a dedicated IPL organization and having it work closely with business divisions and development departments as an integrated trio.

(Episode 261) IP Practice Online: “A compass for succeeding in future markets: How to turn IP landscaping into a management tool” (Guest: Hiroshi Hirose, Development and Intellectual Property Department, Technology Division, Precision Machinery Company, Ebara Corporation)

https://lnkd.in/gmyjATF5

Original article (2025-11-03):

https://lnkd.in/gvuh77Hv

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513028759889985536/

[Video introduction] Generative AI and prompt-driven reform in Shimadzu's IP operations [Koji Akutsu] [Summaria webinar]

Original Ameblo publication: 2025-11-03

Article type: Lectures and videos

Topics: AI and intellectual property / IP management / Patent drafting and translation

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12942839630.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513029162211885056-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513028913489518592-ja

[Video introduction] Generative AI and prompt-driven reform in Shimadzu's IP operations [Koji Akutsu] [Summaria webinar]

Annual cost savings exceeding JPY 100 million

As with the move to paperless operations, reform was pushed forward by overcoming resistance.

The approach is to replace the specialized work itself—“intellectual work that can be expressed as logic”—with AI. Prompts shared throughout the company were developed.

First, translations for foreign applications were brought in-house.

ChatGPT was initially used, but inconsistent terminology and omitted paragraphs led to a switch to a large Gemini model, improving quality.

Next, AI replaced local counsel's analysis during foreign patent prosecution.

Using NotebookLM, only PDFs of the office action, cited references, and the invention in the application are provided. Restricting the information suppresses hallucinations and enables highly accurate analysis and preparation of proposed amendments in about two minutes.

For the “invention disclosures” prepared by inventors, development materials (PDFs, PowerPoint files, etc.) are entered into Gemini Deep Research. It extracts the inventive technology and organizes the problems, solutions, and effects, then automatically conducts a prior-art search and prepares claim charts based on that information.

This allows the essential aspects of an invention to be identified and searched in about 15 minutes.

Work has also begun on automating specification drafting.

Based on the invention's configuration, refined through a prior-art search, AI automatically generates the specification's “prior art,” “problems,” and “effects,” as well as embodiments and even the claims (independent and dependent).

Preparing drawings remains difficult.

For FTO (third-party patent clearance) searches, product specifications are also extracted automatically from development materials. AI (the GPT-4o API) then compares and assesses every claim in a set of several thousand patents retrieved using a broad search query against the product specifications.

This has drastically reduced the work previously requiring researchers to read 100,000 documents annually, narrowing the cases down to those the IP department needs to review (triangle and circle ratings).

“Prompts” are at the heart of these reforms.

Creating prompts means putting experienced staff's tacit knowledge (decision logic) into words and converting it into explicit knowledge.

The speaker emphasizes three measures against hallucinations: (1) selecting a model suited to the work, (2) giving instructions in very fine-grained steps, rather than only stating the goal, and (3) restricting input information to create a closed information environment.

Looking ahead, he anticipates an era in which AI will devise patent strategies from management strategies and development plans and output them together with specifications. AI cannot assume responsibility or exercise authority; humans must make the final judgments.

https://lnkd.in/g6Fa8K52

Original article (2025-11-03):

https://lnkd.in/gUrSQDYt

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513029045849317376/

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513029162211885056/

[United States] HOOP v. HOOP (Fed. Cir., 279 F.3d 1004) (2002)

Original Ameblo publication: 2025-11-05

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12943352669.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513029827914895361-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513029403845705729-ja

[United States] HOOP v. HOOP (Fed. Cir., 279 F.3d 1004) (2002)

Determining inventorship (design authorship) for U.S. design patents

⇒ At the preliminary-injunction stage, the court upheld the finding that the later design was likely to be found similar to, and merely a refinement and completion of, the earlier design, rather than a separate invention (design). Final resolution of that factual question was left for the trial on the merits.

★ This connects to determining inventorship (design authorship) for inventions (designs) created using AI!!

https://lnkd.in/g66tzbWc

Original article (2025-11-05):

https://lnkd.in/ghHiMs6N

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513029827914895361/

[Article / United States] Determining inventorship (design authorship) for U.S. design patents (Tsuyoshi Fujimoto, AIPPI (2025), Vol. 70, No. 10)

Original Ameblo publication: 2025-11-06

Article type: Publication review

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12943532367.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513030045985226753-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513029958471139328-ja

[Article / United States] Determining inventorship (design authorship) for U.S. design patents (Tsuyoshi Fujimoto, AIPPI (2025), Vol. 70, No. 10)

USPTO guidance

α: A design created by a natural person is input into AI.

⇒ If the AI output is similar, the natural person is the inventor (design author).

β: A natural person finishes a design created by AI.

⇒ If the finished design is dissimilar to the AI-created design, the natural person is the inventor (design author).

Cites HOOP v. HOOP (Fed. Cir., 279 F.3d 1004) (2002).

[Update] The USPTO's February 13, 2024 Inventorship Guidance for AI-Assisted Inventions was rescinded and replaced by revised guidance that the USPTO announced on November 26, 2025 and that was published in the Federal Register on November 28, 2025 (90 FR 54636). The current guidance applies the ordinary conception standard regardless of whether AI was used.

Original article (2025-11-06):

https://lnkd.in/gaYEPT2e

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513030045985226753/

[United States] FMC v. Sharda (CAFC, August 1, 2025)

Original Ameblo publication: 2025-11-07

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12943750560.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513030238377951232-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513030131834273792-ja

[United States] FMC v. Sharda (CAFC, August 1, 2025)

During prosecution, a provisional application was first filed containing several teachings that the disclosed compositions were stable.

Subsequently, all references to stability were deleted from the common specification of the two asserted patents.

The CAFC held that, in view of those deletions in the prosecution history, a person skilled in the art would not understand the compositions recited in the asserted patents' claims to cover only stable formulations.

(Lesson) The history of deleting limiting statements from the original specification may weigh against a narrow claim construction. Such deletion does not invariably prevent a narrow construction.

⇒ Would the same apply in Japan? What about concerns over extending the scope of disclosure or adding new matter?

https://t.co/dOorQsAGU9

Original article (2025-11-07):

https://lnkd.in/gVCp5jiQ

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513030238377951232/

[IP Practice Online] “Analysis” is changing: The world of patent analysis evolving with generative AI (Yutaro Uemura, LeXi/Vent Co., Ltd.)

Original Ameblo publication: 2025-11-10

Article type: Lectures and videos

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12944455998.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513030465075924993-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513030350793531393-ja

[IP Practice Online] “Analysis” is changing: The world of patent analysis evolving with generative AI (Yutaro Uemura, LeXi/Vent Co., Ltd.)

(1) AI output depends heavily on the quality of the instructions (prompts) it receives, making prompt-engineering skills essential.

(2) Selection of the “patent population” (input data) underlying the analysis determines the reliability of the results.

(3) Issues include hallucinations (generation of fictitious patent numbers or factual errors), risks of confidential information leakage, copyright infringement, and biases inherent in AI.

https://lnkd.in/gpQw-zsJ

Original article (2025-11-10):

https://lnkd.in/gnu3nwvA

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513030465075924993/

Osaka District Court, 2023 (Wa) 8403 [Ventilation structure beneath a coping] <Takemiya>

Original Ameblo publication: 2025-11-10
Article type: Case note
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12944456599.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7513030720752283649-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513030601713586176-ja

Osaka District Court, 2023 (Wa) 8403 [Ventilation structure beneath a coping] <Takemiya>

* For a person skilled in the art, the natural construction of “ventilation member” is that the member itself has “ventilation performance and waterproofing performance.” This is also consistent with the specification.

⇒ The claim element was not satisfied.

(Excerpt from the judgment, translated)

For a person skilled in the art, the natural construction of the “ventilation member” specified in claim element C is that at least the member itself must have “ventilation performance and waterproofing performance.” This is also consistent with the specification.

(b) The ventilation structure beneath a coping incorporating the defendant's product is outlined in item 2 of the attached “Drawings.” The plaintiff argues that inclined portion ⑤ corresponds to “a ventilation member that exhibits ventilation performance and waterproofing performance.” However, even if inclined portion ⑤ could qualify as something placed inside the “member beneath the coping” (first vertical portion ① through second horizontal portion ④), it is a plate made of Galvalume steel (the entire import of the oral argument), and inclined portion ⑤ itself cannot be found to have air permeability as a material. A certain space is secured between the upper part of inclined portion ⑤ and the first horizontal portion. Although that space may be regarded as a ventilation passage, it cannot be said to constitute the “ventilation member” (or part of it); the plaintiff, too, argues that inclined portion ⑤ corresponds to the “ventilation member.” The “ventilation member” therefore cannot be construed as having ventilation performance. Inclined portion ⑤ provides a blocking function (waterproofing performance) through its shape, including its inclination, and clearly narrows the area through which air can pass. It cannot be found to exhibit ventilation performance as a “ventilation member.”

Accordingly, the ventilation structure beneath a coping incorporating the defendant's product does not satisfy the “ventilation member that exhibits ventilation performance ...” in claim element C.

https://lnkd.in/g5qdZQcU

Original article (2025-11-10):

https://lnkd.in/gTveZbQt

Source material

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[IP Practice Online] “Counterfeits defeated even at China's Supreme Court! A thorough explanation of the keys to victory with the actual inventor” (Denka Company Limited / Yasuki Ito and Shunichi Sugawara, patent attorney)

Original Ameblo publication: 2025-11-10
Article type: Lectures and videos
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12944457316.html
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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513030863744409601-ja

[IP Practice Online] “Counterfeits defeated even at China's Supreme Court! A thorough explanation of the keys to victory with the actual inventor” (Denka Company Limited / Yasuki Ito and Shunichi Sugawara, patent attorney)

The inventor and the IP department's section manager look back on more than seven years of experience leading to victory at China's Supreme People's Court and explain practical lessons.

1. Litigation

In China, invalidity cannot be asserted as a defense in infringement litigation (as in Germany).

When sued for infringement, a defendant may respond by requesting invalidation before the patent office. Such a request does not automatically stay the infringement proceedings; in a dispute concerning an invention patent, the court may decide not to stay the proceedings.

In infringement litigation in China, using notarization throughout acquisition, opening, transportation, and analysis of suspected counterfeit products is important for preserving the identity and authenticity of the evidence. However, a notary’s presence throughout every stage is not a uniform legal requirement for all evidence submitted to a court.

China uses “judicial appraisal,” in which a third-party institution designated by the court conducts the analysis.

To prepare for this appraisal, Denka selected a reliable analytical institution in advance, had the inventor provide technical guidance, and prepared accurate, notarized analytical data.

This preparation helped steer the subsequent judicial appraisal results in Denka's favor.

2. Invalidation proceedings

(1) Enablement was challenged on the basis of another patent for which Denka applied after the patent at issue, and a paper by the inventor.

(2) To enhance the patent's reliability, the specification identified specific manufacturers and product names, such as “manufactured by XX, product name XX” for reagents. This was effectively providing counterfeiters with a “recipe.”

(3) It proved advantageous that, when filing the PCT application, the inventor had added experimental data showing that “although incomplete, even one component can be separated.”

https://lnkd.in/gTrrRRab

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IP High Court, 2005 (Gyo-Ke) 10099 [Image processing system]

Original Ameblo publication: 2025-11-11

Article type: Case note

Topics: Added matter / Divisional applications

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12944690873.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513031248231956480-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513031104174391298-ja

IP High Court, 2005 (Gyo-Ke) 10099 [Image processing system]

* Even if a person skilled in the art could understand the subject matter from the parent's original specification sufficiently to implement it readily, that did not mean the invention was disclosed there. The divisional-application requirements were therefore not met.

(Excerpt from the judgment, translated)

A straightforward reading of the above passages of the original specification of the parent application shows that the “digital image data” of the invention described there consists solely of digital image data obtained by reading images on developed negative film. No other “digital image data” is described.

… At the time of the parent application, it was well known (1) that various devices, including television cameras, scanners, electronic cameras and video cameras, could create digital image data, and (2) that image-processing devices such as personal computers could perform prescribed processing on digital image data produced by any of those devices. However, as described above, the image-processing system disclosed in the original specification of the parent application includes scanner means that read images on film and convert them into digital image data, and is characterized by transmitting the processed digital image data to the laboratory system for printing. Accordingly, although television cameras, electronic cameras and video cameras were generally known as devices for creating digital image data, the original specification of the parent application did not disclose any such means as a component of the apparatus, or any device for importing into the image-processing system the digital image data created by those means. Therefore, it cannot be said to have been obvious from the original specification that digital image data obtained from television cameras, electronic cameras or video cameras would be edited by the photographer, transmitted to a laboratory system and printed. …

Even if an image-processing system for digital image data created by an electronic camera or the like and an image-processing system for digital image data obtained by reading an image on film have the same purpose and effect, if the means for inputting the digital image data differ, the systems or apparatuses plainly differ in configuration in that respect. The fact that two inventions having different configurations have the same purpose and effect does not make them the same invention. It therefore cannot be concluded from statements of purpose and effect that the original specification disclosed an invention in which “digital image data are not limited to data obtained by scanning exposed negative film.” … Even if the transmission-data configuration or transmission system forming part of the image-processing system did not limit “digital image data,” the original specification contained no disclosure of “digital image data” other than those obtained by reading images on developed negative film. It therefore cannot be said that the original specification disclosed an invention absent from that disclosure—namely, an invention in which the “means for reading a target image and converting it into digital image data” was not limited to scanner means. …

Even if a person skilled in the art (a person having ordinary knowledge in the technical field to which the invention belongs) could understand from the original specification, to an extent permitting ready implementation, that the “digital image data” may be data formed by an electronic camera or the like and is not limited to a scanner, that does not mean the original specification described an invention in which the “means for reading a target image and converting it into digital image data” is not limited to scanner means.

https://lnkd.in/gnWiKGzD

Original article (2025-11-11):

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Intellectual property consultation guide

Originally posted on LinkedIn: https://www.linkedin.com/feed/update/urn:li:activity:7513031360299692033/

IP High Court, 2005 (Gyo-Ke) 10420 [Information supply system using a communication line] <Shinohara>

Original Ameblo publication: 2025-11-12

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12944999497.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513031589426040832-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513031469393539072-ja

IP High Court, 2005 (Gyo-Ke) 10420 [Information supply system using a communication line] <Shinohara>

* Even if obvious, domestic priority was denied.

(Excerpt from the judgment, translated)

... The matter need not necessarily be expressly stated in the specification. However, the purpose of the priority system is to provide the benefit of the earlier filing date for matters disclosed in the specification of the priority application. Matters equivalent to being described must therefore be distinguished from matters readily recognizable from the description. Even if the Internet was widely known and a person skilled in the art reading the priority specification recognized that the Internet could be used to implement the invention of the priority application, that alone is insufficient to deem it equivalent to having been described. To qualify as a matter equivalent to being described, it must be self-evident to the extent that a person skilled in the art would recognize it as naturally being described in the specification. It is clear that the priority specification does not meet that standard.

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[United States] LAB v. Qiagen (CAFC, August 13, 2025)

Original Ameblo publication: 2025-11-13

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12945245671.html

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513031693528834048-ja

[United States] LAB v. Qiagen (CAFC, August 13, 2025)

When claim language differs within a claim depending on whether a modifier is included, the different wording is understood to have been chosen deliberately.

Where a claim contains both “partially matching” and “matching,” a partial match was held insufficient to satisfy “matching,” and the claim element was found not satisfied.

* Lesson: Where “partially matching” and “matching” coexist, clarify the technical meaning of the distinction and the intended scope. If both are intended to include partial matches, reflect that intention consistently in the respective terms.

https://www.cafc.uscourts.gov/opinions-orders/23-2350.OPINION.8-13-2025_2557800.pdf

Original article (2025-11-13):

https://lnkd.in/gZ97CNHm

Judgment (English original)

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Tokyo District Court order, 2023 (Yo) 30402 [Siphon rain-gutter system] <Nakashima>

Original Ameblo publication: 2025-11-14

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12945513246.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513032113068261376-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513031962232516608-ja

Tokyo District Court order, 2023 (Yo) 30402 [Siphon rain-gutter system] <Nakashima>

* Based on the specification's explanation and other material, the claim term “lid member” was construed as not requiring complete closure.

⇒ The claim element was satisfied.

(Excerpt from the decision, translated)

... According to the claim elements and the descriptions in Specification 2, the “lid member” in the claim element includes shapes not positioned so as to close the outlet opening completely. It is sufficient for the member to be positioned above the outlet. ... Applying this to the respondent's product, ... although its outlet-facing portion is not positioned to close the outlet opening completely, it is found to be positioned above the outlet. Accordingly, the outlet-facing portion of the respondent's product satisfies the “lid member” in claim element 2-2-D. ...

* Action on the merits: 2023 (Wa) 70402

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[Overview] Patent Examination Standards Working Group: Disclaimer amendments and AI-related examination issues (November 17, 2025)

Original Ameblo publication: 2025-11-16

Article type: Legal and examination updates

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12946063025.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513032373446324224-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513032254009331712-ja

November 17, 2025

Industrial Structure Council, Intellectual Property Committee, Patent System Subcommittee

18th Meeting of the Working Group on Patent Examination Standards

<Document 1> Recent initiatives concerning examination standards

A report investigating the technological level of generative AI, the use of AI, and whether inventions exist without human involvement was published in April 2024. The survey identified issues including effects on inventive-step assessments and disclosure requirements, determination of inventorship where human involvement is limited, and requests to recognize AI as a rights holder.

<Document 2> Planned revisions to examination standards

Addressing “disclaimer claims”: Amendments excluding certain matters from claims to overcome grounds for rejection are increasing, and there are numerous concerns about how they are being used. Reviewing the examination standards to clarify the approach is under consideration.

<Document 3> Approach to amendments introducing “disclaimer claims”

Such amendments have recently increased, and individual companies and relevant organizations have expressed concerns about their use.

The JPO is preparing drafting examples for examiners, introducing checks by managers, and communicating points requiring attention.

Effect on inventive step: Excluding the portion overlapping with a cited invention can overcome lack of novelty. For inventive step, however, whether a person skilled in the art could readily arrive at the claimed invention from the cited invention must be considered anew. If inventive step is still lacking, a decision of rejection will issue.

Even if an essential configuration is excluded, inventive step is denied where redesigning it into another configuration falls within the ordinary creative ability of a person skilled in the art.

This working group will examine whether the examination standards need review or revision from the perspectives of inventive step, addition of new matter, clarity, and other issues.

<Reference Document 1> (Committee member Takashi Tanishima)

The Japan Intellectual Property Association's comments note that amendments introducing “disclaimer claims” have increased since the Solder Resist case (the IP High Court's 2008 Grand Panel judgment). Although useful in some situations for obtaining rights, they are sometimes used inappropriately.

Practical issues identified include cases in which inventions inherently lacking inventive step are nevertheless found inventive after such amendments; difficulty using other prior art once one cited reference has been excluded; and prolonged examination through repeated amendments, making third parties' business decisions difficult.

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Source material

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Images from the original AMEBLO article

English translations of the original image text

Example of a case where inventive step is denied even after an essential configuration is excluded

- Even if an amendment excludes a configuration regarded as essential in the cited invention, there are cases where, for a person skilled in the art, rather than the inventor of the cited invention, attempting a design change to some configuration other than that configuration for further improved inventions or the like can be said to be an exercise of the ordinary creative ability of a person skilled in the art.
- Further, even if the configuration was described as essential in the cited invention, there are cases where a teaching away so strong as to completely prevent replacement with any other configuration is not recognized, and where it cannot be said that excluding that configuration in the present invention has an advantageous effect.
- In such cases, inventive step is still denied in accordance with the approach of the current Examination Guidelines.

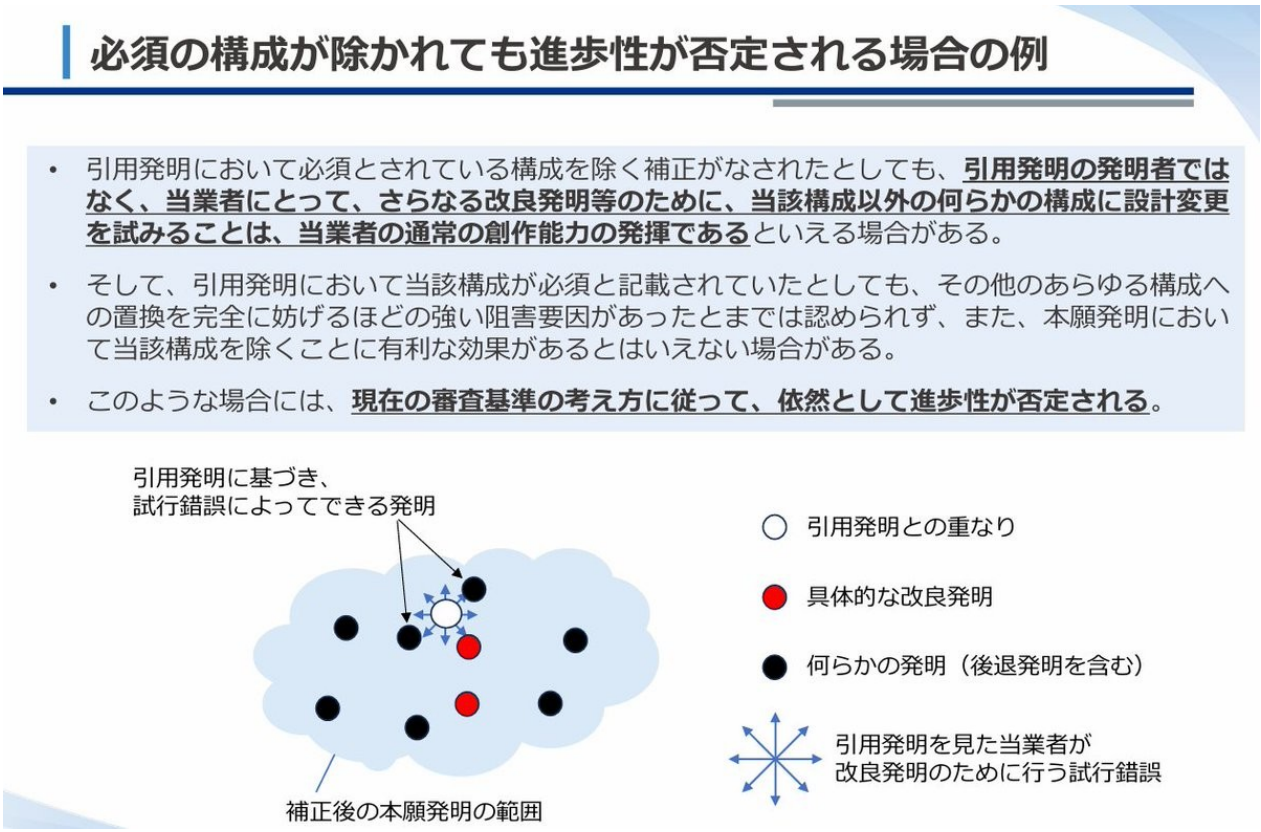
Diagram labels:

Inventions obtainable through trial and error based on the cited invention
Scope of the present invention after amendment

Legend:

Open circle	—	Overlap with the cited invention
Red circle	—	Specific improved invention
Black circle	—	Some invention (including a retrogressive invention)
Multiple arrows	—	Trial and error for an improved invention by a person skilled in the art who has seen the cited invention

Original images retained for comparison



Original AMEBLO article

https://ameblo.jp/hideki-takaishi/entry-12946063025.html

Tokyo District Court, 2023 (Wa) 70346 [Wireless scuff plate] <Nakashima>

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513032486193528832-ja

Tokyo District Court, 2023 (Wa) 70346 [Wireless scuff plate] <Nakashima>

* The claim term “adjustable” was construed as meaning capable of precise adjustment.

⇒ Active “adjustment” is required!!

(Excerpt from the judgment, translated)

Claim element F provides that “the time interval between its on and off states is adjustable.” As to the meaning of “adjustable,” paragraph [0014] of the specification states that “the control module 6 can intelligently adjust the time interval between the on and off states according to the sensing signal,” and paragraph [0019] states that “the control module can switch the light on or off, or control the duration of illumination.” In light of claim element F and those descriptions, and considering the meaning of “intelligently” and “control” in the specification, it is appropriate to construe “adjustable” in claim element F as meaning capable of precisely adjusting the “duration of illumination.” ...

In the defendant's products ..., when the backlight module is left in the on (illuminated) state, it gradually dims and goes out. This happens because the module is affected by charging or discharging of the connected capacitor, rather than because the time until it goes out is controlled through a control circuit or control program for precisely adjusting the duration of illumination. ...

https://lnkd.in/gjzeY7xf

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https://lnkd.in/gpGxpNcn

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Osaka District Court, 2022 (Wa) 11025 [Porous air-permeable bag containing food for mites]

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513032763835482114-ja

Osaka District Court, 2022 (Wa) 11025 [Porous air-permeable bag containing food for mites]

* The invention has a structure capable of retaining the attractant inside.

⇒ In the defendant's product, the mite attractant is merely sandwiched between two superposed nonwoven sheets, gauze, etc., and can spill out around their periphery. The claim element was therefore not satisfied.

* ... Is the defendant's product really like that? Should experiments or other evidence have been used to prove that the attractant does not spill out?

(Excerpt from the judgment, translated)

According to the above descriptions in the specification, the invention aims to provide a high capacity to capture mites. Its means are to attract mites over a wide area by diffusing a mite attractant from a woven sheet impregnated with it, and then to place inside the mat adhesive tape for capturing mites and porous air-permeable bags containing food for mites, attached to the tape in a staggered arrangement. This causes the attracted mites to enter further into the interior from both the front and back surfaces of the mat, contact the adhesive tape, and be captured there. The configuration impregnates the woven sheet with “fragrance” as a substance for attracting mites and places porous air-permeable bags containing “food” on both the front and back surfaces of the double-sided adhesive tape, thereby luring the mites inside the porous air-permeable cover and causing them to contact the unmixed adhesive layer and be captured. Thus, in the invention, the “porous air-permeable bag” is envisaged as having the function of keeping the food in the same location without reducing the adhesive strength of the adhesive layer. In addition, the structure of the bag allows a single bag to accomplish these functions and reduces the number of constituent materials.

In light of the foregoing, both the dictionary meaning and the specification make it appropriate to construe the “porous air-permeable bag” in claim element A-3 as requiring at least a structure capable of retaining its contents inside and preventing their dispersion. In the defendant's product sold, however, the mite attractant is merely sandwiched between two superposed nonwoven sheets, gauze, etc., and can spill out around their periphery. It therefore cannot be found to have a structure capable of retaining the attractant inside.

https://lnkd.in/gdV38XWc

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[IP Practice Online] Current state, challenges, and responses in Customs' border enforcement against IP-infringing goods (Attorney Kei Iida)

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[IP Practice Online] Current state, challenges, and responses in Customs' border enforcement against IP-infringing goods (Attorney Kei Iida)

Current import-suspension results for IP-infringing goods

China accounts for approximately 80% of cases by country of shipment.

In the 2024 import-suspension results, goods infringing trademark rights accounted for 93.6% of the aggregate number of suspension cases counted by type of intellectual property right, with cases involving multiple rights counted in each relevant category.

The trend toward small consignments is pronounced.

Counterfeiting is becoming more sophisticated. Products with similar, rather than identical, trademarks or appearances, and unbranded copies of designs, are increasing.

Personal imports

For counterfeit goods involving trademark or design rights, treating importation solely as an act by an individual in Japan for personal use created a problem: without a business character, that act did not constitute infringement, making Customs suspension difficult.

To address this, the 2021 amendments to the Trademark Act and Design Act and the 2022 amendment to the Customs Act expressly included within importation an act by “a person in a foreign country” of “causing another person to bring goods into Japan.” Direct shipment of counterfeit goods by overseas e-commerce businesses and others consequently became subject to regulation.

⇒ As this is a clarifying provision, could the same argument be made for patents?

Exhaustion (parallel imports)

Under the 2020 amendment to the Plant Variety Protection and Seed Act, domestic exhaustion is also denied for exports to countries other than designated countries (violations of restrictions on use).

Importation of harvested material obtained from propagating material “propagated without authorization” abroad is unlawful. In Customs practice, importers are expected to be required to prove lawfulness—that the propagation was not unauthorized.

For deterrent effect, I consider that Customs should also display the status of accepted applications in foreign languages and change the current practice under which that information disappears ten days after acceptance.

https://lnkd.in/gJNnppJg

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[IP Practice Online] Intellectual property rights and Customs procedures (Attorney Reiko Tonomura)

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[IP Practice Online] Intellectual property rights and Customs procedures (Attorney Reiko Tonomura)

Customs determination procedures

Customs receives written opinions from both the right holder and the importer (or exporter) and decides whether the goods are infringing.

Even where sales-territory restrictions exist, imports may qualify as “parallel imports of genuine goods” if their quality and source (manufacturer) are the same as those of authorized goods.

For works other than cinematographic works, the right of transfer is exhausted in respect of the original or copy where the statutory conditions, such as a lawful transfer by the copyright owner, are met.

Customs procedures can be used not only to prevent infringing goods from entering Japan but also with a view to coordinating subsequent civil and criminal proceedings.

⇒ Prior consultation with the police and preparation of supporting evidence are important when seeking acceptance of a criminal complaint.

The police are cautious because accepting a criminal complaint requires them to begin an investigation. On the other hand, the prosecution rate following referral to prosecutors is high, at 70–80%.

https://lnkd.in/gdyExtQS

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Article on the same topic — [Article/Patents] Customs and plant breeders’ rights in the years ahead (Reiko Tonomura, Patent, September 2024).

Osaka District Court, 2022 (Wa) 9696 [Method for producing active GcMAF]

Original Ameblo publication: 2025-11-25

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12947974109.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513033653447290880-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513033506227372032-ja

Osaka District Court, 2022 (Wa) 9696 [Method for producing active GcMAF]

* A claim seeking registration of the transfer of a share in the patent right under Article 74(1) of the Patent Act or under the agreement was denied.

⇒ If the other party to joint research is filing an application, the parties should consider whether joint filing is appropriate after checking inventorship, succession to rights, and the agreement, rather than abandoning the issue merely because patentability appears uncertain. Any inference about why joint filing did not occur should be distinguished from established facts.

(Excerpt from the judgment, translated)

... P1 had knowledge and experience in the relevant technical field, as well as his own knowledge of patents and IP management strategies, and sufficiently understood the invention at the time of the discussions. ... After seeking a patent attorney's opinion, ... he confirmed with P3 that Saisei Mirai would abandon seeking a patent for the invention.

(3) In light of this course of events, the plaintiff Saisei Mirai, fully aware of the invention and following discussions with the defendant, decided that it would not obtain rights in (have attributed to itself) the results of the research, including the invention. An agreement was therefore reached through the consultations contemplated by Article 14(1) of the agreement. ...

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Source material

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[IP Practice Online] A surge during COVID-19! Online sales of counterfeits in Asia: Current situation and countermeasures (Patent attorney Tsuyoshi Masutani)

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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513033758799917058-ja

[IP Practice Online] A surge during COVID-19! Online sales of counterfeits in Asia: Current situation and countermeasures (Patent attorney Tsuyoshi Masutani)

Counterfeit sales have become a global business through cross-border e-commerce, rapidly expanding from a market previously centered on China to Southeast Asia and India.

The counterfeit business is becoming more sophisticated and higher in quality.

Impersonation sales using photographs of genuine stores without permission, fabricated consumer reviews, and similar practices are widespread, and platforms' enforcement efforts are reaching their limits.

The prevalence of small-consignment shipping through delivery services also makes infringement harder for brand owners to detect.

The quality of counterfeit products is improving, and manufacturing is speeding up. Copies of the latest products appear on the market almost simultaneously with their launch.

There are also cases involving the outflow of technology or personnel from authorized local factories, or former local agents participating in counterfeit production.

Bad-faith trademark registrations, in which third parties improperly register well-known Japanese trademarks locally, are also a serious problem, particularly in Indonesia and Vietnam.

In China, social networks such as WeChat offer powerful anti-counterfeiting functions for brand owners.

Brand owners can view complaints from other users, including photographs and purchase-location information, and use them to understand infringement across China and gather evidence.

In Southeast Asia, major e-commerce platforms such as Lazada and Shopee, as well as Facebook, have simplified their takedown-request processes.

In Thailand and Vietnam, it is possible to communicate directly with police and Customs personnel through social networks such as LINE.

Customs officers send photographs of suspected counterfeit goods through LINE; brand owners assess authenticity, allowing Customs clearance to be stopped immediately.

https://lnkd.in/g4KyG3FN

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Osaka District Court, 2023 (Wa) 10237 [Tool for slaughtering wild animals]

Original Ameblo publication: 2025-11-27

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948165955.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513034105953878016-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513033995362775040-ja

Osaka District Court, 2023 (Wa) 10237 [Tool for slaughtering wild animals]

* “A rod of a predetermined length that is freely extendable and retractable”

⇒ A fixed-length rod is not included.

(The plaintiff argued that “freely extendable and retractable” means that the length of the rod's functional portion can be changed by changing where it is held.)

(Excerpt from the judgment, translated)

Claim 1 recites “a rod of a predetermined length that is freely extendable and retractable” (claim element A). From that wording, a person skilled in the art can understand that a configuration in which the rod is freely extendable and retractable is indicated.

The specification shows that the problem the invention seeks to solve is, in essence, to enable even a person with limited physical strength to slaughter dangerous wild animals simply and reliably where those animals live. ...

To solve that problem, configuring the rod to extend and retract freely allows the distance from the animal to be adjusted. For example, one can keep a greater distance from birds of prey or, where safety can be ensured, shorten the distance and reliably bring the electrode into contact with the animal's body. ...

Accordingly, a person skilled in the art would understand “a rod of a predetermined length that is freely extendable and retractable” as meaning a rod whose structure allows the length of the rod portion itself to be changed. A fixed-length rod must be regarded as excluded.

https://lnkd.in/gNHhpAmV

Original article (2025-11-27):

https://lnkd.in/gBArgimm

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513034105953878016/

[Unfair Competition / Trade Secrets] Osaka District Court, 2023 (Wa) 2681

Original Ameblo publication: 2025-11-27

Article type: Case note

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948166030.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513034360107855872-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513034227572129792-ja

[Unfair Competition / Trade Secrets] Osaka District Court, 2023 (Wa) 2681

* “For a confidentiality clause to be valid, there must be trade secrets or other information deserving protection”!!

(Note) The quoted statement above is the defendants’ argument as recorded in the judgment, not the court’s holding. The court held that the confidentiality undertaking contained nothing unreasonable and recognized Defendant P2’s duty of confidentiality (see the excerpt from the court’s reasoning below).

⇒ NDA provisions should be drafted so that their scope is construed as extending beyond “trade secrets” under the Unfair Competition Prevention Act.

* The court also rejected liability in general tort because the information was not managed as secret and there were no circumstances in this case requiring consideration of an interest separate from those protected by the Unfair Competition Prevention Act.

(Excerpt from the defendants’ submissions recorded in the judgment, translated)

For a confidentiality clause to be valid, trade secrets or other information deserving protection must exist. However, the copied information at issue lacks, at a minimum, management as secret and usefulness, and the document data at issue is not highly confidential. Neither therefore qualifies as trade secrets or other information deserving protection. Defendant P2 signed and sealed both the undertaking given upon joining the company and the confidentiality undertaking at issue, but the plaintiff never explained their specific contents to him. He should not be subjected to unnecessary and excessive confidentiality obligations on their basis. Accordingly, P2 did not breach a confidentiality obligation by acquiring the copied information or providing the document data.

(Excerpt from the court’s reasoning, translated)

The plaintiff and Defendant P2 had agreed, through the confidentiality undertaking, on the scope of his duty of confidentiality during employment. As the undertaking contained nothing unreasonable, P2 must be regarded as having owed a duty of confidentiality regarding the “confidential information” specified in it.

... In light of the information-management system then in place for information within the plaintiff's operation-management system (including the copied information and document data), both sets of information lacked management as secret and did not constitute “trade secrets” under Article 2(6) of the Unfair Competition Prevention Act. Nor are there circumstances in this case requiring consideration, in relation to acts involving such information, of an interest separate from those protected by that Act.

Accordingly, P2 committed no unlawful act, and the defendants' alleged joint tort, premised on such an act, is not established either.

https://lnkd.in/gJyr8rym

Original article (2025-11-27):

https://lnkd.in/guFb4Rkj

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513034360107855872/

Tokyo District Court, 2024 (Wa) 70106 <Kokubu>

Original Ameblo publication: 2025-11-28
Article type: Case note
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948273109.html
HP: https://www.takaishihideki.com/en/single-post/linkedin-7513034621463306240-en
Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513034506950410242-ja

Tokyo District Court, 2024 (Wa) 70106 <Kokubu>

* An obligation to grant a non-exclusive license under another person's patent was not performed.

⇒ Termination was effective.

(Excerpt from the judgment, translated)

Even where someone grants another person a non-exclusive license without the patent owner's consent, it is possible to obtain the patent owner's authorization after concluding the contract. Thus, even if someone without authority to grant a non-exclusive license grants one to a third party, there is no need immediately to deny the contract's validity between the contracting parties.

However, such a license agreement concerns another person's rights. A person who grants a non-exclusive license despite lacking authority to do so must therefore, under Articles 559 and 561 of the Civil Code, acquire that authority for the non-exclusive licensee.

In this case, ... the agreement included the plaintiff's promise to grant the defendant non-exclusive licenses under the patents at issue. ... Patent 1 is found to be jointly owned by Japan Conservation Engineers & Co., Ltd. and Nihon Sofuken, while Patent 3 is jointly owned by those two companies and Nihon Mikuniya Co., Ltd. Accordingly, as an obligation under the agreement, the plaintiff owed the defendant a duty to obtain from those co-owners the authority to grant non-exclusive licenses for the defendant. ...

However, ... although the plaintiff had been granted an exclusive license under Patent 2 by its sole owner, Nihon Sofuken, the entire import of the oral argument shows that, for Patents 1 and 3, the plaintiff had not obtained the co-owners' authorization to establish non-exclusive licenses for the defendant. The plaintiff therefore failed to perform that obligation. ...

... The requirements for termination following a demand for performance—the plaintiff's nonperformance of its contractual obligation, the defendant's demand for performance within a reasonable period, failure to perform within that period, and a declaration of termination—are satisfied (main clause of Article 541 of the Civil Code). As a result of termination of the agreement, the defendant has no obligation to pay the license fees. ...

https://lnkd.in/gbFBYPUm

Original article (2025-11-28):

https://lnkd.in/g6ayXYz5

Source material

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https://www.linkedin.com/feed/update/urn:li:activity:7513034621463306240/

[New on YouTube] May 28, 2025 (IP LAB)

Original Ameblo publication: 2025-11-29

Article type: Lectures and videos

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948376641.html

HP: https://www.takaishihideki.com/en/single-post/linkedin-7513034859343331328-en

Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513034722898460673-ja

[New on YouTube] May 28, 2025 (IP LAB)

A read-through of the Encyclopedia of Patent Case Law (draft manuscript for the fourth edition), covering “(pharmaceutical) use inventions, the subjective requirements for indirect infringement, incorporating a purpose into a claim, and whether claim elements are satisfied.”

https://lnkd.in/gpdSvX72

Original article (2025-11-29):

https://lnkd.in/gfGdUWwb

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513034859343331328/

[IP Practice Online] An enjoyable discussion of patent claim interpretation (Attorney Masakazu Kobayashi)

Original Ameblo publication: 2025-11-30
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Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948514671.html
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Japanese version: https://www.takaishihideki.com/single-post/linkedin-7513034976284536832-ja

[IP Practice Online] An enjoyable discussion of patent claim interpretation (Attorney Masakazu Kobayashi)

For example, “annular” in the claim phrase “an annular sealing member” is explained in the Kojien dictionary as “a ring-like shape,” “a round shape,” and so forth.

Focusing on “ring-like” and the technical significance of the “sealing function” described in the specification, a patent owner would argue that a shape making one circuit with its ends joined falls within the patent's scope even if the defendant's product is quadrilateral. A concrete example, such as the Osaka Loop Line not being a perfect circle, may also inform interpretation.

The defendant, in contrast, would rely on the definition “a round shape” and circular drawings of the embodiments to argue that the scope is limited to circular shapes.

Likewise, even a seemingly clear term such as “rod-shaped” may give rise to a dispute over whether an L-shaped or conical product can be considered a “rod.” Here, too, interpretation looks beyond mere word definitions to the member's technical significance within the invention—for example, its function of “sliding along a straight elongated hole.”

Claim interpretation can be divided into three categories: (1) the meaning of terms, (2) the integral/separate-member issue (one member or a combination of multiple members), and (3) the whole/part issue (whether the entire item must satisfy a requirement or whether a part suffices).

If the wording alone does not resolve the dispute, the principal battleground moves to the technical significance, problems, and effects described in the specification.

Here, too, disputes arise over the level of generality at which to understand the technical significance—for example, a “sealing function” or the narrower “uniform sealing function.”

Numerically limited inventions are no exception. In a recent case involving a claim requiring “a molecular weight of 700 or more,” literal infringement was strictly denied for a defendant's product with a molecular weight of 699.9.

Even if the number itself is clear, ambiguity in the definition of what is measured (for example, “particle diameter”), the measurement method, product variability, and changes over time can become issues, making interpretation difficult.

In conclusion, claim interpretation involves constructing one's legal argument by drawing on the specification, drawings, prosecution history, and common technical knowledge, while recognizing the ambiguity of language.

https://lnkd.in/gdN9pp2B

Original article (2025-11-30):

https://lnkd.in/gsuXKidZ

Source material

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7513035099232169986/

Tokyo District Court, 2023 (Wa) 70425 [Information Processing Apparatus] <Nakashima>

Original Ameblo publication: 2025-12-01

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948604221.html

Tokyo District Court, 2023 (Wa) 70425 [Information Processing Apparatus] <Nakashima>

The “application” must itself provide the relevant functions, such as a credit function.

The defendant's program itself does not provide the d-barai payment function itself.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93658.pdf

[Contract] Osaka District Court, 2023 (Wa) 12021

Original Ameblo publication: 2025-12-02

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948717992.html

[Contract] Osaka District Court, 2023 (Wa) 12021

Even in the allegations, it is unclear specifically what information was used and how, or specifically what effect it had on the course of the “Project at Issue.” … Nor is there sufficient evidence to find that those defendants engaged in such conduct in this case.

Furthermore, the plaintiff vacated the research premises at issue on the basis of the termination of the Exhibit Ko 3 contract. Although defendant P2 ultimately took the lead, the action is not found … to have been contrary to the wishes of the plaintiff's representative at the time.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93713.pdf

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2023 (Wa) 12731

Original Ameblo publication: 2025-12-03

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948829828.html

[Unfair Competition Prevention Act / Trade Secrets] Osaka District Court, 2023 (Wa) 12731

*Merely signing a confidentiality undertaking does not automatically establish that information was managed as secret.

(Translation of an excerpt from the court's reasoning)

… The plaintiff asserts that the defendant signed the confidentiality undertaking at issue, but that alone does not mean that Information 1 at issue automatically qualifies as “confidential information” or was managed as secret.

Furthermore, … an online form was publicly available through which customers could request a free estimate and agree to a visit for an estimate …. That and a customer's request to a contractor for a site survey are identical in that both involve conducting visiting sales activities in the form of an application from the customer. Thus, Information 1 at issue also lacks non-public status.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93700.pdf

[Europe] CJEU Grand Chamber Judgment on Jurisdiction over Foreign Patent Infringement and Its Implications for the UPC (February 25, 2025), C-339/22

Original Ameblo publication: 2025-12-04

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12948936981.html

[Europe] CJEU Grand Chamber Judgment on Jurisdiction over Foreign Patent Infringement and Its Implications for the UPC (February 25, 2025), C-339/22

BSH Hausgeräte GmbH v Electrolux AB

The judgment clarified the jurisdiction of the courts of the EU Member State where the defendant is domiciled over infringement actions concerning patents granted or validated in another Member State or a third State. It did not decide the UPC's own jurisdiction, but is also relevant to the consideration of the UPC's long-arm jurisdiction.

In a separate related case, the UPC's Düsseldorf Local Division recognized jurisdiction over infringement of the UK part of a European patent. That UPC ruling must be distinguished from this CJEU judgment.

This judgment opened the way to pursuing, together in the courts of the defendant's country of domicile, not only infringement of the European patent part validated in that country, but also infringement based on European patent parts in other countries and on foreign patents.

Article 24(4) of the Brussels I bis Regulation gives the courts of the Member State in which a patent is granted or validated exclusive jurisdiction over its validity, including where invalidity is raised as a defence. However, the court hearing the infringement action does not thereby lose jurisdiction over that action.

As a result, the court of the EU Member State where the defendant is domiciled retains jurisdiction over the infringement action even if an invalidity defence is raised concerning a foreign patent part, and may adjudicate infringement in other Member States and third States. Whether cross-border injunctive relief is available depends on the substantive requirements for an injunction and other applicable requirements in the particular case.

The validity of a patent granted or validated in another EU Member State falls within the exclusive jurisdiction of that Member State's courts. Article 24(4), however, does not apply to the courts of a third State. Subject to restrictions arising from the Lugano Convention, bilateral conventions, and rules concerning proceedings already pending in a third State, the court of the defendant's Member State of domicile may determine an invalidity defence concerning a third-State patent with effects limited to the parties, without altering the existence or content of the patent in the third State's register.

The infringement court, on the other hand, has the power to sever and stay infringement proceedings if there is a reasonable possibility that the patent will be invalidated in invalidity proceedings pending in another country.

Parallel disputes over infringement and validity in different countries make proceedings more complex and increase defendants' costs.

The judgment clarified that jurisdiction over an infringement action must be distinguished from jurisdiction to determine validity even when invalidity of a foreign patent is raised as a defence. Merely raising invalidity does not automatically deprive the court chosen by the patentee of jurisdiction over the infringement action.

⇒ Favorable to patentees.

For the UPC, the judgment is relevant when considering jurisdiction over European patents validated in non-contracting states, such as the UK and Turkey. It does not, however, uniformly establish jurisdiction or entitlement to an injunction in each UPC case or for every national patent.

At the same time, confirmation that the national courts of EU Member States have similarly broad jurisdiction has expanded patentees' opportunities for forum shopping between the national court of the defendant's domicile and the UPC, and judicial competition between the two is expected to intensify.

https://hasegawa-ip.com/ep-patent/upc-long-arm/#google_vignette

[Copyright] Tokyo District Court, 2024 (Wa) 70126 <Nakashima>

Original Ameblo publication: 2025-12-05

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949049163.html

[Copyright] Tokyo District Court, 2024 (Wa) 70126 <Nakashima>

*The explanatory texts and scripts displayed at the Tokutomi Roka Memorial Literature Museum are works made in the course of duties whose author is the defendant (Shibukawa City), and the copyright belongs to the defendant.

“In the first place, the plaintiff was hired by the defendant as a curator to work on the exhibition rooms of the literature museum at issue and continued that work until the exhibition rooms were completed. Thus, even if the plaintiff made a substantial contribution to that work but was not appointed director of the museum, these circumstances deserving consideration in the plaintiff's favor cannot be said to affect ownership of copyright through the determination of whether the works qualify as works made in the course of duties.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94072.pdf

IP High Court Grand Panel, 2006 (Gyo-Ke) 10563 [Solder Resist]

Original Ameblo publication: 2025-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949482642.html

IP High Court Grand Panel, 2006 (Gyo-Ke) 10563 [Solder Resist]

A case in which an invention could be specified using a trademark (a disclaimer claim).

(Translation of an excerpt from the court's reasoning)

The invention is specified in a negative form of expression (the so-called “disclaimer claim” format), with reference to the description of particular substances or products in Example 2 of the earlier application's specification. Since this appears to be the only way to exclude the portion identical to the cited invention precisely, neither more nor less, the use, in the corrections at issue, of the trademark “TEPIC,” which serves as an element specifying the cited invention, to indicate the excluded portion cannot be said to violate Article 24 of the above Regulations.

https://www.courts.go.jp/ip/vc-files/ip/file/10563.pdf

https://www.jpo.go.jp/system/laws/rule/guideline/patent/tukujitu_kijun/product_process/document/index/02.pdf

[IP Practice Online] Explanation of Patent Eligibility Issues in the United States and Practical Responses in Patent Prosecution (Japanese and U.S. Patent Attorney Shigeki Takeuchi)

Original Ameblo publication: 2025-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949482771.html

[IP Practice Online] Explanation of Patent Eligibility Issues in the United States and Practical Responses in Patent Prosecution (Japanese and U.S. Patent Attorney Shigeki Takeuchi)

<1> Basic principles and case law

The current framework for assessing eligibility is the “Alice test,” based on Supreme Court case law.

<2> USPTO (United States Patent and Trademark Office) examination guidelines

Examiners conduct examination based on the Alice test while using their own flowchart (Steps 2A and 2B).

The general rule for examiners' claim construction is the “broadest reasonable interpretation” (BRI).

The eligibility analysis considers whether a claim integrates a judicial exception into a practical application rather than merely using it. An improvement to computer functionality or other technology can support that determination. However, even where integration is not established under USPTO Step 2A, a claim may satisfy eligibility under Step 2B if additional elements amount to significantly more than the exception.

<3> Practical responses

From the Japanese filing stage, it is recommended that the specification describe in detail the technical field, the technical problems specific to that field, and the technical effects that solve those problems.

For AI-related inventions in particular, it is important to specify field-specific data and inputs and outputs, and the resulting improvement in the system's functionality, rather than a general-purpose model.

In drafting claims, it is necessary to avoid “results-based functional expressions” (for example, “analyzing” or “displaying”) and to describe specific hardware configurations or processing steps.

https://youtu.be/bbNVkn-i9sA

[IP Practice Online] Abductive Reasoning as an Axis of Logic and Thought in Patent Prosecution Practice—Focusing on Chemical Inventions (Patent Attorney Masanori Tomatsuri)

Original Ameblo publication: 2025-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949482882.html

[IP Practice Online] Abductive Reasoning as an Axis of Logic and Thought in Patent Prosecution Practice—Focusing on Chemical Inventions (Patent Attorney Masanori Tomatsuri)

In addition to “deduction” and “induction,” logical reasoning includes “abductive reasoning” (abduction).

1. Inventors' materials often state objective facts but omit the “unspoken essentials,” such as why a particular configuration was chosen, why other configurations do not work, the difficulties encountered, and the mechanism by which effects arise.

Use abduction when reviewing inventors' materials, reasoning about questions such as “Why is this statement included?” and “Why is this point not discussed?”

2. If the causal relationships described in the inventor's materials seem “too neat,” prepare questions based on the hypothesis that the explanation was constructed after the fact and that there may actually have been trial and error or unexpected results.

3. In interviewing the inventor, build a relationship of trust, because you will be playing the role of “devil's advocate.”

4. When drafting a specification (especially for a chemical invention), stating the mechanism definitively risks rejection for lack of inventive step on the ground that the result “could readily have been predicted.” An effective writing approach is therefore deliberately to introduce a “pause” in the logic, along the lines of: “Surprisingly, this effect was obtained, but the mechanism has not been fully elucidated. However, the following is conjectured.”

Setting a lower hurdle for the problem addressed by the invention (for example, “rapid action ‘or’ high strength,” or a more relaxed threshold for an acceptable result) increases the possibility of obtaining broader protection without violating the support requirement.

https://youtu.be/IiLHKip0ey8

[Copyright] Tokyo District Court, 2024 (Wa) 70189 <Nakashima>

Original Ameblo publication: 2025-12-09

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949483043.html

[Copyright] Tokyo District Court, 2024 (Wa) 70189 <Nakashima>

*Copyrightability of the program denied (no creativity in expression).

“The plaintiff is understood to assert that two portions of the source code of the program at issue, marked in red, are creative expressions: (1) the portion relating to the function of displaying a drop-down list of product names (hereinafter ‘Portion (1)’), and (2) the portion relating to the function of searching for and confirming a customer's name (hereinafter ‘Portion (2)’). Despite repeated requests for clarification by the court …, however, the plaintiff has not specifically alleged why these portions constitute creative expression.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93669.pdf

Tokyo District Court, 2022 (Wa) 70058 [Grapple Bucket Device] <Kokubu>

Original Ameblo publication: 2025-12-10

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949591631.html

Tokyo District Court, 2022 (Wa) 70058 [Grapple Bucket Device] <Kokubu>

“Curved in an arc” (constituent requirement D2) not satisfied.

<No literal infringement>

“It is appropriate to interpret ‘arc-shaped’ in constituent requirement D2 as meaning a shape like a portion of a circumference, composed entirely of a curve, and ‘curved in an arc’ as meaning a shape that curves like a bow in the form of a portion of a circumference.”

⇒ The defendant's product has a shape in which two straight lines intersect, and is not found to be arc-shaped.

<No infringement under the doctrine of equivalents>

“It is appropriate to find that the characteristic part constituting the technical idea peculiar to the invention at issue and absent from the prior art … is that, by adopting the configuration relating to constituent requirements C and D, a large value of the inclination angle θ at which the blade edge contacts the object is maintained even in portions far from the pivot center, thereby maintaining a draw-cutting action and achieving a smooth cutting effect.”

⇒ The defendant's product does not possess the essential part of the invention at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93448.pdf

<Study Group on Effective Disclosure and Governance of Intellectual Property Investment and Utilization Strategies (24th Meeting)>

Original Ameblo publication: 2025-12-11
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949733265.html

<Study Group on Effective Disclosure and Governance of Intellectual Property Investment and Utilization Strategies (24th Meeting)>

Material 3 (Cabinet Office, Intellectual Property Strategy Promotion Secretariat)

Presents a shift in thinking from treating research and development as an expense to treating it as asset formation, visualization of investment productivity, realization of a virtuous cycle through constructive dialogue with investors, dissemination of the Intellectual Property and Intangible Asset Governance Guidelines (GGL) and promotion of an awards program, and development of the Innovation Box tax regime.

Material 4 (Association for the Promotion of Intellectual Property and Intangible Asset Governance)

Sets out the purpose, organization, and selection process of a private-sector-led awards program, aiming to recognize and disseminate throughout society initiatives that link intellectual property and intangible-asset strategies to corporate value.

Material 5 (Intellectual Property and Intangible Asset Governance Association)

Disclosure by the top 990 Prime Market companies by market capitalization is improving, but challenges remain among companies making no disclosure and in non-manufacturing industries. Companies should seek to enhance corporate value through active disclosure informed by good examples.

Material 6 (Japan Patent Office)

In response to revisions to the Corporate Governance Code (CGC), presents a framework for advancing management through better-quality disclosure of intellectual property and intangible assets and constructive dialogue with investors. Sets out implementation-support procedures, including dispatching expert teams and developing value-creation stories.

Material 7 (Ministry of Economy, Trade and Industry)

Provides for a deduction of 30% of eligible income relating to patent rights and copyrighted AI-related programs, and explains operational advance-confirmation and certification procedures.

Material 8 (Committee Member Toshihiko Mori)

Proposes using the introduction of enterprise-value security interests as an opportunity to spread the GGL among the financial sector and small and medium-sized enterprises, and to use its logo. The aim is to strengthen value-creation capabilities by embedding the idea that research and development and similar activities should be treated as assets rather than expenses, and by extending that thinking throughout the supply chain.

Material 9 (Committee Member Araki)

Emphasizes the foundations and value-conversion mechanisms for generating business results from intellectual property. Taking into account facilitating factors such as leadership by top management and use of IP landscape analysis (IPL), as well as impediments such as personnel constraints, this position regards maintaining and strengthening the structure while working alongside those on the ground as the most important task.

(*Material 1, “Agenda,” and Material 2, “List of Committee Members,” are omitted because they contain only the agenda and the list of members.)

https://www.kantei.go.jp/jp/singi/titeki2/tyousakai/tousi_kentokai/dai24/gijisidai.html

IP High Court, 2025 (Gyo-Ke) 10046 [Multifunctional Quantum Charge Ratio Flow Conversion Device] <Nakadaira>

Original Ameblo publication: 2025-12-12

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949805885.html

IP High Court, 2025 (Gyo-Ke) 10046 [Multifunctional Quantum Charge Ratio Flow Conversion Device] <Nakadaira>

*The applicant's own publication was not accepted as establishing common general technical knowledge!!

(1) Clarity requirement not satisfied.

Regarding the statement that “NI(t)e− (negative quantum charge)” and “PI(t)e+ (positive quantum charge),” which form the foundation of the claimed invention, are generated by applying random numbers to electric charges, there is no evidence that this was common general technical knowledge at the time of filing, and the specification's explanation is also unclear.

The specification repeatedly states that applying the action of random numbers to the “negative charge” and “positive charge” from the energy source's ± electrodes generates aperiodic and fluctuating “negative quantum charge NI(t)e−” and “positive quantum charge PI(t)e+.” However, it does not address their physical meaning or the specifics of the generation mechanism. It merely notes that Figures 1 and 2 are basic conceptual diagrams, and provides little identification of circuits, elements, conditions, and the like.

(Even assuming the clerical error asserted by the applicant, the conclusion that the clarity requirement is not satisfied is unaffected.)

The non-patent literature relied on by the plaintiff consists of the plaintiff's own writings and is not recognized as common general technical knowledge.

(2) Enablement requirement not satisfied.

The specification does not describe a concrete configuration for generating quantum charge in the “negative (positive) quantum charge generation unit.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94989.pdf

“Manual for Startups on Collaboration with Operating Companies” (INPIT)

Original Ameblo publication: 2025-12-13

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12949935349.html

“Manual for Startups on Collaboration with Operating Companies” (INPIT)

Kenjiro Suzuki introduced it on IP Practice Online.

A practical guide to collaboration between startups and large companies.

(1) Searching for potential partners (designing appropriate patent classifications and keywords in J-PlatPat and similar services, and ranking candidate companies in a “target report”).

(2) Making proposals to candidates (selection, meetings, and preparation of proposals, also taking account of non-patent information such as investor-relations materials).

Successful proposals require three qualities: starting from a business problem rather than stopping at a technical problem, scenario hypotheses, and backcasting.

⇒ Even if you manage to meet someone, simply presenting your own strengths will not produce a match. It is the same as seeking a marriage partner: merely talking about your annual income or your strengths will not get you married. (Mr. Suzuki)

https://www.inpit.go.jp/content/100882028.pdf

[IP Practice Online] Joint Reading Festival for “A Sham Selection of One Hundred Copyright Cases” (Subaru Tomori)

Original Ameblo publication: 2025-12-14

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950047923.html

[IP Practice Online] Joint Reading Festival for “A Sham Selection of One Hundred Copyright Cases” (Subaru Tomori)

1. “The Complete Suicide Mania”

   A parody of the cover design of “The Complete Suicide Manual.”

   The specific expressions differ (for example, a coffin versus a gravestone), and what they have in common amounts only to “ideas,” such as layout, or “commonplace expression.”

   The defendant's “boomerang strategy” succeeded: it submitted evidence that the plaintiff, too, had published numerous parody books consisting merely of puns without critical content, such as “Noruwei no Omori,” a parody of “Noruwei no Mori” (Norwegian Wood).

2. “Time Does Not Betray Dreams”

   The line at issue appeared in a 1996 sequel and was not well known, and it was found unlikely that Mr. Makihara had relied on it (or encountered it).

   Moreover, the expressions “must not betray” used by Mr. Matsumoto (a wish or admonition) and “will never betray” used by Mr. Makihara (a categorical statement or conviction) convey different meanings.

   ⇒ A number of Mr. Matsumoto's statements were held to constitute defamation, and the dispute was settled with Mr. Matsumoto apologizing to Mr. Makihara.

3. LINE Creators' Stickers, “Urusee Tori” (Noisy Bird)

   The plaintiff asserted similarities such as “an oval head,” “eyes consisting of black dots,” and “a white shirt with a red tie.” All of these, however, were merely ideas or commonplace expression, so the scope of protection as a copyrighted work was narrow. Because the specific expressions differed, infringement was not found.

(Note) The Tokyo District Court judgment of October 14, 2020 (2019 (Wa) No. 26106) found that each of the individual features was commonplace expression in cartoons and illustrations of anthropomorphized characters, while also stating that the plaintiff’s work was found to be creative in combining those features to express it, and held that the scope of protection of the plaintiff’s work as a copyrighted work was limited to a narrow range in light of its content and nature (pp. 10–11 of the judgment).
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89898.pdf

4. “Doeraimon Encyclopedia”

   Shogakukan sent a warning under the Unfair Competition Prevention Act, alleging that the cover of “Doeraimon Encyclopedia,” a book introducing counterfeit Doraemon toys, imitated the cover design of the Doraemon comic books.

   The response centered on the practice of parody in the publishing industry and the differences in specific expression, citing examples such as Fujiko F. Fujio himself having drawn a Star Wars parody (R-3D-3).

5. “One Hundred Selected Copyright Cases”

   An editor of the fourth edition was excluded from editing the fifth edition.

The publisher (Yuhikaku) responded that “the professor's name was merely on the cover, and the professor was not a substantive author of the fourth edition.”

Internal emails and other evidence showed that the contribution amounted only to advice, and the professor was found not to qualify as an “author.”

https://youtu.be/YsB1ubb7Kuc

Tokyo District Court, 2025 (Wa) 70002 [Nanocomposite Having Quantum Dots and Method for Manufacturing the Same] <Takahashi>

Original Ameblo publication: 2025-12-15

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950128756.html

Tokyo District Court, 2025 (Wa) 70002 [Nanocomposite Having Quantum Dots and Method for Manufacturing the Same] <Takahashi>

*No objection was raised to filing in the company's name.

⇒ Assignment of the right to obtain a patent was found.

Plaintiff A, a former technical adviser to the defendant, and plaintiff B, its founder and former representative director, sought confirmation of their co-ownership interests in rights relating to patents applied for in the defendant's name.

The plaintiffs argued that, although they had discussed a draft agreement specifying consideration for assignment of the rights (such as share acquisition rights and royalties), the draft agreement at issue had never been signed, so no agreement had been concluded; they would not have assigned their research results without compensation.

⇒ Claims dismissed (an agreement to assign the rights existed).

<The court's findings>

(1) In their capacities as officers or technical advisers to the defendant, the plaintiffs instructed a patent firm to undertake procedures naming the defendant as applicant and raised no objection to the applicant entries in the draft application documents. These facts support an inference that, no later than the filing of the respective applications at issue, there had been an agreement to assign the rights to the defendant.

(2) As to the absence of a written agreement, a written agreement is not essential to assignment of rights, and none had been prepared for another application around the same time, so its absence was not unnatural.

(3) As to the argument that assignment without compensation would be strange, relations had not deteriorated at the time of filing, and plaintiff A had offered to help launch the business without compensation. In those circumstances, it is entirely conceivable that the rights would first be assigned to the defendant even without an agreement on consideration.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95009.pdf

IP High Court, 2025 (Ne) 10032 [Rod-Shaped Light] <Honda>

Original Ameblo publication: 2025-12-16

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950237053.html

IP High Court, 2025 (Ne) 10032 [Rod-Shaped Light] <Honda>

*Under the principle, based on the Regulations under the Patent Act, that claim terminology should be used consistently throughout the specification, the same term “first predetermined input” means the same input method.

⇒ “Said first predetermined input” in constituent requirements J3 and J4 refers to one of the two input methods specified in J2, either a “short press” or a “long press,” and means the same input method in J3 and J4.

Even if this renders the invention unclear, “it can only be described as the result of the applicant's drafting of the claims.”

⇒ Claim requirements not satisfied.

(Translation of an excerpt from the court's reasoning)

Terms recited in the claims should be interpreted in light of the requirement that terminology be used in its ordinary meaning and consistently throughout the specification and claims (Article 24 of the Regulations under the Patent Act; Note 8 to Form 29). “Or” is a word expressing a relationship in which one of two or more matters is selected. Thus, the “first predetermined input” in constituent requirement J2 refers to one of the two input methods specified as the “first predetermined input,” either a “short press” or a “long press”; and “said first predetermined input” in constituent requirements J3 and J4 is interpreted to mean the same input method as the “first predetermined input” in constituent requirement J2. Accordingly, as a matter of the meaning of the claim language of the invention at issue, there is no room to interpret the input method for “said first predetermined input” in constituent requirement J3 as differing from the input method for “said first predetermined input” in constituent requirement J4. Even if this interpretation leaves it unclear, as the appellant argues, whether carrying out the “first predetermined input” on the second button while the light-emitting portion is emitting light causes storage of the recommended color (constituent requirement J3) or emission of light in the recommended color (constituent requirement J4), that can only be described as the result of the applicant's drafting of the claims of the patent at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94890.pdf

IP High Court, 2024 (Gyo-Ke) 10012 [Enzyme-treated milk product] <Judge Hibiku Shimizu>

Original Ameblo publication: 2025-12-17
Article type: Case note
Category: Patents
Case information: IP High Court, 2024 (Gyo-Ke) 10012 [Enzyme-treated milk product] <Judge Hibiku Shimizu>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950339768.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-10012-enzyme-treated-milk-product-judge-hibiku-shimizu

Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10012【乳酵素処理物】-清水響

IP High Court, 2024 (Gyo-Ke) 10012 [Enzyme-treated milk product] <Judge Hibiku Shimizu>

* Inventive step denied for the use of bovine “normal milk.”

[Difference between the principal cited reference and the invention]

Regarding “bovine milk,” the amended invention specifies “milk derived from cows (excluding bovine colostrum (milk secreted by a mother cow through the tenth day after calving)),” whereas the Ko 1 invention uses “bovine colostrum (secreted during the first several days after calving).”

(This judgment)

According to literature published before the priority date, the difference in Gc-globulin concentration between colostrum and normal milk is not so large after approximately one week following calving, and cannot be said always to be at least fortyfold.

Bovine normal milk is distributed in overwhelmingly larger quantities and is easier to obtain than colostrum, providing sufficient motivation to use it as a source of Gc-globulin.

The experimental results in Exhibit Ko 10 do not clarify when the comparator “bovine colostrum” was milked or whether the macrophages used in the experiment had the same responsiveness. It was also unclear whether experimental error or statistical significance had been examined. These results therefore cannot be accepted as evidence supporting a remarkable effect.

https://lnkd.in/gJtyg7Up

Original article:

https://lnkd.in/g6whk3pq

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93505.pdf

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IP High Court, 2024 (Gyo-Ke) 10076 [Fuel and Blending Combinations Thereof] <Judge Hibiku Shimizu>

Original Ameblo publication: 2025-12-18
Article type: Case note
Category: Patents
Case information: IP High Court, 2024 (Gyo-Ke) 10076 [Fuel and Blending Combinations Thereof] <Judge Hibiku Shimizu>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950445101.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-10076-fuel-and-its-blending-combinations-judge-hibiku-shimizu

IP High Court, 2024 (Gyo-Ke) 10076 [Fuel and Blending Combinations Thereof] <Judge Hibiku Shimizu>

~ Clarity requirement not satisfied.

<Judgment>

The wording “(a) ... (b) ... and (c) ...” in Claim 1 means that conditions (a), (b) and (c) must be “satisfied simultaneously,” in light of the ordinary use of the conjunction “and.”

⇒ While condition (b) means “(L)%/(H)% = 1,” condition (c) specifies a ratio that does not give “(L)%/(H)% = 1” (e.g., 0.4/1 to 0.6/1). There is therefore “no combination of (L)% and (H)% that satisfies both simultaneously.”

<JPO decision>

The JPO decision held that the term “end point of the 90% distillation temperature” was unclear because it is not a well-known, customary technical term, is not defined in the specification, and combines the substantively different terms “90% distillation temperature” and “end point,” making it incomprehensible to a person skilled in the art.

⇒ The judgment did not decide this issue.

https://lnkd.in/gt5YqSW5

Original article:

https://lnkd.in/gg-3HGeF

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94786.pdf

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IP High Court, 2024 (Ne) 10069 [Toilet rolls, etc.] <Judge Nakadaira>

Original Ameblo publication: 2025-12-19

Article type: Case note

Category: Patents

Case information: IP High Court, 2024 (Ne) 10069 [Toilet rolls, etc.] <Judge Nakadaira>

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950550957.html

HP: https://www.takaishihideki.com/en/single-post/reiwa-6-ne-10069-toilet-rolls-etc-judge-nakahira

Japanese version: https://www.takaishihideki.com/single-post/令和６年-ネ-10069【トイレットロール等】-中平

IP High Court, 2024 (Ne) 10069 [Toilet rolls, etc.] <Judge Nakadaira>

① “Embossing depth” is not defined in the claims.

⇒ The specific measurement method described in the specification—calculating a contour curve from a sectional curve and identifying P1 and P2—must be followed. The appellant’s own measurement methods, such as surface roughness measurement, cannot be adopted. Although the specification calls P1 and P2 “two upward-convex inflection points,” the court interprets this expression as referring to two upward-convex points of maximum curvature.

(Excerpt from the judgment, translated)

<Method for measuring the “embossing depth” of toilet rolls>

The claims for Invention 1 contain no description defining “embossing depth”....

The term “embossing depth” in the claims for Invention 1 should be interpreted as the numerical value measured by the method described in the above paragraphs of Specification 1....

The measurement method described in the above paragraphs of Specification 3 is the same as the method described in the previously mentioned paragraphs of Specification 1.

② Configuration of the package's “slit-shaped finger hole”

⇒ The shape of the handle portion of the package should be assessed in the product's condition before cutting it out.

“Although the centers of the slits in Appellee's Products 1 and 3 are arcuate, both ends curve outward and downward, with their terminal points located inward. The shape of each slit itself therefore cannot be said to be ‘substantially oval.’”

③ Infringement under the doctrine of equivalents

⇒ In the opposition proceedings, after the advance notice of the decision, the patentee corrected the claim to limit the shape of the finger hole, intentionally excluding other shapes. This is an additional reason why infringement under the doctrine of equivalents is not established.

https://lnkd.in/gfwNdRyK

Original article:

https://lnkd.in/gsD8u_gV

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94688.pdf

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Osaka District Court, 2022 (Wa) 8985 [Cross connector] <Judge Matsukawa>

Original Ameblo publication: 2025-12-22
Article type: Case note
Topics: Claim interpretation
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950883103.html
HP: https://www.takaishihideki.com/en/single-post/part-1-2-osaka-district-court-reiwa-4-wa-8985-cross-connector-judge-matsukawa

Japanese version: https://www.takaishihideki.com/single-post/大阪地判令和４年-ワ-8985【交差連結具】-松川

Case information: Osaka District Court, 2022 (Wa) 8985 [Cross connector] <Judge Matsukawa>

Osaka District Court, 2022 (Wa) 8985 [Cross connector] <Judge Matsukawa>

(Plaintiff: Inaba Denki Sangyo v. Defendant: Marui Sangyo)

Based on the specification and common general technical knowledge, the court held that the invention also encompasses a configuration in which the “first holding portion” and the “second holding portion” share members.

⇒ Claim elements satisfied.

(Excerpt from the judgment, translated)

The claims and the specification contain no wording providing that the “first holding portion” and the “second holding portion” cannot share members. Rather, there is a description premised on their being able to share members (paragraph [0057] of the specification). Therefore, it cannot be said that the “first holding portion” and the “second holding portion” are subject to a limitation prohibiting them from sharing members.

Nor is there any recognized limitation under which the “first holding portion” must hold the first rod-shaped body by sandwiching it between the base plate portion and an enclosing part of the first holding plate portion, and fastening the base plate portion and holding plate portion together by one fastening member (even if the specification describes such a configuration as a preferred embodiment or the like, it is also clear from the specification that the invention is not limited to it).

Accordingly, the “first holding portion” in the invention at issue should be understood, in accordance with the wording of claim elements B to D, as a portion that “holds the first rod-shaped body,” “includes a base plate portion formed in a plate shape,” and “is connected to the second holding portion so as to permit relative displacement.”

Likewise, the “second holding portion” should, in accordance with claim elements C and F, be construed as a portion that “is connected to the first holding portion so as to permit relative displacement” and “sandwiches and holds the corresponding second rod-shaped body along the respective axial direction of each second rod-shaped body,” with one of the pair of “second holding portions” connected to one of the pair of attachment bases (provided on both sides of the base plate portion), and the other connected to the other attachment base. As explained above, no limitation prevents the “first holding portion” and the “second holding portion” from sharing members; consequently, a portion having that configuration falls within the “second holding portion” even if it shares members with the “first holding portion.”

Furthermore, “(the second holding portion is) connected to the first holding portion so as to permit relative displacement” (claim element C), also taking account of paragraph [0050] of the specification, is understood to include enabling easy adjustment of the crossing angle between suspension bolt 81 (first rod-shaped body) and brace bolt 82 (second rod-shaped body) through relative displacement of the “second holding portion” with respect to the “first holding portion” during an intermediate stage of installation. As stated above, there is no limitation prohibiting the “first holding portion” and the “second holding portion” from sharing members. Therefore, where the crossing angle between the first and second rod-shaped bodies can easily be changed through relative displacement of the “second holding portion” with respect to the “first holding portion,” the requirement “connected so as to permit relative displacement” is satisfied even if the connected members are shared by the first and second holding portions.

https://lnkd.in/gAkpjpGy

Judgment/source material: https://ipforce.jp/Hanketsu/jiken/no/14730

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IP High Court, 2024 (Gyo-Ke) 10100 [Child safety seat for attachment to a vehicle seat] <Judge Nakadaira>

Original Ameblo publication: 2025-12-22

Article type: Case note

Topics: Patent corrections, Patent drafting and translation

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950883167.html

HP: https://www.takaishihideki.com/en/single-post/part-1-2-reiwa-6-gyo-ke-10100-child-safety-seat-for-attachment-to-a-vehicle-seat-judge-nakahi

Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10100【車両シートに取り付けるためのチャイルドセーフティシート】-中平

Case information: IP High Court, 2024 (Gyo-Ke) 10100 [Child safety seat for attachment to a vehicle seat] <Judge Nakadaira>

IP High Court, 2024 (Gyo-Ke) 10100 [Child safety seat for attachment to a vehicle seat] <Judge Nakadaira>

The JPO decision permitting correction of a mistranslation was revoked.

~ The patent proprietor's inconsistent position had an impact.

(The judgment notes that the proprietor had previously argued that “LINEAR → 直線的 (straight-line)” was correct.)

<Requirements for correction of a mistranslation>

① The meaning of the description in the specification, claims or drawings of the international application as of the international filing date (the original text) differs from that in the specification, claims or drawings at registration (as corrected if there has been a correction through a trial for correction), due to a translation error (mistranslation).

② The corrected description expresses the meaning of the original text, so the meanings of the two descriptions coincide.

(Excerpt from the judgment, translated)

Correction Item 7 included a correction, for the purpose of correcting a mistranslation, changing “直線的 (straight-line)” to “直接的 (direct)” in paragraph [0008] of the specification and related documents, where “linear” in the original text (...) had been translated as “直線的 (straight-line)” before the correction....

The defendant argues that the correction was not made by focusing only on the single translated term “直線的 (straight-line)” and treating that term itself as a mistranslation to be changed to “直接的 (direct),” but was intended to make the meaning of the text as a whole faithful to the original.

However, dictionaries define “linear” as “1a) straight-line, line-shaped”.... Moreover, in the earlier request for correction ..., the defendant not only did not seek correction of the above “直線的 (straight-line)” wording in paragraph [0008], but ... in Correction Item XII of the correction request deemed withdrawn, based on correction of a mistranslation, expressly sought a correction that included translating the word “linear” in two places in the relevant original text ... as “直線的 (straight-line),” asserting that this was the correct translation of the original.

In view of these circumstances, where “linear” in the original text is translated as “直線的 (straight-line)” in the specification, the meanings of the original and the specification cannot be found to differ.

Further passage appearing in the published Japanese judgment (translation; its apparently inconsistent formulation is retained without correction):

“On the other hand, because the word ‘直線 (straight line)’ and the word ‘直接 (direct)’ have different meanings, where ‘linear’ in the original text is translated in the specification as ‘直線的 (straight-line),’ the meaning of the original text and that of the specification are different and cannot be regarded as coinciding.”

Accordingly, in Correction Item 7 ..., the meaning of “直線的 (straight-line)” in the specification before correction cannot be said to differ from the meaning of “linear” in the original because of a translation error, so requirement ① in (1) above is not satisfied. Nor can the corrected description be said to coincide with an expression of the original meaning, so requirement ② is also not satisfied.

https://lnkd.in/g8Guj6Pb

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94701.pdf

Original article:

https://lnkd.in/ghDWpVup

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IP High Court, 2024 (Gyo-Ke) 10085 [... Solar power self-consumption system] <Judge Nakadaira>

Original Ameblo publication: 2025-12-22
Article type: Case note
Category: Patents
Case information: IP High Court, 2024 (Gyo-Ke) 10085 [... Solar power self-consumption system] <Judge Nakadaira>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950883215.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-7-gyo-ke-10085-solar-power-self-consumption-system-judge-nakahira

Japanese version: https://www.takaishihideki.com/single-post/令和７年-行ケ-10085【-太陽光自家消費システム】-中平

IP High Court, 2024 (Gyo-Ke) 10085 [... Solar power self-consumption system] <Judge Nakadaira>

1. Enablement requirement

The court emphasized that the examples in the specification provide specific table values (e.g., β = 30 kW when 0 < α ≤ 20%) and explain their effects (avoiding reverse power flow and improving generation efficiency), and that the table is rewritable, with the idea of adjusting margins according to operation itself disclosed as part of the invention. It held that a person skilled in the art could implement this within the scope of ordinary design and adjustment, and that this could not be regarded as “undue trial and error.”

2. Inventive step

① Exhibits Ko 16–18 concern technologies in other fields—calculation of environmental burdens, assessment of component failure rates, and energy-saving management, respectively—with backgrounds different from the problems in Ko 1 of avoiding reverse power flow in photovoltaic generation and improving generation efficiency.

② These publicly known technologies disclose no specific motivation to “introduce a ratio obtained by dividing power consumption by the PCS rating and control the output upper limit by referring to a table according to that ratio” in the Ko 1 invention.

③ The Ko 1 invention uses coefficients a and b of a linear function as parameters and attempts to solve the problem by adjusting a and b within that framework. There is no necessity to replace that framework with ratio α and a table method.

⇒ The configuration pertaining to Difference 1-1 cannot be reached merely because “a ratio can be calculated using elementary mathematics”; technical motivation is lacking.

⇒ Inventive step affirmed.

https://lnkd.in/gN9YmdQn

Original article:

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Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94700.pdf

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IP High Court, 2024 (Gyo-Ke) 10081 [Pet matching system] <Judge Nakadaira>

Original Ameblo publication: 2025-12-23
Article type: Case note
Category: Patents
Case information: IP High Court, 2024 (Gyo-Ke) 10081 [Pet matching system] <Judge Nakadaira>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12950974573.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-10081-pet-matching-system-judge-nakahira

Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10081【愛玩動物マッチングシステム】-中平

IP High Court, 2024 (Gyo-Ke) 10081 [Pet matching system] <Judge Nakadaira>

* Inventive step denied for a claim containing a disclaimer.

A limitation “excluding animal hospitals and places where a veterinarian is present” was added to distinguish the prior art (a system for handing over animals at an animal hospital), but it was held to be obvious.

(Excerpt from the judgment, translated)

The plaintiff argues that ... the handover location being “at least one of a veterinarian or an animal hospital” is fundamental to the technical idea of the cited invention and an essential requirement for solving its problem. On that basis, the plaintiff contends that changing the handover location from “at least one of a veterinarian or an animal hospital” to a place other than an animal hospital or a place where a veterinarian is present would change an essential requirement fundamental to the cited invention's technical idea and necessary to solve its problem. Because this would run counter to that technical idea, the plaintiff argues that there is no motivation to make the change and, rather, a teaching away exists.

However, that argument presupposes that the location for handing over animals in the cited invention is limited to an animal hospital or a place where a veterinarian is present. Since that premise cannot be accepted ..., the plaintiff's argument lacks its premise and cannot be adopted.

https://lnkd.in/gMSeAYiv

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https://lnkd.in/gJ76Zres

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94642.pdf

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IP High Court, 2025 (Ne) 10042 [Fastening hardware] <Judge Hibiku Shimizu>

Original Ameblo publication: 2025-12-24
Article type: Case note
Category: Patents
Case information: IP High Court, 2025 (Ne) 10042 [Fastening hardware] <Judge Hibiku Shimizu>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951083841.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-7-ne-10042-fastening-hardware-judge-hibiku-shimizu

Japanese version: https://www.takaishihideki.com/single-post/令和７年-ネ-10042 号【締結金物】-清水響

IP High Court, 2025 (Ne) 10042 [Fastening hardware] <Judge Hibiku Shimizu>

* Reciting an effect in the claim (“to delay destruction caused by the growth of cracks and improve short-term allowable load-bearing capacity”) was held not to limit the configuration of the invention.

+ The comparator (excluded configuration) asserted by the plaintiffs is not described in the specification.

(Excerpt from the judgment, translated)

The phrase “to improve short-term allowable load-bearing capacity” is also described in the specification as an operation/effect of the invention. The specification discloses no configuration beyond the “configuration of the branch-like portions” as necessary to obtain that operation/effect.... Accordingly, the phrase merely indicates the operation/effect intended to be achieved by the “configuration of the branch-like portions” and does not limit the configuration of the invention. Even if improving short-term allowable load-bearing capacity in practice requires the specific design (conditions) asserted by the plaintiffs in addition to the “configuration of the branch-like portions,” the wording “to improve short-term allowable load-bearing capacity” cannot be regarded as specifying any particular design (conditions) other than the “configuration of the branch-like portions.”

https://lnkd.in/gmmwQ3x5

Original article:

https://lnkd.in/gnpxevMy

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94631.pdf

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Osaka District Court, 2024 (Wa) 6216 [Taxi dispatch management system] <Judge Matsuami>

Original Ameblo publication: 2025-12-25
Article type: Case note
Category: Patents
Case information: Osaka District Court, 2024 (Wa) 6216 [Taxi dispatch management system] <Judge Matsuami>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951188984.html
HP: https://www.takaishihideki.com/en/single-post/osaka-district-court-reiwa-6-wa-6216-taxi-dispatch-management-system-judge-matsuami

Japanese version: https://www.takaishihideki.com/single-post/大阪地判令和６年-ワ-6216【タクシー配車管理システム】-松阿彌

Osaka District Court, 2024 (Wa) 6216 [Taxi dispatch management system] <Judge Matsuami>

* Claim elements not satisfied.

⇒ In this case, the new means of attack or defense submitted after the court disclosed its preliminary view were rejected as untimely: their late submission was attributable to intent or gross negligence and would delay the conclusion of the proceedings.

(Excerpt from the judgment, translated)

“Assuming that ‘taxi selection range information’ has been transmitted before reaching configuration ③ in the defendant's product, what is shown on the user terminal at configuration ③ is a ‘screen for selecting conditions,’ not information on individual vehicles. The defendant's product therefore does not satisfy claim element B3.

Furthermore, the defendant's product has no configuration for requesting dispatch of a particular taxi selected by the user. It therefore also lacks the ‘dispatch confirmation request’ in claim element B4.”

https://lnkd.in/gVkf5FWB

Original article:

https://lnkd.in/gFe7QgRJ

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94996.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7512692967279587328/

IP High Court, 2024 (Gyo-Ke) 10073 [Therapeutic agent inducing cytotoxicity] <Judge Masuda>

Original Ameblo publication: 2025-12-26
Article type: Case note
Category: Patents
Case information: IP High Court, 2024 (Gyo-Ke) 10073 [Therapeutic agent inducing cytotoxicity] <Judge Masuda>
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951291054.html
HP: https://www.takaishihideki.com/en/single-post/reiwa-6-gyo-ke-10073-therapeutic-agent-inducing-cytotoxicity-judge-masuda

Japanese version: https://www.takaishihideki.com/single-post/令和６年-行ケ-10073【細胞傷害誘導治療剤】-増田

IP High Court, 2024 (Gyo-Ke) 10073 [Therapeutic agent inducing cytotoxicity] <Judge Masuda>

≈ IP High Court, 2024 (Gyo-Ke) 10074

* Even if a particular mutation was common general technical knowledge, it cannot necessarily be said to have been disclosed in the cited reference.

⇒ Nevertheless, inventive step denied.

(Judgment, translated)

Regarding Difference 3 (whether aspartic acid at position 265 of the Fc region is mutated to alanine), the court stated: “However, paragraph [0744] of Exhibit Ko 10 merely states that ‘certain other Fc regions’ may be used where it is desirable to eliminate or reduce effector function; it does not clarify specifically what those ‘certain other Fc regions’ are. Even if the D265A mutation in the Fc region was well-known technology or common general technical knowledge as one means of reducing Fcγ receptor binding affinity and effector function, it cannot be said that the specific D265A mutation is described, or can be regarded as described, as one of those ‘certain other Fc regions.’”

⇒ Nevertheless, in the bispecific antibody of the Ko 10 invention, which does not require effector function, introducing the D265A mutation into the Fc region on the basis of that common general technical knowledge would have been readily conceivable to a person skilled in the art.

⇒ Inventive step denied.

https://lnkd.in/gp5gi8Ub

Original article:

https://lnkd.in/ggHNqYqJ

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94878.pdf

Originally posted on LinkedIn:
https://www.linkedin.com/feed/update/urn:li:activity:7512693335896051712/

Osaka District Court, 2024 (Wa) No. 7193 — Article transport equipment (Judge Matsuami)

Original Ameblo publication: 2025-12-27
Article type: Case note
Topics: Employee inventions
Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951419510.html
HP: https://www.takaishihideki.com/en/single-post/article-transport-equipment-reiwa6-wa-7193-en

Japanese version: https://www.takaishihideki.com/single-post/大阪地判令和６年-ワ-7193号【物品搬送設備】-松阿彌

Osaka District Court, 2024 (Wa) No. 7193 — Article transport equipment (Judge Matsuami)

⇒ The claim for compensation for an employee invention was dismissed.

1. The process of formulating and operating the regulations

Following the amended Patent Act that took effect in 2016 and publication of the guidelines, the defendant consulted with the labor union and explained the reward system and calculation method. When revising the regulations, it also solicited opinions from all employees and responded to the plaintiff's opinions, thus undertaking careful and sincere procedures, which were reasonable.

2. Awareness of the regulations

The regulations were available for viewing at all times through the internal system and were also explained in training for new employees. The plaintiff had received rewards during employment and was in a position to understand the system.

3. Content of the regulations

The performance reward system is one in which the business division and the intellectual property department evaluate performance based on objective indicators and determine grades, and inventors are also assured an opportunity to state their opinions. It is therefore not unreasonable.

(Excerpt from the judgment, translated)

“It is doubtful whether the appropriateness of the amount of compensation, which in itself may be considered to be left to private autonomy, is necessarily included among the perspectives for determining unreasonableness prescribed in Article 35(5) of the Patent Act. Even assuming that it could be one factor for consideration, the case would be different, for example, if the regulations provided only for payment of small lump sums as application and registration rewards without distributing the profits subsequently obtained by the company through working the patent rights. The detailed rules at issue, however, evaluate the economic value of the patent rights, etc. relating to their working from various perspectives, such as contribution to profit and exclusion of competitors, and provide for payment of corresponding performance rewards in stages. It is difficult to find any point that would make them unreasonable.”

In conclusion, because the regulations at issue are not unreasonable, the claim for statutory reasonable benefits under Article 35(7) of the Patent Act, which presupposes that those regulations do not apply, is without merit.

Source: https://lnkd.in/gT9puumr

Original article: https://lnkd.in/gVXrBGeE

Judgment/source material: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95035.pdf

IP High Court, 2025 (Ne) 10025 [Spindle Motor] <Nakadaira> ⇛ Claim for Compensation for an Employee Invention

Original Ameblo publication: 2025-12-28

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951545162.html

IP High Court, 2025 (Ne) 10025 [Spindle Motor] <Nakadaira>

⇒ Claim for compensation for an employee invention. Dismissed.

(Co-inventorship denied.)

The core of the Japanese invention at issue lies in the formation of particular “communicating holes.” However, the written explanation submitted by the appellant does not refer to their specific configuration and describes an entirely different problem and solution. The appellant's idea therefore does not exhibit the characteristics of the Japanese invention at issue.

(The “Invention / Utility Model Explanation” submitted by the appellant to the employer merely describes a different problem and solution and does not address the specific configuration of the communicating holes.)

The parts of the U.S. and Chinese patented inventions that differ from the Japanese invention at issue are based on “Invention A,” in which through-holes are provided in the sleeve. These parts also differ in configuration from the appellant’s concept of providing a communicating groove between the sleeve and the housing, and were not found to be the appellant’s invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94960.pdf

IP High Court, 2025 (Ne) 10035 [Vehicle Guidance System] <Honda> (PXZ v. East Nippon Expressway Company Limited)

Original Ameblo publication: 2025-12-30

Ameblo: https://ameblo.jp/hideki-takaishi/entry-12951727893.html

IP High Court, 2025 (Ne) 10035 [Vehicle Guidance System] <Honda>

(PXZ v. East Nippon Expressway Company Limited)

*Non-satisfaction of the relevant claim limitations was found on the same basis as the finding in IP High Court, 2024 (Gyo-Ke) 10086 that the grandparent application failed to meet the divisional-application requirements.

“The ‘entrance/exit for ordinary vehicles’ in claim element 2E cannot be construed as including an entrance/exit for ordinary vehicles at another interchange adjacent to the toll-road tollgate, service area, or parking area where the vehicle guidance system of Invention 2 at issue is installed.”

⇒ The relevant claim limitations are not satisfied.

“Guidance” means objectively directing a vehicle. In the absence of signs or the like, a driver's voluntary U-turn cannot be evaluated as guidance provided by a function of the facility.

⇒ “None of the facilities identified by the plaintiff can be said to have guidance means for directing vehicles from which tolls cannot be collected by ETC onto a ‘route returning once again to a point before said entrance/exit exclusively for ETC vehicles’; accordingly, they do not satisfy claim element 2E.”

⇒ The relevant claim limitations are not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94616.pdf

Hideki Takaishi Article Collection

January–June 2026

English Edition

185 articles

Legal Update (items posted January–June 2026)

In order of the month of posting

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16 2026-01 [Patent ★] A case in which the description in the detailed description of the invention concerning the derivation method for a parameter in the claims was erroneous, the allegation that the description contained an error was also rejected, and the support requirement was denied — Tokyo District Court, 2023 (Wa) No. 70114 [Brake Control Device for a Motorcycle] <Presiding Judge Shibata> — (Same holding on appeal: Intellectual Property High Court, 2024 (Ne) No. 10038 <Presiding Judge Honda>)

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44 2026-02 2024 (Ne) No. 10056 [Van-Type Motor Vehicle for Cleaning Work] <Nakadaira>

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67 2026-02 2024 (Ne) No. 10072 [Draft Difference Measuring Device] <Nakadaira>

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(Plaintiff), and Posting Them Together with the Text of Posts on Twitter (X) via the Internet on 25 Occasions, the Appellant Alleged Infringement of Copyright (Right of Making Transmittable) in the Photographs at Issue and Sought Damages in Tort, and the Court Held that the Quotation Defense (Article 32(1) of the Copyright Act) or the Defense of Exploitation of Incidentally Included Works (Article 30-2 of the Copyright Act) Applied and that the Appellant's Claims Should Be Dismissed

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124 2026-04 2023 (Gyo-Ke) No. 10139 [Gaming machine] <Presiding Judge Hibiku Shimizu>

125 2026-04 Tokyo District Court, 2023 (Wa) No. 70619 [Device for measuring the difference in draft between both sides of a ship] <Presiding Judge Nakashima>

126 2026-04 [Trademark law ★] A case in which the court held that the designated services in Class 40, "rental of food waste processing machines; rental of chemical machinery and equipment," of the trademark at issue consisting of the standard characters "ゴミサー" are similar to the cited designated goods in Class 7, "food waste processing machines; liquid fertilizer manufacturing apparatuses," of the cited trademark consisting of the standard characters "ゴミサー" (falling under Article 4(1)(xi) of the Trademark Act), and rescinded the JPO trial decision dismissing the request for invalidation of the trademark registration at issue, which had held, among other things, that "rental of food waste processing machines" in Class 40 among the designated services at issue was not similar to "food waste processing machines" in Class 7 among the cited designated goods (not falling under Article 4(1)(xi) of the Trademark Act),

127 2026-05 【Copyright Law ★★★】 A precedent holding that, where the shapes and other features of all or part of a mass-produced utilitarian article can be perceived, conceptually and separately from the configuration derived from its function, as a creative expression of thoughts or sentiments, all or part of that article falls within the artistic domain among the works referred to in Article 2(1)(i) of the Copyright Act, affirming the lower court's denial of copyrightability of the plaintiff's products shown below, and dismissing the appeal

128 2026-05 【Design】 Osaka District Court, 2023 (Wa) 10125, “Container for a Liquid Soap Dispenser” case ＜Presiding Judge Matsuami＞

129 2026-05 【Copyright】 Tokyo District Court, 2023 (Wa) 70125 ＜Presiding Judge Takahashi＞

130 2026-05 【Unfair Competition Prevention Act / Non-Compete】 Osaka District Court, 2023 (Wa) 9115 ＜Presiding Judge Matsuami＞

131 2026-05 【Contract】 Tokyo District Court, 2023 (Wa) 70680 【Method for Screening Inhibitors of Phosphorylation of Telomerase Reverse Transcriptase】 ＜Presiding Judge Nakashima＞

132 2026-05 【Copyright】 Osaka District Court, 2023 (Wa) 11871, “Method of Diagnostic Imaging Based on Relativization through Comparison” ＜Presiding Judge Matsuami＞

133 2026-05 【Unfair Competition Prevention Act / Trade Secrets】 Osaka District Court, 2023 (Wa) 5749 ＜Presiding Judge Takemiya＞

134 2026-05 【Paper / European Patents】 Patent Protection for Food Use Inventions at the European Patent Office (Nobuhiro Tago, Patent, September 2025)

135 2026-05 【Trademark】 Tokyo District Court, 2022 (Wa) 11316, “Paku to Mogu” ＜Presiding Judge Kokubu＞

136 2026-05 【Trademark (Violation of Public Order and Morality)】 Intellectual Property High Court, 2024 (Gyo-Ke) 10079 ＜Presiding Judge Honda＞

137 2026-05 【Authors’ Moral Rights】 Osaka High Court, 2024 (Ne) 1431 ＜Presiding Judge Morisaki＞

138 2026-05 【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10089, “VALENTINO” case ＜Presiding Judge Miyasaka＞

139 2026-05 【Trademark Act】 Intellectual Property High Court, 2024 (Gyo-Ke) 10090, “Pon-chan” case

140 2026-05 【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10072 ＜Presiding Judge Nakadaira＞

141 2026-05 【Copyright】 Intellectual Property High Court, 2024 (Ne) 10065 ＜Presiding Judge Miyasaka＞

142 2026-05 【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10048 ＜Presiding Judge Hibiku Shimizu＞

143 2026-05 【Unfair Competition Prevention Act / Circulation or Communication of False Facts】 Osaka High Court, 2024 (Ne) 338 ＜Presiding Judge Morisaki＞

144 2026-05 【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10067, “MYOFOCUS” = 2024 (Gyo-Ke) 10068

145 2026-05 【Copyright】 Intellectual Property High Court, 2024 (Ne) 10017 ＜Presiding Judge Honda＞

146 2026-05 【Trademark】 Appeal 2024-18950

147 2026-05 Osaka District Court Orders, 2025 (Yo) 20008 and 20009 【Prostaglandin Derivatives for the Treatment of Abdominal Discomfort】

148 2026-05 【Trademark】 Appeal 2025-416

149 2026-05 Osaka High Court, 2025 (Ne) 1750 【Koi Ichigo】 ＜Presiding Judge Morisaki＞

150 2026-05 【Trademark】 Osaka District Court, 2024 (Wa) 5007, “Awa Koi Ichigo” ＜Presiding Judge Matsukawa＞

151 2026-05 Tokyo District Court, 2019 (Wa) 32779 【Clothing】 ＜Presiding Judge Kokubu＞

152 2026-05 Intellectual Property High Court, 2023 (Gyo-Ke) 10062 【Bone Anchor with Improved Fixation Strength】 ＜Presiding Judge Shoji＞

153 2026-05 Intellectual Property High Court, 2023 (Gyo-Ke) 10092 【Bag Processing Machine】 ＜Presiding Judge Honda＞

154 2026-06 [Article / Unfair Competition Prevention Act] The Practice and Theory of Preservation of Evidence in Intellectual Property Cases and Related Matters (高村隆司, Patent, June 2025)

155 2026-06 [Article / U.S. Designs] New Standards for Determining Obviousness of U.S. Design Patents (佐々木眞人, Patent, June 2025)

156 2026-06 [Article / Unfair Competition Prevention Act] Infringement Risks Arising from the Use of Other Companies' Trade Secrets Brought in by Employees Changing Jobs (石本貴幸, Patent, October 2025)

157 2026-06 [Article / Patents] Examination of Clarity Determinations in Recent Court Decisions (岡田健太郎 et al., Patent, June 2025)

158 2026-06 2024 (Gyo-Ke) No. 10036 [Chip Detection Device] <Presiding Judge Honda>

159 2026-06 [Article / Patents] Use of AI in Patent Examination (五十嵐康弘, Patent, August 2025)

160 2026-06 [Article / Chinese Patents] The Support Requirement for Numerical Range Limitations in China (胡春豊 and 林軍, Patent, September 2025)

161 2026-06 [Article / European Patents] Differences Between the Japanese and European Patent Systems That Require Attention (野村和弘 and フロリアン キューベック, Patent, September 2025)

162 2026-06 [Article / UK Patents] The UK InterDigital v. Lenovo Litigation over the Calculation of FRAND Rates (小林和人, Patent, September 2025)

163 2026-06 [Article / Patents] Intellectual Property and Intangible Assets in the Food Industry (藤原研二郎, Patent, September 2025)

164 2026-06 [Article / U.S. Designs] Protection of Goods and Other Subject Matter in Virtual Space under U.S. Design Law (山口洋一郎, Patent, August 2025)

165 2026-06 [Article / Designs] A Consideration of Future Responses under Japanese Design Law to Design Protection in Virtual Space — In Light of International Trends (星野光秀, Patent, October 2025)

166 2026-06 [Article / Trademarks] Treatment under Trademark Law of Goods and Services Relating to Virtual Space — The Nice Classification and the Situations in Europe, the United States, South Korea, and Japan (星野光秀, Patent, June 2025)

167 2026-06 [Article / Trademarks] Consideration of the Use of the "Consent System" through Model Cases (中山真理子 and 竹山尚治, Patent, October 2025)

168 2026-06 2023 (Gyo-Ke) No. 10149 [Multi-Branched Heat Exchanger with Independent Baffles] <Presiding Judge Miyasaka>

169 2026-06 2024 (Ne) No. 10038 [Brake Control Device and Behavior Analysis Device for a Motorcycle] <Presiding Judge Honda>

170 2026-06 [Trademarks / Similarity] 2025 (Gyo-Ke) No. 10111 "SORA" <Presiding Judge Moritomi>

171 2026-06 [Article / Austrian Trademarks] A Consideration of the Protection of Well-Known Trademarks and Unfair Use through Packaging Imitation Learned from the "Jägermeister" Case (遠藤華英, Patent, November 2025)

172 2026-06 [Article / Customs] Customs Expert Advisers (磯貝克臣, Patent, November 2025)

173 2026-06 [Article / Intellectual Property in General] Patent Attorneys as Judicial Research Officials (髙村和宗 and 岩永勇二, Patent, November 2025)

174 2026-06 [Article / Intellectual Property in General] A Note on the Prohibition of Abuse of Rights in Intellectual Property Infringement (森本晃生, Patent, December 2025)

175 2026-06 [Article / Patents] Research and Proposals on Lack of Unity of Inventions Expressed as Alternatives (Biotechnology and Life Sciences Committee, Patent, December 2025)

176 2026-06 [Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

177 2026-06 [Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

178 2026-06 [Article / Patents] Cases and Issues in Patent Protection of Biopharmaceuticals (Biotechnology and Life Sciences Committee, Patent, December 2025)

179 2026-06 [Article / Patents] Points to Note When Filing Food-Use Inventions in Different Countries (Biotechnology and Life Sciences Committee, Patent, December 2025)

180 2026-06 [Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

181 2026-06 [Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

182 2026-06 [Article / U.S. Designs] Changes in the Methods for Determining Design Right Infringement in the United States (佐々木眞人, Patent, January 2026)

183 2026-06 [United States] Focus Prod v. Kartri Sales (CAFC, 2025.9.30)

184 2026-06 2024 (Gyo-Ke) No. 10017 [Optimized Nutritional Formulations, Methods for Selecting Tailored Diets Therefrom, and Uses Thereof] <Presiding Judge Miyasaka>

185 2026-06 Tokyo District Court, 2024 (Wa) No. 4142 [Portable Information Communication Device and Personal Computer System Using the Portable Information Communication Device] <Presiding Judge Kokubu> (related case decided the same day: Tokyo District Court, 2024 (Wa) No. 70083, defendant SoftBank Corp.)

Legal Update (Items Posted in January 2026)

Scope: The collection supplied as attorney Hideki Takaishi's January 2026 articles (Nakamura & Partners), including coauthored articles

Number of items included: 34

List page: https://www.nakapat.gr.jp/ja/legal_updates_jp/

All 34 articles, figures, and the English figure descriptions are included. Commentary in the articles should be distinguished from the courts' holdings.

<Highlights of This Month> Key Points in the January 2026 Intellectual Property and Legal Affairs Update

This month's legal update addresses 34 court decisions and commentaries spanning a broad range of intellectual-property practice, including chains of divisional applications, new grounds for invalidation in appellate proceedings, scientific errors in specifications, claim construction, international jurisdiction, standard-essential patents, and employee inventions. The important decisions and practical points are as follows.

1. The [Vehicle Guidance System] Case, Which Shakes the Chain of Divisional Applications <Presiding Judge Honda>

The Intellectual Property High Court judgment in 2024 (Gyo-Ke) No. 10086, the [Vehicle Guidance System] case, focused on the configurations that had been indispensable in the fourth-generation specification as originally filed: returning, through a branch lane, a vehicle that could not use ETC, and determining the vehicle subject to return based on whether communication was possible. The fifth-generation divisional application, which did not limit these configurations and also encompassed guidance based on any criterion or method, was held to introduce new technical matter. As a result, retroactive effect of the filing date under Article 44, paragraph 2 of the Patent Act was denied, and the patent at issue, which was of the seventh generation, lacked novelty over the publication of the original application. The Intellectual Property High Court judgment of the same date in 2025 (Ne) No. 10035, the [Vehicle Guidance System] case <Presiding Judge

Honda>, likewise limited “entrance/exit for ordinary vehicles” and “guidance means” in accordance with the specification and found non-infringement. At each generation of a divisional-application tree, the deletion of essential configurations and unrestricted generalization should be examined.

2. An Untimely Allegation Not Saved Even by a Statement of Reasons for Appeal — [Women’s Garment] Case <Presiding Judge Nakadaira>

The Intellectual Property High Court judgment in 2024 (Ne) No. 10010, the [Women’s Garment] case, held that a ground for invalidation based on U.S. patent documents submitted for the first time in the statement of reasons for appeal was untimely because it could have been asserted in the court of first instance and there were no circumstances making submission difficult. Nevertheless, because the appellee made a rebuttal in the alternative and the appellant made no further rebuttal, the court also ruled on the invalidity issue, finding that the allegation could not be said to delay completion of the litigation. Even an allegation made at the initial stage of an appeal is not necessarily permitted, and arguments in the alternative must also be fully presented in the court of first instance. In addition, the [Smoking-Article Cartridge] case <Presiding Judge Shibuya> denied an interest in obtaining a declaratory judgment of nonexistence after the claim for damages had been waived, while the [Video Viewing Device] case <Presiding Judge Takemiya> held that an infringement report to Amazon constituted an act of unfair competition on the premise of non-infringement. Attention is required both to the timing of submission of claims and defenses and to the manner of exercising rights.

3. Scientific Accuracy of the Specification and the Limits of Supplementation by Common General Technical Knowledge

The Tokyo District Court judgment in 2023 (Wa) No. 70114, the [Brake Control Device for a Motorcycle] case <Presiding Judge Shibata>, and the appellate judgment <Presiding Judge Honda> held that the only formula for deriving corrected lateral G was a formula that subtracted physical quantities having different dimensions and therefore had no meaning in physics. Although the existence of an error could be understood, the method of correction was not

uniquely determined and inconsistencies with other descriptions would also arise; therefore, the assertion that the description contained an error was rejected and a violation of the support requirement was found. By contrast, the Intellectual Property High Court judgment in 2023 (Gyo-Ke) No. 10147, the [RNA-Dependent Targeted DNA Modification] case <Presiding Judge Hibiku Shimizu>, found substantive disclosure based on the first application documents as a whole and the common general technical knowledge as of the filing date, and upheld the benefit of priority. Common general technical knowledge may supplement a disclosure, but it does not reconstruct an error whose content cannot be uniquely determined. Pre-filing verification of formulas, units, and mechanisms is important.

4. Precisely Reading Claim Language, Flows Between Devices, and the Essence of the Invention

The Intellectual Property High Court judgment in 2024 (Ne) No. 10012, the [R Badge, Receiving Device] case <Presiding Judge Hibiku Shimizu>, excluded from the determination of the gist of the invention a limitation concerning the counterpart mobile telephone because it did not specify the structure or function of the receiving device itself, and denied inventive step. On the other hand, the interlocutory judgment of the Intellectual Property High Court in 2024 (Ne) No. 10034, the [Elasto-Plastic Hysteretic Damper] case <Presiding Judge Honda>, did not limit “input” to a horizontal force in a specified direction and found the cause of the damages claim well founded for some products. By contrast, non-infringement was found in the [Remotely Controlled Unmanned Boat] case for lack of a configuration in which one control device determines two conditions; in the [Reservation Management Device] case for lack of direct transmission from the server to the image printing device; in the [Shopping Payment System] case for lack of a camera that acquires images; and in the [Game System and Game Program] case for lack of a configuration that separately stores two types of quantities. Mapping the processing order, information path, and even operations and effects is indispensable to claim drafting and proof of infringement.

5. Cross-Border Enforcement, Standard-Essential Patents, and Employee Inventions

The Osaka District Court judgment in 2024 (Wa) No. 2705, the [Angle-Adjustable Hinge] case <Presiding Judge Takemiya>, denied Japanese jurisdiction over claims for registration of transfer of German and Chinese patent rights on the ground that the courts of the countries of registration had exclusive jurisdiction. The Tokyo District Court judgment in 2023 (Wa) No. 70022, the “LEGAL FORCE” case <Presiding Judge Takahashi>, likewise dismissed claims for trademark infringement and other relief on the ground that the website did not target consumers in Japan, while recognizing jurisdiction concerning a Japanese domain name. The Osaka District Court judgment in 2023 (Wa) No. 7855, the [Method for Mapping a Physical Hybrid Automatic Repeat Request Indicator Channel] case <Presiding Judge Matsuami>, held that Google had indicated willingness to take a license on FRAND terms, had presented counterproposals, and had negotiated sincerely, and therefore held that the injunction claim based on an SEP constituted an abuse of rights. The [Spindle Motor] case denied joint inventorship for lack of contribution to the core of the invention, and the [Article Conveying Facility] case recognized the reasonableness of employee-invention regulations in light of consultation with the labor union, dissemination, solicitation of opinions, and the evaluation system.

Also important are the [Pharmaceutical Composition/Registration of Patent Term Extension] case, which did not regard revision of a package insert as a disposition eligible for patent-term extension; the [Antipruritic Agent] case, which treated the consumption-tax equivalent differently under paragraphs 1 and 3 of Article 102 of the Patent Act; and the [Patent Royalties Relating to a Fulvic Acid Production Method] case, which did not derive a broad exemption from an abstract cautionary clause. The decisions in this issue should be used to review applications, contracts, litigation, and internal corporate systems.

Three-Line Summaries of All Articles

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ko) No. 10007 [Pharmaceutical Composition/Registration of Patent Term Extension] <Presiding Judge Nakadaira>** **① The issue was whether revision of a pharmaceutical product's package insert constituted a "disposition" providing a basis for registration of a patent-term extension.** **② It was held to be outside the scope of extension registration because the administration rate was not an approved matter, the PMDA's instruction was merely administrative guidance, and a notification of revision of the package insert was not a disposition changing rights or obligations.** **③ This case shows that the dispositions under Article 2, item 2 of the Enforcement Order of the Patent Act are exhaustively enumerated and that a package-insert revision not expressly provided for cannot be extended by analogy to the subject matter of extension registration.**
Patent	**2024 (Ne) No. 10076 [Retractable Temporary Protective Fence] <Presiding Judge Nakadaira>** **① The issue was whether the accused product's "square tube," a square pipe-shaped post, satisfied or was equivalent to the patented invention's "pivoting plate-shaped member."** **② Because the configuration of making the member thin as a "plate" and housing it in the web portion of H-shaped steel was the essential part of the invention, literal infringement was denied and Requirement 1 of the doctrine of equivalents was also held not satisfied.** **③ This case identified, from the problem and effects stated in the specification, a technical idea not found in the prior art, and determined the essential part for Requirement 1 of the doctrine of equivalents.**

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ke) No. 10024 [X-Ray Inspection Device] <Presiding Judge Nakadaira>** **① Of the two cooling circulation systems described in Cited Document 2, the issue was whether the decision properly extracted only the sensor section's "cold-air circulation system" and recognized it as a technical matter.** **② Because the cold-air circulation system for the sensor section and the liquid-refrigerant circulation system for the signal-processing circuit section could be understood as separate technical ideas, the decision was held not to have erred in recognizing only the cold-air circulation system.** **③ This case shows that where multiple configurations in a cited document can be understood as different technical ideas, only one may be objectively and specifically extracted to identify the cited invention.**
Patent	**May 27, 2025; 2021 (Ne) No. 10037 [Antipruritic Agent] <Presiding Judge Hibiku Shimizu>** **① In a case in which the court found infringement of the extended patent right, modified the first-instance judgment, and awarded a total of more than JPY 21.7 billion, the issue was whether the consumption-tax equivalent could be added when calculating damages under paragraphs 1 and 3 of Article 102 of the Patent Act.** **② Lost profits under paragraph 1 were not consideration for a transfer of assets, etc., and consumption tax could not be added, while the reasonable-royalty amount under paragraph 3 could be regarded as such consideration and the consumption-tax equivalent could be added.** **③ This case shows that the consumption-tax treatment of patent-infringement damages differs between lost profits under paragraph 1 and a reasonable royalty under paragraph 3.**

Category	Article Title and Three-Line Summary
Copyright / Trademark	**[Copyrighted Works and Trademark Rights] Tokyo District Court, 2021 (Wa) No. 32244 <Presiding Judge Nakashima>** **① The defendant, a skateboarder and artist, disputed with the plaintiff, its licensee, ownership of copyright and registration of transfer of trademark rights.** **② Copyright in album cover art and the like belonged to the defendant; the plaintiffs had obligations to return the trademark rights and cooperate in their return; and because use premised on the return obligation lacked an intention to possess for oneself, acquisitive prescription did not arise.** **③ This case distinguished, in accordance with the contractual language, transfer of copyright from the grant of an exclusive right of use, and shows that a trademark-return clause also affects whether acquisitive prescription arises.**
Patent	**Osaka District Court, 2024 (Wa) No. 2705 [Angle-Adjustable Hinge] <Presiding Judge Takemiya>** **① The issue was the lawfulness of an action seeking procedures in a Japanese court for registration of transfer of German and Chinese patent rights.** **② Japanese jurisdiction over the transfer-registration claim was denied because of the exclusive jurisdiction of the country of registration. Jurisdiction by appearance was recognized for the alternative claim for a declaration of ownership, but that claim was dismissed for lack of a legal interest in such a declaration.** **③ This case shows that when disputing ownership of a foreign patent, it is necessary to consider the exclusive jurisdiction of the country of registration and whether a Japanese judgment would have legal effect there.**

Category	Article Title and Three-Line Summary
Patent	**Osaka District Court, 2023 (Wa) No. 10970 [Video Viewing Device] <Presiding Judge Takemiya>** **① The issues were whether the accused device had the "compression" of limitations F and G and whether an infringement report to Amazon constituted an act of unfair competition.** **② The limitations were not satisfied because "compression" required temporal shortening of vehicle-travel information so that it fit within a period shorter than the original period, and the damages claim concerning the infringement report was partially granted.** **③ This case shows that a patent-infringement report to a sales platform may give rise to damages liability as an act of unfair competition where the targeted product does not satisfy the patented invention.**
Patent	**2025 (Ne) No. 10008 [Method for Deodorizing a Room in Which a Deceased Person and/or an Animal Has Been Left] <Presiding Judge Nakadaira>** **① The issue was whether limitation E was satisfied in special cleaning, namely that filth remained at a place exposed by dismantling work and that place was covered with paint.** **② The limitation was held not satisfied because an estimate merely predicted the need for coating, and cleaning agents and coating could also be used preventively, so the presence of remaining filth could not be inferred.** **③ This case shows that proof of satisfaction requires objective evidence that filth remained at a place exposed after dismantling, not merely an estimate for the work or the fact that chemicals were used.**

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10084 [Remotely Controlled Unmanned Boat] <Presiding Judge Nakadaira>** **① The issue was whether the "first control device" in limitation J required a mechanism capable of determining both automatic-return activation conditions: signal loss and low remaining power.** **② The flowchart in Figure 8 of the specification and other descriptions required one mechanism that determined both conditions, rather than two inventions separately having each condition; literal infringement was denied, as were Requirements 1 and 5 of the doctrine of equivalents.** **③ This case shows that the relationship among multiple conditions is construed not only from claim language but also from flowcharts in the specification, and a configuration separately providing each condition may fail to satisfy the claim.**
Patent	**2024 (Ne) No. 10078 [Porous Air-Permeable Bag Containing Feed for Mites] <Presiding Judge Honda>** **① The issue was whether the accused product, in which mite attractant was sandwiched between two nonwoven sheets, gauze, or the like, satisfied the "porous air-permeable bag" in limitation A-3.** **② A "bag" required an internal space and an opening that could be closed, retaining its contents and preventing dispersion. The accused product lacked that structure. Limitation A-1 concerning "impregnation" and the first and second requirements for equivalence were also found not satisfied.** **③ This case shows that, in determining whether a "bag" limitation is satisfied, not only external form but also the internal space and opening and the function of retaining contents internally and preventing dispersion is a key matter of proof.**

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10012 [R Badge, Receiving Device] <Presiding Judge Hibiku Shimizu>** **① The issue was whether the matter concerning the mobile telephone “according to claim 4,” cited in a subcombination claim for a receiving device, should be treated as a matter specifying the receiving-device invention.** **② Because the matter had no meaning for specifying the receiving device, it was excluded from the determination of the gist of the invention, and inventive step was denied because applying well-known techniques to the Exhibit Otsu 52 invention would have been easy.** **③ This case shows that a description that specifies only the counterpart device of a subcombination and does not specify the structure or function of the claimed device may be excluded from determination of the gist of the invention.**
Patent	**2024 (Gyo-Ke) No. 10042 [Melting Furnace] <Presiding Judge Masuda>** **① The issue was whether there was motivation to replace the regenerative burner of the primary-reference invention with a well-known flat-flame burner and further add a heat exchanger.** **② Inventive step was affirmed because, despite the existence of the well-known technique, the primary-reference invention deliberately adopted another burner for energy efficiency and other reasons and already included a heat exchanger for waste-heat recovery, so there was no motivation for the replacement or addition.** **③ This case shows that even a well-known technique may lack motivation for application where the primary-reference invention intentionally adopts a different configuration and already solves the same problem.**

Category	Article Title and Three-Line Summary
Patent	**[Patent ★★★] It was held that, because the fifth-generation divisional application violated the divisional requirements, the seventh-generation patent had a ground for invalidation based on lack of novelty over the publication of the original application. — Intellectual Property High Court, 2024 (Gyo-Ke) No. 10086 [Vehicle Guidance System] <Presiding Judge Honda> —** **① The issue was whether the fifth-generation divisional application satisfied the divisional requirements after removing limitations concerning the cases in which vehicles were returned and the determination method, which the fourth-generation specification as originally filed had treated as indispensable to solving the problem.** **② The unrestricted generalization introduced new technical matter and therefore violated the divisional requirements; the seventh-generation application at issue likewise did not receive retroactive effect to the original filing date and lacked novelty over the publication of the original application.** **③ This case shows that a violation of the divisional requirements in the middle of a divisional chain can cause subsequent applications to lose the benefit of retroactivity to the original filing date, so it is necessary to confirm at each generation that the invention remains within the disclosure of the immediately preceding specification and drawings.**

Category	Article Title and Three-Line Summary
Patent	**[Patent ★★] A case in which, on appeal in a patent-infringement action, a new ground for invalidation asserted in the statement of reasons for appeal was held untimely because it could have been asserted in the court of first instance — Intellectual Property High Court, 2024 (Ne) No. 10010 [Women's Garment] <Presiding Judge Nakadaira> — (First Instance: Tokyo District Court, 2021 (Wa) No. 18262 <Presiding Judge Kokubu>)** **① The issue was whether first asserting in the statement of reasons for appeal a new ground for invalidation based on Exhibits Otsu 31 through 33, which could have been submitted in the first instance, constituted an untimely allegation or defense.** **② It was held that the late submission involved gross negligence and ordinarily would have had to be dismissed, but because the appellee rebutted it and the oral argument concluded without a further rebuttal, there was no litigation delay; the court therefore ruled on the merits and rejected the ground for invalidation.** **③ This case shows that even a ground for invalidation submitted in a statement of reasons for appeal may be deemed untimely if it could have been asserted in the first instance, and therefore invalidity materials and defenses should be submitted as fully as possible at the first-instance stage.**

Category	Article Title and Three-Line Summary
Patent	**[Patent ★] A case holding that the configuration and the like of the counterpart of a subcombination were not matters specifying the invention. ⇒ No inventive step — Intellectual Property High Court, July 10, 2025, 2024 (Ne) No. 10012 [R Badge, Receiving Device] <Presiding Judge Hibiku Shimizu> —** **① The issue was the standard for recognizing a feature of the counterpart device stated in a subcombination claim as a matter specifying the claimed device's invention.** **② Matters that specify only the counterpart device and do not specify the structure, function, or the like of the claimed device were excluded from determination of the gist of the invention, and internal circumstances of the mobile telephone and the like were found to produce no difference on the receiving-device side.** **③ To make a limitation on the counterpart device a matter specifying the invention, it is useful to reflect corresponding signal processing, physical shape, timing control, or the like in the claim as a structure or function of the claimed device.**

Category	Article Title and Three-Line Summary
Patent	**[Patent ★] A case in which the description in the detailed description of the invention concerning the method for deriving a parameter in a claim was erroneous, the assertion that the description contained an error was rejected, and the support requirement was denied — Tokyo District Court, 2023 (Wa) No. 70114 [Brake Control Device for a Motorcycle] <Presiding Judge Shibata> — (Same holding on appeal: Intellectual Property High Court, 2024 (Ne) No. 10038 <Presiding Judge Honda>)** **① The issues were whether the formula in the specification for deriving corrected lateral G was physically valid and whether the formula could be corrected as an unambiguous error in the description so that the support requirement was satisfied.** **② The formula subtracting velocity from acceleration had inconsistent dimensions and no meaning in physics; because there were possible solutions other than the correction asserted by the plaintiff and inconsistencies with other descriptions would arise, it was not found to be an error in the description, and the support requirement was denied.** **③ This case shows that calculations and methods for deriving parameters forming the core of problem-solving must be described in the specification with physical consistency and so that a person skilled in the art can understand them unambiguously.**

Category	Article Title and Three-Line Summary
Patent	**2025 (Ne) No. 10001 “Patent Royalties Relating to a Fulvic Acid Production Method” <Presiding Judge Honda>** **① Concerning an agreement intended to transfer an exclusive patent license and sublicense a non-exclusive license, the issues were the validity of termination for breach due to lack of licensing authority and the exemptive effect of Article 7 of the agreement.** **② The article was merely a cautionary clause recognizing the possibility that registration might be unavailable in the future, and was not an exemption for a situation in which the licensing obligation could not be performed from the time of contracting; accordingly, the appellee’s termination was held valid.** **③ This case shows the distinction between a cautionary clause indicating a future risk of failure to register and an exemption from inability to perform the principal obligation existing from the time of contracting.**
Patent	**2023 (Gyo-Ke) No. 10147 [RNA-Dependent Targeted DNA Modification] <Presiding Judge Hibiku Shimizu>** **① The issue was whether the first application documents sufficiently disclosed a PAM sequence, NLS and codon optimization, and application to eukaryotic cells, so that the invention at issue could enjoy the benefit of the priority claim.** **② The court found that the existence and role of PAM sequences were common general technical knowledge, that NLS and codon optimization were applicable well-known techniques, and that application to eukaryotic cells did not require undue experimentation. It therefore recognized substantive disclosure and the benefit of priority.** **③ This case shows that disclosure serving as the basis for priority is judged not only from the wording of the first application documents but also in light of the common general technical knowledge at the filing date and whether undue experimentation was required.**

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court, 2025 (Wa) No. 70003 [Smoking-Article Cartridge] <Presiding Judge Shibuya>** **① The issue was whether, after the defendant waived its claim for damages following the filing of an action for a declaration that the claim did not exist, there remained an interest in immediate determination while customs procedures and the like were still pending.** **② The court denied an interest in immediate determination because there was no actual dispute over nonexistence of the damages claim and a declaratory judgment would not prevent assertion of an injunction claim or the like.** **③ This case shows that after a rights holder conclusively waives a claim for damages, a party seeking to dispute an injunction claim must directly seek a declaration that the injunction claim does not exist.**
Trademark	**[Trademark/Domain] Tokyo District Court, 2023 (Wa) No. 70022, “Legal Force” Case <Presiding Judge Takahashi>** **① The issues were Japan’s international jurisdiction and infringement and the like concerning use of the “LEGAL FORCE” trademark on an English-language website by a U.S. corporation and use of a Japanese domain name.** **② The court denied jurisdiction over the trademark-related claims because the website did not target consumers in Japan; although it recognized jurisdiction over the .JP domain, it denied an improper purpose and dismissed the claims.** **③ This case shows that, for international jurisdiction over web services, the reality of targeting consumers in Japan is important, while for a domain name the location of the administering organization and the purposes of acquisition and use are separately considered.**

Category	Article Title and Three-Line Summary
Patent	**Interlocutory Judgment; 2024 (Ne) No. 10034 [Elasto-Plastic Hysteretic Damper] <Presiding Judge Honda>** **① For an elasto-plastic hysteretic damper, the issues were the direction of "input" in limitation G and whether the "pair of plates" in limitation D was satisfied.** **② The Intellectual Property High Court did not limit "input" to a specified direction, held that the two connecting plates or stiffeners of Σ-shaped Dampers 5 and 6 were a "pair of plates," and held that the cause of the damages claim was well founded with respect to some accused products.** **③ This case did not add a directional limitation to "input" where the claims and specification had none, and determined whether there was a "pair" based on the shape, arrangement, and connection relationships of the members.**
Patent	**Tokyo District Court, 2024 (Wa) No. 70283 [Reservation Management Device] <Presiding Judge Sugiura>** **① The issue was whether "transmission" from the reservation management device to the image printing device included the accused system, which printed image data through a pharmacy terminal.** **② The court denied satisfaction by the accused system because neither the claims nor the specification disclosed or suggested a configuration in which the reservation management device transmitted through another device.** **③ This case shows that satisfaction of a transmission-path limitation should be determined, based on the claims and specification, by distinguishing direct communication between a server and printer from communication through a terminal.**

Category	Article Title and Three-Line Summary
Patent	**Osaka District Court, 2024 (Wa) No. 4500 [Shopping Payment System] <Presiding Judge Matsuami>** **① For a shopping payment system, the issues were whether a barcode scanner was a “camera,” whether it was “associated” with a customer terminal, and whether the “abnormality” detection limitations were satisfied.** **② The court found non-infringement because a scanner acquiring a code was not a camera acquiring an image, correspondence with a membership number was not association with a customer terminal, and detection based on a weight change was not an abnormality based on success or failure of image identification.** **③ This case shows the need to individually confirm whether the information acquired, the object with which a correspondence relationship is established, and the trigger for abnormality detection match the technical configurations defined in the claim.**
Patent	**2024 (Ne) No. 10068 [Leak-Preventing Sealing Material] <Presiding Judge Hibiku Shimizu>** **① The issues were the state in which “diameter” was measured and whether an accused product installed by a third party was an article used exclusively for production of a product infringing the patent at issue.** **② The Intellectual Property High Court construed “diameter” as thickness in the original-yarn state and found non-infringement, and denied indirect infringement because there was no proof that Canon installed the product at the prescribed angle or that there was no other economic, commercial, or practical use.** **③ This case shows that the measurement state of a term is determined from the specification and common general technical knowledge, and that application of Article 101, item 1 of the Patent Act requires proof of the prescribed actual use and absence of other uses.**

Category	Article Title and Three-Line Summary
Patent	**2025 (Ne) No. 10005 [Jig for a Lifeline Post] <Presiding Judge Masuda>** **① The issues were whether the accused product's hook was a "bent portion" formed by bending the end of a rectangular plate into a U shape and whether infringement under the doctrine of equivalents was established.** **② The Intellectual Property High Court denied literal infringement and infringement under the doctrine of equivalents because the hook was not formed by bending the bottom plate into a U shape and the essential part also differed, and affirmed the first-instance judgment finding notification and dissemination of false facts.** **③ This case shows that where not only a member's shape but also its method of formation is specified in a limitation and relates to the essential part, both literal infringement and infringement under the doctrine of equivalents may be denied.**
Patent	**Tokyo District Court, 2024 (Wa) No. 70128 [Box-Shaped Vessel] <Presiding Judge Nakashima>** **① The issue was whether maintenance involving replacement of a pH sensor with a one-year service life and other components constituted "production" under Article 2, paragraph 3, item 1 of the Patent Act.** **② The court held that the pH sensor was a consumable, was not an essential part of the invention, and had extremely slight economic value compared with the box-shaped vessel as a whole; accordingly, replacement did not destroy the product's identity and did not constitute "production."** **③ This case shows that whether replacement constitutes "production" is determined from the service life of the replacement part, its relationship to the essential part, its economic value, and the identity of the product as a whole, and that only the act of installation should not be isolated.**

Category	Article Title and Three-Line Summary
Patent	**2025 (Ne) No. 10004 [Wireless Scuff Plate] <Presiding Judge Nakadaira>** **① The issues were the meaning of "a control module that adjustably switches the backlight module on and off with respect to the time interval between the on and off states" and whether the appellee's products satisfied that limitation.** **② The Intellectual Property High Court construed "adjustable" to mean actively varying the light-emission duration, and found non-infringement because the products did not include a control module that variably adjusted it independently of the timing of magnetic detection.** **③ This case shows that the functional language "adjustable" is judged not merely by whether switching on and off is possible, but by whether there is a configuration capable of variably controlling the target time.**
Patent	**Tokyo District Court, 2024 (Wa) No. 70463 [Connecting Fixture for Faucet Elbows] <Presiding Judge Sugiura>** **① The issues were claims for royalties, etc. under a joint-application agreement concerning a patent right co-owned with the defendant, and contractual claims and tort liability concerning a patent application or application invention for a connecting fixture for faucet elbows that had received a decision of rejection.** **② The court denied the claims because there were no circumstances showing establishment of a right, the invention was not found to be within the agreement at issue, and the defendant's involvement in the application process or working of the invention was not found.** **③ This case shows that imposing contractual or tort liability based on a rejected application invention requires support for establishment of a right, inclusion within the contractual subject matter, and the other party's specific involvement.**

Category	Article Title and Three-Line Summary
Design	**[Design] Osaka District Court, 2023 (Wa) No. 2668, “Vegetated Earth-Retaining Sandbag” Case <Presiding Judge Matsuami>** **① The issues were identification and similarity of a design for an earth-retaining vegetated sandbag including the natural object “grass,” and infringement under the doctrine of equivalents concerning the configuration fixing the vegetation sheet.** **② After specifying the shape of the grass within the range of regularity and reproducibility, the court held that the accused sandbag was dissimilar because, in particular, the manner in which the grass grew differed greatly, and it also denied infringement under the doctrine of equivalents because the fixing configuration was an essential part of the invention.** **③ This case shows that similarity of a design including a natural object may be judged as a reproducible shape, and that a distinctive fixing configuration producing operations and effects may be an essential part under the doctrine of equivalents.**
Patent	**Tokyo District Court, 2024 (Wa) No. 70223 [Game System and Game Program] <Presiding Judge Nakashima>** **① The issues were quantity management and priority consumption of purchased items and in-game acquired items in the game system, and satisfaction of “cumulative number acquired” in the game program.** **② The court denied satisfaction of each patent because the accused system did not distinguish the free portion granted upon purchase from the portion acquired in the game and had no priority-consumption function, and because the relevant value also included the number of skill-ticket uses. It also found Invention 2 at issue to lack inventive step.** **③ This case shows that whether quantities are managed in aggregate or separately, and whether another element is mixed into the target value, affects satisfaction of a claim specifying a data configuration.**

Category	Article Title and Three-Line Summary
Patent	**Osaka District Court, 2023 (Wa) No. 7855 [Method for Mapping a Physical Hybrid Automatic Repeat Request Indicator Channel] <Presiding Judge Matsuami>** **① For an injunction based on a standard-essential patent, the issue was whether Company G's conduct in license negotiations constituted bad-faith holdout.** **② The court held that the time required for NDA negotiations and review of numerous claim charts was unavoidable and that Company G had sincerely negotiated by presenting a reasoned counterproposal and revised proposals; it therefore dismissed the injunction claim as an abuse of rights.** **③ This case shows that sincerity in FRAND negotiations is judged not only by the length of the negotiation period but also by the need for confidentiality and patent review, responses to the basis for the royalty rate, and the reasonableness of counterproposals.**
Patent	**2025 (Ne) No. 10035 [Vehicle Guidance System] <Presiding Judge Honda> (PXZ v. East Nippon Expressway Company Limited)** **① The issues were the scope of "entrance/exit for ordinary vehicles" and whether there was a "guidance means" for returning a vehicle for which ETC toll collection was impossible to a prescribed route.** **② The Intellectual Property High Court found non-infringement because an entrance/exit for ordinary vehicles at a separate adjacent interchange was not included, and a driver's voluntary U-turn without a sign or the like was not guidance by the facility.** **③ This case held that the "entrance/exit for ordinary vehicles" meant an entrance/exit at the same facility where the vehicle guidance system was installed, did not include an entrance/exit at another adjacent interchange, and that a driver's voluntary U-turn without a sign or the like was not "guidance" by the facility.**

Category	Article Title and Three-Line Summary
Patent	**2025 (Ne) No. 10025 [Spindle Motor] <Presiding Judge Nakadaira> ⇒ Claim for Employee-Invention Remuneration** **① The issue was whether the appellant could claim employee-invention remuneration as a joint inventor of patented inventions in Japan, the United States, and China concerning a spindle motor.** **② The Intellectual Property High Court denied joint inventorship and dismissed the claim because the appellant's explanatory document did not address the specific configuration of the communication hole forming the core of the Japanese invention, and the through-holes of the U.S. and Chinese inventions differed from the appellant's idea of a groove.** **③ This case shows that proof of joint inventorship requires materials showing involvement in the specific configuration forming the core of the invention, and that an explanatory document describing a different problem and solution is insufficient.**

Category	Article Title and Three-Line Summary
Patent	**Osaka District Court, 2024 (Wa) No. 7193 [Article Conveying Facility] <Presiding Judge Matsuami> ⇒ Claim for Employee-Invention Remuneration Dismissed** **① The issues were whether the establishment, operation, dissemination, and content of internal employee-invention rules were unreasonable under Article 35, paragraph 5 of the Patent Act and whether a reasonable benefit could be claimed under paragraph 7 of that Article.** **② In light of consultation with the labor union, solicitation of opinions from all employees, continuous access and training, performance rewards based on objective indicators, and opportunities to state opinions, the court held that the rules were not unreasonable and dismissed the claim.** **③ This case shows that consultation and solicitation of opinions when rules are established, dissemination of the system, objective evaluation, rewards according to performance, and opportunities for inventors to state opinions are emphasized as circumstances supporting the reasonableness of the rules.**

2024 (Gyo-Ko) No. 10007 [Pharmaceutical Composition/Registration of Patent Term Extension] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b310007%e3%80%90%e5%8c%bb%e8%96%ac%e7%b5%84%e6%88%90%e7%89%a9-%e5%ad%98%e7%b6%9a%e6%9c%9f%e9%96%93%e5%bb%b6%e9%95%b7%e7%99%bb%e9%8c%b2%e3%80%91%ef%bc%9c/

2024 (Gyo-Ko) No. 10007 [Pharmaceutical Composition/Registration of Patent Term Extension] <Presiding Judge Nakadaira>

<Issue> Does a “revision of the package insert” for a pharmaceutical product constitute a “disposition” that provides a basis for registration of a patent-term extension (Article 67, paragraph 4 of the Patent Act and Article 2 of the Enforcement Order of the Patent Act)?

⇒ A revision of a package insert does not constitute a “disposition” eligible for registration of an extension.

(1) Legal Nature of the Revision of the Package Insert (Related to Issue 1)

<Distinction from Approved Matters>

In the marketing approval for the pharmaceutical product at issue, the “administration rate” was not applied for as an approved matter (dosage and administration) and was not subject to review. The PMDA’s instruction concerning the administration rate remained administrative guidance and was not a legally binding disposition.

<Not a Lifting of a Prohibition>

Even before the revision of the package insert, the administration method at issue (administration at a high rate) was not prohibited by law. Accordingly, the revision

of the package insert did not lift any prohibition (and thereby make working of the patented invention possible).

<Difference from Partial-Change Approval>

Filing a notification of revision of the package insert is performance of an obligation by the marketing authorization holder, and does not in itself mean that an administrative agency changed rights or obligations (a disposition). It therefore differs in legal nature from “partial-change approval” under the Pharmaceuticals and Medical Devices Act.

(2) Whether the Enforcement Order May Be Applied by Analogy (Related to Issue 2)

The “dispositions” that provide a basis for registration of an extension under Article 2, item 2 of the Enforcement Order of the Patent Act are understood to be an exhaustive enumeration.

Although the Enforcement Order has been amended repeatedly, it has not been amended to include revision of a package insert as a disposition even after introduction of the package-insert revision consultation system.

In view of the foundation of the patent system (the public interest), under which anyone may freely use an invention after expiration of the patent term, a “revision of a package insert,” for which there is no express provision, should not be made eligible for registration of an extension by analogical interpretation.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94150.pdf

2024 (Ne) No. 10076 [Retractable Temporary Protective Fence] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10076%e3%80%90%e8%b5%b7%e4%bc%8f%e5%8f%8e%e5%ae%b9%e5%bc%8f%e4%bb%ae%e8%a8%ad%e9%98%b2%e8%ad%b7%e6%9f%b5%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2024 (Ne) No. 10076 [Retractable Temporary Protective Fence] <Presiding Judge Nakadaira>

The accused product's "square tube" (a square pipe-shaped post) does not literally satisfy the "pivoting plate-shaped member" of the patented invention.

The problem addressed by the invention is "to provide a raisable and stowable temporary protective fence that can reduce the width of the raising and lowering members of a temporary protective fence and achieve reduced weight, compactness, and the like, while enabling improved efficiency of installation and removal work," as described in paragraph [0007] of the corrected specification, etc.

⇒ Paragraph [0009] of the corrected specification, etc. states that "because the pivoting plate-shaped member has thickness in the short-side direction, its width in the short-side direction can be made thin" (judgment, p. 12). In summary, the effect described in the holding is that making the pivoting plate-shaped member thin enables the guardrail and the pivoting plate-shaped member to be lowered and housed within the width of the web portion of the base frame (H-shaped steel).

⇒ The configuration of making the post thin by making it "plate-shaped," so that it fits in the recess (web portion) of the H-shaped steel, is a distinctive technical idea not found in the prior art (= the essential part).

⇒ No infringement under the doctrine of equivalents (Requirement 1 not satisfied).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94147.pdf

2024 (Gyo-Ke) No. 10024 [X-Ray Inspection Device] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110024%e3%80%90%ef%bd%98%e7%b7%9a%e6%a4%9c%e6%9f%bb%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2024 (Gyo-Ke) No. 10024 [X-Ray Inspection Device] <Presiding Judge Nakadaira>

Cited Document 2 describes a “cold-air circulation system” for the sensor section and a “liquid-refrigerant circulation system” for the signal-processing circuit section, but these can be understood as separate technical ideas in terms of cooling configurations.

⇒ Accordingly, the decision did not err in extracting and finding only the “cold-air circulation system” related to cooling of the sensor section.

(Excerpt from the Holding)

The decision at issue is found to have objectively and specifically identified, as a cooling configuration and on the basis of the above descriptions in Cited Document 2, the cold-air circulation system that removes heat from the sensor section, which is one of the two circulation systems that can be understood as embodying different technical ideas. In light of the foregoing, no error is found in the decision’s identification of the technical matter described in Cited Document 2.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94148.pdf

May 27, 2025; 2021 (Ne) No. 10037 [Antipruritic Agent] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b45%e6%9c%8827%e6%97%a5-%e4%bb%a4%e5%92%8c3%e5%b9%b4%e3%83%8d10037%e3%80%90%e6%ad%a2%e7%97%92%e5%89%a4%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

May 27, 2025

2021 (Ne) No. 10037 [Antipruritic Agent] <Presiding Judge Hibiku Shimizu>

<Damages> Treatment of the Consumption-Tax Equivalent

Article 4 and Article 2, paragraph 1, item 8 of the Consumption Tax Act, and Basic Circular 5-2-5 on the Consumption Tax Act

⇒ Lost profits calculated as “sales quantity × profit per unit” under Article 102, paragraph 1 of the Patent Act cannot be regarded as “consideration for a transfer of assets, etc.,” and consumption tax therefore cannot be added.

On the other hand, the “amount of money the patentee would have been entitled to receive for the working of the patented invention” under Article 102, paragraph 3 of the Patent Act is an amount equivalent to a royalty determined after the fact between the patentee and the infringer, and can be regarded as “consideration for a transfer of assets, etc.”; accordingly, the consumption-tax equivalent may be added to that extent.

Note: The determinations on the grounds for invalidity of the term-extension registration are to the same effect as the judgment of the same date in 2024 (Gyo-Ke) No. 10033 [Antipruritic Agent (Nalfurafine Hydrochloride/Patent-Term Extension)] <Presiding Judge Hibiku Shimizu>.

https://www.courts.go.jp/assets/hanrei/hanrei-point_pdf-94302.pdf

[Copyrighted Works and Trademark Rights] Tokyo District Court, 2021 (Wa) No. 32244 <Presiding Judge Nakashima>

Former Nakamura & Partners article URL: https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e8%91%97%e4%bd%9c%e7%89%a9%e3%83%bb%e5%95%86%e6%a8%99%e6%a8%a9%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c3%e5%b9%b4%e3%83%af32244%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e/

Sources (author: Hideki Takaishi; article title: [Copyrighted Works and Trademark Rights] Tokyo District Court judgment, 2021 (Wa) No. 32244 <Nakashima>)
Blog: https://ameblo.jp/hideki-takaishi/entry-12954423597.html
Personal website: https://www.takaishihideki.com/single-post/linkedin-7512399803360694272-ja

[Copyrighted Works and Trademark Rights] Tokyo District Court, 2021 (Wa) No. 32244 <Presiding Judge Nakashima>

The defendant (AI), a skateboarder and artist, sought registration of transfer of the trademark rights from the plaintiff SI, with which the defendant had entered into a license agreement and conducted business (counterclaim).

① Copyright in each of the copyrighted works at issue belongs to the defendant.

Plaintiff SI asserted that it had acquired the copyright under the 2000 music agreement at issue. Under the proper construction of that agreement, however, musical works and the like were subject to transfer (“shall be transferred”), whereas album cover art and the like were merely subject to the grant of an exclusive right of use for promotional purposes (“shall have the exclusive rights”).

② The plaintiffs are obligated to return each of the trademark rights at issue to the defendant and to cooperate in effecting the return.

Article 11 of the license agreement at issue provides that marks such as “MARK GONZALES” may be registered for protection of the rights, on the condition that the trademark registrations be returned to the defendant upon the defendant’s

request.

The plaintiffs asserted acquisitive prescription, but because their use presupposed an obligation to return the rights and no “intention to possess for oneself” was found, acquisitive prescription did not arise.

Note: U.S. and Korean judgments were cited as evidence. Because California law was the governing law, citation of the U.S. judgment is understandable, but citation of the Korean judgment is interesting.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93786.pdf

Osaka District Court, 2024 (Wa) No. 2705 [Angle-Adjustable Hinge] <Presiding Judge Takemiya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af2705%e3%80%90%e8%a7%92%e5%ba%a6%e8%aa%bf%e6%95%b4%e5%8f%af%e8%83%bd%e3%81%aa%e3%83%92%e3%83%b3%e3%82%b8%e3%80%91%ef%bc%9c/

Osaka District Court, 2024 (Wa) No. 2705 [Angle-Adjustable Hinge] <Presiding Judge Takemiya>

Claims seeking procedures for registration of transfer of German and Chinese patent rights

⇒ Dismissed as inadmissible.

An action concerning patent registration is subject to the exclusive jurisdiction of the courts of “the place where registration is to be made (that country).” Japanese courts have no jurisdiction.

For the alternative claim for a declaration of ownership, jurisdiction by appearance was recognized under Article 3-8 of the Code of Civil Procedure because the Defendant argued the merits without objecting to jurisdiction. The following discussion of litigation in China, Germany, and Japan concerns the legal interest in that declaratory claim.

(China) Because there is no reciprocity for recognition of judgments between Japan and China, a final Chinese judgment in the defendant’s favour would not be recognised in Japan. Therefore, there is no legal interest in obtaining a declaration of ownership of the patent rights in Japan in order to prevent recognition of that Chinese judgment on the ground of inconsistency with an earlier Japanese judgment.

(Germany) No concrete possibility that the plaintiff would conduct business in Germany was shown, and the legal dispute had not matured.

(Risk of Suit in Japan) The judgment examined territoriality and Article 22 of the Act on General Rules for Application of Laws in relation to claims based on

instructions or proposals made in Japan. It also recognized that a damages claim could succeed if the actor in China was merely an instrument and the individual Plaintiff was found to be the direct infringer in China. Nevertheless, the dispute was insufficiently mature in this case to justify an abstract declaration of ownership in anticipation of future litigation. The judgment does not generally exclude claims in Japan based on infringement of foreign patents.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94374.pdf

Osaka District Court, 2023 (Wa) No. 10970 [Video Viewing Device] <Presiding Judge Takemiya>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af10970%e3%80%90%e6%98%a0%e5%83%8f%e8%a6%96%e8%81%b4%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e6%ad%a6%e5%ae%ae%ef%bc%9e/

Osaka District Court, 2023 (Wa) No. 10970 [Video Viewing Device] <Presiding Judge Takemiya>

For the accused device to have the “compression” of limitations F and G, where vehicle-travel information exists for period T1 (or for “period T2 + period T1”), the vehicle-travel information must be temporally shortened (compressed) so that it fits within period T2, which is shorter than those periods.

⇒ Limitation not satisfied.

⇒ The claim for damages was partially granted (Case B; JPY 10,700,382) on the ground that the infringement report to Amazon constituted an act of unfair competition!!

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94185.pdf

2025 (Ne) No. 10008 [Method for Deodorizing a Room in Which a Deceased Person and/or an Animal Has Been Left] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10008%e3%80%90%e6%95%85%e4%ba%ba%e5%8f%8a%e3%81%b3%ef%bc%8f%e5%8f%88%e3%81%af%e5%8b%95%e7%89%a9%e3%81%ae%e6%94%be%e7%bd%ae%e3%81%95%e3%82%8c%e3%81%9f%e9%83%a8/

2025 (Ne) No. 10008 [Method for Deodorizing a Room in Which a Deceased Person and/or an Animal Has Been Left] <Presiding Judge Nakadaira>

Court of first instance: Tokyo District Court, 2023 (Wa) No. 70512

Limitation E: “a coating step of covering with paint a place where filth remains and that was exposed by the dismantling work”

⇒ Limitation not satisfied.

(Summary of the Holding)

<Description in the Estimate>

Inclusion in the estimate merely showed a “prediction” that coating work would probably be necessary, and did not provide a basis for finding the objective fact that filth actually remained at a place exposed after dismantling.

<Use of Chemicals>

Even if a cleaning agent or coating was used in special cleaning, its use was not limited to cases in which filth remained and could have been preventive or merely precautionary.

Accordingly, the fact that such work was performed, by itself, cannot support an inference that filth remained at a place exposed by dismantling.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94197.pdf

2024 (Ne) No. 10084 [Remotely Controlled Unmanned Boat] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10084%e3%80%90%e9%81%a0%e9%9a%94%e6%93%8d%e7%b8%a6%e7%84%a1%e4%ba%ba%e3%83%9c%e3%83%bc%e3%83%88%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2024 (Ne) No. 10084 [Remotely Controlled Unmanned Boat] <Presiding Judge Nakadaira>

The “first control device” in limitation J is a mechanism capable of making determinations concerning both automatic-return activation condition ① (loss of signal) and condition ② (low remaining power). … It is also clear from Figure 8 of the specification—namely, the flowchart provides that automatic return occurs if no signal is received within a prescribed time; if receipt is confirmed, the process proceeds to determine whether the remaining power is at or below a prescribed value; and, if automatic return has not occurred, both conditions are checked—that the specification does not describe two separate inventions, one having condition ① and the other having condition ②.

⇒ No literal infringement.

No infringement under the doctrine of equivalents either; Requirements 1 and 5 not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94196.pdf

2024 (Ne) No. 10078 [Porous Air-Permeable Bag Containing Feed for Mites] <Presiding Judge Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10078%e3%80%90%e3%83%80%e3%83%8b%e7%94%a8%e9%a3%9f%e9%a4%8c%e5%85%a5%e3%82%8a%e3%81%ae%e5%a4%9a%e5%ad%94%e8%b3%aa%e9%80%9a%e6%b0%97%e6%80%a7%e8%a2%8b%e3%80%91/

2024 (Ne) No. 10078 [Porous Air-Permeable Bag Containing Feed for Mites] <Presiding Judge Honda>

★ The patent is the same as in the court of first instance, Osaka District Court, 2022 (Wa) No. 11025.

* The invention at issue has a structure capable of retaining the attractant internally.

⇒ The accused product merely sandwiches the mite attractant between two nonwoven fabric sheets, gauze, or the like, and the mite attractant falls out from around the perimeter; therefore, the limitation is not satisfied.

Note: … Is the accused product really like that? Should it have been proved through experiments or the like that the material did not fall out?

Supplement: The preceding question is the author's observation on proof. The court required the structure of a "bag," including an internal space and an opening that could be closed; an allegation that more than 80% of the attractant was retained was insufficient. It separately rejected "impregnation" in Limitation A-1 and the first and second requirements for equivalence. Proof that the material did not fall out would therefore not, by itself, change the outcome.

(Court of First Instance — Excerpt from the Holding)

According to the specification, the invention at issue aims to exhibit a high mite-capturing capability. Its means are to attract mites over a broad area by diffusing a mite attractant from a woven sheet impregnated with the mite attractant, and then to arrange inside the mat an adhesive tape for capturing mites and porous air-permeable bags containing mite feed attached to the adhesive tape in a

staggered pattern, so that mites attracted by the mite attractant further enter the inside from both the front and back surfaces of the mat, contact the adhesive tape, and are captured there. In addition, because the configuration impregnates a woven sheet with “fragrance” as the substance that attracts mites and arranges the porous air-permeable bags containing “feed” on both the front and back surfaces of the double-sided adhesive tape, thereby luring the mites inside the porous air-permeable cover and bringing them into contact with an unmixed adhesive layer so that they are captured, the “porous air-permeable bag” in the invention is expected to have a function that keeps the feed at the same location and does not reduce the adhesiveness of the adhesive layer. Moreover, the structure of the porous air-permeable bag makes it possible to achieve these results with one bag and to reduce the number of constituent materials.

In light of the foregoing, it is appropriate to construe “porous air-permeable bag” in limitation A-3, both according to its dictionary meaning and the specification, as requiring at least a structure capable of retaining the enclosed material inside and preventing its dispersion. In the accused product sold, by contrast, the mite attractant is merely sandwiched between two nonwoven fabric sheets, gauze, or the like, and falls out from around the perimeter; accordingly, the product cannot be found to have a structure capable of retaining the attractant inside.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94224.pdf

2024 (Ne) No. 10012 [R Badge, Receiving Device] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c%ef%bc%96%e5%b9%b4%e3%83%8d10012%e3%80%90%ef%bd%92%e3%83%90%e3%83%83%e3%82%b8%e3%80%81%e5%8f%97%e4%bf%a1%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

2024 (Ne) No. 10012 [R Badge, Receiving Device] <Presiding Judge Hibiku Shimizu>

* A case in which a subcombination limitation was held not to be a matter specifying the invention.

As of the priority date of the patent at issue, techniques of incorporating smart-card functionality into a mobile telephone and communicating by RFID (Exhibit Otsu 19), and of communicating between a mobile telephone and a receiving terminal instead of using an IC card (Exhibits Otsu 9 and 11), were well-known techniques to a person skilled in the art. The invention of Exhibit Otsu 52 and these well-known techniques shared a technical field, and a person skilled in the art could easily have conceived of adopting a configuration in which the contactless data carrier of the Exhibit Otsu 52 invention was a mobile telephone.

⇒ No inventive step.

(Excerpt from the Holding)

The matter concerning the mobile telephone “according to claim 4,” which is the “other subcombination” in corrected claim 5, can be said to have no meaning for specifying the invention of the “receiving device” in Corrected Invention 5.

Accordingly, in determining the gist of Corrected Invention 5, it is appropriate to exclude the matter “according to claim 4.”

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94282.pdf

2024 (Gyo-Ke) No. 10042 [Melting Furnace] <Presiding Judge Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c%ef%bc%96%e5%b9%b4%e8%a1%8c%e3%82%b110042%e3%80%90%e6%ba%b6%e8%a7%a3%e7%82%89%e3%80%91%ef%bc%9c%e5%a2%97%e7%94%b0%ef%bc%9e/

2024 (Gyo-Ke) No. 10042 [Melting Furnace] <Presiding Judge Masuda>

① Although flat-flame burners were well known, the primary reference deliberately adopted a regenerative holding burner for reasons including energy efficiency.
② The primary reference already included a heat exchanger for exhaust-heat recovery, and there was no motivation to add another heat exchanger.
⇒ Inventive step affirmed.

(Excerpt from the Holding)

Although flat-flame burners were well known for uses such as aluminum melting when the tower-type nonferrous-metal melting and holding furnace of the Exhibit Ko 3 invention was placed on the market, it can be found that a regenerative burner was deliberately adopted as the holding burner from the standpoint of energy efficiency and the like. Accordingly, it cannot be found that a person skilled in the art who encountered the Exhibit Ko 3 invention would have been motivated to deliberately adopt a flat-flame burner in place of that holding burner.

The holding burner of the Exhibit Ko 3 invention is found to employ a regenerative burner, and a regenerative burner has a self-contained waste-heat recovery function, namely, a function of drawing in exhaust gas, exchanging heat in a heat-storage body, and preheating air, and therefore includes a heat exchanger; … thus, no motivation can be said to exist to additionally provide a further heat exchanger.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94212.pdf

[Patent ★★★] It was held that, because the fifth-generation divisional application violated the divisional requirements, the seventh-generation patent had a ground for invalidation based on lack of novelty over the publication of the original application. — Intellectual Property High Court, 2024 (Gyo-Ke) No. 10086 [Vehicle Guidance System] <Presiding Judge Honda> —

Original Article URL:
https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e2%98%85%e3%80%91%e7%ac%ac%ef%bc%95%e4%b8%96%e4%bb%a3%e5%88%86%e5%89%b2%e5%87%ba%e9%a1%98%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e5%88%86%e5%89%b2%e8%a6%81/

◆ Judgment Text

[Summary of This Judgment and Some Observations]

1. Overview of the Case

The fourth-generation specification, etc. as originally filed states, as indispensable configurations in the invention of a vehicle guidance system, (i) the matter of causing a vehicle that cannot use ETC to travel on a branch lane and return when that vehicle enters an ETC-only lane, and (ii) the matter of determining whether a vehicle is one to be returned according to whether wireless communication between an ETC on-board unit and a roadside antenna is possible; and it does not disclose a technical concept that does not make items (i) and (ii) above essential configurations.

By contrast, each invention recited in the claims of the fifth-generation divisional application introduces, in a three-way branching lane provided with either a lane that branches from an entrance-side lane extending from an ordinary road toward a parking area or service area of a toll road and returns to the ordinary road, or a lane that branches from an exit-side lane extending from a parking area or service

area of a toll road toward an ordinary road and returns to the parking area or service area, a new technical matter whereby, with respect to opening and closing the two barriers on the left and right beyond the branch, no determination means is specified, so that, according to any criterion or method not limited to one involving a determination as to whether an inability or failure of wireless communication has occurred between the roadside antenna and the on-board unit of the ETC system, one of the barriers remains closed while the other opens, thereby guiding a vehicle either to continue traveling on the main lane or to enter the branch lane. Because (i) there is no limitation on the circumstances in which the vehicle is caused to travel on the branch lane and return and (ii) there is no limitation on the method for determining a vehicle to be returned, these two configurations constitute an unlimited generalization of the essential configurations described in the fourth-generation specification, etc. as originally filed

Accordingly, each fifth-generation invention should be regarded as introducing new technical matter in relation to the technical matter derived from all the descriptions in the fourth-generation specification, etc. as originally filed. The fifth-generation divisional application is therefore not entitled to application of the main clause of Article 44(2) of the Patent Act, and its filing date is its actual filing date, December 2, 2014.

It follows that the filing date of the application at issue, which is the seventh-generation divisional application, can relate back only as far as December 2, 2014.

Exhibit Ko 9 (Japanese Unexamined Patent Application Publication No. 2006-79580, which is the publication of the first original application), which was distributed in Japan before December 2, 2014, describes the configuration of a vehicle guidance system installed at a toll-road tollgate that includes the respective configurations of Inventions 1 and 2 at issue, and states that a vehicle guidance system having the same configuration may be installed at a service area or parking area.

Accordingly, each invention at issue is an invention described in Exhibit Ko 9 and cannot be patented under Article 29(1)(iii) of the Patent Act.

2. Excerpts from the Holding

According to the wording of the claims, each fifth-generation invention is described as a smart interchange having an ETC-only entrance tollgate, an ETC-only exit tollgate, or both, and including, as its configuration, a three-way branching lane consisting of the lane on which that tollgate is installed (hereinafter the “main lane”) and a lane branching from the main lane on which a vehicle returns (hereinafter the “branch lane”); barriers installed at one location before the branch of the three-way branching lane and at two locations on the left and right beyond the branch; and a vehicle detection device installed on the main lane before the branch of the three-way branching lane. Each invention is further described as opening only one of the barriers installed at the two locations on the left and right beyond the branch when detection of a vehicle by the vehicle detection device serves as the trigger.

By contrast, in each fifth-generation invention, at least (i) the circumstances in which a vehicle is caused to travel on the branch lane and return (Claim 1 of the fourth-generation specification, etc. as originally filed: "when an inability or failure to communicate occurs between the roadside antenna and the on-board unit") and (ii) the determination, by wireless communication of the ETC system, of whether the vehicle is one that should be returned (a matter such as Claim 3 thereof: "the roadside antenna has a pre-gate antenna for determining whether wireless communication with the on-board unit is possible and an ETC antenna for transmitting and receiving entrance information and toll information") are not recited as matters specifying the invention.

Accordingly, each fifth-generation invention has (i) no limitation on the circumstances in which a vehicle is caused to travel on the branch lane and return and (ii) no limitation on the method for determining a vehicle to be returned.

...

The fourth-generation specification, etc. as originally filed states, in relation to the problem that, if a vehicle that cannot use ETC enters an ETC-only lane, there is a risk of congestion or collision with a following vehicle, as means for solving that problem, matters such as providing means by which such vehicles that cannot use ETC can leave the ETC-only lane, providing, as the leaving means, a lane branching from the ETC-only lane, and guiding a vehicle by lowering a barrier when entry of the vehicle is detected; and it is recognized that it discloses a vehicle guidance system that, upon detecting a vehicle that cannot use ETC, guides the vehicle so as to cause it to leave the ETC-only lane. In addition, as the method for detecting and identifying a vehicle that cannot use ETC, it is stated, as seen in paragraphs [0010] and [0012], that this is done according to whether there is an "inability or failure to communicate between the roadside antenna and the on-board unit"; and, in the description of the embodiments, paragraphs [0031] to [0053] and [0066] to [0068], Figures 3 to 8, and Figure 12 disclose that this is done according to whether the vehicle is capable of ETC wireless communication. Further, paragraphs [0054] to [0062], Figures 9 and 10, which are an example of an interchange with an enhanced reverse-entry prevention function, and paragraphs [0063] to [0065] and Figure 11, which are an example of a vehicle guidance system for a smart interchange, also state that "Figure 9 is a modified example of Figure 4" ([0055]) and that "except that there are no ordinary-vehicle lanes B and C, the roles of lanes (A→D) and (A→E) at entrance tollgate 12 and the roles of lanes (A→D) and (A→E) at exit tollgate 13 are the same as those in Figures 3, 4, 6 and 7" ([0064]); thus, all of them are premised on guidance according to whether the vehicle is capable of ETC wireless communication. Accordingly, it is recognized that the fourth-generation specification, etc. as originally filed, in the invention of a vehicle guidance system that causes a vehicle unable to use ETC to leave an ETC-only lane in order to solve the problem of congestion and the risk of collision with a following vehicle, respectively describes, as specific means for solving the problem, (i) the matter of causing the vehicle to travel on a branch lane and return when a vehicle unable to use ETC has entered an ETC-only lane, and (ii) the matter of determining whether the vehicle is one to be returned according to whether wireless communication

between the ETC on-board unit and the roadside antenna is possible. Moreover, even considering all descriptions in the fourth-generation specification, etc. as originally filed as a whole, there is no other description disclosing or suggesting the circumstances in which a vehicle is caused to travel on a branch lane and return, or a method for determining a vehicle to be returned. Therefore, items (i) and (ii) above should be regarded as indispensable configurations for solving the problem in the invention disclosed in the fourth-generation specification, etc. as originally filed ...

By contrast, ... each fifth-generation invention introduces, in a three-way branching lane provided with either a lane that branches from an entrance-side lane extending from an ordinary road toward a parking area or service area of a toll road and returns to the ordinary road, or a lane that branches from an exit-side lane extending from a parking area or service area of a toll road toward an ordinary road and returns to the parking area or service area, a new technical matter whereby, with respect to opening and closing the two barriers on the left and right beyond the branch, no determination means is specified, so that, according to any criterion or method not limited to one involving a determination as to whether an inability or failure of wireless communication has occurred between the roadside antenna and the on-board unit of the ETC system, one of the barriers remains closed while the other opens, thereby guiding a vehicle either to continue traveling on the main lane or to enter the branch lane. Because (i) there is no limitation on the circumstances in which a vehicle is caused to travel on the branch lane and return and (ii) there is no limitation on the method for determining a vehicle to be returned, these two configurations constitute an unlimited generalization of the essential configurations described in the fourth-generation specification, etc. Accordingly, each fifth-generation invention should be regarded as introducing a new technical matter in relation to the technical matter derived by considering all descriptions in the fourth-generation specification, etc. as originally filed as a whole. ...

The Defendant alleges that Fifth-Generation Invention 1 merely extracts and recites, from among the inventions described in the fourth-generation

specification, etc. as originally filed, the invention relating to guidance means that uses a vehicle detection device and barriers to guide a vehicle either to continue traveling on the entrance-side lane or to return to the return road. However, if the invention is one of guidance means that uses a vehicle detection device and barriers to guide a vehicle either to continue traveling on the entrance-side lane or to return to the return road, then, in order to associate the vehicle detection device with the barriers, the guidance means cannot function as such unless there is means or a method for deciding to which lane a detected vehicle is to be guided. Yet, ... the fourth-generation specification, etc. as originally filed describes, as the means or method for deciding to which lane a detected vehicle is to be guided, only the method of determining whether wireless communication between the ETC on-board unit and the roadside antenna is possible. It must therefore be said that extracting from the fourth-generation specification, etc. as originally filed an invention of guidance means that uses a vehicle detection device and barriers to guide a vehicle to one of the lanes without specifying the means or method for deciding to which lane the detected vehicle is to be guided introduces a new technical matter in relation to the technical matter described in the fourth-generation specification, etc. as originally filed The Defendant also alleges that, where the invention of the original application is a manufacturing method consisting of a first step and a second step, amending it to an invention of only the first step does not constitute the addition of new matter, and therefore, in this case as well, filing a divisional application directed only to the downstream configuration of the invention described in the fourth-generation specification, etc. as originally filed does not constitute the addition of new matter. However, what is described in the fourth-generation specification as originally filed is a vehicle guidance system having a processing flow such as that shown in Figure 5 below, namely, a system in which the processes of vehicle detection by the vehicle detection device, communication between the pre-gate antenna and the ETC on-board unit, determination of whether ETC toll collection is possible, guidance by the vehicle guidance device, and opening and closing of the barriers are carried out in sequence and achieve the objective as a whole; a system omitting its

principal processes (S04, S06, and S07 in the example of Figure 5) cannot function as guidance means. Therefore, it cannot automatically be equated with an invention of a method for manufacturing an article consisting of a first step for obtaining an intermediate product and a second step for obtaining a final product, so as to permit a divisional application directed only to the downstream configuration. Accordingly, the Defendant’s allegation cannot be accepted. ([Figure 5])

The Defendant alleges that Fifth-Generation Invention 1 is an independent invention that has the object of preventing unauthorized vehicles and that prevents unauthorized vehicles from entering in reverse from the lanes by keeping the two barriers installed on the left and right beyond the branch of the three-way branching lane constantly "closed" and opening one of the barriers upon detecting passage of a vehicle. However, in paragraphs [0054] to [0062] of the fourth-generation specification, etc. as originally filed, which refer to preventing entry of unauthorized vehicles, it is stated, as means for solving such a problem, that a new barrier and vehicle detection device are installed in each of the two branched lanes to form a closed section. In addition, it expressly states: "The embodiment described with reference to Figure 4 has the problem that it cannot prevent an unauthorized vehicle, for such a purpose as nonpayment of a toll, from entering an ETC vehicle lane in reverse from the exit of the ETC vehicle lane or the exit of the leaving lane" ([0054]); thus, it is expressly stated that the configuration in which one of the two barriers on the left and right beyond the branch remains closed while the other opens (the configuration described in paragraphs [0034] and [0035] with reference to Figure 4) does not solve the problem alleged by the Defendant. In light of such descriptions, a person skilled in the art could not recognize that the fourth-generation specification, etc. as originally filed describes an invention that has the object, as alleged by the Defendant, of preventing reverse entry of unauthorized vehicles and uses the configurations of the respective fifth-generation inventions as the means for solving that problem. Accordingly, the Defendant’s allegation cannot be accepted. ...

3. Infringement Judgment of the Same Date (2025 (Ne) No. 10035) — Non-Satisfaction Under the Same Logic as This Judgment

(1) Non-Satisfaction of "Entrance/Exit for Ordinary Vehicles" (Limitation 2E)

Based on the description of the specification at issue and other matters, the court held that the term "entrance/exit for ordinary vehicles" does not include the entrance/exit for ordinary vehicles of another interchange adjacent to the toll-road tollgate, service area, parking area, or the like at which the vehicle guidance system according to Invention 2 at issue is installed.

(Excerpt from the Holding)

It cannot be read from the description of the parent-application specification at issue that the use, by a vehicle that could not use the smart interchange because ETC toll collection was impossible, of an entrance/exit for ordinary vehicles at another adjacent interchange is the result of guidance by the guidance means according to Invention 2 at issue. Accordingly, the "entrance/exit for ordinary vehicles" in Limitation 2E cannot be construed as including the entrance/exit for ordinary vehicles of another interchange adjacent to the toll-road tollgate, service area, or parking area at which the vehicle guidance system according to Invention 2 at issue is installed.

(2) Non-Satisfaction of "Guidance Means" (Limitation 2E)

The court held that "guidance" means inviting and leading toward a destination and that, where there are no signs or the like (including no sign or the like instructing a U-turn), even if the driver could make a U-turn and return to a point before the ETC-only entrance/exit, this does not constitute "guidance means" for a route returning to a point before the ETC-only entrance/exit.

(Excerpt from the Holding)

"Guidance" means inviting and leading toward a destination. Because no sign or the like instructing a U-turn exists within any of the Plaintiff’s facilities, it cannot be said that the Plaintiff’s facilities invite and lead a vehicle for which ETC toll

collection is impossible onto a route returning it again to a point before the ETC-only entrance/exit. Even if it is factually possible for the driver of that vehicle, by the driver's own choice, to make a U-turn and return again to a point before the ETC-only entrance/exit, it must be said to be unreasonable to characterize such travel of the vehicle based on the driver's intention as being attributable to guidance means installed at the Plaintiff's facilities. Accordingly, none of the Plaintiff's facilities can be said to include guidance means that guide a vehicle for which ETC toll collection is impossible onto a "route returning it again to a point before the ETC-only entrance/exit."

4. Some Observations

At a time when the proportion of divisional applications is increasing, there is concern that instances will increase in which the addition of new matter in a patent application partway through a divisional tree prevents the filing date from relating back to the filing date of the original application, resulting in denial of novelty or inventive step. Although there have previously been few cases in which courts have so held, such cases are expected to increase.

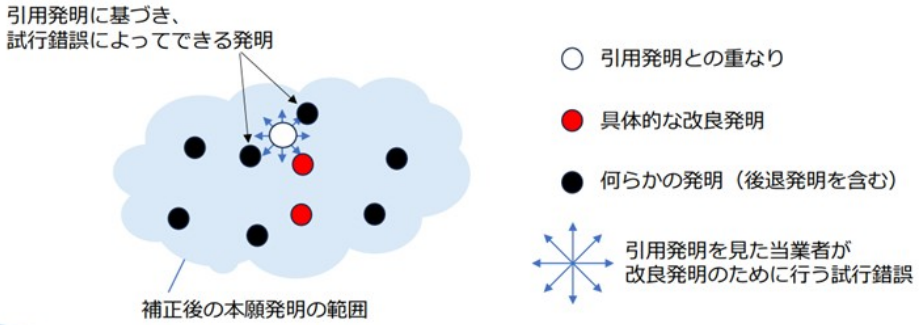
In particular, in 2025 the Japan Patent Office issued a message suggesting revision of the Examination Guidelines in the direction of making the amendment requirements for so-called "excluding claims" stricter. If inventions claimed in issued patents by means of "excluding claims" begin to be held to have a ground for invalidation based on the addition of new matter, the problem described above will surface, and there is concern that patent practice will become confused in the future. (See the materials of the 18th Working Group of the Examination Standards Subcommittee, Patent System Subcommittee, Intellectual Property Committee, Industrial Structure Council.)

https://www.jpo.go.jp/resources/shingikai/sangyo-kouzou/shousai/kijun_wg/18-shiryou.html

Timing and interpretation note: The preceding passage expresses the author's assessment and forecast as of the original article's publication in January 2026. The characterization as "stricter" is not a holding of this judgment and does not mean that every disclaimer claim adds new matter or is automatically invalid.

必須の構成が除かれても進歩性が否定される場合の例

- 引用発明において必須とされている構成を除く補正がなされたとしても、**引用発明の発明者ではなく、当業者にとって、さらなる改良発明等のために、当該構成以外の何らかの構成に設計変更を試みることは、当業者の通常の創作能力の発揮である**といえる場合がある。
- そして、引用発明において当該構成が必須と記載されていたとしても、その他のあらゆる構成への置換を完全に妨げるほどの強い阻害要因があったとまでは認められず、また、本願発明において当該構成を除くことに有利な効果があるとはいえない場合がある。
- このような場合には、**現在の審査基準の考え方に従って、依然として進歩性が否定される**。



7

新規事項の判断に係る審査基準の記載（３）

3.3.1 特許請求の範囲の補正

(1) 発明特定事項を上位概念化、削除又は変更する補正の場合

(2) 発明特定事項を下位概念化又は付加する補正の場合

b 請求項の発明特定事項を下位概念化する補正が当初明細書等に明示的に記載された事項又は当初明細書等の記載から自明な事項までは下位概念化しない補正であっても、**この補正により新たな技術上の意義が追加されないことが明らかな場合であれば、新たな技術的事項を導入するものではない**。したがって、このような補正は許される。

(3) 数値限定を追加又は変更する補正の場合

(4) 除くクレームとする補正の場合

「除くクレーム」とは、請求項に記載した事項の記載表現を残したままで、請求項に係る発明に包含される一部の事項のみをその請求項に記載した事項から除外することを明示した請求項をいう。

補正前の請求項に記載した事項の記載表現を残したままで、補正により当初明細書等に記載した事項を除外する「除くクレーム」は、**除外した後の「除くクレーム」が新たな技術的事項を導入するものではない場合には、許される**。

以下の(i)及び(ii)の「除くクレーム」とする補正は、新たな技術的事項を導入するものではないので、補正は許される。

(i) 請求項に係る発明が引用発明と重なるために新規性等（第29条第1項第3号、第29条の2又は第39条）が否定されるおそれがある場合に、その重なりのみを除く補正

・・・（後述）

(ii) 請求項に係る発明が、「ヒト」を包含しているために、第29条第1項柱書の要件を満たさない、又は第32条に規定する不特許事由に該当する場合において、「ヒト」のみを除く補正

・・・

(5) マーカッシュ形式等の択一形式のクレームについてする補正の場合

14

「除くクレーム」とする補正の類型と審査基準との関係

A) 特定の事項を含まないという技術的事項が、当初明細書等に明示的に記載されている場合

→ その補正は、新たな技術的事項を導入するものではないから**許される**。（審査基準の**3.1**）

B) 特定の事項を含まないという技術的事項が、当初明細書等の記載から自明な事項といえる場合

→ その補正は、新たな技術的事項を導入するものではないから**許される**。（審査基準の**3.2**）

C) 特定の事項を含む場合には第29条第1項柱書の要件を満たさない、又は第32条に規定する不特許事由に該当する場合

→ 請求項に係る発明が「ヒト」を包含しているために、第29条第1項柱書の要件を満たさない、又は第32条に規定する不特許事由に該当する場合において、「ヒト」を発明対象から除外することによって、上記拒絶理由を解消する補正は、補正前の明細書等から導かれる技術的事項に何らかの変更を生じさせるものとはいえない。したがって、このような補正は新たな技術的事項を導入しないものであることが明らかであるから、**許される**。（審査基準の**3.3.1(4)(ii)**）

D) 類型A～Cのいずれにも該当しない場合

→ **新たな技術的事項を導入するものではない場合には許される。**

その一例として、「請求項に係る発明が引用発明と重なるために新規性等(第29条第1項第3号、第29条の2又は第39条)が否定されるおそれがある場合に、その重なりのみを除く補正」（審査基準の**3.3.1(4)(i)**）は、「新たな技術的事項を導入するものではないので、**許される**」とされている。

そのほかにも、例えば、下位概念化であって新たな技術上の意義が追加されないことが明らかな場合（審査基準の**3.3.1(2)b**）に該当すれば、「補正は許される」とされている。

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審査基準の3.3.1(4)(i)の記載について（１）

- 審査基準の3.3.1(4)(i)で例示しているのは、**引用発明と技術的思想としては顕著に異なり本来進歩性を有するが、たまたま引用発明と重なることで新規性の拒絶理由が通知された場合**に、その重なりを除くことで、新規性の拒絶理由を解消すると同時に、進歩性も有する発明となる場合等である。

(i)請求項に係る発明が**引用発明と重なるために新規性等(第29条第1項第3号、第29条の2又は第39条)が否定されるおそれがある場合に、その重なりのみを除く**補正

(説明)

上記(i)における「除くクレーム」は、第29条第1項第3号、第29条の2又は第39条に係る引用発明である、刊行物等又は先願の明細書等に記載された事項(記載されたに等しい事項を含む。)のみを除外することを明示した請求項である。

上記(i)の「除くクレーム」とする補正は、引用発明の内容となっている特定の事項を除外することによって、補正前の明細書等から導かれる技術的事項に何らかの変更を生じさせるものとはいえない。したがって、このような補正は、新たな技術的事項を導入しないものであることが明らかである。

なお、**「除くクレーム」とすることにより特許を受けることができる発明は、引用発明と技術的思想としては顕著に異なり本来進歩性を有するが、たまたま引用発明と重なるような発明である。引用発明と技術的思想としては顕著に異なる発明ではない場合は、「除くクレーム」とすることによって進歩性欠如の拒絶理由が解消されることはほとんどないと考えられる。**

・・・

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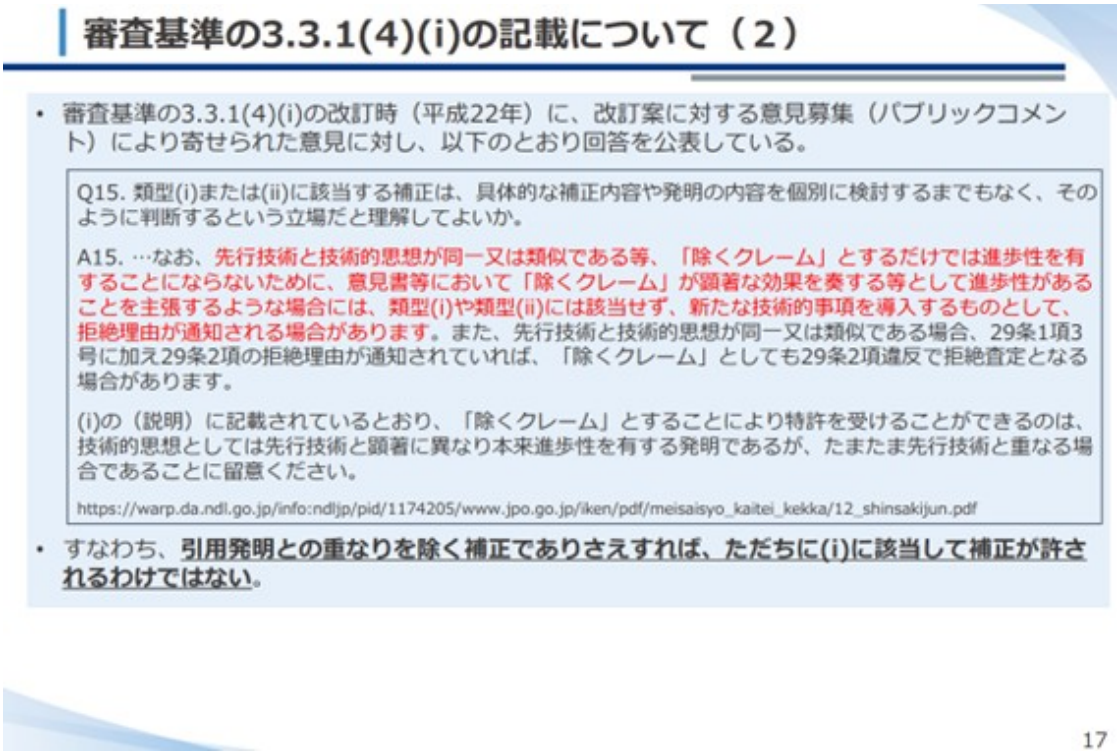


図６　多世代分割出願と補正・取下げの関係

⑤平成 28 年（行ケ）10263：「分割出願が適法であるための実体的要件としては，①もとの出願の明細書又は図面に二以上の発明が包含されていたこと，②新たな出願に係る発明はもとの出願の明細書又は図面に記載された発明の一部であること，③新たな出願に係る発明は，もとの出願の当初明細書等に記載された事項の範囲内であることを要する。本件出願は，第１出願から数えて５世代目になる分割出願であるため，本件出願が第１出願の出願時にしたものとみなされるには，本件出願，第４出願，第３出願及び第２出願が，それぞれ，もとの出願との関係で，上記①ないし③の分割の要件を満たし，かつ，本件発明が第１出願の出願当初の明細書等に記載した事項の範囲内のものであること，という要件を満たさなければならない。」

同旨：①大阪高判平成 14 年（ネ）2776＜若林＞、②東京高判平成 15 年（行ケ）65＜篠原＞。

子出願時は適法でも、子を出願後に補正すると、補正の遡及効により、子出願が分割要件違反となる場合がある。その場合、孫出願日は子出願日までしか遡及しない。

補正後が新規事項追加であると、分割要件違反となる。③東京地判平成 16 年（ワ）第 14649 号＜設樂＞。

分割要件＝補正要件：⑧東京地判平成 15 年（ワ）第 9215 号＜三村＞。

補正の遡及効：親出願日、子出願日、子の補正、孫の出願日の順序で検討する。補正により分割要件違反（要旨変更）が治癒されると、分割要件違反を免れる。④東京高判昭和 50 年（行ケ）第 75 号。

「本件訂正によって請求項の全部が削除されたことにより、本件実用新案登録は、初めから存在しなかったものとみなされる」⑥平成 13 年（行ケ）421＜山下＞。

子が取り下げられても、孫の出願日は親の出願日に遡及する。⑦平成 27 年（ワ）8517【畦塗り機事件】＜嶋末＞。同事件では、取下げ前に分割要件違反はなかった。特許法 39 条 5 項以外、出願取下げに遡及効はない（平成 1 年審 123 号）。

分割出願が新規事項追加のまま拒絶・無効確定すると、孫の出願日が親出願日に遡及しない。拒絶で終わる場合にも、新規事項追加を解消する補正を試みるべきである。

Figure 6, case ③: Tokyo District Court, April 13, 2006, 2004 (Wa) No. 14649 (Telephone Call Control System).

図７　画像形成装置事件と分割出願の新規事項

令和元年（ワ）23164【画像形成装置】＜田中＞。参照：令和２年（行ケ）10131＜大鷹＞。

子出願が分割要件違反であれば、孫出願の出願日は子出願の現実の出願日までしか遡及せず、親出願日まで遡及しない。大阪高判平成14年（ネ）2776、東京高判平成15年（行ケ）65も同旨。

明細書の追加記載が新規事項追加とされた例として、【人工乳首事件】（平成14年（行ケ）539）と比較する。

「本件出願２が分割出願された時点における本件出願１の明細書等…と、本件出願２の明細書等（本件出願２分割時明細書…）とを比較すると、本件出願２分割時明細書は、例えば、指定キープ指示部によって、電源OFF後も加工条件をキープし、次回以降最初に表示される画面に表示することに関する記載が追加されている点（段落【0100】）、倍率を指示する「一つ上」や「一つ下」の表示によって、使用頻度の高い加工条件である倍率の設定数を減らし、メニューの設定数を減らすことに関する記載が追加されている点（段落【0105】）、登録されたメニューを変更不可にロックする手段を設けることによって、安易なメニュー変更による誤指示を防止することに関する記載が追加されている点（段落【0145】）、図７ないし図15及びこれに関連する記載が追加されている点（段落【0041】…）で、本件出願１査定時明細書の記載と相違しており、本件出願２分割時明細書は、本件出願１査定時明細書には存在しない記載事項を含むものであるから、本件出願１査定時明細書に記載された事項の範囲内であるとはいえない…。そうすると、本件出願２は、…②の分割要件を満たさない…」

親出願日後、子出願日前の引用発明に基づき、進歩性欠如とされた。

優先権主張時は「部分優先」が有り得るが、分割出願時の明細書への追記には注意を要する。原明細書等に開示があれば追記は不要であり、開示がなければ新規事項追加となる。

Figure 7, related decision: Intellectual Property High Court, October 13, 2021, 2020 (Gyo-Ke) No. 10131 (Image Forming Apparatus).

[Related Court Decisions (Concerning Divisional Requirements)]

(1) Intellectual Property High Court, 2024 (Gyo-Ke) No. 10086 [Vehicle Guidance System] <Presiding Judge Honda> (This Judgment)

* The child application violates the divisional requirements ⇒ the filing date of the grandchild application does not relate back to the filing date of the parent application.

<Excerpt from the Holding>

The fourth-generation specification, etc. as originally filed states, in relation to the problem that, if a vehicle that cannot use ETC enters an ETC-only lane, there is a risk of congestion or collision with a following vehicle, as means for solving that problem, matters such as providing means by which such vehicles that cannot use ETC can leave the ETC-only lane, providing, as the leaving means, a lane branching from the ETC-only lane, and guiding a vehicle by lowering a barrier when entry of the vehicle is detected; and it is recognized that it discloses a vehicle guidance

system that, upon detecting a vehicle that cannot use ETC, guides the vehicle so as to cause it to leave the ETC-only lane. In addition, as the method for detecting and identifying a vehicle that cannot use ETC, it is stated, as seen in paragraphs [0010] and [0012], that this is done according to whether there is an "inability or failure to communicate between the roadside antenna and the on-board unit"; and, in the description of the embodiments, paragraphs [0031] to [0053] and [0066] to [0068], Figures 3 to 8, and Figure 12 disclose that this is done according to whether the vehicle is capable of ETC wireless communication. Further, paragraphs [0054] to [0062], Figures 9 and 10, which are an example of an interchange with an enhanced reverse-entry prevention function, and paragraphs [0063] to [0065] and Figure 11, which are an example of a vehicle guidance system for a smart interchange, also state that "Figure 9 is a modified example of Figure 4" ([0055]) and that "except that there are no ordinary-vehicle lanes B and C, the roles of lanes (A→D) and (A→E) at entrance tollgate 12 and the roles of lanes (A→D) and (A→E) at exit tollgate 13 are the same as those in Figures 3, 4, 6 and 7" ([0064]); thus, all of them are premised on guidance according to whether the vehicle is capable of ETC wireless communication. Accordingly, it is recognized that the fourth-generation specification, etc. as originally filed, in the invention of a vehicle guidance system that causes a vehicle unable to use ETC to leave an ETC-only lane in order to solve the problem of congestion and the risk of collision with a following vehicle, respectively describes, as specific means for solving the problem, (i) the matter of causing the vehicle to travel on a branch lane and return when a vehicle unable to use ETC has entered an ETC-only lane, and (ii) the matter of determining whether the vehicle is one to be returned according to whether wireless communication between the ETC on-board unit and the roadside antenna is possible. Moreover, even considering all descriptions in the fourth-generation specification, etc. as originally filed as a whole, there is no other description disclosing or suggesting the circumstances in which a vehicle is caused to travel on a branch lane and return, or a method for determining a vehicle to be returned. Therefore, items (i) and (ii) above should be regarded as indispensable configurations for solving the

problem in the invention disclosed in the fourth-generation specification, etc. as originally filed ...

⇒ Because each fifth-generation invention lacks items (i) and (ii) above (the indispensable configurations for solving the problem), it constitutes the addition of new matter.

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(2) Tokyo District Court, 2019 (Wa) No. 23164 [Image Forming Apparatus] <Presiding Judge Tanaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91102.pdf

* The child application violates the divisional requirements ⇒ the filing date of the grandchild application does not relate back to the filing date of the parent application.

* In 2020 (Gyo-Ke) No. 10131 concerning the same patent, the court held: "Considering together ... that there was an opportunity to cure the state in which Application 2 at issue violated the divisional requirements by making an amendment such as deleting the added portion above, it was not appropriate for the examiner of Application 2 at issue to overlook the above violation of the divisional requirements, but ..."

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90633.pdf

<Excerpt from the Holding>

... The patent application at issue is a patent application obtained by further dividing Application 3 at issue, which was itself obtained by further dividing Application 2 at issue, which was a divisional application of Application 1 at issue. The Defendant alleges that Application 2 at issue violates the divisional requirements; therefore, the court examines this point.

... Where a divisional application is lawful, its filing date relates back to the filing date of the original application (main clause of Article 44(2) of the Patent Act); where a divisional application is unlawful, substantive examination is conducted based on the date on which the divisional application was actually filed. In order

for the filing date of a divisional application to relate back to the filing date of the original application, it is reasonable to construe that it is necessary that (i) the matters described in the specification, etc. of the divisional application fall within the scope of matters described in the specification, etc. of the original application as filed, and (ii) the matters described in the specification, etc. of the divisional application fall within the scope of matters described in the specification, etc. of the original application immediately before the division. Where a patent application is divided during a period in which the specification, etc. of the original application may be amended, it is understood that satisfaction of requirement (i) above also satisfies requirement (ii). However, because Application 2 at issue ... was not filed during a period in which the specification, etc. of Application 1 at issue could be amended ..., it is understood that, as a divisional requirement for Application 2 at issue, requirement (ii) above must also be satisfied separately from requirement (i). ...

... Comparing the specification, etc. of Application 1 at issue at the time Application 2 at issue was filed as a divisional application, namely, the specification, etc. of Application 1 at issue at the time of the decision to grant a patent, ... with the specification, etc. of Application 2 at issue (the specification at the time of division of Application 2 at issue ...), the latter differs from the former in, for example, that it adds a description relating to maintaining machining conditions even after power-off by means of a designated-keep instruction unit and displaying them on the first screen shown on the next and subsequent occasions (paragraph [0100]); that it adds a description relating to reducing the number of settings for the magnification, which is a frequently used machining condition, and reducing the number of menu settings by means of displays indicating magnification, such as "one above" and "one below" (paragraph [0105]); that it adds a description relating to preventing erroneous instructions caused by casual menu changes by providing means for locking a registered menu so that it cannot be changed (paragraph [0145]); and that it adds Figures 7 to 15 and related descriptions (paragraph [0041] ...). The specification at the time of division of Application 2 at issue therefore contains matters not present in the specification of Application 1 at

issue at the time of the decision to grant a patent and cannot be said to fall within the scope of matters described in the latter specification. ... Accordingly, Application 2 at issue fails to satisfy divisional requirement (ii) above and should be regarded as violating the divisional requirements; Article 44(2) of the Patent Act does not apply to Application 2 at issue.

... According to the foregoing, even if the patent application at issue satisfies the divisional requirements in relation to Application 3 at issue and Application 3 at issue satisfies the divisional requirements in relation to Application 2 at issue, Application 2 at issue does not satisfy the divisional requirements in relation to Application 1 at issue. Therefore, the filing date of Application 2 at issue does not relate back to the filing date of Application 1 at issue and is its actual filing date ..., and likewise, the filing date to which the patent application at issue relates back is the filing date of Application 2 at issue ....

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(3) Osaka High Court, 2002 (Ne) No. 2776 [Concrete Embedded Object] (Mirai Kogyo v. Nichido Denko)

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11279.pdf

* The child application came to violate the divisional requirements due to the retroactive effect of a procedural amendment.

⇒ The filing date of the grandchild application does not relate back to the filing date of the parent application.

* The fact that invalidity of the child application became final is unrelated to whether the filing date of the grandchild application relates back to the filing date of the parent application.

<Excerpt from the Holding>

Considering the divisional filing of the child application, the amendment to the child application ... included matters neither described in the specification or drawings of the parent application as filed nor described in the specification or drawings of the child application as filed, and the specification of the child

application after the amendment contained matters outside the scope of the specification or drawings of the parent application as filed. The child application therefore could not be said to have been lawfully divided from the parent application under Article 44(1) of the Patent Act. The child application was subsequently patented, and the invalidation decision at issue became final; there was therefore no longer any room to correct, by a procedural amendment or a request for correction, ... the content of the procedural amendment. Because the content after the amendment had become final, the child application cannot be said to have been lawfully divided from the parent application under Article 44(1) of the Patent Act and is not deemed to have been filed at the time of the parent application. Because it is not deemed to have been filed at the time of the parent application, ... the filing date of the child application is deemed to be ... the date on which the amendment was submitted .... In this regard, the Plaintiff alleges that the child application was a divisional application lawfully divided under Article 44 of the Patent Act and that, by the amendment in the procedural amendment, its filing date was merely postponed under Article 40 of the Patent Act, and the division of the child application itself did not become unlawful or invalid. However, ... it is clear that the division of the child application did not satisfy the divisional requirements and was unlawful in the first place, and the Plaintiff's allegation above cannot be accepted. ...

Application 1 at issue (the grandchild application) may be considered lawful as a divisional application having the child application as its parent application because it may be said to satisfy the other divisional requirements. However, in relation to the parent application, ... because the child application cannot be said to have been lawfully divided from the parent application, Application 1 at issue (the grandchild application) likewise is not deemed to have been filed at the time of the parent application, but is deemed to have been filed at the time of the child application, and is deemed to have been filed on the date ... deemed to be the filing date of the child application. ...

Enjoyment of the benefit of retroactivity of the filing date of the grandchild application is, after all, enjoyment of the benefit of the filing date of the child

application, and is premised on the child application satisfying the divisional requirements and having been lawfully divided; the filing date of the grandchild application does not relate back without limitation to the time of the parent application, independently of the child application and removed from the time at which division was originally possible. The Patent Act recognizes ... that an amendment has effect retroactive to the beginning of the procedure, and patent procedures are administered on the premise of such retroactive effect of amendments. In fact, with respect to divisional applications as well, where the invention of the original application and the invention of the divisional application were identical at the time of division but subsequently an amendment to the specification or drawings of the original application rendered the two inventions non-identical, the divisional application is deemed lawful; conversely, where the invention of the original application and the invention of the divisional application were not identical at the time of division but subsequently an amendment to the specification or drawings of the original application rendered the two inventions identical, the divisional application is deemed unlawful. Moreover, even if the retroactive effect of such an amendment gives rise to a situation in which a division is unlawful, the person who made the amendment may cure the ground of unlawfulness by making a further amendment correcting it. In light of these points, where a parent application, a child application, and a grandchild application are divided in sequence, even if the division from the child application to the grandchild application had no defect in the divisional requirements, it is unavoidable that whether the division of the child application from the parent application satisfies the requirements may vary depending on whether and how the child application is amended, thereby changing the filing date of the child application and, in turn, changing the filing date of the grandchild application. ...

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(4) Tokyo High Court, 2003 (Gyo-Ke) No. 65 [Concrete Embedded Object] (Mirai Kogyo v. Nichido Denko)

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10885.pdf

* The child application came to violate the divisional requirements due to the retroactive effect of a procedural amendment.

⇒ The filing date of the grandchild application does not relate back to the filing date of the parent application.

<Excerpt from the Holding>

... In this case, the patent application at issue (grandchild application) is a further divisional application of the child application, which was a divisional application from the parent application. Therefore, if each of the divisions of the grandchild application (the patent application at issue) and the child application satisfies the divisional requirements under former Article 44(1) of the Patent Act, and Inventions 1 and 2 at issue fall within the scope of matters described in the original specification, etc. of the parent application, the filing dates of Inventions 1 and 2 at issue relate back to the filing date of the parent application. However, the invention of the child application was amended by the procedural amendment dated October 29, 1993 (Exhibit Ko 17), such that it no longer fell within the scope of matters described in the original specification, etc. of the parent application. After registration of establishment of the patent right, the invalidation decision became final with the invention as so amended, and the patent right for the child application was deemed never to have existed. Accordingly, there is no longer any room to correct the amended invention, and the invention of the child application no longer falls within the scope of matters described in the original specification, etc. of the parent application; it is therefore clear that the child application does not satisfy the substantive requirements for division. Thus, without even examining whether the division of the grandchild application was proper, there is no room for the filing date of the patent application at issue, which is the grandchild application, to relate back to the filing date of the parent application. ...

... The amendment to the child application ... should originally have been rejected as impermissible, but was not rejected; after registration of establishment of the patent right with the invention as amended, the invalidation decision became final and the patent right relating to the child application was deemed never to have existed. ... The child application did not satisfy the divisional requirements and was not lawfully divided. ...

... The Plaintiff further alleges that, under the Examination Guidelines prepared by the Japan Patent Office in May 1983 and applicable to the patent application at issue, a divisional application filed on the same date on which the original application was withdrawn or abandoned is lawful, except that, where the original application is withdrawn, abandoned, or invalidated, a divisional application is unlawful if the invention of the original application and the invention of the divisional application are identical at the time of such act; and therefore it is the practice of the Japan Patent Office that invalidation of the right relating to the child application after it has become final does not also invalidate the grandchild application. However, as stated above, the child application was deemed, under former Article 40 of the Patent Act, to have been filed on the date on which the procedural amendment was submitted; it was not deemed withdrawn or abandoned. It is also clear that the decision does not hold that the grandchild application is invalid because the child application became invalid. The Plaintiff's allegation above merely criticizes the decision at issue based on a misunderstanding of it and cannot be accepted.

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(5) Tokyo District Court, 2003 (Wa) No. 9215 [Fastener and Cord Fastening Device] (JP3367651) <Presiding Judge Mimura>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-10373.pdf

* Divisional applications and amendments are permitted within the same scope.

= Tokyo District Court, 1998 (Wa) No. 8345 [Ear-Hanging Device for Cultured Shellfish] <Presiding Judge Mimura>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-13449.pdf

<Excerpt from the Holding>

Regarding the division of a patent application, Article 44(1) of the Patent Act provides that "only within the period during which an amendment may be made to the specification or drawings attached to the application, a patent applicant may make a part of a patent application containing two or more inventions into one or more new patent applications." In order for such a divisional application to be recognized as lawful, the original application must be pending before the Japan Patent Office and must contain two or more inventions; containing two or more inventions is understood not to require that they be contained only in the claims, but is satisfied if the specification contains two or more inventions. A divisional application must also be filed within a period during which an amendment may be made (Article 44(1) of the Patent Act). Further, a divisional application is deemed to have been filed at the time of the original patent application (paragraph (2) of the same Article), and novelty, inventive step, and the like are assessed as of the filing date of the patent application from which the divisional application originated. In light of these matters, division of an application may be said to have a function similar to that of an amendment (Article 17 of the Patent Act); therefore, the permissible scope of a divisional application should likewise be construed as limited to the scope within which the original application may be amended. (If division were permitted even where the requirements for amendment were not satisfied, it would in substance permit circumvention of the amendment requirements by means of the divisional procedure, which would be unreasonable.) Thus, the specification or drawings of a divisional application should be construed not to include anything outside the scope of matters described in the specification or drawings of the original application as filed. ...

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(6) Tokyo District Court, 2004 (Wa) No. 14649 [Telephone Call Control System] <Presiding Judge Shitara>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-32912.pdf

* A case in which the divisional requirements were assessed based on the claims after amendment (retroactive effect of amendment) — the same logic and conclusion as for the amendment requirements

= Tokyo High Court, 2003 (Gyo-Ke) No. 65; cf. 2016 (Gyo-Ke) No. 10114

<Excerpt from the Holding>

... The first and second amendments to Application 2 at issue added a description of an embodiment in which, before a customer pays a deposit, the amount of the deposit and a special code are stored in advance in memory means of a special exchange unit, and should be regarded as additionally describing an invention producing a new operation and effect, "...", that was not described in the original specification of Application 2 at issue. Accordingly, the first and second amendments to Application 2 at issue cannot be recognized as amendments that increased, decreased, or changed the claims of the original specification of the divisional application within the scope of matters described in the original specification or drawings of Application 2 at issue. Therefore, the divisional application at issue does not satisfy the divisional-application requirements of former Article 44(1) of the Patent Act and is deemed to have been filed on May 7, 1997. Furthermore, because the first and second amendments to Application 2 at issue cannot be recognized as having been made within the scope of matters described in the original specification or drawings of the divisional application at issue, they violate Article 17-2(3) of the Patent Act. ...

(7) Tokyo High Court, 1975 (Gyo-Ke) No. 75

A discussion of the possibility of curing a divisional defect should not be read as a finding that the defect was cured in that case or as an unconditional remedy under current law.

* A violation of the divisional requirements may be cured by an amendment (retroactive effect of amendment).

(Reference) Tokyo High Court, 2003 (Gyo-Ke) No. 65, [Concrete Embedded Object] ⇒ The filing date of a grandchild application divided from a child application does not relate back to the filing date of the parent application where the child application ceases to satisfy the divisional requirements due to an amendment.

⇒ The filing date of the child application is the date on which the procedural amendment was submitted!!

<Excerpt from the Holding>

Insofar as the original specification and drawings of the patent application at issue are concerned, the application does not satisfy, in relation to the original patent application, the divisional requirements concerning the technical matter described above and therefore cannot be regarded as a lawful divisional application. Consequently, retroactivity of the filing date is not recognized, and the application is treated as having been filed on its actual filing date, April 23, 1964.

However, if the divisional requirements above subsequently came to be satisfied by an amendment to the patent application at issue, retroactivity of the filing date may newly be recognized as a result, and therefore the court examines whether the amendment at issue falls within such a case. If the amendment at issue changes the gist of the specification or drawings in relation to the patent application at issue (which is a divisional application and a new application) itself, the amendment is not permitted; not only does the patent application at issue fail, by virtue of the amendment, to satisfy the divisional requirements above, but regardless of whether it falls within the scope of matters described in the original specification or drawings of the original patent application, it cannot be accepted under the former Act and must also be dismissed under the new Act. ...

It is recognized that the amendment at issue ... does not fall within the scope of matters described in the original specification or drawings of the patent application at issue (and the evidence cited above also establishes that the matter in question is not described in the original specification or drawings of the original patent application). Accordingly, it cannot be said that, by virtue of the

amendment at issue, the patent application at issue came to satisfy the divisional requirements above.

(8) Tokyo District Court, 2015 (Wa) No. 8517 [Ridge Plastering Machine] <Presiding Judge Shimasue>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85939.pdf

* A third-generation patent in a sequence of original application ⇒ first generation ⇒ second generation ⇒ third generation.

* The second-generation application had been withdrawn, but whether its filing date could relate back to the first-generation application and the original application was not disputed.

* Tokyo High Court, 2003 (Gyo-Ke) No. 65, and Osaka High Court, 2002 (Ne) No. 2776, held that invalidity of the child application itself was irrelevant.

<Excerpt from the Holding>

[Defendant's Allegation]

The configuration in Claim 1 that "the connecting piece is fixed to the rear surface of the ridge-forming surface of the ridge-forming plate positioned on the front side in the direction of rotation among the adjacent ridge-forming plates and does not extend to the ridge-forming surface of the ridge-forming plate positioned on the rear side in the direction of rotation" (the configuration added by the amendment at issue), and the configuration of "a connecting piece provided along the boundary portion," are each outside the scope of matters described in the specification, claims, and drawings immediately before the division (filing of the patent at issue) of the original application for the patent at issue (Japanese Patent Application No. 2014-78397) (hereinafter collectively the "Specification, etc. at the Time of Division of the Original Application"). ... Accordingly, the application relating to the patent at issue (the divisional application of Japanese Patent Application No. 2014-78397) is not a lawful divisional application (Article 44(1)(i) of the Patent Act), and its filing date does not relate back to the filing date of the

original application. As a result, each invention at issue lacks novelty or inventive step (Article 29(1)(iii) or (2) of the Patent Act) over the published patent application relating to the original application for the patent at issue (Japanese Unexamined Patent Application Publication No. 2014-128287, distributed on July 10, 2014 [Exhibit Otsu 15]).

...

[Court's Determination]

Of the descriptions in the Specification, etc. at the Time of Division of the Original Application, the description ... relating to the configuration that "the connecting piece is fixed to the rear surface of the ridge-forming surface of the ridge-forming plate positioned on the front side in the direction of rotation among the adjacent ridge-forming plates and does not extend to the ridge-forming surface of the ridge-forming plate positioned on the rear side in the direction of rotation" may be inferred to be the same as the description ... in the original specification, etc.; therefore, that configuration should be regarded as self-evident from the above description in the Specification, etc. at the Time of Division of the Original Application. The configuration of "a connecting piece provided along the boundary portion" is likewise recognized as self-evident from the description in the specification at the time of division of the original application. ... According to the foregoing, the patents for the respective inventions at issue cannot be found not to relate to lawful divisional applications. ...

(9) Intellectual Property High Court, 2016 (Gyo-Ke) No. 10263 [Wiring Box] (Mirai Kogyo v. Nichido Denko) <Presiding Judge Takabe>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87087.pdf

* General method for assessing the divisional requirements of a fifth-generation (great-great-grandchild) patent

<Excerpt from the Holding>

The substantive requirements for a divisional application to be lawful are that (i) the specification or drawings of the original application contained two or more inventions, (ii) the invention of the new application is part of an invention described in the specification or drawings of the original application, and (iii) the invention of the new application falls within the scope of matters described in the original specification, etc. of the original application. Because the application at issue is a fifth-generation divisional application counted from the first application, in order for the application at issue to be deemed to have been filed at the time of filing of the first application, the application at issue, the fourth application, the third application, and the second application must each satisfy divisional requirements (i) to (iii) above in relation to their respective original applications, and the invention at issue must fall within the scope of matters described in the original specification, etc. of the first application.

End

(Plaintiff) East Nippon Expressway Company Limited

(Defendant) PXZ Limited Company

[Patent ★★] A case in which, in the appellate instance of a patent infringement action, a new ground for invalidity was alleged in the statement of reasons for appeal, but was held untimely because it could have been alleged in the court of first instance — Intellectual Property High Court, 2024 (Ne) No. 10010 [Women's Garment] <Presiding Judge Nakadaira> — (First Instance: Tokyo District Court, 2021 (Wa) No. 18262 <Presiding Judge Kokubu>)

Original Article URL:
https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e2%98%85%e3%80%91%e7%89%b9%e8%a8%b1%e6%a8%a9%e4%be%b5%e5%ae%b3%e8%a8%b4%e8%a8%9f%e3%81%ae%e6%8e%a7%e8%a8%b4%e5%af%a9%e3%81%ab%e3%81%8a%e3%81%84%e3%81%a6%e3%80%81/

◆ Judgment Text

[Summary of This Judgment and Some Observations]

1. Claims (Claim 1)

A. A women's garment covering at least the bust portion of a woman, comprising:

B. a cup member covering at least the bust portion of the woman;

C. left and right front-body members disposed on the front-surface side of the cup member in a state separated from the cup member,

the left and right front-body members being provided from the respective left and right underarm portions of the bust portion to a central portion of the lower bust while covering the sides of the bust; and

D. a plurality of connecting members provided so as both to connect the left and right front-body members to each other near the central portion of the lower bust and to permit adjustment of the connecting width of the left and right front-body members,

E. the women's garment being characterized thereby.

2. Infringement Analysis (First-Instance Judgment / Tokyo District Court, 2021 (Wa) No. 18262 [Women's Garment] <Presiding Judge Kokubu>)

First-instance judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92632.pdf

The sixth edition of Kojien sets out two meanings of the term "tomoni": (i) "as one; together; in company; alike" and (ii) "at the same time."

The Defendant (the alleged infringer) alleged that, when Kojien sets out two meanings, the meaning listed first is the more general meaning, but this allegation was not accepted.

The Tokyo District Court stated: "There is insufficient evidence to establish that the sixth edition of Kojien adopted an editorial policy of listing meanings beginning with those in broad and general use. Further, ... the items specifically exemplified as 'connecting members' in the specification ... are inconsistent with the Defendant's ... construction. ..." It construed the claim term "tomoni" in the patented invention to have meaning (ii), "at the same time," and found infringement. (The patentee prevailed.)

(Excerpt from the Holding / First-Instance Judgment)

The Defendant alleges that, with respect to "tomoni" in Limitation D, because, when a dictionary is compiled, the meanings of each word or phrase are listed beginning with those in broad and general use, the term should have the meaning listed first in the sixth edition of Kojien, namely, "as one;

together; in company; alike." However, which meanings of a word or phrase are given priority in the description is considered to depend on the editorial policy of each dictionary, and ... there is insufficient evidence to establish that the sixth edition of Kojien adopted an editorial policy of listing meanings beginning with those in broad and general use. Further, ... each item specifically exemplified as a "connecting member" in the specification at issue is such that its connecting width cannot be adjusted unless the connecting members are disconnected from each other, and is therefore inconsistent with the Defendant's proposed construction of "tomoni." ...

3. Invalidity Analysis (Although Held Untimely, It Was Nevertheless Considered.)

Grounds for invalidity alleged by the Appellant in the court of first instance

- **Lack of novelty and inventive step based on Otsu 8 as the primary reference**
- **Lack of inventive step based on Otsu 9 and Otsu 10 as secondary references**

Grounds for invalidity first alleged by the Appellant on appeal

- **Lack of novelty and inventive step based on Otsu 31 to 33 (U.S. patent documents)**

<u>The Appellee's Arguments on Untimeliness and the Intellectual Property High Court's Determination</u>

1. The Appellee's argument: There was a time at which it should have been alleged in the court of first instance

- **On August 31, 2022, at a procedural session, the court disclosed its preliminary view on infringement.**
- **It was possible to allege the new grounds for invalidity by that time.**

2. The Appellee's argument: They were neither submitted nor alleged at all in the court of first instance

- **“The Appellant did not even submit Otsu 31 to 33 through the end of the proceedings.”**
- **“Nor did it make any allegations of invalidity based on those documents.”**

3. The Appellee’s argument: There were no circumstances making the allegation difficult

- **“There are no circumstances suggesting that it was difficult to allege an invalidity defense based on the documents Otsu 31 to 33.”**

4. The court’s determination: Delay in concluding the proceedings was not established in this case

- A change in the level of court or in counsel did not justify the late submission. However, the Appellee had responded in the alternative, and the proceedings closed without a further response from the Appellant. To that extent, the court did not find that consideration would delay the conclusion of the proceedings.
- **5. Conclusion**

The failure to make the allegation in the court of first instance, despite being able to do so, was held “untimely.” However, delay in concluding the proceedings was not established, and the court addressed the invalidity grounds on their merits.

6. “It cannot be said that it would delay completion of the proceedings”

Because a response to the grounds for invalidity had been made and oral argument was concluded without any further response, the court held that it could not be said that consideration of the grounds would delay completion of the proceedings and therefore decided the invalidity issues.

(Excerpt from the Holding / Appellate Judgment (This Judgment))

First, in examining whether this constitutes an untimely allegation or defense, the Appellant’s new allegation of grounds for invalidity in this appellate instance was made in the statement of reasons for appeal dated February 6, 2024. In a patent infringement action, an invalidity defense may be alleged

without awaiting finalization of an invalidation decision in a patent invalidation trial, in order to resolve a dispute concerning patent infringement as promptly as possible within the patent infringement proceedings. Because the defense is made within civil litigation proceedings, which are separate from a patent invalidation trial, it should be dismissed as an untimely allegation or defense when, in light of the course of the proceedings, it would unduly delay the proceedings.

On that basis, reviewing the course of the proceedings in the court of first instance, the Appellant, which was the first-instance Defendant, denied in its answer dated October 22, 2021 and submitted on October 27, 2021 that the Appellee's product satisfied the limitations of the invention at issue, and alleged a ground for invalidity based on lack of inventive step, using Otsu 8 as the primary reference and combining it with well-known art or using Otsu 9 as a secondary reference. After receiving the Appellee's response and other submissions, the Appellant added, in Preparatory Brief (3) dated March 18, 2022, a ground for invalidity based on lack of novelty over Otsu 8. After receiving the Appellee's further response, it additionally alleged, in Preparatory Brief (4) dated May 27, 2022, a ground for invalidity based on lack of inventive step, using Otsu 8 as the primary reference and Otsu 10 as a secondary reference. In response to the Appellee's arguments on that point, it further replied in Preparatory Brief (5) dated August 29, 2022.

Then, on the premise that the parties had fully presented their allegations and evidence on infringement, in a preparatory proceeding conducted by web conference on August 31, 2022, the court disclosed its preliminary view that the proceedings would move to damages (the progress table for the preparatory proceeding on August 31, 2022 states in the "result of discussion" column: "Both parties: allegations and proof regarding infringement have been completed"; and "Presiding Judge: hereafter, the proceedings will address damages"). Proceedings on damages then continued. At the oral-argument hearing held on September 22, 2023, the Appellant stated that it

had no further allegations or evidence, the oral argument in the court of first instance was concluded, and the original judgment was rendered.

In light of this course of proceedings in the court of first instance, the new allegation of grounds for invalidity in this appellate instance constitutes an untimely allegation or defense, and the Appellant was grossly negligent in delaying its submission. It would therefore ordinarily have to be dismissed. However, the Appellee has, albeit in the alternative, responded to the grounds for invalidity submitted in this appellate instance, and the oral argument in this appellate instance has been concluded without any further responsive allegation by the Appellant. To that extent, it cannot be said that considering the grounds would delay completion of the proceedings; therefore, the court will decide them below. ...

4. Some Observations

The course of allegations and proof in the court of first instance was ordinary for a patent infringement action. Thus, if, under the reasoning of this judgment, new grounds for invalidity "made in the statement of reasons for appeal" are held untimely, it may in substance become impossible to make any new allegation beginning in the appellate instance.

In the Ichitaro case (discussed below), the assertion of a new ground for invalidity beginning on appeal was permitted because the first-instance proceedings were short and the new primary reference was a foreign-language document. In this case, however, the assertion of a new ground for invalidity using the invention in Otsu 31, an English-language document, as the primary reference was held, in principle, to be untimely.

The Appellee argued that "the Appellant did not even submit Otsu 31 to 33 through the end of the proceedings." In response to that argument, one might think they should simply have been submitted and alleged even after disclosure of the first-instance court's preliminary view. Yet another Intellectual Property High Court judgment held an allegation untimely

because it had been dismissed as untimely in the first instance; there is therefore no way out.

Separately from whether an allegation is untimely, one possible strategy for obtaining an appellate holding, as in this judgment, that "it cannot be said that it would delay completion of the proceedings" is to make all allegations in the statement of reasons for appeal and then refrain from making a further response to the Appellee's response. Because the proceedings in this case followed that course, the invalidity issues were decided on the ground that "it cannot be said that it would delay completion of the proceedings."

If so, when a new ground for invalidity is alleged in the statement of reasons for appeal, the Appellee could adopt a strategy of not responding to its substance and alleging only untimeliness. However, although it would ordinarily be difficult to imagine that the appellate court would close oral argument at that point, uphold the invalidity defense, and reverse in favor of the alleged infringer, a strategy of making no response entails risk. In many cases, therefore, the Appellee will likely respond on the merits as a precaution.

Regarding allegations first made on appeal and untimeliness, many prior Intellectual Property High Court judgments did not find an allegation untimely if made in the statement of reasons for appeal, but found it untimely if made in a preparatory brief after that statement; this judgment is extremely strict. A comprehensive strategy should be formulated while bearing in mind that other Intellectual Property High Court judgments have found that new grounds for invalidity alleged beginning on appeal were not untimely.

For example, 2016 (Ne) No. 10100 [Electric Fishing Reel] <Presiding Judge Takabe> involved a correction defense that had been alleged after the court of first instance disclosed its view that the patent was invalid and had been dismissed as untimely. When the correction defense dismissed below was alleged in the statement of reasons for appeal, however, it was not dismissed as untimely.

That judgment held: "In light of the course of proceedings in the court of first instance and this court, it may be said that it would have been desirable to make the correction defense earlier. Nevertheless, because the Appellant, after the original judgment was rendered and advance notice of the trial decision was issued, set out the correction defense in detail in the statement of reasons for appeal and promptly submitted that allegation in this appellate instance, it cannot be said that the Appellant's submission of the correction defense was untimely." This is close to practical sensibilities. Where the first-instance judgment contains an unexpected determination, should not an allegation made on the basis of that determination be permitted on appeal, so long as it is made in the statement of reasons for appeal, at the outset of the appellate proceedings?

[Related Court Decisions Concerning the Timeliness of New Allegations on Appeal]

1. Court decisions addressing the timeliness of allegations made at the outset of the appeal in the statement of reasons for appeal

Intellectual Property High Court, 2024 (Ne) No. 10010 [Women's Garment] <Presiding Judge Nakadaira> (This Judgment)

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93355.pdf

* A new invalidity defense alleged in the statement of reasons for appeal was held untimely. (On this reasoning, nothing new could be alleged beginning on appeal ...)

Supplement: In this case, delay in concluding the proceedings was not established and the invalidity defense was not dismissed. The parenthetical observation is the author's criticism; the judgment does not impose a categorical prohibition on new allegations on appeal.

"The Appellant's new allegation of grounds for invalidity in this appellate instance was made ... in the statement of reasons for appeal. ...

... After receiving the court's disclosure of its preliminary view that the proceedings would move to damages, ... proceedings on damages continued, and ... at the oral-argument hearing, the Appellant stated that it had no further allegations or

evidence; the oral argument in the court of first instance was concluded; and the original judgment was rendered. ... In light of this course of proceedings in the court of first instance, the new allegation of grounds for invalidity in this appellate instance constitutes an untimely allegation or defense, and the Appellant was grossly negligent in delaying its submission. It would therefore ordinarily have to be dismissed. However, the Appellee has, albeit in the alternative, responded to the grounds for invalidity submitted in this appellate instance, and the oral argument in this appellate instance has been concluded without any further responsive allegation by the Appellant. To that extent, it cannot be said that considering the grounds would delay completion of the proceedings; therefore, the court will decide them below. ... The allegation of lack of inventive step is without merit."

Intellectual Property High Court, 2017 (Ne) No. 10055 [Continuous Shellfish Fastening Tool] <Presiding Judge Mori>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88166.pdf

* Although untimely, the next hearing had been scheduled and completion of the proceedings would not be delayed. ⇒ Not dismissed. ⇒ Lack of novelty.

"It is recognized that the Appellants could have submitted the defense concerning Ground for Invalidity 3 (lack of novelty) no later than January 26, 2017; therefore, it constitutes an 'allegation or defense submitted untimely' (Article 157(1) of the Code of Civil Procedure).

However, at the first oral-argument hearing in this appeal, ... Appellant Shinwa alleged that, before the date on which the patent at issue was deemed filed, it had sold a product satisfying the limitations of each invention at issue and that the patent at issue therefore lacked novelty. At that hearing, a further hearing was scheduled and additional allegations and proof were contemplated. In those circumstances, there was insufficient basis to find that the allegation at that time would delay completion of the proceedings." (* January 26, 2017 was the date on which oral argument in the court of first instance was concluded.)

Intellectual Property High Court, 2023 (Ne) No. 10071 [Chip-Type Fuse] <Presiding Judge Miyasaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92795.pdf

* An allegation concerning a different claim that had been dismissed as untimely in the court of first instance was also dismissed as untimely on appeal.

“The facts stated in the attached ‘Course Leading to the Addition of the Cause of Action at Issue’ are recognized as the course of proceedings and other matters in the court of first instance leading to the addition of the cause of action at issue. Specifically, at the answer stage (dated February 28, 2022), the Appellee submitted detailed allegations disputing satisfaction of the fourth requirement of the doctrine of equivalents, specifically identifying such publicly known documents as Otsu 1 and Otsu 3. Thereafter, by November of that year, the Appellant and Appellee exchanged two rounds of briefs containing arguments on that issue and fully presented allegations and proof. During that period, the record of the preparatory proceedings included the Appellee’s procedural position that it would ‘submit a responsive brief focusing on the fourth requirement of the doctrine of equivalents,’ and satisfaction of the fourth requirement was recognized as at least one of the central issues in the case. At a discussion by web conference on November 28, when allegations and proof on infringement had reached a preliminary stopping point (a discussion in written preparatory proceedings; the same applies below), the court disclosed to both parties its preliminary view that the Appellee’s product did not fall within the technical scope of Invention 1 at issue, and the parties were to consider settlement. Settlement negotiations soon failed. At the discussion on January 27, 2023, the Appellant stated that it would submit a preparatory brief setting out a further response concerning the arc-extinguishing action (note: relating to the second requirement of the doctrine of equivalents), supplementation of its prior allegations, and other matters. Nevertheless, in a preparatory brief dated February 27, 2023, the Appellant then alleged the addition of the cause of action at issue. In response, by a preparatory brief dated April 13, 2023, the Appellee moved for dismissal as an untimely method

of attack or for a ruling refusing the amendment of the action as one that would substantially delay the proceedings.

... On the basis of the foregoing, first examining whether addition of the cause of action at issue was "untimely," the Appellant sought that addition because, as long as the issue was whether Invention 1 at issue under Claim 1 fell within the technical scope, it was highly likely, in relation to the publicly known documents submitted by the Appellee, ... that the fourth requirement of the doctrine of equivalents (non-equivalence to publicly known art, etc.) would be held unsatisfied; the Appellant therefore attempted to satisfy the fourth requirement by putting at issue Invention 2 under Claim 3, which includes the additional configuration at issue. However, ... the Appellee's allegation disputing the fourth requirement of the doctrine of equivalents had already been submitted in detail and with specificity at the answer stage, and it was possible to consider addition of the cause of action at issue as a countermeasure. Thereafter, the parties exchanged two rounds of briefs over approximately nine months and fully presented allegations and proof on this issue. The Appellant then suddenly added the cause of action at issue after disclosure of the court's preliminary view and despite having itself stated the procedural position that it contemplated only a supplemental submission. It is clear that this constituted submission of an untimely method of attack."

Intellectual Property High Court, 2017 (Ne) No. 10072 [Personal-Network Relationship Registration System] <Presiding Judge Tsuruoka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-87419.pdf

* An allegation under the doctrine of equivalents made at the first appellate hearing was dismissed as untimely.

Cf. 2017 (Ne) No. 10029 and 2015 (Ne) No. 10076, in which the allegations were not dismissed.

"At the first oral-argument hearing in this appellate instance, ... this Court dismissed the allegation of infringement under the doctrine of equivalents as

an untimely allegation or defense. The reasons are as follows. ... The Appellant should naturally have anticipated from the outset that the conclusion on satisfaction or non-satisfaction of the limitations could change depending on the claim construction regarding ... and the manner of internal processing by the Appellee's server. Accordingly, the Appellant had ample opportunity, at the issue-organizing stage in the court of first instance, to consider whether to allege infringement under the doctrine of equivalents even in the alternative and to make that allegation as necessary. (In light of the actual use of planned proceedings in patent infringement litigation, it is reasonable to view the matter in this way; and at least no objective circumstances preventing the Appellant from making the allegation are recognized.) Nevertheless, the Appellant did not make the allegation at the issue-organizing stage below, stated that there were 'no further allegations or proof regarding infringement,' and allowed the issue-organizing procedure to conclude. In these circumstances, the Appellant's addition of an allegation of infringement under the doctrine of equivalents in this appellate instance, as stated above, was clearly untimely even though made before the first oral-argument hearing, and the Appellant is found to have acted intentionally or with gross negligence in that regard. ..."

Cf. Intellectual Property High Court, 2015 (Ne) No. 10076 [Circular Table] <Presiding Judge Takabe>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85463.pdf

* An allegation under the doctrine of equivalents made at the first appellate hearing was not dismissed as untimely (because the appeal was dismissed at the first hearing, meaning the patentee lost).

"The Appellant's allegation above was set out in ... the preparatory brief stating the reasons for appeal, the Appellee also admitted or denied and responded to it, and it could be decided based on evidence already submitted. This Court then ... concluded oral argument at the first appellate oral-argument hearing. Accordingly,

the Appellant's allegation above cannot be found to 'delay completion of the proceedings' (Article 157(1) of the Code of Civil Procedure), and therefore should not be dismissed as untimely."

Cf. Intellectual Property High Court, 2014 (Ne) No. 10111 [Method for Mixing Granular Material and Removing Fine Powder] <Presiding Judge Takabe>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85366.pdf

* An allegation under the doctrine of equivalents made at the first appellate hearing was held untimely, but was decided.

"In light of the course of the proceedings, including that the issues in the first instance concerned exclusively satisfaction of Limitations 2E and 1B; that the notice of appeal did not state reasons for appeal; that the statement of reasons for appeal did not include ... an allegation of infringement under the doctrine of equivalents or give notice of such an allegation; and that the Appellant's first preparatory brief was submitted only five days before ... the first oral-argument hearing in this appellate instance, the Appellant's allegation of infringement under the doctrine of equivalents must be regarded as untimely. However, because the Appellee also admitted or denied and responded to the allegation, the court will decide below whether infringement under the doctrine of equivalents is established."

Cf. Intellectual Property High Court, 2022 (Ne) No. 10078 [Display Device Capable of One-Handed Support] <Presiding Judge Kanno>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91824.pdf

*** Three correction defenses were alleged in the court of first instance ⇒ a fourth correction defense was alleged in the statement of reasons for appeal; in light of the course of the proceedings, the court stated that it ordinarily would have to be dismissed as untimely. However, because a response had been made, the court decided it.**

“Reviewing the course of the proceedings in the court of first instance, after the invalidity defense alleging that the patent at issue lacked novelty and inventive step was made at the first preparatory-hearing date (November 18, 2019) (Defendant’s Preparatory Brief No. 1), the Appellant submitted, by the third preparatory-hearing date (July 27, 2020), Plaintiff’s Preparatory Brief No. 2 concerning a correction defense based on the second correction. In conjunction with correction requests in the patent invalidation trial, it then submitted Plaintiff’s Preparatory Brief No. 5 dated March 3, 2021 and Plaintiff’s Preparatory Brief No. 6 dated May 27, 2021, setting out a correction defense based on the third correction (those briefs, including corrected versions, were stated at the fourth preparatory-hearing date (December 16, 2021)). The original judgment held that neither the correction defense based on the second correction nor that based on the third correction satisfied the correction requirements, and that the patent at issue should be invalidated in a patent invalidation trial. The Appellant then added, in the statement of reasons for appeal, a correction defense based on the fourth correction. In light of this course of proceedings below, the fourth correction constitutes an untimely allegation or defense, and the Appellant was grossly negligent in delaying its submission, so it would ordinarily have to be dismissed. However, the Appellee responded to the correction defense based on the fourth correction, including that the fourth correction does not satisfy the correction requirements. To that extent, it cannot be said that considering the defense would delay completion of the proceedings; therefore, the court will decide it below.”

2. Court decisions in which the allegation was not held untimely on appeal (because, for example, an invalidation decision had issued. ⇒ A similar effect may be expected if proceedings have reached advance notice of the trial decision.)

Intellectual Property High Court, 2018 (Ne) No. 10033 [Aerosol Can Product] <Presiding Judge Otaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88388.pdf

* The same ground for invalidity dismissed below was alleged in the statement of reasons for appeal. ⇒ Not dismissed.

"... The commissioned judge in the court of first instance granted the Appellee's motion above and dismissed the Appellant's allegations and evidence relating to the invalidity defense above. The Japan Patent Office, ... finding a violation of the support requirement ... and the existence of the ground for invalidity relating to the invalidity defense at issue, rendered a separate decision invalidating the patent. ...

The Appellant's invalidity defense in this appellate instance is the same in substance as the allegation dismissed below as an untimely allegation or defense because it was submitted after the infringement phase had concluded and the damages phase had begun. However, the Appellant resubmitted it in this appellate instance after a separate decision invalidating the patent at issue had been rendered before conclusion of oral argument below, recognizing the existence of the ground for invalidity relating to the invalidity defense at issue and other matters. It is also recognized that the Appellant set out the invalidity defense at issue in the statement of reasons for appeal and alleged it from the outset of the appellate proceedings. Therefore, submission of the Appellant's invalidity defense in this appellate instance cannot be said to have been untimely. In light of the course of the appellate proceedings, it is also not recognized that submission of the invalidity defense by the Appellant would delay completion of the proceedings. Accordingly, ... the court will not dismiss it as an untimely allegation or defense."

Intellectual Property High Court, 2019 (Ne) No. 10066 [Information Management Program] <Presiding Judge Mori>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-89631.pdf

* The same ground for invalidity that was dismissed below. ⇒ Not dismissed.

In the court of first instance, an invalidity defense based on lack of novelty over the Otsu 14 invention had been dismissed as untimely.

⇒ The first-instance Defendant reasserted in the statement of reasons for appeal, in light of the invalidation decision, the lack-of-novelty defense based on the Otsu 14 invention that had been dismissed as untimely below. The appellate court addressed that invalidity ground on its merits.

⇒ The patentee lost on reversal based on lack of novelty. (★ Three months earlier, the same Second Division of the Intellectual Property High Court had rendered a judgment in the action to rescind the trial decision, 2019 (Gyo-Ke) No. 10109, and had upheld the invalidation decision based on lack of novelty.)

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3. Other Cases

Intellectual Property High Court, 2016 (Ne) No. 10100 [Electric Fishing Reel] <Presiding Judge Takabe>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86595.pdf

* A correction defense alleged after the court of first instance disclosed its view that the patent was invalid had been dismissed as untimely.

⇒ When the correction defense dismissed below was alleged in the statement of reasons for appeal, it was not dismissed as untimely.

“The Appellant did not submit a correction defense in the court of first instance before conclusion of the preparatory proceedings, but first alleged it in a preparatory brief submitted after those proceedings had concluded, and it was therefore dismissed by the court of first instance as untimely. (The correction alleged below was identical to the correction in this appellate instance, except for the presence or absence of the words ‘with one hand.’) After the original judgment was rendered on September 8, 2016, the Appellant filed an appeal on September 21. On September 30, advance notice of the trial decision was issued in each patent invalidation trial concerning Patents 1 to 3 at issue. The Appellant therefore set out the correction defense in the statement of reasons for appeal submitted on

November 10 of that year. In light of the course of proceedings in the court of first instance and this court described above, it may be said that it would have been desirable to make the correction defense earlier. Nevertheless, because the Appellant, after the original judgment was rendered and advance notice of the trial decision was issued, set out the correction defense in detail in the statement of reasons for appeal and promptly submitted that allegation in this appellate instance, it cannot be said that the Appellant's submission of the correction defense was untimely. In addition, in light of the content of the correction defense at issue, its submission is not recognized as delaying completion of the proceedings. The court therefore will not dismiss the Appellant's correction defense as untimely."

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Intellectual Property High Court (Grand Panel), 2005 (Ne) No. 10040 [Ichitaro Case]

Judgment: https://www.courts.go.jp/ip/vc-files/ip/file/10040.pdf

"Whether an allegation or defense should be dismissed under Article 157 of the Code of Civil Procedure as untimely must be determined, in accordance with the specific progress of the litigation, based on whether there were objective circumstances under which it could have been expected to be submitted earlier than it was. Each of the circumstances alleged by the Appellant merely concerns matters unrelated to the specific progress of this litigation concerning the Appellee's claim.

In the court of first instance, only slightly more than two months elapsed from the first oral-argument hearing until oral argument was concluded at the third hearing, and less than four months elapsed even from filing of the action. Thus, the first-instance proceedings were conducted extremely quickly over a short period. Except for certain supplemental portions, the Appellant's new allegations and proof in this appellate instance concerning satisfaction of the limitations and the grounds for invalidity of the patent at issue were basically made together with the statement of the reasons for appeal at the first oral-argument hearing in this

appellate instance, and were submitted at the outset of the appellate proceedings. Turning to the substance of the additional allegations and proof above, the part concerning satisfaction of the limitations merely supplemented, from a somewhat different angle, the Appellant's allegation already made below concerning satisfaction of the limitation (the meaning of 'icon'). The part concerning the grounds for invalidity of the patent at issue was based on newly added documents, but each was an English-language document distributed abroad and had been distributed before the filing date of the patent at issue, which was nearly fifteen years before this action was filed. It was therefore unavoidable that investigating and searching for such publicly known documents would require a certain amount of time. Considering all these circumstances together, the Appellant's additional allegations and proof newly submitted in this appellate instance concerning satisfaction of the limitations and the grounds for invalidity of the patent at issue cannot be said to have been untimely."

Intellectual Property High Court, 2018 (Ne) No. 10044 [Optical Information Reading Device] <Presiding Judge Otaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88010.pdf

* A correction defense made four days before the first appellate hearing was dismissed as untimely.

"A correction defense to an invalidity defense should originally be alleged at an appropriate time in the court of first instance. Moreover, although the Appellant could have alleged the correction defense in this appellate instance no later than the deadline for submitting the statement of reasons for appeal, it did not do so and first submitted a preparatory brief setting out the correction defense at issue only four days before the first oral-argument hearing. The correction defense at issue should therefore be regarded as an untimely allegation or defense submitted due at least to the Appellant's gross negligence."

Intellectual Property High Court, 2018 (Ne) No. 10031 [Lower-Limb Garment] <Presiding Judge Takabe>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-88234.pdf

* An invalidity defense made after the deadline for submitting the statement of reasons for appeal was dismissed as untimely.

"... More than one month after ... the deadline for submitting their statement of reasons for appeal, ... the first-instance Defendants submitted ... 'Statement of Reasons for Appeal (3).' ... The addition of the invalidity defense and publicly known-art defense should be dismissed as an untimely allegation or defense under Article 157(1) of the Code of Civil Procedure. ...

In addition to the circumstances above, ... the grounds for invalidity sought to be added in this appellate instance ... number at least six. Addition on appeal of an invalidity defense based on such a large number of grounds for invalidity must be regarded as having been submitted for the purpose of unduly delaying the proceedings. Accordingly, the additional invalidity-defense allegations should also be dismissed under Article 104-3(2) of the Patent Act."

Intellectual Property High Court, 2021 (Ne) No. 10084 [Printed Retroreflective Sheet] <Presiding Judge Miyasaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-92685.pdf

* A new invalidity defense at the first appellate hearing was dismissed as untimely.

Allegations (i) and (ii) of lack of inventive step first made on appeal were dismissed as untimely!!

- The primary reference alleged below + other secondary references
- An allegation changing the construction of the primary reference alleged below (the determination of the primary-reference invention)

Intellectual Property High Court, 2022 (Ne) No. 10008 [Information Providing Device] <Presiding Judge Otaka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91603.pdf

* Correction defense alleged after conclusion of written preparatory proceedings on appeal ⇒ dismissed as untimely

The court of first instance found lack of novelty, but the patent was maintained in the JPO invalidation trial. The patentee therefore did not allege a correction defense from the outset of the appeal and did not do so during the appellate issue-organizing procedure before conclusion of the written preparatory proceedings, but alleged it after those proceedings had concluded. ⇒ Dismissed as untimely. <Because the sequence was a decision maintaining the patent followed by the original judgment, the correction defense should have been asserted in the alternative.> The alleged infringer changed its comparison with the primary reference so as to cover the decisive difference on which the decision maintaining the patent had found the patent maintainable, and the original judgment found lack of novelty.

Intellectual Property High Court, 2021 (Ne) No. 10094 [... Work Glove] <Presiding Judge Kanno>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91303.pdf

* A correction defense alleged after the court of first instance disclosed its view that the patent was invalid had been dismissed below as untimely. ⇒ Although the correction defense dismissed below was alleged in the statement of reasons for appeal, it was again dismissed as untimely.

“The Appellant alleges in the statement of reasons for appeal that the invention at issue should be corrected (a correction defense), but this Court dismissed the allegation as an untimely allegation or defense. The reasons are as follows. According to the record, the correction defense was made after the court of first instance disclosed its view that the patent at issue was invalid and was therefore dismissed below as an untimely allegation or defense. No

circumstances are found showing that it could not have been alleged at an appropriate time in the court of first instance. The above allegation in this appellate instance is therefore plainly untimely, the Appellant was at least grossly negligent in that regard, and permitting this allegation or defense would plainly cause substantial delay in completion of these proceedings."

Intellectual Property High Court, 2020 (Ne) No. 10044 [Fluid Supply Device and ... Program] <Presiding Judge Tsuruoka>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90472.pdf

* The invalidity allegation was made after disclosure of the court of first instance's preliminary view, but there was a problem with the organization of allegations below (whether there was a judicial admission).

⇒ Whether and when an invalidity argument should be submitted must be assessed in light of the course of the allegations and evidence on infringement. In this case, there were deficiencies in the first-instance court's organization of the issues, and submission after disclosure of the court's provisional view did not, by itself, make the argument untimely. — Not dismissed.

"Regarding whether the allegations constituted 'untimely allegations or defenses': Invalidity Allegations A, B, and D were made after disclosure of the court of first instance's preliminary view on infringement and were therefore treated below as untimely. However, as already noted in the section concerning infringement, the organization of allegations in the court of first instance concerning satisfaction of Limitation 1C1 (Non-Infringement Allegation (iv)) and satisfaction of Limitations 1A, 1C, 1F3, and 1F4 (Non-Infringement Allegation (v)) was deficient in that issues that should have been treated as disputed were treated as undisputed. The necessity and timing of allegations concerning invalidity cannot be considered separately from the development of allegations and proof on infringement. Therefore, in this case, where further allegations and proof should originally have been presented on infringement, it is not appropriate to characterize the invalidity allegations as untimely merely because they were made after disclosure of the

court of first instance’s preliminary view. The invalidity allegations concerning the above grounds for invalidity were also made promptly after appeal. Accordingly, neither from the perspective of viewing the proceedings below and on appeal as a whole nor from the perspective focused on the appellate proceedings can the first-instance Defendant’s invalidity allegations above be characterized as untimely.”

End

(Appellant) FLORe Co., Ltd.

(Appellee) MIC Co., Ltd.

[Patent ★] A case in which the configuration, etc. of the counterpart subcombination was held not to be a matter specifying the invention. ⇒ No inventive step — Intellectual Property High Court, July 10, 2025; 2024 (Ne) No. 10012 [R Badge, Receiving Device] <Presiding Judge Hibiku Shimizu> —

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https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%89%b9%e8%a8%b1%e2%98%85%e3%80%91%e3%82%b5%e3%83%96%e3%82%b3%e3%83%b3%e3%83%93%e3%83%8d%e3%83%bc%e3%82%b7%e3%83%a7%e3%83%b3%e3%81%ae%e7%9b%b8%e6%89%8b%e6%96%b9%e3%81%ae%e6%a7%8b%e6%88%90/

(1) Criteria for Determining Matters Specifying the Invention in a Subcombination Claim

This judgment has important practical significance because, in determining the gist of a subcombination invention (an invention of a device constituting part of a multifunctional system), it provided guidance on when matters concerning the "other subcombination (counterpart device)" recited in the claim are taken into account as matters specifying the invention (or are ignored).

This judgment confirmed the framework that a description concerning the counterpart device of a subcombination is excluded (ignored) in determining the gist of the invention "where the matters concerning that other subcombination are matters specifying only that other subcombination and do not specify the structure, function, or the like of the subcombination under the claim."

Quotation source: Judgment, p. 17. Here, the other subcombination refers to the counterpart device, and the subcombination under the claim refers to the claimed device itself.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94282.pdf

That is, even if the claim wording merely includes a limitation concerning the counterpart device (for example, a high-function mobile phone, an application-download function, or the like), it is excluded (ignored) from determination of the gist of the invention at issue, which is the premise for assessing novelty and inventive step, if it does not affect the structure, function, or the like of the device

under that claim (for example, the receiving device) itself (= if it has no meaning in specifying that device).

(2) Whether the Feature Is Reflected in the "Structure, Function, or the Like" (Comparison with Related Court Decisions)

Viewing this judgment together with the [Related Court Decisions] below (affirmative and negative examples), the dividing line for whether a subcombination claim is recognized as stating a matter specifying the invention may be said to be whether the feature of the counterpart device of the subcombination specifies (limits) the "structure, function, or the like" of the claimed device itself.

(i) Cases in Which the Matter Was Not Recognized as a Matter Specifying the Invention (This Judgment, the "Information Processing Device" Judgment, the "Lock and Key" Judgment, etc.)

In this judgment, whether the mobile phone (the counterpart) had "means for downloading an application and adding a function," a "credit-card function," or the like caused no difference, from the perspective of the receiving device, in the basic operation of receiving transmitted identification information (ID). In other words, where only the "internal circumstances" of the counterpart device or the "semantic content of the information" handled by it are described, and the signal format or physical shape at the interface between the two devices does not change, that description is excluded from the gist of the invention.

The "Information Processing Device" judgment discussed below held that the statement concerning the "basis" on which the server extracts information did not specify the content of the information-processing device's publication-notification means. In the "Rotary Disc Tumbler Lock and Key" judgment, the invention was identified by the matters specifying the key itself. Adding limitations concerning the lock did not limit the key itself and therefore did not constitute a correction for narrowing the claims or another permitted purpose. The latter decision thus also concerns the requirements for correction.

(ii) Cases in Which the Matter Was Recognized as a Matter Specifying the Invention (the “Waste Storage Device” Judgment, the “Liquid Container” Judgment, etc.)

By contrast, in the “Waste Storage Device” judgment discussed below, the existence of the rotating device directly determined the engagement structure and the manner in which the cassette was supported. In the “Liquid Container” judgment, the light-emitting portion of the ink container and the light-receiving portion of the printer body cooperated as a system, and one directly controlled or detected the operation of the other.

As the author’s synthesis of these cases, where the configuration of the counterpart device of a subcombination “necessarily defines” the configuration of the claimed device itself (where there is physical fitting or an inseparable interaction as a system), it is recognized as a matter specifying the invention.

(3) Practical Guidance

In light of this judgment, in drafting a subcombination claim, merely stating “(the claimed device) communicates with (a counterpart device) having the configuration ...” entails a risk that the matter will not be regarded as specifying the invention because it does not specify (limit) the structure, function, or the like of the claimed device itself.

For effective acquisition and enforcement of patent rights, it is useful to claim the “reflection” in the structure and function of the claimed device itself corresponding to the characteristic configuration of the counterpart device, such as “what signal processing is performed (decoding, authentication, etc.),” “what physical shape is required (fitting, arrangement, etc.),” and “how timing control changes.”

Going further, where both the claimed device and the counterpart device are manufactured and sold separately, as with a printer and an ink cartridge, one patent-application strategy would be to design them so that each device’s structure and function are specified (limited) by the other device, allowing

subcombination claims to be patented for each, and to consider some technical significance of that structure and function and describe it in the specification.

Judgment in the case under discussion: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94282.pdf

Related decisions and primary sources

1. Intellectual Property High Court, February 10, 2022, 2021 (Gyo-Ke) No. 10056, Information Processing Device and Method, and Program
Judgment pp. 31–36. The court examined whether descriptions of server processing specified the structure or function of the information-processing device and excluded those that did not from the determination of the gist of the invention.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90915.pdf

2. Tokyo District Court, November 25, 2011, 2010 (Wa) No. 24818, Rotary Disc Tumbler Lock and Key
Judgment pp. 39–41 and 54. The court identified the invention by the shape of the key itself. A correction adding limitations concerning the lock, without limiting the key, did not narrow the claims or serve another permitted correction purpose.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81783.pdf

3. Intellectual Property High Court, Grand Panel, February 1, 2013, 2012 (Ne) No. 10015, Waste Storage Device, and the incorporated first-instance judgment
Appellate judgment p. 22; Tokyo District Court, December 26, 2011, 2009 (Wa) No. 44391 and related case, pp. 77–85. Satisfaction of the limitations was assessed by reference to the cassette's structure for engagement with, support and rotation by, and suspension from a rotating device. Requiring a structure suitable for that use is distinct from restricting its actual uses exclusively to that use.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83009.pdf
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81995.pdf

4. Intellectual Property High Court, February 8, 2011, 2010 (Gyo-Ke) No. 10056, Liquid Ink Container
Judgment p. 50. The specific ink container dedicated to the system formed the invention as a pair with the recording apparatus. The limitation requiring projection of light to the light-receiving means limited the container's light-emitting portion, so the recording apparatus could not be disregarded in the obviousness analysis.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-81062.pdf

[Patent ★] A case in which the description in the detailed description of the invention concerning the derivation method for a parameter in the claims was erroneous, the allegation that the description contained an error was also rejected, and the support requirement was denied — Tokyo District Court, 2023 (Wa) No. 70114 [Brake Control Device for a Motorcycle] <Presiding Judge Shibata> — (Same holding on appeal: Intellectual Property High Court, 2024 (Ne) No. 10038 <Presiding Judge Honda>)

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◆ Judgment Text

[Summary of This Judgment and Some Observations]

1. Claims (Claim 1)

1A. A brake control device used in a vehicle that is a so-called motorcycle and has at least two wheels,

1B. the brake control device being composed of a vehicle-speed detection device, a vehicle-behavior detection device, an ECU (control unit), and a braking device;

1C. the vehicle-speed detection device being a wheel-speed sensor and obtaining vehicle traveling speed from a detected signal;

1D. the vehicle-behavior detection device being a sensor that detects states in left and right roll directions and left and right lateral directions relative to the traveling direction, and obtaining bank angular velocity (Ψ) and lateral

acceleration (Gken) from the detected signal;

1E. the ECU performing calculation of detected signals, calculation of a target braking force according to vehicle behavior, and issuance of a braking command to the braking device;

1F. as the signal calculation, at least having a method of deriving corrected lateral G (Ghosei), obtained by performing a calculation that removes the effect of roll on an acceleration sensor that detects lateral acceleration;

1G1. the braking device being a mechanism that decelerates the vehicle in response to a braking command from the ECU;

1G2. having means for engine braking and for increasing and decreasing pressure on a brake disk;

1H. in the vehicle, vehicle behavior being determined based on a combination of the bank angular velocity (Ψ) and the corrected lateral G (Ghosei); and

1I. a target braking force according to the vehicle behavior being determined, braking being performed at the wheels, and behavior in the roll direction being suppressed by braking, the vehicle brake control device being characterized thereby.

2. This Judgment

(1) Summary of This Judgment

This judgment held that the description in the detailed description of the invention concerning the "method of deriving ... lateral G," a parameter in the claims, was erroneous, rejected the Plaintiff's (patentee's) allegation that the

description contained a correctable clerical error, and denied compliance with the support requirement.

Paragraph [0073] of the specification states the formula "Ghosei = Gken − (Ψ·Rhsen)" (Formula A). The judgment pointed out that, although Ψ is understood as bank angular velocity and Rhsen as the height of the sensor position, this formula subtracts velocity from acceleration, so the dimensions do not agree and the formula has no meaning in physics. In other words, because Formula A is physically invalid, the court held that a person skilled in the art could not actually use it to derive corrected lateral G.

The Plaintiff alleged that Formula A contained an error and should be corrected to Formula A′ by correcting Ψ in the formula to (the symbol Ψ with a dot above it), which represents bank angular acceleration. The judgment held, however, that because the specification at issue consistently used bank angular velocity Ψ throughout, and correcting it to acceleration would create portions inconsistent with other descriptions and render them incomprehensible, the specification could not be understood as uniquely supporting the alleged correction of the clerical error; therefore, the correction alleged by the Plaintiff could not be assumed.

"Although a person skilled in the art can understand that there is some error because the terms in Formula A have different dimensions, the method of resolving the problem of different dimensions is not limited to the correction alleged by the Plaintiff, and there is insufficient evidence to establish that, from the content of Formula A and other matters, a person skilled in the art would understand that there is no method other than correction to Formula A′ for resolving the problem of different dimensions. Further, if the portions of the specification at issue concerning Formula A are corrected so as to be consistent with the correction of Formula A, it is recognized that the purport of descriptions that previously presented no problem becomes incomprehensible or inconsistent. In light of these circumstances, it cannot be

said that the specification at issue would be understood as showing that Formula A is an erroneous description of Formula A′. Accordingly, the Plaintiff's allegation, which is premised on Formula A being understood as an erroneous description of Formula A′, lacks its premise. ... None of the inventions at issue can be said to be an invention described in the specification at issue, and each fails to satisfy the support requirement."

(2) Excerpts from This Judgment Concerning Violation of the Support Requirement

"(1) Invention 1 at Issue

A. Limitation 1F of Invention 1 at issue is: 'as the signal calculation, at least having a method of deriving corrected lateral G (Ghosei), obtained by performing a calculation that removes the effect of roll on an acceleration sensor that detects lateral acceleration'; Limitation 1H is: 'in the vehicle, vehicle behavior is determined based on the combination of the bank angular velocity (Ψ) and the corrected lateral G (Ghosei), ...'; and Invention 1 at issue is stated to be a vehicle brake control device (Limitation 1I) that appropriately brakes the wheels by means of an ECU using the calculated corrected lateral G (Ghosei), thereby suppressing behavior in the roll direction.

As stated in Section 1 above, Invention 1 at issue solves the problem that conventional control devices for motorcycles and the like could not accurately detect a bank angle, and makes it possible to detect accurate lateral G while the vehicle is traveling. In light of these matters, the 'lateral G (Ghosei)' in Limitations 1F and 1H is recognized as accurate lateral G during banked travel of the vehicle, calculated after, among other things, accurately detecting the bank angle, which could not previously be done.

Because the 'lateral G (Ghosei)' serving as the premise for a braking command is stated to be one 'obtained by performing a calculation that removes the

effect of roll on an acceleration sensor that detects lateral acceleration' (Limitation 1F), 'lateral G (Ghosei)' may be understood as a value obtained by applying a correction to the detected value of an acceleration sensor that detects lateral acceleration. However, the claims of Invention 1 at issue merely state, regarding 'lateral G (Ghosei),' that a 'calculation that removes the effect of roll' is performed on the acceleration-sensor value (Limitation 1F), and do not expressly state what calculation is performed. Accordingly, the claims state only that something capable of solving the conventional problem is used, but do not state the configuration for solving that problem.

B. As stated in Section 1 above, the specification at issue describes the significance of the invention at issue as solving the problem that it had not been possible to detect an accurate bank angle and therefore had not been possible to detect accurate lateral G, thereby making it possible to detect accurate lateral G while the vehicle is traveling.

However, the specification at issue contains no description of how to detect the accurate bank angle that previously could not be detected, or what correction is to be performed to calculate accurate lateral G once that bank angle is known.

On the other hand, as a method of correcting a sensor detection result and calculating lateral G, the specification at issue states Ghosei = Gken − (Ψ · Rhsen) (Formula A) ([0073]). Paragraph [0073] of the specification at issue states that 'Gken' is detected lateral G detected during actual banked travel, that 'Ψ' is bank angular velocity, and that 'Ghosei' is lateral G after correction of Gken using Ψ. (Although 'Rhsen' is not defined in the specification at issue, there are descriptions suggesting that 'hsen' is the distance between the road surface and the sensor ([0050], [0058], [0061], and Figures 8 and 9); a description that 'R is the height at which G sensor #23 is installed on the actual vehicle (Figure 8 bhsen)' ([0063]); and, regarding Ψ · Rhsen, after

substituting 1 for Rhsen, a description stating 'provided, however, that the sensor installation height R is 1 m' ([0074]). It is therefore possible, at least tentatively, to infer that 'Rhsen' is the height of the sensor installation position when the vehicle body is upright.) That 'Ghosei' may be understood as the 'accurate lateral G' referred to as the problem of the invention at issue. Further, from its form, Formula A may be understood as a formula describing a method of calculating 'accurate lateral G' using Gken detected by the 'lateral G sensor' and Ψ detected by the 'angular-velocity sensor,' as stated in the description of the significance of the invention at issue (see Section 1 above).

However, the bank angle is not calculated from 'Ψ · Rhsen,' and Formula A cannot be understood as solving, without calculating the bank angle, the 'various problems caused by the inability to detect an accurate bank angle.' Further, Ghosei and Gken have the dimension of acceleration (length/time^2), whereas Ψ · Rhsen has the dimension of velocity (length/time), and Formula A is therefore plainly meaningless in physics (the entire purport of the oral argument).

The specification at issue contains no description, other than Formula A, of a method for calculating 'accurate lateral G' based on values measured by the sensors.

C. According to the specification at issue, the invention at issue states as its problem that acquisition of 'accurate lateral G' is necessary for vehicle control, but the value of an acceleration sensor detecting lateral acceleration cannot be used as-is; and that, to calculate accurate lateral G from that value, it is necessary to acquire the bank angle but this cannot be done. The invention at issue is stated to solve that problem by calculating accurate lateral G during banked travel of the vehicle. Thus, the calculation concerning 'lateral G (Ghosei),' described as 'performing a calculation that removes the

effect of roll on an acceleration sensor that detects lateral acceleration,' is the core part of solving the problem of the invention at issue.

However, the claims do not recite, with respect to that calculation, a configuration sufficient to solve the conventional problem. The relevant descriptions in the detailed description of the invention in the specification at issue are also as stated in B above. Formula A in the specification at issue ([0073]) may tentatively be understood as the above calculation, but there is no other relevant description. As stated in B above, Formula A does not calculate the bank angle that is identified as the problem of the invention at issue and is, in the first place, physically meaningless. A person skilled in the art could not understand that lateral G (Ghosei) usable for vehicle control can be calculated using Formula A.

D. (a) The Plaintiff alleges that the descriptions in the specification at issue contain errors in the description as shown in the attached comparison table and should correctly read as stated in the 'After Correction' column of that table. With respect to the 'calculation' in Limitation 1F, only Formula A could possibly correspond to it. As found in B above, Formula A subtracts physical quantities having different dimensions and is therefore physically meaningless; a person skilled in the art could understand that Formula A contains some error. On this point, if Formula A were understood, as the Plaintiff alleges, to be an error in the description for

Ghosei = Gken − (Ψ：Rhsen) (Formula A′)

(where 'Ψ' is bank angular acceleration),

the problem that the physical quantities being subtracted have different dimensions would be resolved. However, if the sole purpose is to make the dimensions consistent, the method of correction is not limited to changing it

to Formula A′; other methods of resolution may be conceived, and there is insufficient evidence to establish that such conceivable methods would be unreasonable in light of physical laws, technical common knowledge based thereon, or the like. Therefore, the wording of Formula A alone does not uniquely determine the nature of the error.

(b) The Plaintiff further proposes, when correcting 'Ψ' in Formula A to 'Ψ̈,' to correct not only Formula A but also the other references to 'Ψ' in paragraph [0073] to 'Ψ̈,' and one reference to 'bank angular velocity' to 'bank angular acceleration,' because otherwise a contradiction would arise with other descriptions in paragraph [0073] explaining Formula A.

However, under the correction alleged by the Plaintiff, corrected paragraph [0073] would include the following description: 'This corrected lateral G (Ghosei) is a correction of Gken in Formula (0063) using bank angular acceleration (Ψ̈), and, in relation to Formula (0067), is a condition in which the bank angle does not change. That is, because the term "Ψ̈：Rhsen" in the formula becomes zero, organizing and expressing the two formulas gives ...' Yet even if bank angular acceleration (Ψ̈) is zero, when bank angular velocity (Ψ) is not zero (when banking at a constant speed), the bank angle is changing. Therefore, the fact that the term 'Ψ̈：Rhsen' relating to bank angular acceleration (Ψ̈) is zero does not immediately mean 'a condition in which the bank angle does not change.' If the correction alleged by the Plaintiff is made, the purport of that description becomes incomprehensible. By contrast, if 'Ψ' is not corrected to Ψ̈ at that location, the content is comprehensible.

Similarly, with respect to the following description in paragraph [0073] as corrected by the Plaintiff: '... In this way, data in which the term "Ψ̈：Rhsen" in the formula is set to zero are sometimes called data obtained during steady-state circular turning. ...,' during steady-state circular turning the bank angle is constant and therefore the 'bank angular velocity' is zero. However, even if

a term relating to 'bank angular acceleration' is zero, the 'bank angle' is not necessarily unchanging (a bank angular acceleration of zero also includes banking at a constant speed). Thus, if the correction is made, the purport of that description becomes incomprehensible. On this point as well, the content is comprehensible if the location is not corrected.

Furthermore, Formula A may be regarded as a formula that corrects measured acceleration (Gken) by the value of angular velocity (Ψ), and this most closely follows, as a matter of wording, the method expressly stated in the specification at issue as the basic method for solving the problem, namely, 'solving various problems caused by the conventional inability to detect an accurate bank angle by associating the lateral G sensor and the angular-velocity sensor during travel' (Section 1 above). By contrast, if Formula A is corrected to Formula A′, its content no longer, at least directly, most closely follows that wording.

(c) The Plaintiff further alleges that paragraph [0063], after correction of the errors in the description, shows that an acceleration component (Ψ：Rhsen), which is the effect of a change in roll velocity, is superimposed on detected lateral G (Gken) detected during banked travel, and that the superimposed acceleration component can be removed by subtracting bank angular acceleration (Ψ'), which is the change in velocity of the bank angular-velocity sensor.

However, as explained in B above, the only acceleration mentioned in the specification at issue as an acceleration used for control and obtained by correcting an acceleration value acquired by a sensor is the lateral G (Ghosei) in paragraph [0073]; paragraph [0063] does not describe the method for calculating the 'lateral G (Ghosei)' of Invention 1 at issue. Even if paragraph [0063] could be evaluated as containing a description suggesting that the 'calculation that removes the effect of roll on the acceleration sensor'

according to Invention 1 at issue means subtracting 'Ψ：Rhsen,' paragraph [0073] is more directly a description of a method of calculating corrected acceleration used for control, yet Formula A has the problem explained in B above.

Paragraph [0063] also states the formula

Gken = g · cos Φ · tan ρ − Ψ · Rhen

(after correction, 'Gken = g · cos Φ · tan ρ + Ψ：Rhsen').

Although the corrected formula contains the term 'Ψ：Rhsen,' there is insufficient evidence to establish that, as a matter of physics, 'g · cos Φ · tan ρ,' obtained by subtracting it (adding it in the corrected formula), corresponds to the 'accurate lateral G' that the invention at issue has the problem of calculating, or that knowing this physical quantity would solve the 'various problems caused by the inability to detect an accurate bank angle.' Accordingly, even if the description in paragraph [0063] could be found to be an error in the description as alleged by the Plaintiff, it cannot be understood from that formula alone that subtracting 'Ψ：Rhsen' from 'Gken,' the value detected by the sensor, leads to solving the problem and constitutes the 'calculation that removes the effect of roll' in Limitation 1F.

The Plaintiff's allegations also include an assertion that the descriptions in paragraphs [0061] and [0062] before paragraph [0063] make it possible to understand that the description in paragraph [0063] is an error in the description. However, paragraphs [0061] and [0062] also contain numerous errors in the description, including not only errors concerning 'Ψ' and 'Ψ' but also errors concerning '−' and '+'; it is difficult to find that which portions are errors in the description can readily be understood. From the beginning of its explanation and throughout, the specification at issue was originally written,

basically consistently, on the premise of a formula that adds or subtracts a physical quantity having the dimension of angular velocity (circumferential velocity) to or from a physical quantity having the dimension of acceleration; as explained in D above, even portions not directly related to that formula were written so as not to contradict it. Correcting that formula in such a specification creates contradictions with other portions. In light of these matters, even if a person skilled in the art would understand that there is an error in the specification at issue, it cannot be found that such a person could understand what was originally intended to be written or which portions contain which errors in the description.

(d) As stated above, although a person skilled in the art can understand that there is some error because the terms in Formula A have different dimensions, the method of resolving the problem of different dimensions is not limited to the correction alleged by the Plaintiff, and there is insufficient evidence to establish that, from the content of Formula A and other matters, a person skilled in the art would understand that there is no method other than correction to Formula A′ for resolving the problem of different dimensions. Further, if the portions of the specification at issue concerning Formula A are corrected so as to be consistent with the correction of Formula A, it is recognized that the purport of descriptions that previously presented no problem becomes incomprehensible or inconsistent.

In light of these circumstances, it cannot be said that the specification at issue would be understood as showing that Formula A is an erroneous description of Formula A′. Accordingly, the Plaintiff's allegation, which is premised on Formula A being understood as an erroneous description of Formula A′, lacks its premise. ...”

(3) Supplemental Allegations in the Appellate Judgment, Intellectual Property High Court, 2024 (Ne) No. 10038 <Presiding Judge Honda>

Appellate judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93712.pdf

"Focusing on the 'return angle (ρ)' alleged by the Appellant, the detailed description of the invention states: 'Hybrid sensor 20 compactly incorporates acceleration sensor 21 for detecting acceleration in the traveling direction, bank angular-velocity sensor 22 for detecting roll velocity in the traveling direction, and acceleration sensor 23 for detecting acceleration in the roll direction, and is arranged near the combined center of gravity including the rider's weight. In hybrid sensor 20, both the theoretical bank angle (Φ) occurring during banking and the return angle (ρ) arising from a change in the tire's load-contact point due to banking are present at the same time. (See Figure 8 as well.) A deviation arises between the force generated at sensor 20 (vector A) and the force actually generated (vector A′). Analysis showed that accurate lateral G could be detected from this deviation angle (return angle (ρ)).' ([0060]); and 'The formula can be transformed to Gken = g·cos Φ·tan ρ − Ψ·Rhen, yielding a simple formula. Here, Φ represents the theoretical bank angle of the vehicle, which is also the theoretical inclination angle, and is an angle obtained by time-integrating angular velocity Ψ (rad/sec) detected by bank angular-velocity sensor 22; ρ represents the bank-return angle; and R represents the height at which G sensor #23 is installed on the actual vehicle (Figure 8 bhsen).' ([0063]). However, these descriptions merely show that, as a result of analyzing 'lateral acceleration (Gken),' it can be expressed by a formula using bank angle Φ, bank-return angle ρ, bank angular velocity Ψ, and the like. By contrast, although the claims specify that the 'lateral acceleration (Gken)' of Invention 1 at issue is detected by an 'acceleration sensor that detects lateral acceleration,' they do not specify that it is derived from the calculation Gken = g·cos Φ·tan ρ − Ψ·Rhen based on bank angle Φ, bank-return angle ρ, bank angular velocity Ψ, and Rhen. The Appellant's allegation therefore lacks its premise.

Further, if the ‘lateral acceleration (Gken)’ detected by the ‘acceleration sensor that detects lateral acceleration’ were accurate lateral G, detection of accurate lateral G would be an inherent function of the ‘acceleration sensor that detects lateral acceleration’ and would be unrelated to detection of an accurate bank angle. That would also contradict the problem alleged by the Appellant, namely, ‘(i) enabling detection of “accurate lateral G” during travel by “associating the lateral G sensor and angular-velocity sensor during travel” and “detecting an accurate bank angle.”’ The Appellant’s allegation is therefore an independent view inconsistent with the specification at issue and cannot be accepted.”

Quotation note: The Japanese version retains the original judgment’s wording “小型に内蔵されおり” as written (sic).
Judgment, p. 6.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93712.pdf

3. Some Observations

The support requirement is determined by examining “whether the invention recited in the claims is an invention described in the detailed description of the invention and falls within the scope in which a person skilled in the art can recognize, based on the detailed description, that the problem of the invention can be solved, or, even without such description or suggestion, within the scope in which a person skilled in the art can recognize, in light of technical common knowledge as of the filing date, that the problem of the invention can be solved.”

Where no specific challenge is made to the specification, the analysis may proceed on the basis of its description. The absence of a challenge does not, however, automatically establish compliance with the support requirement. It remains necessary to consider whether the claimed scope is within the range in which a person skilled in the art could recognize that the problem can be solved, in light of the detailed description and common general technical knowledge at the filing date.

Where an error in a mechanism, mode of action, example, comparative example, or the generalization across the claimed scope is specifically disputed, allegations and proof appropriate to the issue are required. Case law places the burden of proving compliance with the support requirement on the patent applicant or patentee, and some decisions also address the applicant's allegations and proof concerning enablement (see below). The requirements and the procedural contexts, including refusal, invalidation, and infringement proceedings, must nevertheless be distinguished. They cannot be combined into a single proposition concerning the burden of proof that also encompasses qualification as an invention. The party alleging invalidity for lack of inventive step must substantiate that ground, while a patentee or applicant relying on an unpredictable remarkable effect must address the concrete evidence supporting that effect. What must be alleged and proved about the effect should be considered case by case, separately from the debate between the independent-requirement and overall-consideration theories. There are also decisions in which the reliability of an effect stated in the specification was rejected and inventive step was denied (see below).

An allegation that a description in the detailed description is scientifically erroneous (contrary to a law of nature) is often proved by replication testing, publicly known documents (including documents after the filing date), expert opinions, and the like.

[Related Court Decisions (Cases in Which Patentability Requirements Were Denied Because a Description in the Detailed Description of the Invention Was Erroneous)]

1. Court Decisions Denying the Support, Enablement, or Other Disclosure Requirements

(1) Intellectual Property High Court, 2005 (Gyo-Ke) No. 10645 [Method for Inspecting Sealed Packages] <Presiding Judge Tsukahara>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-33052.pdf

Classification note: This judgment rejected compliance with enablement and clarity. It should not be classified as a ruling on the support requirement under Article 36(6)(i) of the Patent Act.

“The trial decision’s determination regarding violations of Article 36(4) and (6) of the Patent Act ...

Paragraph [0008] states: ‘Accordingly, when electrode 4 from the voltage-output terminal of high-voltage power supply 6 is brought into contact with or close to side portion 31 of sealed package 3, electrically conductive contents 1 in sealed package 3 are charged by the negative or positive potential of the high voltage (0.6 kV to 30 kV) applied to electrode 4, and negative (−) ions or positive (+) ions are generated.’ Figure 1 depicts only negative (−) ions as if generated throughout the contents. However, it is unclear how these ‘negative (−) ions or positive (+) ions’ are generated, and a person skilled in the art cannot readily carry this out. Specifically, if there is no closed circuit and no displacement current flows, or if charge does not move along side portion 31 of sealed package 3, it is unclear from where the charge for generating negative (−) ions or positive (+) ions is supplied. If negative (−) ions or positive (+) ions are generated in the contents without charge being supplied from outside the contents, this violates the law of conservation of charge.

...

Court’s Determination

...

As in the invention of the application, “bringing ... a single electrode 4 into contact with or close to side portion 31 of sealed package 3 ... and charging contents 1 in sealed package 3 through electrically insulating coating 2” violates the law of conservation of charge and cannot be realized by anyone. Such an invention must therefore be regarded as unclear, and the detailed description of the invention in

the specification of the application cannot be said to describe the invention clearly and sufficiently to such an extent that a person skilled in the art can carry it out. ...”

(2) Intellectual Property High Court, 2021 (Gyo-Ke) No. 10094 [PCSK9 (Second Litigation)] <Presiding Judge Kanno>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-91751.pdf

* Successfully proved that the technical significance of the invention at issue (as alleged by the patentee) did not hold true!!

⇒ Support requirement not satisfied.

“... The technical significance of the invention at issue lies in specifying that an antibody competing with the 31H4 antibody has the functional characteristic of being an antibody that neutralizes binding between PCSK9 and the LDLR protein by the same mechanism as the 31H4 antibody. ... In the absence of any particular explanation of a mechanism supporting that antibodies of this kind in general exhibit functional characteristics similar to the 31H4 antibody, it cannot be said that ‘an antibody that competes with the 31H4 antibody for binding to PCSK9’ in the invention at issue ‘exhibits functional characteristics similar’ to the 31H4 antibody. ...

A person skilled in the art would find it difficult to understand that an antibody competing with the 31H4 antibody is a binding-neutralizing antibody.

... Dr. [name omitted] expressed the opinion that “it is certainly erroneous to say that all antibodies competing with the 31H4 antibody ... would have the effect of neutralizing binding.” ... According to the foregoing, neither Invention 1 nor Invention 5 at issue is recognized as complying with the support requirement.”

(3) Intellectual Property High Court, 2016 (Gyo-Ke) No. 10064 [Polyvinyl-Alcohol-Based Polymer Film] <Presiding Judge Mori>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86905.pdf

* It could not be recognized that the problem could be solved by every substance falling within the invention, regardless of type.

* Although the detailed description stated, “The inventors ... found that the above objective is achieved by a PVA-based polymer film having a pH within a certain range when dissolved in water ...,” the court held that the mechanism could not be recognized.

“... Even when a person skilled in the art encounters the disclosure that, in an example adopting the lauric-acid diethanolamide mixture at issue as the surfactant, setting the numerical range for the content of the nonionic surfactant at ‘0.3 parts by mass’ and setting the numerical range for the pH of the PVA-based polymer film at ‘3.6 to 6.2’ produced an effect of suppressing yellowing in a 30°C long-term storage test and an 80°C short-term storage test, it cannot be recognized that the person skilled in the art could understand that, for any ‘nonionic surfactant (B)’ of Corrected Invention 1 at issue regardless of its type, setting the numerical range for the content of the nonionic surfactant at ‘0.001 to 1 part by mass’ and setting the numerical range for the pH of the PVA-based polymer film at ‘2.0 to 6.8’ would solve the problem of Corrected Invention 1 at issue, namely, providing a PVA-based polymer film capable of suppressing yellowing during long-term storage at room temperature. Accordingly, Corrected Invention 1 at issue exceeds the scope described in the corrected specification at issue in such a manner that a person skilled in the art having the technical common knowledge as of the filing date could recognize that the problem of Corrected Invention 1 at issue can be solved, and cannot be said to comply with the support requirement prescribed in Article 36(6)(i) of the Patent Act.”

(4) Intellectual Property High Court, 2015 (Gyo-Ke) No. 10201 [Beverage in a Container] <Presiding Judge Shimizu>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-86483.pdf

* The problem was specifically identified ⇒ Support requirement not satisfied.

The mechanism for solving the problem could not be read from the examples.

* Although the detailed description stated, “The inventors found that a beverage whose appearance is maintained with little change in color tone even after long-term storage is obtained by causing specified amounts of alcohols to be contained together with isoquercitrin and its sugar adducts and further adjusting the pH within a specified range,” the court held that a person skilled in the art could not recognize that mechanism.

“... It cannot be said that a person skilled in the art would understand that, because isoquercitrin and its sugar adducts were blended in addition to L-ascorbic acid under the conditions of the examples and comparative examples in the specification at issue, browning of L-ascorbic acid did not occur (and therefore that changes in color tone caused by browning of L-ascorbic acid were not included in the changes in color tone of the beverages in the examples and comparative examples of the specification at issue). ...

According to the foregoing, in light of the detailed description of the invention in the specification at issue and the technical common knowledge as of the filing date, it cannot be said that a person skilled in the art could recognize that Corrected Inventions 9 to 16 at issue solve the problem of providing a method for suppressing a change in the color tone of a beverage in a container by suppressing changes in the color tone of isoquercitrin and its sugar adducts contained in that beverage.”

(5) Tokyo High Court, 2000 (Gyo-Ke) No. 176 [Continuous Forming and Trimming Method]

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-11944.pdf

* Burden of proof where the specification contains no description

⇒ The court found a description deficiency because the specification's disclosure was insufficient.

(Summary of the holding) A party asserting that the technology recited in the claims is such that a person skilled in the art can readily implement it without further explanation must present sufficient allegations and proof for the court to make that finding. Without them, the specification is treated as deficient.

"The detailed description of the invention must describe the above configuration to such an extent that a person skilled in the art can readily carry it out. ... However, where the matter stated in the claims is technology of such a degree that a person skilled in the art, merely upon encountering the wording, can readily carry it out without any further particular explanation, it is a reasonable construction, in light of the purpose of the above provision, that exceptionally it is not always necessary to describe that explanation in the specification. Nevertheless, if, in an action to rescind a trial decision, it becomes disputed whether the matter stated in the claims is technology of the above degree, then unless the party asserting that it is technology of that degree presents allegations and proof sufficient for even a court, which is not a person skilled in the art, to make that finding, the court has no choice but to treat the specification as deficient. ..."

(6) Intellectual Property High Court, 2013 (Gyo-Ke) No. 10250 [Polyimide Film]

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-85069.pdf

* The applicant bears the burden of proof regarding the enablement requirement.

⇒ (Summary of the holding) Concerning the enablement requirement: The applicant originally bears the burden of allegation and proof regarding compliance

with the enablement requirement. Although the specification at issue lacks specific guidance for reducing the coefficient of thermal expansion, the Defendant (applicant) has presented no specific proof.

"... The specification at issue provides no specific guidance whatsoever on how to control solvent content, temperature conditions, stretching speed, and the like so as to reduce the coefficient of thermal expansion to the level of Invention 9 at issue. Although the burden of allegation and proof regarding the enablement requirement originally rests on the Defendant, which is the applicant, the Defendant makes no specific allegation or proof that a two-component ODA/BPDA polyimide film satisfying the range of coefficients of thermal expansion in Invention 9 at issue can be manufactured. ..."

2. Court Decision Denying Qualification as an Invention

(1) Tokyo High Court, 2003 (Gyo-Ke) No. 166 [... Topical Agent for Treating Atopic Dermatitis] <Presiding Judge Tsukahara>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-9822.pdf

"Although the specification at issue ... describes the results of the clinical trial at issue, it must be said that there is insufficient evidence to establish (i) that the clinical trial at issue was actually conducted, (ii) that the drugs used in the clinical trial were in fact ... the topical ointment and topical cream, and (iii) that the results of the clinical trial were accurately stated in the specification at issue. Further, even considering the various points alleged by the Defendant other than the clinical trial at issue, there is insufficient evidence to establish that the drug at issue has a therapeutic effect. It therefore cannot be inferred that the technical content (technical means) of the invention at issue can produce the intended technical effect. The subject matter asserted to be the invention at issue is thus incomplete as an invention, does not constitute an 'invention' under the introductory clause of Article 29(1) of the Patent Act, and cannot be patented. ..."

3. Court Decision Denying Inventive Step (Unlike the First Judgment, the Unpredictable Remarkable Effect Was Denied)

(1) Intellectual Property High Court, 2012 (Gyo-Ke) No. 10419 [Carvedilol (Second Judgment)] <Presiding Judge Shitara>

Judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-83666.pdf

⇒ (Although the holding concerns a remarkable effect for inventive-step purposes,) a case in which the effect stated in the examples in the specification was denied by post-filing documents and other evidence. No inventive step.

“As explained above, the results of the U.S. carvedilol study had low reliability due to the short treatment period and other factors. Accordingly, even though the study was discontinued because an advantageous effect over placebo was confirmed in the U.S. carvedilol study, it cannot be said that the invention at issue has a remarkable effect.”

(Plaintiff) Individual

(Defendant) Yamaha Motor Co., Ltd.

2025 (Ne) No. 10001 “Patent Royalties Relating to a Fulvic Acid Production Method” <Presiding Judge Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10001%e3%80%8e%e3%83%95%e3%83%ab%e3%83%9c%e9%85%b8%e8%a3%bd%e9%80%a0%e6%96%b9%e6%b3%95%e9%96%a2%e9%80%a3%e7%89%b9%e8%a8%b1%e4%bd%bf%e7%94%a8%e6%96%99%e3%80%8f/

2025 (Ne) No. 10001 “Patent Royalties Relating to a Fulvic Acid Production Method” <Presiding Judge Honda>

⇒ The Appellee’s termination was valid.

The purpose of Article 7 of the agreement is merely to serve as a cautionary provision stating that the three related companies recognize that “among the patents and patent applications covered by the exclusive patent-license agreement executed today, there may be defects that could prevent preservation of registration at the registration authority in the future.”

⇒ It is a provision recognizing the risk of a future unforeseen event, namely, that registration “may not be obtained / may be refused”; it is not a provision exempting liability for a breach of obligation such as the fact that, as of execution of the agreement, authority to grant a license for Patent Rights 1 and 3 at issue had not been obtained from the co-owners (that is, the obligation to grant the license was impossible to perform from the outset).

The principal purpose of the agreement at issue was “assignment of an exclusive patent license + sublicense of a non-exclusive license.” It would be unnatural to derive from the abstract wording of Article 7 an exemption clause broad enough to mean that even a failure to perform this principal obligation “does not constitute a breach of obligation.”

⇒ The “exemption” effect that the Appellant attempted to read into Article 7 was denied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94268.pdf

2023 (Gyo-Ke) No. 10147 [RNA-Dependent Targeted DNA Modification] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c%ef%bc%95%e5%b9%b4%e8%a1%8c%e3%82%b110147%e3%80%90%ef%bd%92%ef%bd%8e%ef%bd%81%e4%be%9d%e5%ad%98%e6%80%a7%e6%a8%99%e7%9a%84%ef%bd%84%ef%bd%8e%ef%bd%81%e4%bf%ae%e9%a3%be%e3%80%91/

2023 (Gyo-Ke) No. 10147 [RNA-Dependent Targeted DNA Modification] <Presiding Judge Hibiku Shimizu>

* Based on the descriptions in the first-application documents as a whole and the technical common knowledge at the filing date, the subject matter should be regarded as having been disclosed in substance; the invention at issue was therefore entitled, under Article 4A of the Paris Convention, to the benefit of the priority claim based on the first application.

(Excerpt from the Holding)

That is, it can be said that, as of the priority date at issue, the requirement of a PAM sequence for DNA cleavage using the CRISPR/Cas system of bacteria (prokaryotes) had been described in many documents and was well known to persons skilled in the art. ... No circumstances are found suggesting that, as of the priority date at issue, it was ordinarily considered that, where DNA is cleaved using that mechanism, a PAM sequence is required only in prokaryotic cells and becomes unnecessary in eukaryotic cells. Accordingly, the fact that, as of the priority date at issue, a PAM sequence must also be present downstream of the target DNA sequence when DNA is cleaved in a eukaryotic cell using the CRISPR/Cas9 system should be regarded as a matter that a person skilled in the art could easily have predicted and confirmed. ... Based on the foregoing, it is reasonable to find that, as of the priority date at issue, the existence and role of PAM sequences in the

CRISPR/Cas9 system fell within the scope of the technical common knowledge of persons skilled in the art, and the Plaintiff's allegation cannot be accepted.

The Plaintiff alleges that, as of the priority date at issue, NLS and codon optimization were not well-known art, among other things. ... Accordingly, it is reasonable to find that, as of the priority date at issue, although NLS and codon optimization were not indispensable technologies in the CRISPR/Cas9 system, implementation of each had been reported in many documents, and each was well-known technology applicable also to the CRISPR/Cas9 system.

However, the mere fact that the inventors had not succeeded in their experiments as of the priority date at issue does not make the disclosure of the invention in the first-application documents insufficient. If it is recognized that the invention at issue could be carried out based on the descriptions in the first-application documents without requiring undue experimentation, the disclosure is sufficient. In life-science experiments, finding optimal conditions by changing experimental conditions is considered part of ordinary experimentation. The emails and other materials identified by the Plaintiff merely reflect exchanges of views on hypothetical possibilities or concerns in the course of ordinary experimentation; those materials alone make it difficult to recognize the existence of a barrier that would require undue experimentation by a person skilled in the art. Rather, after the inventors published the CRISPR/Cas9 system relating to the first priority application in a publication (Otsu 12, June 28, 2012), it is found that many researchers reported, during the short period from October 2012 to January 2013, that the CRISPR/Cas9 system had been applied to eukaryotic cells and had enabled genome editing (see 2-4 above). This shows that a person skilled in the art could carry out the invention at issue based on the descriptions in the first-application documents without undue experimentation.

hanrei-pdf-94292.pdf

Tokyo District Court, 2025 (Wa) No. 70003 [Smoking-Article Cartridge] <Presiding Judge Shibuya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%af70003%e3%80%90%e5%96%ab%e7%85%99%e5%85%b7%e7%94%a8%e3%82%ab%e3%83%bc%e3%83%88%e3%83%aa%e3%83%83%e3%82%b8%e3%80%91%ef%bc%9c/

Tokyo District Court, 2025 (Wa) No. 70003 [Smoking-Article Cartridge] <Presiding Judge Shibuya>

* The right to claim damages was waived during the litigation.

⇒ Although customs proceedings concerning an injunction remained, an action seeking a declaration only that the right to claim damages did not exist lacked an interest in immediate determination.

(Excerpt from the Holding)

It is recognized that, on February 27, 2025, after the actions at issue were filed, the Defendant notified the Plaintiffs that it waived the right to claim damages at issue and would not exercise that right; and, at the second oral-argument hearing in these cases held on April 23 of that year, stated that it waived the right to claim damages at issue and would not allege its withdrawal, revocation, or invalidity, whether within or outside the litigation.

Accordingly, the Defendant admits that it has no right to claim damages against the Plaintiffs. There is no present dispute between the parties on that point, nor can it be said that there is uncertainty or danger concerning the Plaintiffs' rights or legal status. An interest in immediate determination is therefore not recognized.

Each action at issue seeks a declaration that the right to claim damages at issue does not exist. Even if a judgment granting that relief became final, the

determination in the reasons concerning whether the patent right at issue was infringed would not become final with res judicata effect; therefore, the Defendant would not be prevented from exercising against the Plaintiffs a right to seek an injunction based on infringement of the patent right at issue or a claim involved in separate litigation. Rather, to dispute the Defendant's right to seek an injunction against the products at issue based on infringement of the patent right at issue, the Plaintiffs may directly bring an action seeking a declaration that the right to seek the injunction does not exist. Thus, obtaining a declaratory judgment that the right to claim damages at issue does not exist cannot be said to be necessary and appropriate to remove danger or uncertainty concerning the Plaintiffs' rights or legal status.

The Plaintiffs also allege that there is a difference in the amount of filing fees between a case in which the Defendant brings an action seeking partial damages and a case in which the Plaintiffs bring an action seeking a declaration that the right to seek an injunction does not exist. Such a circumstance does not directly affect the interest in immediate determination and does not alter the determination above.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94270.pdf

[Trademark / Domain Name] Tokyo District Court, 2023 (Wa) No. 70022, “Legal Force” Case <Presiding Judge Takahashi>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%95%86%e6%a8%99%ef%bc%8f%e3%83%89%e3%83%a1%e3%82%a4%e3%83%b3%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70022%e3%80%8elegal-force%e3%80%8f%e4%ba%8b/

[Trademark / Domain Name] Tokyo District Court, 2023 (Wa) No. 70022, “Legal Force” Case <Presiding Judge Takahashi>

Trademark infringement and other relief were sought with respect to the U.S. corporate Defendant’s provision of services in English under the mark.

⇒ The court denied Japan’s international jurisdiction and dismissed the action on the grounds, among others, that the Defendant’s website was not directed to consumers in Japan.

* Did U.S. attorneys residing in Japan not use it?

— Regarding Japanese customers of the Defendant’s trademark-application services: “It is recognized that the Defendant filed trademark applications for 44 Japanese customers.” The legalforcelaw website stated in English: “LegalForce RAPC represents clients in more than 100 countries worldwide”; “Outside the United States, LegalForce RAPC Trademarkia’s top filing countries are as follows: / (... omitted ...) Japan 97 /”; and “LegalForce RAPC has supported trademark filings in 88 countries worldwide since 2009 / (... omitted ...) Japan.”

“No evidence was found showing that, with respect to ‘AI-based review of contracts and email accounts’ on the Defendant’s website at issue, services were provided to users in Japan.”

⇒ If there had been a person in Japan using the “AI-based review of contracts and email accounts” on the Defendant’s website at issue, would that have changed the conclusion!?

By contrast, with respect to the claim concerning use of a Japanese domain name (.jp), the court recognized jurisdiction because the domain-name administrator was located in Japan.

However, the Defendant had used the name in the United States before the Plaintiff, and automatically directing the domain name to the Defendant’s business website had a legitimate purpose. The court therefore denied both a “purpose of obtaining an illicit gain” and a “purpose of causing damage to another” under the Unfair Competition Prevention Act and dismissed the claim.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93748.pdf

Interlocutory Judgment, 2024 (Ne) No. 10034 [Elasto-Plastic Hysteretic Damper] <Presiding Judge Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%b8%ad%e9%96%93%e5%88%a4%e6%b1%ba%e3%83%bb%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10034%e3%80%90%e5%bc%be%e5%a1%91%e6%80%a7%e5%b1%a5%e6%ad%b4%e5%9e%8b%e3%83%80%e3%83%b3%e3%83%91%e3%80%91%ef%bc%9c/

Interlocutory Judgment, 2024 (Ne) No. 10034 [Elasto-Plastic Hysteretic Damper] <Presiding Judge Honda>

By interlocutory judgment, the court held that, with respect to houses incorporating the Defendant's Σ-shaped Dampers 5 and 6, the cause of the claim for damages based on the tort of infringement of the patent right at issue (excluding the amount) is well founded (first instance: Tokyo District Court, 2021 (Wa) No. 15964).

Limitation G provides that "the shear portion deforms and absorbs energy when it receives a load from an input." The court of first instance construed "input" as limited to a horizontal force in a specific direction, such as the bridge-axis direction, and found the limitation not satisfied; the Intellectual Property High Court rejected that construction.

According to the corrected claims and corrected specification at issue, Corrected Invention 1 at issue has a configuration in which "a pair of plate-shaped shear portions" are "provided with mutually different orientations" ([0007]) and does not limit the direction of an "input" to the "shear portions" in any way. Accordingly, it is reasonable to construe "input" in Limitation G as encompassing any load externally applied to a "shear portion" and as not being limited to a particular direction.

According to the underlying facts, each web portion included in the

Defendant's dampers "deforms and absorbs energy when it receives a load from an input"; therefore, the Defendant's dampers satisfy Limitation G.

Limitation D: "a pair of plates"

In Defendant's Σ-shaped Dampers 1 to 4, one end of each parallel-plate portion and web portion is welded to a vertical plate portion, and the vertical plate portion is bolted to a column constituting a load-bearing panel. By contrast, the other end of each parallel-plate portion and web portion is directly welded to a steel pipe constituting the load-bearing panel (Defendant's Σ-shaped Dampers 1 to 3) or to channel steel (Defendant's Σ-shaped Damper 4). A vertical plate portion and a steel pipe or channel steel cannot be said to be two thin, flat pieces of metal constituting one set. Therefore, Defendant's Σ-shaped Dampers 1 to 4 cannot be recognized as including "a pair of plates."

The web portion and parallel-plate portion constituting Defendant's Σ-shaped Damper 5 are arranged between two connecting plates, and both ends of the web portion and parallel-plate portion are directly welded to the respective connecting plates. The two connecting plates are rectangular metal plates of the same shape and are disposed on the left and right sides so as to sandwich the web portion and parallel-plate portion. They are therefore recognized as constituting "a pair of plates."

In the load-bearing panel in which Defendant's Σ-shaped Damper 6 is used, the web portion and parallel-plate portion constituting Defendant's Σ-shaped Damper 6 are arranged between two stiffeners, and both ends of the web portion and parallel-plate portion are directly welded to the respective stiffeners. The two stiffeners are rectangular metal plates of the same shape and are disposed on the left and right sides so as to sandwich the web portion and parallel-plate portion. They are therefore recognized as constituting "a pair of plates."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94603.pdf

Tokyo District Court, 2024 (Wa) No. 70283 [Reservation Management Device] <Presiding Judge Sugiura>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af70283%e3%80%90%e4%ba%88%e7%b4%84%e7%ae%a1%e7%90%86%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e6%9d%89%e6%b5%a6%ef%bc%9e/

Tokyo District Court, 2024 (Wa) No. 70283 [Reservation Management Device] <Presiding Judge Sugiura>

In the patented invention at issue, the reservation management device (server), in response to operation of a store terminal, transmits received image data to an image printing device (printer/fax).

Flow: server → printer

Defendant's system: the server sends image data to a pharmacy terminal (PC/tablet), and the pharmacy terminal sends the data to a printer for printing. The server does not communicate directly with the printer.

Flow: pharmacy terminal → printer

An expansive construction under which it is sufficient for the reservation management device to send the data "through another device" lacks support in the specification.

(Excerpt from the Holding)

"According to the wording of the claims, there is no description suggesting that the reservation management device may transmit image data to the image printing device through another device. The specification at issue likewise contains no description disclosing or suggesting inclusion of a configuration in which, at a store terminal that has received prescription image data from the reservation management device and displays the image data, the image data are printed by

the image printing device directly from the store terminal through a user's operation of the store terminal, without transmitting a legibility instruction or the like to the reservation management device."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94951.pdf

Osaka District Court, 2024 (Wa) No. 4500 [Shopping Payment System] <Presiding Judge Matsuami>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af4500%e3%80%90%e8%b2%b7%e7%89%a9%e6%b1%ba%e6%b8%88%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e6%9d%be%e9%98%bf/

Osaka District Court, 2024 (Wa) No. 4500 [Shopping Payment System] <Presiding Judge Matsuami>

The “camera” of the patented invention at issue acquires an image (video image) in order to identify a product.

By contrast, the “barcode scanner” in the Defendant’s product acquires barcode information (a code), not an image, and performs a different function.

⇒ Limitation not satisfied.

The patented invention at issue requires linking the camera and a “customer terminal” by means of a specific ID or the like.

However, the Defendant’s product establishes a correspondence between the store terminal (cart) and only a membership number (customer identification information), and does not technically “link” the customer terminal itself.

⇒ Limitation not satisfied.

The patented invention at issue treats as an “abnormality” a case in which a product cannot be identified from a camera image.

By contrast, the Defendant’s product detects an abnormality based on a “change

in the weight sensor” when an item is placed in the basket without scanning, not based on success or failure of image identification.

⇒ Limitation not satisfied.

(Excerpt from the Holding)

According to the description in the specification at issue and the ordinary understanding of a person skilled in the art, the “camera” of the invention at issue is recognized as a device that uses an optical system to form an image of a subject on the surface of an imaging element or the like (see Kojien, seventh edition). With respect to the barcode scanner in the Defendant’s product, there is insufficient evidence to establish that it performs such a function. Further, in general, a barcode scanner acquires “information” embodied in a barcode and does not acquire an “image,” that is, does not perform imaging. The barcode scanner in the Defendant’s product therefore does not constitute the “camera” in Limitation B.

...

The Plaintiff’s allegation concerning the technical significance of “linking” in Limitation D is unclear. Invention 1 at issue includes as elements that the camera transmits imaging information concerning a product to be purchased to the management server (Limitation E), and that the management server notifies the customer terminal of the product-identification result (Limitation F). “Linking” is therefore construed as establishing, as a premise, a correspondence between the camera and the customer terminal. On this point, the Plaintiff does not dispute that, in the Defendant’s product, the processing under Limitation F is performed by the “store terminal” (and is not performed by the customer terminal). Further considering, as stated above, that shopping can be completed normally in the Defendant’s product even without a customer terminal (that the customer terminal is not an indispensable configuration for realizing the technical concept of the Defendant’s product), it is recognized that the store terminal establishes a

correspondence only with customer identification information (the membership number). Beyond that, the “customer terminal” and the barcode scanner of the store terminal are not recognized as being “linked” in the sense described above.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94493.pdf

2024 (Ne) No. 10068 [Leak-Preventing Sealing Material] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10068%e3%80%90%e3%82%82%e3%82%8c%e9%98%b2%e6%ad%a2%e7%94%a8%e3%82%b7%e3%83%bc%e3%83%ab%e6%9d%90%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

2024 (Ne) No. 10068 [Leak-Preventing Sealing Material] <Presiding Judge Hibiku Shimizu>

<The same issues and the same conclusion as in the first-instance judgments, Osaka District Court, 2022 (Wa) Nos. 9112 and 11173 <Presiding Judge Matsuami>.>

“The diameter of the warp or weft of the ground yarn is made smaller than the diameter of the pile yarn” (Limitation 1C)

⇒ “Diameter” is measured in the original-yarn state, not in the product state.

⇒ Limitation not satisfied.

“In the state of use, the direction of the arrangement is inclined relative to the rotational direction of the rotating body such that the direction of the arrangement forms, relative to the rotational direction, an angle ϕ greater than the predetermined angle θ” (Limitation 1E)

The Defendants were not involved in how the Defendant’s product was installed in toner cartridges manufactured by Canon or its affiliates; the installation position and method were determined by Canon. There was insufficient evidence to establish that Canon installed the Defendant’s product at angle θ < angle ϕ, and there was no proof that installation by a different method or use was not economic, commercial, or practical.

Accordingly, there was insufficient proof that the Defendant's product was an article used exclusively for the production of an article infringing the patent at issue (Article 101(i) of the Patent Act), and the Plaintiff's allegation of indirect infringement could not be accepted.

(Excerpt from the Holding)

The specification at issue includes descriptions concerning the "diameter" of yarn in the original-yarn state and the relative magnitudes thereof, such as: "Figures 4 and 5 each schematically show an example in which yarn having a larger diameter than ground warp yarn 21 and ground weft yarn 22 is used as pile yarn 4 ..." (paragraphs [0043], [0033], [0050], and [0052]). As discussed below, it is reasonable to construe "diameter" as synonymous with "thickness" indicated by methods generally used to refer to the "thickness" of fibers. Because the "diameter" of each yarn in the original-yarn state is uniform, the meaning of the "diameter" of each yarn can be understood unequivocally, and on that basis the relative "magnitudes" of the "diameters" of the respective yarns can also be compared. Accordingly, it is reasonable to construe "diameter" and the relative "magnitudes" thereof in Limitation 1C of Corrected Invention 1 at issue as meaning the "diameter" and relative "magnitudes" of yarn in the original-yarn state. D. According to the technical common knowledge in paragraph (3) above, with respect to "thickness," an important property of fibers, methods indicating fiber thickness by weight per unit length, such as denier, are generally used. Where fibers are made of different materials and have different specific gravities (densities), their thicknesses cannot immediately be compared using denier values, but it is recognized as technical common knowledge that cross-sectional areas can readily be calculated and compared from the fibers' specific gravities and denier values.

Accordingly, "diameter" of the ground-yarn warp and weft and pile yarn in Limitation 1C of Corrected Invention 1 at issue means the "thickness" of each yarn

in the original-yarn state as indicated by a generally used method. It is reasonable, in light of the technical common knowledge of a person skilled in the art at the filing date, to construe the relative “magnitudes” as meaning that the cross-sectional areas of the fibers of the yarns in the original-yarn state are calculated on the premise of that method and the relative magnitudes of the “diameters” are determined. (According to the foregoing, Limitation 1C also cannot be said to be unclear.)

As stated in the original judgment, the Defendants were not involved in how the Defendant’s product was installed in toner cartridges manufactured by Canon or its affiliates; the installation position and method were determined by Canon. There was insufficient evidence to establish that Canon installed the Defendant’s product at angle θ < angle ϕ, and there was no proof that installation by a different method or use was not economic, commercial, or practical. Accordingly, there was insufficient proof that the Defendant’s product was an article used exclusively for the production of an article infringing the patent at issue (Article 101(1)(i) of the Patent Act), and the Plaintiff’s allegation of indirect infringement could not be accepted.

Quotation note: “Article 101(1)(i)” in the preceding translated excerpt reproduces the judgment’s own citation. The correct statutory reference is Article 101(i) of the Patent Act.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94232.pdf

2025 (Ne) No. 10005 [Jig for a Lifeline Post] <Presiding Judge Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10005%e3%80%90%e8%a6%aa%e7%b6%b1%e6%94%af%e6%9f%b1%e7%94%a8%e6%b2%bb%e5%85%b7%e3%80%91%ef%bc%9c%e5%a2%97%e7%94%b0%ef%bc%9e/

2025 (Ne) No. 10005 [Jig for a Lifeline Post] <Presiding Judge Masuda>

Because the hook formed on the side plate of the Defendant's product was not formed by bending the bottom plate into a U shape, the Defendant's product did not include the "bent portions bent into a U shape at vertically spaced intervals at an end of the rectangular plate in the first direction" in Limitation C.

⇒ No literal infringement.

Difference in the essential part

⇒ No infringement under the doctrine of equivalents.

⇒ The court affirmed the original judgment, which found notification and dissemination of false facts.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94223.pdf

Tokyo District Court, 2024 (Wa) No. 70128 [Box-Shaped Vessel] <Presiding Judge Nakashima>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af70128%e3%80%90%e7%ae%b1%e5%9e%8b%e8%88%b9%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e/

Tokyo District Court, 2024 (Wa) No. 70128 [Box-Shaped Vessel] <Presiding Judge Nakashima>

* Replacement of a pH sensor having a one-year service life did not constitute manufacture of a new product.

⇒ No infringement by that maintenance activity.

The judgment as a whole found patent infringement with respect to other conduct and awarded JPY 932,500 in damages. The statement of “no infringement” here concerns the replacement activity described above.

(Excerpt from the Holding)

No particular service life was specified for the box-shaped vessel itself in the Defendant’s product. Among the components subject to the maintenance at issue, only the pH sensor had a specified service life of one year and was therefore replaced with a new one during the annual maintenance. ...

Because the maintenance at issue replaced only the pH sensor, whose service life was one year, out of the entire box-shaped vessel, it may be said merely to replace, in accordance with ordinary use, the pH sensor, which is a consumable component of the box-shaped vessel. Moreover, as to the technical function of the pH sensor, Otsu 4 discloses a box-shaped vessel including a stock-solution supply device that automatically adjusts the supply amount of an acid stock solution based on a value detected by a pH sensor. The pH sensor therefore cannot be said to be a configuration relating to the essential part of the invention at issue. In addition, the economic value of the pH sensor is ... extremely small compared with the value

of the entire box-shaped vessel falling within the technical scope of the invention at issue. Under these circumstances, the maintenance at issue cannot be said to restore satisfaction of a configuration relating to the essential part of the invention after the product came to lack that configuration. Accordingly, the maintenance at issue cannot be regarded as newly manufacturing a box-shaped vessel lacking identity with the Defendant's box-shaped vessel, and cannot be construed as constituting "production" under Article 2(3)(i) of the Patent Act.

In response, the Plaintiff alleges that the maintenance at issue changes a product outside the technical scope of the invention at issue (one lacking a pH sensor and therefore lacking Limitation F) into a product within the technical scope, and therefore constitutes "production" under the same item.

However, as explained above, whether an act constitutes "production" should be assessed by considering the circumstances stated above from the perspective of whether the act may be said to restore satisfaction of a configuration relating to the essential part of the invention after the product came to lack that configuration. It is therefore inappropriate to isolate and assess only the act of newly installing a pH sensor after it was absent; the same reasoning applies to the tube alleged by the Plaintiff.

From the foregoing perspective, replacement of the pH sensor alleged by the Plaintiff and replacement of a tube due to deterioration or damage are acts that should be regarded as repair or maintenance itself, and cannot be said to newly manufacture a box-shaped vessel lacking identity. The maintenance at issue therefore cannot be construed as constituting "production" of the invention at issue.

In the first place, the box-shaped vessel alleged by the Plaintiff should be regarded as having already been manufactured before registration of the patent at issue. Even if the Plaintiff did not obtain a benefit relating to that box-shaped vessel,

because it predates registration of the patent at issue, the result is not unreasonable as alleged by the Plaintiff.

https://patent-law.hatenablog.com/entry/2025/07/19/230000

2025 (Ne) No. 10004 [Wireless Scuff Plate] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10004%e3%80%90%e3%83%af%e3%82%a4%e3%83%a4%e3%83%ac%e3%82%b9%e3%82%b9%e3%82%ab%e3%83%83%e3%83%95%e3%83%97%e3%83%ac%e3%83%bc%e3%83%88%e3%80%91%ef%bc%9c%e4%b8%ad/

2025 (Ne) No. 10004 [Wireless Scuff Plate] <Presiding Judge Nakadaira>

= First instance: Tokyo District Court, 2023 (Wa) No. 70346 <Presiding Judge Nakashima>

* “Adjustable” means capable of being actively varied.

⇒ Limitation not satisfied.

The “control module that, in accordance with the sensing signal, opens and closes the backlight module with the time interval between its on and off states being adjustable” in Limitation F is construed as meaning a control module that can turn the backlight module on and off in accordance with the sensing signal and can also vary the interval after it is turned on in accordance with the sensing signal until it is turned off after a certain time even without another sensing signal, namely, the duration of illumination.

⇒ None of the Appellee’s products was recognized as including a control module that variably adjusts and controls the illumination duration independently of the timing at which magnetism relating to opening or closing is sensed.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94237.pdf

Tokyo District Court, 2024 (Wa) No. 70463 [Connecting Fixture for Faucet Elbows] <Presiding Judge Sugiura>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af70463%e3%80%90%e6%b0%b4%e6%a0%93%e3%82%a8%e3%83%ab%e3%83%9c%e9%80%a3%e7%b5%90%e5%9b%ba%e5%ae%9a%e5%85%b7%e3%80%91%ef%bc%9c/

Tokyo District Court, 2024 (Wa) No. 70463 [Connecting Fixture for Faucet Elbows] <Presiding Judge Sugiura>

The patent application at issue received a decision of refusal, and no specific circumstances suggest that any right was thereafter established for the invention of the application at issue.

Nor can the invention of the application at issue be regarded as included in the subject matter of the agreement at issue.

Further, no specific circumstances suggest any involvement by the Defendant in the patent application at issue or in practicing the invention of the application at issue. Therefore, no tort by the Defendant against the Plaintiff can be found in connection with the application process or practice of the invention. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94920.pdf

[Design] Osaka District Court, 2023 (Wa) No. 2668, “Vegetated Earth-Retaining Sandbag” Case <Presiding Judge Matsuami>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e6%84%8f%e5%8c%a0%e3%80%91%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af2668%e3%80%8e%e5%9c%9f%e7%95%99%e3%82%81%e6%a4%8d%e7%94%9f%e5%9c%9f%e5%9a%a2%e3%80%8f/

[Design] Osaka District Court, 2023 (Wa) No. 2668, “Vegetated Earth-Retaining Sandbag” Case <Presiding Judge Matsuami>

The shape of the “grass” in Registered Design 1 at issue should be identified, even though grass is a natural object, to the extent that it has regularity and reproducibility as a design.

⇒ The appearance of the Defendant’s sandbag, particularly the manner in which the grass grew, differed substantially from Registered Design 1 at issue and was therefore dissimilar.

* With respect to patent infringement (infringement under the doctrine of equivalents) as well, the configuration in which the vegetation sheet is detachably fixed to the bag body “only at the opening-edge portion” is a characteristic part constituting a distinctive technical concept for producing the operation and effect of preventing deformation of the vegetation sheet and the like, and constitutes an essential part of the invention.

⇒ No infringement under the doctrine of equivalents.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93781.pdf

Tokyo District Court, 2024 (Wa) No. 70223 [Game System and Game Program] <Presiding Judge Nakashima>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af70223%e3%80%90%e3%82%b2%e3%83%bc%e3%83%a0%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e5%8f%8a%e3%81%b3%e3%82%b2%e3%83%bc%e3%83%a0/

Tokyo District Court, 2024 (Wa) No. 70223 [Game System and Game Program] <Presiding Judge Nakashima>

<Non-Satisfaction ((i) Game System)>

Patent 1 at issue requires a configuration that separately stores the quantities of purchased items (first items) and items acquired in the game (second items), and preferentially consumes the first items.

However, in the Defendant's system (LINE: Disney Tsum Tsum), free portions received at purchase and portions acquired in the game are not distinguished but are managed in the aggregate, and the quantity of the second items alone is not stored.

Further, because the two are not distinguished, the system does not have a function of preferentially consuming the first items. It therefore does not satisfy Limitations 1B and 1C.

<Non-Satisfaction ((ii) Game Program)>

Patent 2 at issue is an invention that changes data according to the "cumulative number acquired" of the same item.

However, the relevant value in the Defendant's program (the value relating to an increase in skill level) includes not only the number of items themselves acquired

but also another element, namely, the “number of skill tickets used.” This differs from the pure “cumulative number acquired” specified by the patent.

Supplement: In addition to rejecting literal satisfaction of the limitations, the court found Invention 2 at issue to lack inventive step based on the Otsu 6 and Otsu 39 inventions. This invalidity determination should not be extended to Invention 1 at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94988.pdf

Osaka District Court, 2023 (Wa) No. 7855 [Method for Mapping a Physical Hybrid Automatic Repeat Request Indicator Channel] <Presiding Judge Matsuami>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af7855%e3%80%90%e7%89%a9%e7%90%86%e3%83%8f%e3%82%a4%e3%83%96%e3%83%aa%e3%83%83%e3%83%89%e8%87%aa%e5%8b%95%e5%86%8d%e9%80%81/

Osaka District Court, 2023 (Wa) No. 7855 [Method for Mapping a Physical Hybrid Automatic Repeat Request Indicator Channel] <Presiding Judge Matsuami>

* Standard-essential patent (SEP) — abuse of rights

⇒ Claim for injunction dismissed.

1. Defendant’s Negotiating Conduct

The Plaintiff proposed license negotiations on June 12, 2020, and Company G (Google) expressed its willingness on July 7 of that year to take a license on FRAND terms.

The NDA negotiations took a total of five months, and review of 22 claim charts took approximately eight months. However, an NDA accompanies disclosure of trade secrets, and the time required was unavoidable as a period for reviewing numerous patents.

Company G presented a counterproposal (Company G’s First Proposal) and subsequent revised proposals in response to the Plaintiff’s proposal. As of the end of November 2023, no lack of good faith in the negotiations was recognized.

2. Proposals of the Plaintiff and Company G

With respect to the Plaintiff's First Proposal (0.75%), Company G questioned, among other matters, the age of the underlying information, but the Plaintiff did not respond sufficiently. The premise that aggregate royalties should be capped at 27% formed part of the calculation underlying the Plaintiff's First Proposal, not Company G's counterproposal. As to Company G's counterproposal, the court did not regard its calculation method as one that should automatically be excluded from consideration of FRAND terms. It also considered that Company G could not simply be criticized for giving weight to the fact that smartphone prices depend heavily on performance other than communications. The judgment did not, however, determine that 27%, or the royalty rate in Company G's counterproposal, was the proper FRAND rate.

Calculation note: The Plaintiff's First Proposal, using aggregate royalties and its share of SEPs, can be characterized as following a top-down approach. The published judgment redacts parts of the specific calculation underlying Company G's proposals. Those proposals should therefore not be characterized as a top-down calculation using a 27% cap.

⇒ The court found that, even at the relevant time, the end of November 2023, Company G continued sincerely to negotiate toward concluding a license agreement and held that its conduct could not be characterized as bad-faith holdout.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94591.pdf

2025 (Ne) No. 10035 [Vehicle Guidance System] <Presiding Judge Honda> (PXZ v. East Nippon Expressway Company Limited)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10035%e3%80%90%e8%bb%8a%e4%b8%a1%e8%aa%98%e5%b0%8e%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%ef%bc%9e-%ef%bc%88pxz-v-%e6%9d%b1/

2025 (Ne) No. 10035 [Vehicle Guidance System] <Presiding Judge Honda>

(PXZ v. East Nippon Expressway Company Limited)

* On the same substantive reasoning by which 2024 (Gyo-Ke) No. 10086 found a violation of the divisional requirements in the grandparent application, this judgment found the limitation not satisfied.

“It cannot be construed that the ‘entrance/exit for ordinary vehicles’ in Limitation 2E includes an entrance/exit for ordinary vehicles of another interchange adjacent to the toll-road tollgate, service area, or parking area at which the vehicle guidance system according to Invention 2 at issue is installed.”

⇒ Limitation not satisfied.

“Guidance” means inviting and leading toward a destination. Where no signs or the like instructing a U-turn exist, a U-turn voluntarily made by the driver cannot be characterized as guidance by the function of the facility.

⇒ “It cannot be said that the Plaintiff’s facilities invite and lead vehicles for which ETC toll collection is impossible onto the route returning them again to a point before the ETC-only entrance/exit.”

⇒ Limitation not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94616.pdf

2025 (Ne) No. 10025 [Spindle Motor] <Presiding Judge Nakadaira> ⇒ Claim for Employee-Invention Remuneration

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10025%e3%80%90%e3%82%b9%e3%83%94%e3%83%b3%e3%83%89%e3%83%ab%e3%83%a2%e3%83%bc%e3%82%bf%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e-%e2%87%92%e8%81%b7%e5%8b%99/

2025 (Ne) No. 10025 [Spindle Motor] <Presiding Judge Nakadaira>

⇒ Claim for employee-invention remuneration dismissed

(Status as a joint inventor denied)

The core of the Japanese invention at issue lay in forming a particular "communication hole," but the written explanation submitted by the Appellant did not mention that specific configuration and explained a completely different problem and solution. The Appellant's idea therefore did not show the characteristics of the Japanese invention at issue.

(The "Invention/Utility Model Explanation" submitted by the Appellant to the employer merely described a different problem and solution and did not address the specific configuration of the communication hole.)

The U.S. and Chinese patented inventions were based on "Invention A," which provides a through-hole in a sleeve. Because this configuration clearly differs from the Appellant's idea of providing a groove between the sleeve and the housing, they were different from the Appellant's invention.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94960.pdf

Osaka District Court, 2024 (Wa) No. 7193 [Article Conveying Facility] <Presiding Judge Matsuami> ⇒ Claim for Employee-Invention Remuneration Dismissed

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Osaka District Court, 2024 (Wa) No. 7193 [Article Conveying Facility] <Presiding Judge Matsuami>

⇒ Claim for employee-invention remuneration dismissed.

(i) Process for Establishing and Operating the Rules

Following the 2016 amendment to the Patent Act and publication of the Guidelines, the Defendant consulted with the labor union and explained the reward system and calculation method. When revising the rules, it also solicited opinions from all employees and responded to the Plaintiff's opinion, following a careful and sincere process. These measures were reasonable.

(ii) Dissemination of the Rules

The rules were available for viewing at all times on the internal system and were also explained during new-employee training. The Plaintiff received rewards while employed and was in a position to understand the system.

(iii) Content of the Rules

Under the system, the business division and intellectual-property division evaluated performance rewards based on objective indicators and determined grades, and inventors were given an opportunity to state their views. The rules

were therefore not unreasonable.

(Excerpt from the Holding) “It is questionable whether the reasonableness of the amount of compensation, which in itself might be regarded as entrusted to private autonomy, is naturally included in the viewpoints for determining unreasonableness under Article 35(5) of the Patent Act. Even if it could be one factor for consideration, the matter might be different where, for example, rules provide only small lump-sum filing and registration rewards and do not distribute any of the profits subsequently obtained by the company through practice of the patent right. The Detailed Rules at issue, however, evaluate the economic value of practiced patent rights and the like from various perspectives, including contribution to profits and exclusion of competitors, and pay commensurate performance rewards in stages. No basis for finding them unreasonable can be identified.”

In conclusion, because the rules at issue were not unreasonable, the statutory claim for reasonable benefits under Article 35(7) of the Patent Act, premised on non-application of the rules, was without merit.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95035.pdf

Appendix: English Translations of Text Embedded in Figures

This appendix provides English translations of the Japanese text in Figures 1–7.

Embedded Figure 1 — Example in Which Inventive Step Is Denied Even When an Essential Configuration Is Excluded

• Even where an amendment has been made to exclude a configuration described as essential in the cited invention, a person skilled in the art may ordinarily carry out design changes to some configuration other than that configuration for the purpose of further improving the invention. Such work may constitute the ordinary exercise of creative ability by a person skilled in the art.

• Further, even if the configuration is described as essential in the cited invention, unless an impediment is recognized that is strong enough to prevent replacement with any of various other configurations, there may be cases in which excluding that configuration in the claimed invention cannot be said to produce an advantageous effect.

• In such cases, under the current approach of the Examination Guidelines, inventive step is still denied.

Diagram labels:
- Invention obtainable by trial and error based on the cited invention
- Scope of the amended claimed invention
- Overlap with the cited invention
- Specific improved invention
- Some invention (including a regressive invention)
- Trial and error carried out by a person skilled in the art who reviewed the cited invention, for the purpose of an improved invention

Embedded Figure 2 — Description in the Examination Guidelines Concerning Determination of New Matter (3)

3.3.1 Amendment of the Scope of Claims

(1) Where an amendment generalizes, deletes, or changes a matter specifying the invention

(2) Where an amendment narrows a matter specifying the invention to a subordinate concept or adds such a matter

b. Even where an amendment narrowing a matter specifying the invention in a claim to a subordinate concept does not narrow it to a matter expressly stated in the original specification, etc. or to a matter self-evident from the descriptions in the original specification, etc., the amendment does not introduce new technical matter if it is clear that the amendment adds no new technical significance. Such an amendment is therefore permitted.

(3) Where an amendment adds or changes a numerical limitation

(4) Where an amendment uses an “excluding claim”

An “excluding claim” means a claim that expressly excludes, from the matters stated in the claim, only part of the matters included in the invention under the claim while retaining the wording of the matters stated in the claim.

An amendment that retains the wording of the matters stated in the claim before amendment and converts the claim into an “excluding claim” by excluding matters stated in the original specification, etc. is permitted if the “excluding claim” after the exclusion does not introduce new technical matter.

The following amendments using an “excluding claim” do not introduce a new technical matter and are therefore permitted:

(i) Where the claimed invention overlaps the cited invention and novelty, etc. (Article 29(1)(iii), Article 29-2, or Article 39) might therefore be denied, an amendment excluding only that overlap.

(ii) Where a claimed invention includes a “human” and therefore fails to satisfy the requirement in the introductory clause of Article 29(1), or falls under an unpatentable invention prescribed in Article 32, an amendment excluding only the “human.”

(5) Where an amendment concerns a Markush-type or other alternative-form claim

Embedded Figure 3 — Relationship Between Types of Amendments Using an "Excluding Claim" and the Examination Guidelines

A) Where the technical matter of not including a specific matter is expressly described in the original specification, etc.
→ The amendment does not introduce a new technical matter and is permitted. (Examination Guidelines 3.1)

B) Where the technical matter of not including a specific matter is self-evident from the descriptions in the original specification, etc.
→ The amendment does not introduce a new technical matter and is permitted. (Examination Guidelines 3.2)

C) Where inclusion of a specific matter causes failure to satisfy the requirement in the introductory clause of Article 29(1), or causes the invention to fall under an unpatentable invention under Article 32
→ For example, where the claimed invention includes a "human" and therefore fails to satisfy the requirement in the introductory clause of Article 29(1) or falls under Article 32, an amendment excluding "human" from the claimed invention makes the invention no longer fall under the above ground for refusal. It is clear that such an amendment does not introduce a new technical matter and is therefore permitted. (Examination Guidelines 3.3.1(4)(ii))

D) Where none of Types A to C applies
→ The amendment is permitted if it does not introduce a new technical matter.

One example is an "amendment excluding only the overlap where the claimed invention overlaps the cited invention and novelty, etc. might therefore be denied" (Examination Guidelines 3.3.1(4)(i)); the Guidelines state that this is permitted because it does not introduce a new technical matter.

Other examples include amendments that narrow a matter to a subordinate concept where it is clear that no new technical significance is added (Examination Guidelines 3.3.1(2)b); such amendments are stated to be permitted.

Embedded Figure 4 — Regarding the Description in Section 3.3.1(4)(i) of the Examination Guidelines (1)

• The example given in Section 3.3.1(4)(i) of the Examination Guidelines is a case in which the cited invention and the claimed invention have inherently and markedly different inventive concepts, but an overlap happens to cause a novelty rejection; excluding the overlap resolves the novelty rejection while leaving an invention having inventive step.

(i) Where the claimed invention overlaps the cited invention and novelty, etc. (Article 29(1)(iii), Article 29-2, or Article 39) might therefore be denied, an amendment excluding only that overlap

(Explanation)

The “excluding claim” in (i) above is a claim expressly excluding only matters that form part of a cited invention under Article 29(1)(iii), Article 29-2, or Article 39, as stated in a publication or in the specification, etc. of an earlier application (including matters equivalent to those described). The amendment converting the claim into the “excluding claim” in (i) above excludes specific matter forming the content of the cited invention and therefore cannot be said to make any change to the technical matter derived from the specification, etc. before amendment. Accordingly, it is clear that such an amendment does not introduce new technical matter and is therefore permitted.

An invention that can be patented by use of an “excluding claim” is an invention that, as a technical concept, is markedly different from the cited invention and inherently has inventive step, but happens to overlap the cited invention. Where an invention is not markedly different from the cited invention as a technical concept, it is considered that a rejection based on lack of inventive step will almost never be resolved by converting the claim into an “excluding claim.”

Embedded Figure 5 — Regarding the Description in Section 3.3.1(4)(i) of the Examination Guidelines (2)

• When Section 3.3.1(4)(i) of the Examination Guidelines was revised in 2010, the Japan Patent Office published the following response to comments submitted in the public-comment procedure.

Q15. Are amendments falling under Type (i) or Type (ii) judged to fall within those types without separately examining the specific amendment content or the content of the invention?

A15. No. However, where the prior art and the technical concept are identical or similar, so that merely converting the claim into an “excluding claim” does not make the invention inventive, and the applicant argues in a written opinion or the like that the “excluding claim” has inventive step, for example because it produces a remarkable effect, a notice of reasons for refusal may be issued on the ground that the amendment falls under neither Type (i) nor Type (ii) and introduces new technical matter. Further, where the prior art and the technical concept are identical or similar, if a reason for refusal under Article 29(2) is notified in addition to Article 29(1)(iii) or Article 29-2, the application may be finally rejected under Article 29(2) even after conversion to an “excluding claim.”

As stated in the explanation of Type (i), an invention for which a patent can be obtained by converting the claim into an “excluding claim” is an invention that is markedly different from the prior art in technical concept and inherently has inventive step, but merely happens to overlap the prior art.

• Accordingly, the mere fact that an amendment excludes overlap with the cited invention does not immediately mean that it falls under Type (i) and is permitted.

Embedded Figure 6 — Divisional Applications, Amendments, and Retroactive Effect
General rule quoted from Intellectual Property High Court, 2016 (Gyo-Ke) No. 10263:
“The substantive requirements for a divisional application to be lawful are that (i) the specification or drawings of the original application contained two or more inventions, (ii) the invention of the new application is part of an invention described in the specification or drawings of the original application, and (iii) the invention of the new application falls within the scope of matters described in the original specification, etc. of the original application. Because the application at issue is a fifth-generation divisional application counted from the first application, in order for the application at issue to be deemed filed at the time of the first application, the application at issue, the fourth application, the third application,

and the second application must each satisfy requirements (i) to (iii) above in relation to the application from which it was divided, and the invention at issue must fall within the scope of matters described in the specification, etc. of the first application as filed.”

Important note:
Even if a child application is lawful when filed, if the child application is amended after filing, the retroactive effect of the amendment may cause the child application to violate the divisional requirements.

Key authorities and labels:
1. Osaka High Court, 2002 (Ne) No. 2776 <Presiding Judge Wakabayashi>
2. Tokyo High Court, 2003 (Gyo-Ke) No. 65 <Presiding Judge Shinohara>
→ The filing date of the grandchild application relates back only to the filing date of the child application.
Note: If the post-amendment content constitutes the addition of new matter, the divisional requirements are violated.
3. 2004 (Wa) No. 14649 <Presiding Judge Shitara>
4. Tokyo High Court, 1975 (Gyo-Ke) No. 75
→ If an amendment cures a violation of the divisional requirements (a change of gist), the violation of the divisional requirements is avoided.
8. Tokyo District Court, 2003 (Wa) No. 9215 <Presiding Judge Mimura>
→ Divisional requirements = amendment requirements.

Timeline: Parent filing date → Child filing date → Amendment of the child → Grandchild filing date
“The amendment has retroactive effect.”

“Because all claims were deleted by correction, the utility model registration at issue is deemed never to have existed from the beginning.” 2001 (Gyo-Ke) No. 421 <Presiding Judge Yamashita>

Even if the child application is withdrawn, the filing date of the grandchild application relates back to the filing date of the parent application. 2015 (Wa) No. 8517 [Ridge Plastering Machine] <Presiding Judge Shimasue>. In that case, there

had been no violation of the divisional requirements before withdrawal. (Except under Article 39(5) of the Patent Act, withdrawal of an application has no retroactive effect. 1989 Trial Decision No. 123.)

If a divisional application is finally refused or invalidated while still containing added new matter, the filing date of the grandchild application does not relate back to the filing date of the parent application. Therefore, even if the case is likely to end in refusal, an amendment curing the addition of new matter should be attempted.

Embedded Figure 7 — 2019 (Wa) No. 23164 [Image Forming Apparatus] <Presiding Judge Tanaka>

Cf. 2020 (Gyo-Ke) No. 10131 <Presiding Judge Otaka>.

• If a child application violates the divisional requirements, the filing date of a grandchild application relates back only to the actual filing date of the child application. It does not relate back to the filing date of the parent application. This is the same holding as Osaka High Court, 2002 (Ne) No. 2776, and Tokyo High Court, 2003 (Gyo-Ke) No. 65.

• Has adding descriptions to the specification constituted the addition of new matter since the [Artificial Nipple] case (2002 (Gyo-Ke) No. 539)!?

When the specification, etc. of Application 1 at issue at the time Application 2 at issue was divided is compared with the specification, etc. of Application 2 (the specification of Application 2 at the time of division), the latter differs in that it adds descriptions concerning maintaining machining conditions after the power is turned off and displaying them on the first screen shown on the next and subsequent occasions (paragraph [0100]); reducing the number of magnification settings and menu settings by means of “one above” and “one below” displays (paragraph [0105]); preventing erroneous instructions by locking a registered menu against change (paragraph [0145]); and adding Figures 7 to 15 and related descriptions (paragraph [0041], etc.). Because the specification of Application 2 at the time of division contains matters absent from the specification of Application 1 at the time of the decision to grant a patent, it does not fall within the scope of matters described in the latter specification. Application 2 therefore fails to satisfy

divisional requirement (ii). → Lack of inventive step over a cited invention published after the parent filing date and before the child filing date.

• In a priority claim, “partial priority” may be available; however, adding descriptions to the specification when filing a divisional application has no benefit and only causes harm. If the matter is disclosed in the original specification, etc., no additional description is needed; if it is not disclosed there, the additional description constitutes the addition of new matter.

Legal Update (Items Posted in February 2026)

Scope: Articles published in February 2026 by attorneys of Nakamura & Partners: Hideki Takaishi (32 articles), Reiko Tonomura (1 article), and Kei Iida (1 article)

Number of Articles Included: 34

Index Page: https://www.nakapat.gr.jp/ja/legal_updates_jp/ **(Legal Update; 2 articles);** https://www.nakapat.gr.jp/ja/note/2026/02/ **(Attorney Takaishi's IP News; 32 articles)**

<Highlights of the Month> Key Points in the February 2026 Intellectual Property and Legal Affairs Update

This month's legal update addresses 34 judicial decisions and commentaries across a broad range of intellectual property practice, from claim construction, inventive step, inventorship and employee inventions, pharmaceutical patents and standard-essential patents, to expert-appraisal evidence, statutory procedures, and exceptions under copyright law. The particularly noteworthy decisions and practical points are as follows.

1. Scope of Rights Determined by Claim Language and the Specification

The Tokyo District Court Judgment, 2023 (Wa) No. 70380 [Rod-Shaped Light] <Presiding Judge Takahashi>, found that the accused products, including those using different inputs for storing and emitting a recommended color, did not satisfy the claim elements, and also found a violation of the support requirement because there was no description or suggestion of solving the problem by using the same input method. 2024 (Ne) No. 10074 [Filler for Electronic Cigarette] <Presiding Judge Masuda> construed "cut" as a slit formed artificially and actively with a blade and found that the linear portions formed by crimping did not satisfy the claim element. By contrast, the Tokyo District Court Judgment, 2023 (Wa) No. 70594 [Mattress], did not limit "pressure-bonded" to strong compression, construed it as a state in which pressure is applied to the extent that no gap is formed, and found the claim element satisfied. 2024 (Ne) No. 10080 [Under-Coping Ventilation Structure] <Presiding Judge Nakadaira> held that the ventilation member "itself" must have ventilation and waterproofing performance. It is necessary to take into account the problem, means for solving the problem, effects, and means of formation described in the specification.

2. Common General Technical Knowledge, Predictability, Motivation, and Disincentives that Determine Inventive Step

2024 (Gyo-Ke) No. 10037 [Wood Composite Material] <Presiding Judge Hibiku Shimizu> approved separate consideration because no particular synergistic effect was shown for density, dimensions, and random orientation, and treated them as optimization and selection based on well-known art and the like. 2024 (Ne) No. 10032 [Portable Information Communication Device] <Presiding Judge Hibiku Shimizu> and 2024 (Ne) No. 10001 [Yarn Color Placement System] <Presiding Judge Hibiku

Shimizu> likewise emphasized common general technical knowledge regarding image processing and the fact that the adjustments were substantially included in the cited invention or could readily have been conceived by applying common general technical knowledge. By contrast, 2024 (Gyo-Ke) No. 10022 [... Antimicrobial Agent] <Presiding Judge Honda> affirmed inventive step because there was no reasonable expectation that the active ingredient would permeate the nail plate and exert a therapeutic effect. 2024 (Gyo-Ke) No. 10043 [Elasto-Plastic Hysteretic Damper] <Presiding Judge Honda> held that there was no motivation to apply a two-dimensional arrangement to the cited invention premised on unidirectional input and that there was a disincentive, while the Intellectual Property High Court Judgment, 2024 (Ne) No. 10048 [Battery] <Presiding Judge Nakadaira>, emphasized the close relationship between the position of a member in the prior art and its effect. Common general technical knowledge, predictability, motivation, and disincentives should be argued separately.

3. Inventorship and Employee Inventions Are Determined by Involvement in the Characteristic Portion and Application of the Rules

2023 (Gyo-Ke) No. 10078 [Audio Controller] <Presiding Judge Hibiku Shimizu> denied joint inventorship on the ground that persons on the commissioning side had obtained a conception accompanied by a specific means of solution and had completed the invention through the experimental device, while the contractors had merely solved a different problem. 2024 (Ne) No. 10029 "Claim for Confirmation of the Right to Obtain a Patent" <Presiding Judge Masuda> found the professor who had recorded the problem and solution of the vascular plug in a research notebook to be the inventor, and [Employee Invention] Tokyo District Court Judgment, 2023 (Wa) No. 70495 <Presiding Judge Nakashima>, likewise denied the plaintiff's inventorship after finding that other employees had independently conceived and embodied the invention at issue without the plaintiff's involvement and that the asserted time of completion was also unsubstantiated. The Osaka District Court Judgment, 2023 (Wa) No. 10217 [Three-Dimensional Network Fiber Assembly] <Presiding Judge Matsuami>, dismissed the claims in light of the procedure for establishing the reward rules and the product's commercial track record, whereas the Osaka District Court Judgment, 2022 (Wa) No. 11405 [Heterocyclic Derivative] <Presiding Judge Takemiya>, awarded statutory reasonable remuneration of approximately JPY 94 million because there was no provision or agreement applying the rules. Involvement in the characteristic portion should be documented, and the scope and procedures of the rules should be clarified.

4. Scope of Rights and Remedies for Pharmaceutical Patents and Standard-Essential Patents

2023 (Ne) No. 10107 "PCSK9 (Second Litigation)" <Presiding Judge Nakadaira> held that, although "competes" includes competition through steric hindrance, it could not be said that an antibody competing with a reference antibody neutralizes by the same mechanism as the reference antibody, and the specification contained no disclosure at all of the neutralizing activity of antibodies competing through steric

hindrance, and found a violation of the support requirement. As to the patentee's rebuttal based on correction, it rejected that rebuttal without deciding the remaining correction items because Correction Items 1 and 2, which deleted statements from the specification, did not fall within the statutory purposes of correction. The Tokyo District Court Judgment, 2023 (Wa) No. 70527 [Cyclic Protein Tyrosine Kinase Inhibitor] <Presiding Judge Sugiura>, held that the plaintiff's product was not substantially identical to Sprycel tablets because there was no reliable evidence sufficient to find that the addition or replacement of excipients, made in light of problems arising from the adoption of the anhydrous form and other factors, was based on well-known or commonly used art, and it rather appeared that the plaintiff had made it on the basis of its own technology. It is also noteworthy that the preliminary-injunction decision (granting an injunction) and this judgment (dismissing the main action as inadmissible and the counterclaim on the merits) by the same presiding judge reached different conclusions. The Tokyo District Court Judgment, 2022 (Wa) No. 7976 [Communication Equipment] <Presiding Judge Nakashima>, found infringement of an LTE standard-essential patent but held that the claim for an injunction constituted an abuse of rights, apportioned the royalty under FRAND terms, and did not allow an infringement premium because the defendant had been willing to take a license on FRAND terms.

5. Expert-Appraisal Evidence, Statutory Procedures, and Exceptions under Copyright Law

In the [Plant Variety Protection and Seed Act ★] breeder's-right infringement case, the credibility of the expert appraisal was denied because of the possibility that mycelium had been mixed in advance into test tubes prepared by the plaintiff and because subsequent verification had become impossible owing to disposal of the parent strain. The judgment held that, under the circumstances of this case, at a minimum, preparation of the test tubes by a third-party institution and preservation of the parent strain were indispensable. The Tokyo District Court Judgment, 2024 (Gyo-U) No. 5001 <Presiding Judge Shibuya>, held that a defect arising from a request for examination made before submission of a translation in a foreign-language patent application was not cured later and that there was no practical benefit in revoking the disposition. 2024 (Ne) No. 10072 [Draft Difference Measuring Device] <Presiding Judge Nakadaira> held that the opposition to the grant of a patent could not be found to have been unlawful and also held that the other patent-application and maintenance expenses lacked an adequate causal relationship with the conduct. The Intellectual Property High Court Judgment of July 31, 2025 (2024 (Ne) No. 10075) [Copyright Act ★] recognized quotation with respect to news photographs found to be related to the purpose of criticism in the text of the posts, and recognized exploitation of incidentally included works with respect to photographs that appeared only slightly on the same newspaper page, adjacent to the criticized article or the masthead. The collection and preservation of evidence, the sequence of statutory procedures, the causal relationship to damages, and each requirement for quotation should be reviewed.

In addition, this issue includes decisions spanning litigation, prosecution, contracts, and internal systems, including a finding of being "objectively unable to pay" under a contract, the denial of a joint tort based on an offer to sell a product under a different name, the technical significance of numerical limitations, and grounds for retrial. This issue should be used to review the organization of issues and the design of evidence.

Three-Line Summaries of All Articles

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ke) No. 10037 [Wood Composite Material] <Hibiku Shimizu>** ① This case concerned whether, with respect to a wood composite material, density, the dimensions of small flakes, and random orientation of the fiber direction should be considered as an integrated difference having a synergistic effect, or whether obviousness should be considered separately for each of them. ② The court approved the separate consideration on the ground that, although the individual effects of each element were recognized, no particular synergistic effect from their combination was recognized, and denied inventive step on the ground that density, dimensions, and random orientation could each be readily selected or optimized on the basis of well-known art and the like. ③ The decision indicates that, unless a particular synergistic effect from the combination is shown in the specification or experimental data, multiple differences may be considered separately.

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10032 [Portable Information Communication Device] <Shimizu>** ① This case concerned, in relation to the inventive step of a portable information communication device, the findings regarding the invention of Exhibit Hei B9 (differences in resolution from an external monitor, storage of dot data in image memory, and the like) and whether the differences relating to processing of received digital signals by the CPU, generation of display data having the same resolution as the display panel, and the like could readily have been conceived. ② The court held that the differences in resolution and the like were disclosed in the Exhibit Hei B9 document and that the differences not described in that document could readily have been conceived by applying common general technical knowledge at the priority date at issue (or were not substantial differences), denied inventive step, affirmed the judgment of the court of first instance dismissing the claims, and dismissed the appeal. ③ The decision indicates that inventive step may be denied where a configuration not described in a publicly known document could readily have been conceived by applying common general technical knowledge at the priority date at issue.

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10001 [Yarn Color Placement System] <Hibiku Shimizu>** ① This case concerned the inventive step of a configuration that, in consideration of yarns hidden by high-low control, sets the actual tufting density higher than the desired apparent density and controls the feed speed of the backing material. ② The court held that the prior art contained a system for controlling yarn supply and substrate feed, that it was self-evident that the desired appearance would not be obtained if the tufting density were set equal to the desired apparent density, and that adjusting the substrate feed speed to increase the tufting density in consideration of the hidden yarns was substantially included in the invention of Exhibit Otsu No. 4 or, even if not, could readily have been conceived by a person skilled in the art by applying common general technical knowledge at the priority date at issue; it therefore denied inventive step, affirmed the judgment of the court of first instance dismissing the claims, and dismissed the appeal (the judgment expressly states that its determination is not based on a matter of design). ③ The decision indicates that expressing, under a different conceptual name, an adjustment that is substantially included in the cited invention or could readily have been conceived by applying common general technical knowledge may not support inventive step.
Patent	**Tokyo District Court Judgment, 2023 (Wa) No. 70079 [Vehicle Guidance System] <Kokubu>** ① This case concerned whether vehicle guidance at an SIC by opening and closing barriers and using display devices satisfied claim elements including a “system for guiding vehicles entering and exiting through ETC-only entrances and exits.” ② The court of first instance found that vehicles seeking to use ETC-only entrances and exits were guided to prescribed lanes by start-control devices and roadside display devices, and found satisfaction of the claim elements, including Claim Elements A and F, as well as patent infringement. ③ In the court of first instance, the specific operation by which the start-control devices and roadside display devices guided vehicles to prescribed lanes was used in determining whether the vehicle guidance system satisfied the claim elements. The Intellectual Property High Court judgment of October 20, 2025, 2025 (Ne) No. 10043, however, denied satisfaction of Claim Element F, set aside the part of the first-instance judgment adverse to the defendant, and dismissed the claim.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Judgment, 2023 (Wa) No. 70380 [Rod-Shaped Light] <Takahashi>** ① This case concerned whether the button inputs used to store and emit the recommended color of a rod-shaped light constituted the same input method prescribed in the claims or detection of the "first predetermined input," and whether that configuration was supported by the specification. ② The court held that Accused Products 1 and 2 did not satisfy the claim elements because they used different input methods for storage and recall, and that Accused Products 3 and 4 likewise did not satisfy the claim elements because they did not emit light solely upon detection of the first predetermined input; it also found a violation of the support requirement because the specification neither described nor suggested solving the problem by the same input method. ③ The decision indicates that whether the input methods used for storage and emission are identical and whether light is emitted solely upon detection of the predetermined input affect satisfaction of the claim elements, and that claims including the same input method require a corresponding description or suggestion in the specification.
Intellectual Property—General	**A Container Capable of Carrying 10 Cubic Centimeters of Liquid and/or Solid** ① This article considers, using "a container capable of carrying 10 cubic centimeters of liquid and/or solid" as an example, whether a correction changing "A and/or B" to "B" may constitute an expansion or alteration. ② The article presents an example of a correction deleting an alternative and also refers, as the converse pattern, to a case in which adding the wording "electrically" may constitute an expansion or alteration, but does not itself state a conclusion. ③ The article presents the issue that, when making a correction, the possibility of an expansion or alteration should be considered both for deletion of an alternative and for addition of wording.

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ke) No. 10043 [Elasto-Plastic Hysteretic Damper] <Honda>** ① This case concerned lack of inventive step based on a combination of a building damper and a bridge damper and the like, and a violation of the support requirement based on an alleged lack of support although the invention was specified as if it could accommodate a load from any direction, with respect to an elasto-plastic hysteretic damper. ② The court held that there was no motivation to apply a two-dimensional arrangement to the invention of Exhibit Ko No. 1, which was premised on unidirectional input, that there was a disincentive, and that the other cited references likewise did not suggest a pair of shear portions oriented differently from each other; it further denied a violation of the support requirement because the invention at issue did not require maximum energy absorption with respect to loads from all directions. ③ The decision indicates that the direction of load presupposed by a cited invention affects the determination of motivation or disincentive for a combination, and that the support requirement is determined in light of the scope of problem-solving actually required by the claims.

Category	Article Title and Three-Line Summary
Patent	**Intellectual Property High Court Judgment, 2024 (Ne) No. 10048 [Battery] <Nakadaira>** ① In this patent-infringement action concerning a battery, the issues included whether the power-generating element included a stacked type, whether bonding through a member was included in the claims, whether Claim Element A4 could readily have been conceived from the prior art, and whether the appellant's Product 2 fell within the technical scope of Patent 2 at issue (including under the doctrine of equivalents). ② The court found satisfaction of the claim elements because the power-generating element was not limited to a wound type and included a stacked type, and because bonding through a member was not excluded; on the other hand, it found inventive step because the flange position in the invention of Exhibit Otsu No. 12 was closely related to its effect and the other cited references did not lead to Claim Element A4 either and there was no motivation, and it affirmed the first-instance judgment awarding damages of JPY 529,285,945 and delay damages and dismissing the remaining claims on the ground that the appellant's Product 2, the subject of the claims for an injunction and disposal, did not fall within the technical scope of Patent 2 at issue, including under the doctrine of equivalents; both the appeal and the incidental appeal were dismissed. ③ The decision indicates that, in claim construction, it is necessary to ascertain from the specification whether there is a structural limitation and, in determining obviousness, to consider the close relationship between the placement of a member in the prior art and the effect of the invention.

Category	Article Title and Three-Line Summary
Intellectual Property—General	**[Plant Variety Protection and Seed Act ★] Case in Which the Plaintiff's Claims Were Dismissed Because the Credibility of the Expert Appraisal Purporting to Prove Infringement of the Breeder's Right Was Not Established** ① In this breeder's-right infringement action concerning shiitake mushrooms, the credibility of the subculturing acts, which were conducted using test tubes prepared by the plaintiff itself and after which the parent strain was discarded, and of the expert appraisal premised on those acts was disputed. ② The court denied the credibility of the expert appraisal because the possibility that mycelium of the plaintiff's variety had been mixed into the test tubes in advance could not be sufficiently ruled out and subsequent verification had become impossible owing to disposal of the parent strain, and dismissed the plaintiff's claims without needing to determine the remaining points. ③ In separating and subculturing samples used to prove breeder's-right infringement, it is important to have a fair and neutral third-party institution prepare the test tubes and to preserve, rather than discard, the parent strain after subculturing, thereby ensuring the fairness and transparency of the expert appraisal and the subsequent verifiability of the subculturing acts.
Patent	**2024 (Ne) No. 10056 [Van-Type Motor Vehicle for Cleaning Work] <Nakadaira>** ① This case concerned whether the appellee, which received delivery from KCS of Appellee Product 2 (which the first-instance judgment found to fall within the technical scope, granting an injunction and other relief) and offered it for sale under a name different from that of Appellee Product 1 sold by KCS, was liable in joint tort for KCS's sale of Appellee Product 1. ② The court denied a joint tort, holding that, even if the appellee offered for sale Appellee Product 2, which bears a name different from that of Appellee Product 1, it could not be found that this assisted or facilitated KCS's sale of Appellee Product 1. ③ The decision indicates that merely offering for sale, under a different name, a product delivered by another infringer does not, even if the two products have the same structure, amount to assisting or facilitating that other infringer's sales, and does not constitute a joint tort.

Category	Article Title and Three-Line Summary
Intellectual Property—General	**[New YouTube Video] Infringement Analysis (Other than Typical Literal Satisfaction) (Reading Through the Encyclopedia of Patent Judicial Decisions, 4th Edition) November 5, 2025** ① This article introduces a video covering major judicial decisions concerning the doctrine of equivalents, numerical limitations, use inventions, and the like as infringement analyses other than typical literal satisfaction. ② According to the title, the video is a reading of the Encyclopedia of Patent Judicial Decisions, 4th Edition, and the introductory description states that viewers can grasp together, in a single video, major judicial decisions concerning infringement analysis, including the doctrine of equivalents, numerical limitations, and use inventions. ③ The video serves as a starting point for reviewing, across subject matters, major judicial decisions concerning infringement analyses other than typical literal satisfaction.
Intellectual Property—General	**[Contract] Tokyo District Court Judgment, 2022 (Wa) No. 9422 <Shibuya>** ① This case concerned a claim for return of the contract fee of JPY 210 million paid under the contract at issue, a joint development and business alliance agreement, as restitution following termination on the ground of a "state of being objectively unable to pay" under Article 17(2) of the contract (the defendant did not actively dispute the ground for termination). ② Based on the evidence, the court found that the defendant had been in a state of being objectively unable to pay no later than February 7, 2025, held the termination of the contract valid, and granted in full the claim for return of the contract fee of JPY 210 million. ③ This is a case-specific decision in which the defendant did not actively dispute the ground for termination, and it may be referred to as an example in which it was shown by evidence that the counterparty was objectively unable to pay at the time of the declaration of termination.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Judgment, 2023 (Wa) No. 70449 [Fastening Hardware] <Takahashi>** ① This case concerned whether the language “for inducing deformation when an excessive load acts” in the fastening hardware limited the configuration of the invention and whether novelty existed over hardware described in a design gazette. ② The court denied novelty, holding that the language merely indicated the purpose or an operation or effect necessarily obtained by the configuration in which the front portion and rear-edge portion were integrated by multiple branch-like portions, and that the invention of Exhibit Ko No. 5 necessarily obtained the same effect from the same shape. ③ When asserting a difference from the prior art based on claim language indicating a purpose or an operation or effect, it is necessary to consider whether the language limits the configuration and whether that effect necessarily arises from the same configuration.
Patent	**Osaka District Court Judgment, 2023 (Wa) No. 10217 [Three-Dimensional Network Fiber Assembly] <Matsuami>** ① This case concerned, with respect to a three-dimensional network fiber assembly that was an employee invention, the unreasonableness of payment of remuneration under internal reward rules and whether there was reasonable remuneration (profits from exclusivity) apart from those rules (the court examined the latter from the standpoint of the reasonableness of the defendant's determination not to pay an implementation reward). ② The court held that it was not unreasonable to pay remuneration for employee inventions under the reward rules because, in the process of establishing and revising them, general employment rules and the like were referred to, opinions were obtained from persons with knowledge of intellectual property, and the proposed rules were disclosed to employees and their opinions were heard; it further dismissed the claims, holding that there was no unreasonable aspect in the defendant's determination that the requirements for payment of an implementation reward were not satisfied under circumstances including that the defendant's product received a low evaluation as a mattress and commercialization had ended. ③ In determining rewards for employee inventions, it is important, in addition to the procedures for establishing and revising the rules, to specifically record and prove the sales performance, evaluation, and contribution to the business of the relevant product.

Category	Article Title and Three-Line Summary
Patent	**[Employee Invention] Tokyo District Court Judgment, 2023 (Wa) No. 70495 <Nakashima>** ① In response to a claim by the plaintiff, a former employee, for JPY 100 million as reasonable remuneration for an employee invention, this case concerned whether the plaintiff was the inventor or a joint inventor of the invention at issue, including the time of completion of the invention and the plaintiff's involvement in conception and embodiment. ② The court denied the plaintiff's inventorship and joint inventorship, finding that the invention at issue had been independently conceived and embodied by Bi, Di, and others without the plaintiff's involvement, in light of the facts that the plaintiff had no contact with Bi and the others, that the plaintiff's explanatory document was not even circulated to them, and that the Di invention had already been presented before Di received the plaintiff's explanatory document (the court reached the same conclusion after two rounds of requests for clarification), and holding that there was also no reliable evidence substantiating the time of completion asserted by the plaintiff; it dismissed the claim. ③ To assert inventorship, it is necessary to substantiate, by specific materials, the time of completion of the invention and actual involvement in its conception and embodiment.
Patent	**Osaka District Court Judgment, 2022 (Wa) No. 11405 [Heterocyclic Derivative] <Takemiya>** ① This case concerned whether internal employee-invention rules applied to an employee invention relating to a heterocyclic derivative and the amount of reasonable remuneration under the Patent Act before the 2004 amendment. ② The court calculated the statutory reasonable remuneration because there was no provision or agreement applying the employee-invention rules to the invention at issue, and awarded approximately JPY 94 million (after deducting JPY 6,519,000 already paid) after taking into account, for the employer's own working and third-party working, an employer contribution of 99%, a joint-inventor share of one-third, and other factors. ③ Employee-invention rules should clearly specify their scope of application; where the rules do not apply, excess sales, a hypothetical royalty rate, licensing revenue, the employer's contribution, the patent's contribution ratio, and the joint-inventor share should be considered as materials for calculating remuneration.

Category	Article Title and Three-Line Summary
Patent	**2023 (Ne) No. 10107 “PCSK9 (Second Litigation)” <Nakadaira>** ① This case concerned whether the support requirement was met and the merits of the patentee's rebuttal based on correction with respect to an antibody invention defined by the functions of neutralizing the binding between PCSK9 and LDLR and competing with a reference antibody. ② The court held that “competes” included direct competition and competition through steric hindrance, but that it could not be said that an antibody competing with a reference antibody neutralizes by the same mechanism as the reference antibody (in the verification experiments, roughly 80% or more of the antibodies competing with the reference antibodies lacked binding-neutralizing activity) and that the specification contained no disclosure at all of the neutralizing activity of antibodies competing through steric hindrance, and found a violation of the support requirement. As to the patentee's rebuttal based on correction, it rejected that rebuttal without deciding the remaining correction items because Correction Items 1 and 2 did not fall within the statutory purposes of correction. ③ For antibody claims defined by function, it is necessary to confirm whether the entire scope of the claims, including mechanisms of action different from those in the examples, is supported by the specification, and, when asserting correction, to examine separately its admissibility and whether it actually excludes unsupported embodiments. A correction adding conditions concerning neutralization or competition by Fab fragments should be distinguished from a correction limiting the subject matter of the invention to Fab fragments themselves.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Judgment, 2022 (Wa) No. 7976 [Communication Equipment] <Nakashima>** ① This case concerned, in connection with infringement of an LTE standard-essential patent, whether the claim for an injunction constituted an abuse of rights and how damages and an infringement premium based on FRAND terms should be treated. ② While finding patent infringement, the court held that the claim for an injunction constituted an abuse of rights because the failure to reach agreement resulted from the difference in royalty rates and it could not be said that the defendant lacked willingness to obtain a license; it calculated damages by apportioning the royalty rate for the entire standard by the number of patents and, because the defendant had been willing to take a license on FRAND terms, did not allow an increase based on an infringement premium in light of the nature of FRAND terms. ③ In enforcing a standard-essential patent, it is necessary to distinguish a difference of views concerning the royalty rate from an implementer's willingness to obtain a license, and to consider damages in light of the royalty rate for the entire standard, the number of patents, and the relative contribution of each standard.
Patent	**2024 (Ne) No. 10074 [Filler for Electronic Cigarette] <Masuda>** ① This case concerned the meaning of “cut” in Claim Element B relating to a filler for an electronic cigarette and whether linear portions of the accused product formed by crimping satisfied that claim element. ② Based on dictionary descriptions and examples of means for formation in the specification, the court construed “cut” as meaning a slit or cut formed artificially and actively using a blade, and held that the claim element was not satisfied because the linear portions of the accused product were not formed with a blade. ③ Where the meaning of claim language is unclear, it may be construed restrictively based on dictionary meanings and the means for formation described in the specification (including whether other means are described or suggested); therefore, attention should be paid to the choice of terms that may specify the means for formation and to the description in the specification.

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ke) No. 10109 [Assistance Device] <Honda>** ① This case concerned whether the relationship between the original trial decision and the subsequent fourth retrial decision constituted a ground for retrial under Article 338(1)(x) of the Code of Civil Procedure, as applied mutatis mutandis by Article 171(2) of the Patent Act. ② The court rejected the claim, holding that a conflict with the fourth retrial decision, which was issued after the original trial decision that was the subject of the request for retrial, did not constitute a ground for retrial of the original trial decision; even assuming that the fourth retrial decision was the subject, the original trial decision was a decision holding that the request for an appeal against the examiner's decision of refusal was groundless, whereas the fourth retrial decision was a decision dismissing the request for retrial as inadmissible, and they therefore did not conflict with each other. ③ When asserting a ground for retrial against a trial decision, it is necessary to identify the trial decision that is the subject of the retrial and then consider, from the chronology, operative parts, and legal nature of each decision, whether they actually conflict.
Patent	**Tokyo District Court Judgment, 2024 (Gyo-U) No. 5001 <Shibuya>** ① This case sought revocation of the JPO's disposition dismissing as unlawful a request for examination made, with respect to an international patent application in a foreign language, before submission of the translation. ② The court held that Article 184-17 of the Patent Act made it a procedural requirement to request examination after submission of the translation, that the defect in the order of those procedures was not cured by a later submission of the translation, and that there was no interest in the action because the JPO would have no choice but to dismiss the request again even if the disposition were revoked; it therefore dismissed the action as inadmissible. ③ For a foreign-language patent application, a request for examination must be made after submission of the translation, and attention should be paid to the fact that an error in the order of procedures cannot be cured by submitting the translation afterward.

Category	Article Title and Three-Line Summary
Patent	**2024 (Gyo-Ke) No. 10022 [... Antimicrobial Agent] <Honda>** ① This case concerned whether the corrected invention relating to a therapeutic agent for onychomycosis using KP-103 could readily have been conceived from each primary cited invention directed to treating tinea pedis (the invention of Exhibit Ko No. 1-1) or dermatomycosis (the invention of Exhibit Ko No. 1-2). ② The court denied obviousness based on the primary cited invention, holding that there was an obstacle making it difficult for an antifungal agent to penetrate and permeate into the nail plate, that a person skilled in the art could not reasonably have expected delivery of KP-103 to the infected site and a therapeutic effect, and that the effect was also difficult to predict. ③ In determining inventive step for a medical-use invention, it is necessary to consider not only commonality of the causative fungus or keratin, but also whether it could reasonably have been expected that the active ingredient would pass through the target tissue, be delivered to the infected site, and exert a therapeutic effect.
Patent	**2024 (Ne) No. 10029 “Claim for Confirmation of the Right to Obtain a Patent” <Masuda>** ① This case concerned who was the inventor who actually participated in completing the characteristic portion of a vascular-plug invention, and whether a dispute seeking confirmation of the right to obtain foreign patents in connection with a PCT application was ripe for adjudication. ② The court found that it was Professor A, who recorded the problem of the invention at issue and the means for solving it in a research notebook, rather than Y1, who was not found to have a background in clinical knowledge, who actually participated in completing the characteristic portion; it further held that, at the present time, when no new filing or national-phase entry had been made in any foreign country and no specific plan therefor had been disclosed, the ripeness of a dispute seeking confirmation of the right to obtain foreign patents was not established. As a result, the court dismissed the appeal of the plaintiff in the first instance and, on the appeal of the defendant company in the first instance, set aside paragraph 1 of the operative part of the first-instance judgment (the part granting Claim 1-2) and dismissed that claim. ③ With respect to inventorship, actual involvement in the characteristic portion of the invention should be proved by specific materials; when seeking confirmation of the right to obtain a foreign patent, the target countries and specific plans for a new filing or national-phase entry and the like must be clarified.

Category	Article Title and Three-Line Summary
Patent	**2023 (Gyo-Ke) No. 10078 [Audio Controller] <Shimizu> (Defendant: Pixie Dust)** ① This case concerned whether Contractor C and others were joint inventors of the invention at issue and, on that premise, whether misappropriation or violation of the joint-application requirement was established. ② The court held that the invention at issue had already been completed through the experimental device developed by A and B, on the commissioning side (PDT), on the basis of a conception accompanied by specific means for solving the problem, and that the inventors were A and others (A and D) listed in the patent gazette, and that the functions realized by Contractor C and others merely solved a problem different from that of the invention at issue and did not constitute creative involvement in the characteristic portion; it therefore did not find misappropriation or violation of the joint-application requirement. ③ The case indicates that, in determining joint inventorship, it is necessary to consider not contribution in general at the implementation stage, but whether the person embodied the characteristic portion that solves the technical problem of the invention at issue.
Patent	**2023 (Wa) No. 70563 [Transaction Management System] <Shibuya> (Keysoft v. Sankaku Kikaku)** ① This case concerned whether, in the accused system relating to the Furusato Nozei program, a local public body constituted an “intermediate trader” of the invention at issue. ② The court held that Furusato Nozei and the provision of return gifts were not sales transactions and that there was no relationship in which the local public body received an order from the donor and placed an order with a business operator; the local public body therefore did not constitute an “intermediate trader” conducting transactions in goods in stages. ③ The case indicates that satisfaction of a claim element relating to a transaction system must be considered not only from the form of notification but also in light of the actual relationship, including whether the transaction is for consideration and whether order information is received and transmitted in stages.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Judgment, 2023 (Wa) No. 70594 [Mattress]** ① This case concerned the construction of the claim element requiring multiple cushion bodies to be incorporated into a mattress cover in a “pressure-bonded” state and whether the accused product satisfied that claim element. ② The court construed “pressure-bonded” as not requiring a state in which the cushion bodies are strongly compressed and adhere, but as meaning a state in which some pressure is applied to the extent that no gap is formed between the cushion bodies, and found satisfaction because measurement showed that pressure of at least 0.2 MPa was applied between the inner materials of Accused Products 1 and 4 and the same was inferred for the other accused products of the same type; it granted an injunction against manufacture, transfer, and the like and an order for disposal (and dismissed the remaining claims). ③ The case indicates that, in construing claim terms, it is important to consider together not only dictionary meanings but also the embodiments, drawings, and purpose and effects of the invention in the specification, and, with respect to an accused product, to prove by measurement the physical state corresponding to the claim element. The appellate court (Intellectual Property High Court Judgment of November 17, 2025, 2025 (Ne) No. 10045) dismissed the appeal.
Patent	**2023 (Ne) No. 10114 [Layered Body Having Cube-Corner Elements, and Retroreflective Sheet] <Nakadaira>** ① This case concerned whether the numerical limitation setting the dihedral-angle error of cube-corner elements at 1 to 60 arcminutes had technical significance and supported inventive step. ② The court held that there was no basis in the specification for regarding the numerical range as preferable, that examples below 1 arcminute also produced the operation and effect, and that neither a basis for setting the upper limit at 60 arcminutes nor an operation and effect peculiar to the range was shown; accordingly, the numerical range had no particular technical significance and merely reflected the exercise of ordinary creative ability; it therefore found lack of inventive step over the invention of Exhibit Otsu No. 12, rejected the patentee's rebuttal based on correction, and dismissed the appeal. ③ The case indicates that, to support inventive step by a numerical limitation, it is important to substantiate in the specification the basis for the numerical range and its upper and lower limits, as well as an operation and effect peculiar to that range.

Category	Article Title and Three-Line Summary
Patent	**2023 (Gyo-Ke) No. 10121 [Imaging Device] <Masuda>** ① This case concerned whether the support requirement was satisfied in relation to the statement “orthogonal” in the claims and the depiction of Axis A in Figure 4B. ② The court held that “orthogonal” indicated not the angle of intersection between the first axis and the second axis, but the positional relationship in which two sides of the rectangular display intersected at a right angle; it further held that the depiction of Axis A as moving in Figure 4B could not support the assertion because the claims do not state that Axis A can be moved and, even setting that point aside, was an obvious error from which a person skilled in the art could readily understand the correct configuration; it therefore denied a violation of the support requirement (also rejecting the assertions of violations of the clarity and enablement requirements) and dismissed the claim. ③ The case indicates that, even where a drawing contains an error, a violation of the support requirement does not immediately result if a person skilled in the art can readily understand the error and the correct configuration from the claims and the specification as a whole.
Patent	**2023 (Wa) No. 70004 [Portable Information Communication Device] <Takahashi>** ① This case concerned whether, with respect to a portable information communication device, the configurations relating to Difference ① (reception of a radio signal, conversion into a digital signal, and transmission to the CPU) and Difference ② (reading of bitmap data of an image having the same resolution as the screen resolution) could readily have been conceived by applying common general technical knowledge to the invention of Exhibit Otsu No. 6. ② The court denied inventive step, holding that a person skilled in the art at the priority date could readily have conceived, by applying common general technical knowledge to the invention of Exhibit Otsu No. 6, a configuration in which, to import image information from outside, the communication unit received a radio signal, converted it into a digital signal, and transmitted it to the CPU (Difference ①), and a configuration reading bitmap data of an image having the same resolution as the screen resolution (Difference ②); it dismissed the plaintiff's claim under Article 104-3(1) of the Patent Act. ③ The case indicates that whether a difference from the prior invention can be specifically derived by applying common general technical knowledge at the priority date is an important consideration in determining inventive step.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Decision, 2023 (Yo) No. 30214, Petition for a Preliminary Injunction <Sugiura>** ① The text of the original article does not state the specific facts or issues of the petition for a preliminary injunction and refers to the judgment by the same Presiding Judge Sugiura in the main action and counterclaim (2023 (Wa) No. 70527). ② The original article states that the outcome for the patent owner differed between the preliminary injunction and the judgment in the main action and counterclaim; this does not mean that an appellate court set aside a first-instance judgment. The operative part and other particulars of the preliminary-injunction decision can be confirmed in the published copy. Apart from the statement that the creditor's petition is found to be reasonable, the published copy (certified copy) of the decision contains no detailed statement of reasons. ③ The article indicates that the difference in conclusions between the preliminary-injunction decision (granting an injunction) and the judgment in the main action and counterclaim (dismissing the main action as inadmissible and the counterclaim on the merits) by the same presiding judge should be reviewed together with the article concerning that judgment linked from this article.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court Judgment, 2023 (Wa) No. 70527 [Cyclic Protein Tyrosine Kinase Inhibitor] <Sugiura>** ① This case concerned whether the effect of an extended pharmaceutical patent right reached the plaintiff's product as a product “substantially identical as a pharmaceutical product,” despite differences in the hydrate or anhydrous form of the active ingredient and in the composition of excipients. ② The court held that the plaintiff's product appeared to have added or replaced excipients (replacement of PEG and addition of carnauba wax) in light of problems arising from the difference in active ingredient (adoption of the anhydrous form) and other factors, that there was no reliable evidence sufficient to find that this was based on well-known or commonly used art, and that it rather appeared that the plaintiff had done so on the basis of its own technology to bring the dissolution behavior closer to that of Sprycel Tablets or to obtain bioequivalence, and therefore held that the plaintiff's product was not substantially identical to the originator pharmaceutical product and that the extended patent right did not extend to it. ③ If an appeal is filed, a point of practical interest will be whether the logic of this judgment, which treats the problems and technical significance relating to differences in excipients as material, will be maintained, or whether its scope will be limited to cases in which the active ingredient differs. The operative part dismissed as inadmissible the main action for a negative declaration and dismissed on the merits the defendant patentee's counterclaim for damages.

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10080 [Under-Coping Ventilation Structure] <Nakadaira> = Court of First Instance: Osaka District Court Judgment, 2023 (Wa) No. 8403** ① This case concerned whether the plate-shaped portion of the appellee's product constituted a “ventilation member that exhibits ventilation performance and waterproof performance” and satisfied Claim Element C. ② In light of the claim language and the specification, the court construed the ventilation member itself as being required to have ventilation performance and waterproof performance, and denied satisfaction of Claim Element C because the plate-shaped portion (Sloped Portion ⑤) of the appellee's product was not found itself to have that performance, the appellant's "contribution" test lacked a reasonable basis, and, even under that test, Sloped Portion ⑤ reduced ventilation performance and therefore did not contribute to that performance. ③ The case indicates that, for a claim element specifying performance, it should be considered in accordance with the claim language and specification whether the member itself is required to have that performance, and that mere “contribution” to performance cannot be used as the standard without a reasonable basis.
Patent	**2024 (Ne) No. 10072 [Draft Difference Measuring Device] <Nakadaira>** ① This case concerned whether expenses for responding to opposition proceedings and other patent-application and maintenance expenses could be recovered as damages based on the tort of the defendant in the court of first instance. ② The court held that no tort was established because the opposition to the grant of the patent could not be found to have been unlawful, and that the other expenses had been incurred by the plaintiff in the court of first instance on its own judgment and lacked an adequate causal relationship with the conduct of the defendant in the court of first instance. ③ The case indicates that, to claim expenses for responding to a patent opposition or patent-application and maintenance expenses as damages, the unlawfulness of the other party's conduct and an adequate causal relationship between that conduct and the expenditure must be specifically proved.

Category	Article Title and Three-Line Summary
Copyright	**[Copyright Act ★] Case in Which, Regarding the Appellee's (Defendant's) Acts of Photographing, to the Extent Included in a Single Smartphone Photograph, Articles (Headlines, Article Text, and the Photographs at Issue) in a Newspaper Published by the Appellant (Plaintiff), and Posting Them Together with the Text of Posts on Twitter (X) via the Internet on 25 Occasions, the Appellant Alleged Infringement of Copyright (Right of Making Transmittable) in the Photographs at Issue and Sought Damages in Tort, and the Court Held that the Quotation Defense (Article 32(1) of the Copyright Act) or the Defense of Exploitation of Incidentally Included Works (Article 30-2 of the Copyright Act) Applied and that the Appellant's Claims Should Be Dismissed** ① This case concerned whether the quotation defense or the defense of exploitation of incidentally included works applied to infringement of the right of making the photographs transmittable arising from the defendant's acts of photographing articles and photographs in the Seikyo Shimbun with a smartphone and posting them on Twitter (X), together with the text of posts, on 25 occasions. ② With respect to photographs found to be related to the purpose of criticism in the text of the posts, the Intellectual Property High Court found clear distinguishability from the text of the posts, a principal-subordinate relationship, the ability to recognize the source, relevance to the purpose of quotation, and appropriateness of the scope and quantity, and upheld the quotation defense; with respect to photographs that appeared only slightly on the same newspaper page, adjacent to the criticized article or the masthead (Photographs 10 and 27-29 at issue), it found exploitation within a justifiable extent as incidentally included works, and dismissed the appeal. ③ The decision is practically instructive in that, with respect to quotation when posting newspaper pages containing news photographs, it specifically considered clear distinguishability, the principal-subordinate relationship, fair practice, and the justifiable extent for the purpose, while separately treating slight inclusion of material not subject to criticism as exploitation of incidentally included works.

2024 (Gyo-Ke) No. 10037 [Wood Composite Material] <Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e8%a1%8c%e3%82%b110037%e3%80%90%e6%9c%a8%e8%b3%aa%e8%a4%87%e5%90%88%e6%9d%90%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

2024 (Gyo-Ke) No. 10037 [Wood Composite Material] <Hibiku Shimizu>

Date of judgment: February 20, 2025.

Inventive Step: ×

The plaintiff asserted that the three elements of density, dimensions of small flakes, and orientation (direction) operated together to produce a synergistic effect and therefore should be considered as a single difference. This judgment, however, approved the JPO's method of considering them separately, holding that, the specification did not show the effects of the density and orientation configurations as effects of the invention at issue, and the experimental results certificate (Exhibit Ko No. 20) showed only the effects of the individual configurations separately and did not establish a synergistic effect resulting from their combination.

(1) Difference 1: Density (400-550 kg/m³)

The invention of Exhibit Ko No. 1 does not specify density, but it was well known in the prior art (Exhibits Otsu Nos. 2-4) that a density of 0.40-0.65 g/cm³ (400-650 kg/m³) was suitable for a wood board.

⇒ A person skilled in the art could readily optimize or select a preferable numerical density range according to the use (a substrate for flooring material).

(2) Difference 2: Dimensions of the Small Wood Flakes (Thickness of 0.2-0.5 mm, etc.)

The invention at issue specifies the flake size in detail, but similar dimensions were disclosed in the prior art (Exhibits Ko Nos. 4 and 5, among others).

⇒ It was common general technical knowledge that making the flakes smaller produces uniformity and smoothness but reduces strength (a trade-off), and optimizing the numerical values within that relationship was within the ordinary creative ability of a person skilled in the art. The absence of "knots" was also a natural result of reducing the material to small pieces.

(3) Difference 3: Random Orientation of the Fiber Direction

In the invention at issue, the flakes are randomly oriented.

⇒ In OSB, imparting orientation or using a random orientation were well-known alternatives, and it was common general technical knowledge that random orientation eliminates variations in strength depending on direction (anisotropy). It was therefore easy to select random orientation according to the use.

[Supplement] The heading of the original article reads "2025 (Gyo-Ke) No. 10037," but the case number of the judgment is 2024 (Gyo-Ke) No. 10037 (judgment, p. 1, line 2). Further, regarding the statement in the original article that each element individually

produces an effect, the judgment held that the effects of the density-related configuration and the orientation-related configuration are not shown as effects of the invention (judgment, p. 22, lines 8-9), and its statement that the effects produced by each configuration alone were merely shown individually concerned the experimental results certificate (Exhibit Ko No. 20) (judgment, p. 22, line 15 to p. 23, line 8).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93877.pdf

* This article provides general information and does not include legal advice.

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2024 (Ne) No. 10032 [Portable Information Communication Device] <Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10032%e3%80%90%e6%90%ba%e5%b8%af%e6%83%85%e5%a0%b1%e9%80%9a%e4%bf%a1%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%ef%bc%9e/

2024 (Ne) No. 10032 [Portable Information Communication Device] <Shimizu>

Inventive Step: ×

⇒ The judgment of the court of first instance dismissing the claims was affirmed.

At the priority date at issue, it was common general technical knowledge that a mobile telephone receives a radio signal, demodulates it into a digital signal, and that the CPU processes the signal and displays an image.

⇒ The judgment identified Difference 6BDG′ because Exhibit Hei B9 did not describe transmission of a signal from communication unit 12 to CPU 11, and then held that the configuration would have been obvious through application of common general technical knowledge and was not a substantive difference.

In the Exhibit Hei B9 document as well, because data that cannot be fully viewed on the mobile screen is output to an external monitor, there is a "difference in resolution."

VRAM (image memory) and bitmap data (dot data) were considered in identifying the cited invention, namely how a person skilled in the art would understand Exhibit Hei B9 in light of common general technical knowledge. The court also found that, at the priority date at issue, it was common general technical knowledge to generate and display data having the same resolution as the display panel from display data having a higher resolution, and to view the entire image by scrolling.

Priority date at issue: December 24, 2004.

[Supplement] Regarding the statement in the original article that a person skilled in the art would naturally understand this even if it is not expressly stated in a publicly known document, the judgment found that the Exhibit Hei B9 document contains no statement that any signal is transmitted from communication unit 12 to CPU 11 and recognized Difference 6BDG' (judgment, p. 12, lines 14-17; p. 18, line 26 to p. 19, line 4), and then held that the configuration could readily have been conceived by applying common general technical knowledge (or that the difference was not substantial in the first place) (judgment, p. 22, lines 13-18). The statement that the use of VRAM and bitmap data was common general technical knowledge was addressed in the judgment as part of the finding of the Exhibit Hei B9 invention, namely how a person skilled in the art would understand the Exhibit Hei B9 document (judgment, p. 15, lines 7-13). The common general technical knowledge found by the judgment is that display data having the same resolution as the display panel is generated from display data larger than the panel resolution and displayed, and the entire image can be viewed by scrolling (judgment, p. 22, lines 20-26); "reducing" is not mentioned in the judgment.

The relevant date for the judgment is the priority date at issue (judgment, p. 2, line 15; p. 22, lines 8-12).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93879.pdf

* This article provides general information and does not include legal advice.

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2024 (Ne) No. 10001 [Yarn Color Placement System] <Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10001%e3%80%90%e3%83%a4%e3%83%bc%e3%83%b3%e8%89%b2%e9%85%8d%e7%bd%ae%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

2024 (Ne) No. 10001 [Yarn Color Placement System] <Hibiku Shimizu>

Inventive Step: × ⇒ Appeal Dismissed

"High-Low Control" = A conventional technique in which, when creating a pattern, yarns of colors intended to appear on the surface are left high, while yarns of colors intended to be hidden are pulled back low (or pulled out).

The invention at issue = Because some yarns are hidden, the number actually tufted (the effective rate) is set at a "higher density" than the apparent density of the finished product (the desired rate), and the feed speed of the backing material is controlled accordingly.

⇒ In the prior art (the invention of Exhibit Otsu No. 4), a system already existed that controlled the supply of yarn and the feed of the substrate (backing material) to create a desired pattern.

When some yarns are hidden by using "High-Low Control," it is self-evident that the actual tufting density (stitch rate) must be increased so that gaps are not created by the hidden yarns; otherwise, the desired apparent density cannot be obtained.

⇒ In order to obtain the "desired apparent density," setting the "actual tufting density" higher in consideration of the hidden yarns and adjusting the feed speed of the substrate was substantially encompassed by the invention of Exhibit Otsu No. 4; alternatively, it would have been obvious through application of common general technical knowledge to that invention.

(The concept of an "effective stitch rate" asserted by the plaintiff was not a new invention, but merely expressed in different words an adjustment that was necessarily made when carrying out conventional "High-Low Control.")

[Supplement] Regarding the statement in the original article that this was merely a matter of design that a person skilled in the art would naturally implement, the judgment stated that its determination was based on the grounds that the invention of Exhibit Otsu No. 4 substantially included Corrected Invention 3 and, even if not, that Corrected Invention 3 could readily have been conceived by applying common general technical knowledge to that invention, thereby expressly indicating that its determination was not based on a matter of design (judgment, p. 42, lines 14-20). This judgment is an appellate judgment, and its operative part dismisses the appeal (judgment, p. 1, line 26).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93894.pdf

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Tokyo District Court Judgment, 2023 (Wa) No. 70079 [Vehicle Guidance System] <Kokubu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70079%e3%80%90%e8%bb%8a%e4%b8%a1%e8%aa%98%e5%b0%8e%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e5%9c%8b%e5%88%86/

Tokyo District Court Judgment, 2023 (Wa) No. 70079 [Vehicle Guidance System] <Kokubu>

* The court of first instance found patent infringement. The Intellectual Property High Court judgment of October 20, 2025, 2025 (Ne) No. 10043, set aside the part of the first-instance judgment adverse to the defendant and dismissed the claim because Claim Element F was not satisfied. The discussion below introduces the reasoning of the court of first instance.

With respect to satisfaction of Claim Element A (a system for guiding vehicles entering and exiting through ETC-only entrances and exits), the court found, in substance, that the claim elements of the invention at issue were satisfied because, at the SIC, vehicles seeking to use an ETC-only entrance or exit were guided, by opening and closing barriers and using display devices, to the entry/exit route (Lane c) or the exit/general-road route (Lane d).
The court also found Claim Element F (guidance means, etc.) and the other claim elements satisfied.

(Excerpt from the Judgment)
Because each accused system can be said to guide a vehicle seeking to pass through an ETC-only entrance in order to enter a toll-road tollgate, service area, or the like, and a vehicle seeking to pass through an ETC-only exit in order to leave a toll-road tollgate, service area, or the like, to either Lane c or Lane d by means of the respective start-control devices and roadside display device ⑧ described above, it falls within a "system for guiding vehicles entering and exiting through ETC-only entrances and exits."

[Supplement] The original article began with "* Patent infringement was found." and "⇒ Reversed to non-satisfaction in the appellate judgment," and, in the excerpt from the judgment, joined the two types of vehicles with "or" where the judgment lists them side by side. The judgment lists the vehicles side by side (judgment, p. 48, line 26 to p. 49, line 6).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94081.pdf
Summary of the appellate judgment: https://www.courts.go.jp/assets/hanrei/hanrei-point_pdf-94945.pdf

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Tokyo District Court Judgment, 2023 (Wa) No. 70380 [Rod-Shaped Light] <Takahashi>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70380%e3%80%90%e6%a3%92%e7%8a%b6%e3%83%a9%e3%82%a4%e3%83%88%e3%80%91%ef%bc%9c%e9%ab%99%e6%a9%8b%ef%bc%9e/

Tokyo District Court Judgment, 2023 (Wa) No. 70380 [Rod-Shaped Light] <Takahashi>

Claim Elements Not Satisfied + Violation of the Support Requirement

Accused Products 1 and 2 use a "long press" to store and a "short press" to recall, and therefore do not satisfy Claim Element J4, which requires the same input method.
Accused Products 3 and 4 do not emit light in the recommended color solely upon "detection" of the "aforementioned first predetermined input" on the second button, and therefore do not satisfy the configuration "when the aforementioned first predetermined input is detected, ... cause light to be emitted."

"Although the detailed description of the invention in the specification at issue can be said to state that, with respect to storing the recommended color and emitting light in the recommended color, the problem is solved by a configuration using different input methods for the second button, it neither states nor suggests solving the problem by a configuration using the same input method for storing the recommended color and emitting light in the recommended color."
⇒ Violation of the support requirement

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94101.pdf

REIWA 5 (WA) NO. 70380 [ROD-SHAPED LIGHT] <TAKAHASHI>

— CLAIM ELEMENTS NOT SATISFIED + VIOLATION OF THE SUPPORT REQUIREMENT

Accused Products 1 and 2 store the recommended color by a "long press" and recall it by a "short press." Accordingly, they do not satisfy Claim Element J4, which requires the same input method ("the aforementioned first predetermined input on the second button").

Accused Products 3 and 4 do not emit the recommended color solely upon "detection" of the "aforementioned first predetermined input" on the second button. Accordingly, they do not satisfy the configuration "when the aforementioned first predetermined input is detected, ... cause [the light] to emit light."

"The detailed description of the invention in the specification at issue can be said to describe solving the problem, with respect to storing the recommended color and emitting light in the recommended color, by a configuration using different input methods on the second button; however, it neither describes nor suggests solving the problem, with respect to storing the recommended color and emitting light in the recommended color, by a configuration using the same input method."

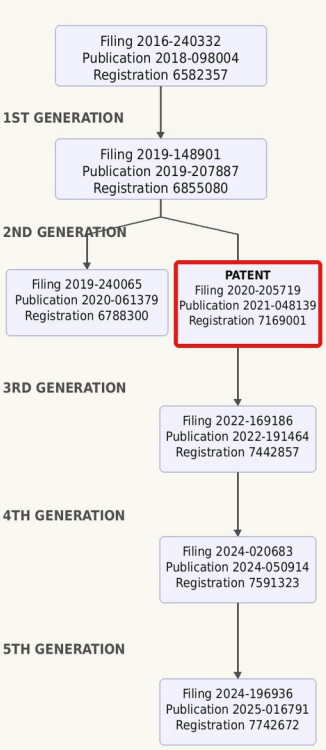
⇒ VIOLATION OF THE SUPPORT REQUIREMENT

*** THE DISCLOSURE OF THE ACCUSED PRODUCTS IS THE SAME AS THE DISCLOSURE IN PARAGRAPH [0074] OF THE DETAILED DESCRIPTION OF THE INVENTION!!**

⇒ THE CLAIM LANGUAGE WAS CONSTRUED AS DEPARTING FROM THE DISCLOSURE OF THE SPECIFICATION.

CLAIM ELEMENT J1 STATES THAT "THE FIRST PREDETERMINED INPUT IS THE AFOREMENTIONED SHORT PRESS OR THE AFOREMENTIONED LONG PRESS."

IN LIGHT OF THE DETAILED DESCRIPTION OF THE INVENTION, COULD SATISFACTION ALSO HAVE BEEN FOUND? (DID THE SAME CORRECTED CLAIM INTEND TO ASSERT THAT EITHER OPERATION MAY BE A "SHORT PRESS" OR A "LONG PRESS"?)



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A Container Capable of Carrying 10 Cubic Centimeters of Liquid and/or Solid

Original Article URL: https://www.nakapat.gr.jp/ja/note/10%e7%ab%8b%e6%96%b9%e3%82%bb%e3%83%b3%e3%83%81%e3%83%a1%e3%83%bc%e3%83%88%e3%83%ab%e3%81%ae%e6%b6%b2%e4%bd%93%e5%8f%8a%e3%81%b3-%e5%8f%88%e3%81%af%e5%9b%ba%e4%bd%93%e3%82%92%e9%81%8b%e6%90%ac/

When A and/or B is changed to B by correction, can that constitute an expansion or alteration?

For example:

A container capable of carrying 10 cubic centimeters of liquid and/or solid, perhaps?

The reverse pattern is:

A pattern in which adding language constitutes an expansion or alteration.

For example, "electrically" connected ...

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2024 (Gyo-Ke) No. 10043 [Elasto-Plastic Hysteretic Damper] <Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110043%e3%80%90%e5%bc%be%e5%a1%91%e6%80%a7%e5%b1%a5%e6%ad%b4%e5%9e%8b%e3%83%80%e3%83%b3%e3%83%91%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%ef%bc%9e/

2024 (Gyo-Ke) No. 10043 [Elasto-Plastic Hysteretic Damper] <Honda>

1. <Invention of Exhibit Ko No. 1 + Invention of Exhibit Ko No. 2, etc.>
The plaintiff asserted that it would have been easy to apply the arrangement of the "invention of Exhibit Ko No. 2 (bridge damper)," which accommodates two-dimensional movement, to the "invention of Exhibit Ko No. 1 (building damper)," which accommodates movement in one direction.
However, the invention of Exhibit Ko No. 1 is premised on a load from one direction along the plane of a building structure.
The invention of Exhibit Ko No. 2 is arranged in multiple directions in order to accommodate two-dimensional movement of a bridge.
There is no motivation to apply the arrangement of the invention of Exhibit Ko No. 2 to the invention of Exhibit Ko No. 1; rather, the premise of the invention of Exhibit Ko No. 1 (unidirectional input) creates a disincentive to arranging the components in different orientations.

2. <Invention of Exhibit Ko No. 12 + Invention of Exhibit Ko No. 13>
The invention of Exhibit Ko No. 12 does not have a configuration in which a pair of shear portions is arranged with their orientations differing from each other.
Exhibit Ko No. 13 provides a "recess" in place of a vertical rib, and making only one "recess" results in a configuration in which one portion is recessed and the other is a flat plate; it does not suggest the "pair of shear portions oriented differently from each other" of the invention at issue.

3. <Violation of the Support Requirement>
The plaintiff asserted that the invention at issue is claimed as if it can accommodate "loads from every direction," but that the specification lacks support for accommodating all directions.
⇒ From the description in the specification, a person skilled in the art can recognize that the problem of a conventional damper having only "one shear portion" (such as being able to accommodate only one direction) can be solved by the invention at issue (arranging two shear portions in different orientations).
The invention at issue does not require "maximum energy absorption with respect to loads from all directions."

(Excerpt from the Judgment)
The plaintiff asserts that Corrected Invention 1 at issue is specified only as "when a

load is received by input, it deforms and absorbs energy," and is functionally specified as if it could accommodate a load from any direction, whereas the decision at issue, despite recognizing that Corrected Invention 1 at issue cannot absorb energy from all directions, found no violation of the support requirement, and is erroneous in this respect.
However, even in light of the description in the specification at issue, Corrected Invention 1 at issue cannot be found to require maximum energy absorption with respect to loads from all directions. The plaintiff's assertion is therefore erroneous in its premise and has no merit.

[Supplement] The reason stated in the original article that the corrugated steel plate of Exhibit Ko No. 12 is a single continuous member and therefore differs in configuration is not found in the court's reasoning. The judgment held that "the shear portion" in Claim 2 refers to one of the "pair of shear portions" in Claim 1, and that the invention of Exhibit Ko No. 12 cannot be found to have a configuration in which a pair (two) of such shear portions are arranged in different orientations (judgment, p. 20, lines 10-14). The expression "loads from every direction" in the original article does not appear in the judgment; the plaintiff's assertion as stated in the judgment was that Corrected Invention 1 at issue is functionally specified as if it could accommodate a load from any direction (judgment, p. 23, lines 20-24).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93912.pdf

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Intellectual Property High Court Judgment, 2024 (Ne) No. 10048 [Battery] <Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e7%9f%a5%e8%b2%a1%e9%ab%98%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10048%e3%80%90%e9%9b%bb%e6%b1%a0%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

Intellectual Property High Court Judgment, 2024 (Ne) No. 10048 [Battery] <Nakadaira>

The judgment of the court of first instance awarding damages of JPY 529,285,945 and delay damages, and dismissing the remaining claims, including the claims for an injunction and disposal, was affirmed.

The operative part states: "Both the appeal and the incidental appeal are dismissed." JPY 1,277,650,000 was the amount sought in the incidental appeal, not the amount awarded (judgment, p. 1, line 23; p. 2, lines 11-13; p. 3, lines 9-15).

According to the description in the specification at issue, the power-generating element is not limited to a wound type and includes a laminated type. The claim language "outer surface of the uncoated active-material portion" and "the surfaces are joined" likewise does not exclude joining through a member such as a clip.

⇒ Satisfied

The position of the flange in Exhibit Otsu No. 12 is inseparable from the effect of the invention of Exhibit Otsu No. 12, and cannot be construed as not being limited to the specifically disclosed location. ... Even if combined, the invention at issue would not be reached.

Exhibit Otsu No. 22 does not lead to Configuration A4, in which terminal-connection members are provided on both the positive and negative electrodes. In Exhibit Otsu No. 23, conductor element 5 cannot be said to be outside the battery casing. Nor was motivation to apply these to the invention of Exhibit Otsu No. 9 found (the same applies to the inventions of Exhibit Otsu No. 10 and Exhibit Otsu No. 11).

⇒ Inventive Step: ○

(Excerpt from the Judgment)

According to the statements in [Claim 1] of the claims of the Exhibit Otsu No. 12 publication and the statements in the detailed description of the invention in the Exhibit Otsu No. 12 publication, it is found that the "flange portion" described in the Exhibit Otsu No. 12 publication is provided on the lower surface of the lid body, and that a rotation-preventing portion engaging an engaging portion of the flange portion is provided on the lower surface of the lid body, thereby producing the effect that the terminal pole does not rotate even when an external force is applied to the terminal pole. ...

Further, according to paragraph [0080] of the Exhibit Otsu No. 12 publication, it is also found that an effect of the invention described in that publication is that, by interposing

an annular packing between the upper surface of a planar flange portion integrally formed with the terminal pole and the lower surface of the lid body, and by locking an annular compression spring to the pole portion to secure the terminal pole to the lid body, the annular packing is compressed in the vertical direction, thereby allowing the terminal pole to be securely sealed and fixed to the lid plate.
Thus, in the invention described in the Exhibit Otsu No. 12 publication, the provision of the flange portion on the lower surface of the lid body is closely related to the effect of the invention. Accordingly, ... the Exhibit Otsu No. 12 publication is found to disclose a configuration in which the flange portion is provided on the lower surface of the lid body; it cannot be said that the Exhibit Otsu No. 12 publication effectively discloses a configuration corresponding to Claim Element A4 of Invention 1 at issue; it also cannot be said that whether to install the flange portion inside or outside the container is a matter of design; and applying the Exhibit Otsu No. 12 configuration to the invention of Exhibit Otsu No. 9 does not reach the configuration of Invention 1 at issue.

[Supplement] The statement in the original article that the court affirmed the first-instance judgment granting an injunction plus JPY 1.27 billion differs from the judgment. The first-instance judgment granted the damages claim to the extent of JPY 529,285,945 and delay damages and dismissed the remaining claims (judgment, p. 3, lines 9-15), and JPY 1,277,650,000 was the amount sought in the incidental appeal (judgment, p. 2, lines 11-13). The claims for an injunction and disposal were directed at the appellant's Product 2 on the basis of Patent 2 at issue (judgment, p. 2, line 26 to p. 3, line 1), and the appellant's Product 2 was found not to fall within the technical scope of Invention 2 at issue, with equivalence also rejected (judgment, p. 28, lines 23-25). Further, of the statement in the original article that Exhibits Otsu Nos. 22 and 23 do not reach Configuration A4 in which terminal-connection members are provided on both electrodes, the point concerning both electrodes is a reason relating to Exhibit Otsu No. 22 (judgment, p. 38, lines 19-24); as to Exhibit Otsu No. 23, the judgment held that it could not be found to have a configuration corresponding to Claim Element A4 because conductive element 5 could not be said to be arranged outside the battery casing (judgment, p. 39, lines 13-16; p. 40, lines 2-3).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94167.pdf

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[Plant Variety Protection and Seed Act ★] Case in Which the Plaintiff's Claims Were Dismissed Because the Credibility of the Expert Appraisal Purporting to Prove Infringement of the Breeder's Right Was Not Established

Original Article URL:
https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e7%a8%ae%e8%8b%97%e6%b3%95%e2%98%85%e3%80%91%e8%82%b2%e6%88%90%e8%80%85%e6%a8%a9%e4%be%b5%e5%ae%b3%e3%82%92%e7%ab%8b%e8%a8%bc%e3%81%99%e3%82%8b%e9%91%91%e5%ae%9a%e3%81%ae%e4%bf%a1%e7%94%a8/

Tokyo District Court Judgment of April 24, 2025 (2022 (Wa) No. 2829) (Presiding Judge Motoyuki Nakashima)

◆ Full Text of the Judgment

[Overview of the Case]
The plaintiff held a breeder's right in a shiitake mushroom variety (Registration No. 17039) and sought, jointly and severally, payment of JPY 55,485,724 in damages and delay damages under Articles 709 and 719(1) of the Civil Code, alleging that the defendants' importation and transfer of mushroom culture beds and their production and transfer of shiitake mushrooms infringed the plaintiff's breeder's right.

The court narrowed the core issues to: (1) whether mycelium could have been mixed in advance into the culture medium in the test tubes prepared by the plaintiff itself; and (2) why the plaintiff disposed of the parent strain and whether that disposal was appropriate. This judgment held that the possibility that the plaintiff had mixed mycelium of the plaintiff's variety into the test tubes at issue in advance could not be sufficiently excluded, that the results of the expert appraisal premised thereon should be found to lack credibility, and that, without needing to decide the remaining points, the plaintiff's claims lacked merit; it therefore dismissed the plaintiff's claims.

[Preliminary Explanation Based on Prior Judicial Decisions—Proof of Infringement of a Breeder's Right under the Plant Variety Protection and Seed Act]
A "variety" protected by the variety-registration system under the Plant Variety Protection and Seed Act means a single grouping of plants that can be distinguished from other groupings of plants by all or part of its characteristics and can be propagated while retaining all of those characteristics (Article 2(2) of the Act). This makes the actually existing grouping of plants itself the object of legal protection. With respect to the scope of a breeder's right, the Act provides that the holder has the exclusive right to exploit, as a business, "the variety for which variety registration has been obtained (hereinafter referred to as the 'registered variety') and any variety that is not clearly distinguishable from the registered variety by its characteristics" (Article 20(1) of the Act). A "variety that is not clearly distinguishable from the registered variety by its characteristics" means a variety that differs in characteristics from the registered

variety but lacks a clear difference of a degree sufficient to establish distinctness as a requirement for variety registration. Specifically, it is understood that a variety whose differences in characteristics from the registered variety remain within the class values established for each characteristic (numerical values classifying characteristics by class; for example, where the registered variety is a strawberry, characteristics include the "ratio of fruit length to width," "fruit size," and "fruit-skin color") will often fall within a "variety that is not clearly distinguishable from the registered variety by its characteristics." Even where the differences in characteristics do not remain within the foregoing range, it has also been held that there may be cases in which a variety can be found to fall within a "variety that is not clearly distinguishable from the registered variety by its characteristics" through comprehensive consideration of the differing items and the degree of difference, the type and nature of the plant, and other matters. It has also been held that "in order to determine whether a variety is one to which the effect of a breeder's right extends, it is ultimately necessary to compare the plants themselves and examine whether the variety suspected of infringement is not clearly distinguishable from the registered variety by its characteristics (the actual-object principle)" (Intellectual Property High Court Judgment of June 24, 2015, 2015 (Ne) No. 10002, Appeal in an Action Seeking an Injunction Against Infringement of a Breeder's Right; court of first instance: Tokyo District Court Judgment of November 28, 2014, 2009 (Wa) No. 47799 / 2013 (Wa) No. 21905). Under the amended Plant Variety Protection and Seed Act effective in 2022, a presumption concerning the scope of a breeder’s right using examination characteristics and a determination system administered by the Minister of Agriculture, Forestry and Fisheries were introduced. The foregoing explains prior judicial decisions and does not mean that only comparison of the actual plants is always permitted under the current system.

[Summary of the Judgment]
1. Determination Concerning the Credibility of the Subculturing Acts at Issue and Related Acts
According to the foregoing basic facts, the foregoing findings of fact, and the entire purport of the oral argument, it is found that the expert appraisal at issue was conducted on mycelium that had been separated from each accused product and subcultured through each separation act at issue, each subculturing act at issue, and the multiple subculturing acts subsequently performed (hereinafter collectively referred to as the "Subculturing Acts at Issue and Related Acts"). Accordingly, as a premise for determining the credibility of the expert appraisal at issue, the credibility of the Subculturing Acts at Issue and Related Acts (Issue 1-1) is examined.
... In view of the fact that the plaintiff deliberately prepared the test tubes at issue in advance within its own company, rather than at a third-party institution such as the Center for Seeds and Seedlings, NARO, and therefore had sufficient time to mix in mycelium of the plaintiff's variety, it must be said that it was fully possible to mix

mycelium of the plaintiff's variety, of a size not visible to the naked eye, into the test tubes at issue in advance. Moreover, according to the foregoing findings of fact and the entire purport of the oral argument, after the Subculturing Acts at Issue and Related Acts, the plaintiff itself disposed of the parent strain at issue or caused the Center for Seeds and Seedlings, NARO to dispose of it, and has not explained any reasonable ground for doing so. It is therefore found that the plaintiff itself made subsequent verification of the Subculturing Acts at Issue and Related Acts impossible. Considering these circumstances as a whole, the possibility that the plaintiff had mixed mycelium of the plaintiff's variety into the test tubes at issue in advance cannot be sufficiently excluded, and it is appropriate to find that the results of the expert appraisal at issue, which are premised thereon, lack credibility.

2. Other Matters

The Subculturing Acts at Issue and Related Acts should, by their nature, have been conducted by a fair and neutral third-party institution. Even if circumstances made it unavoidable to conduct them within the plaintiff's own company, the defendants are correct that conducting them within the plaintiff's own company inherently created a risk of mixing fungal strains or substituting test tubes. In light also of the matters explained above, when conducting the Subculturing Acts at Issue and Related Acts, it was indispensable, at a minimum, to have a third-party institution such as the Center for Seeds and Seedlings, NARO prepare the test tubes and to preserve the parent strain without disposing of it, given the importance of fairness and transparency in expert appraisals in judicial proceedings. Nevertheless, the plaintiff deliberately failed to take those measures, gave no reasonable explanation of the necessity and appropriateness of preparing the test tubes at issue itself, and, with respect to disposal of the parent strain at issue, merely explained that the parent strain had become unnecessary after the mycelium was subcultured and was therefore disposed of, and that there was no problem. Accordingly, at least the Subculturing Acts at Issue and Related Acts lack credibility, as explained above, and the expert appraisal at issue premised thereon must likewise be said to lack credibility.

[Comment]

This is a valuable judicial decision addressing the credibility of an expert appraisal as evidence proving infringement in a breeder's-right infringement action. In proof under the actual-object principle indicated by prior judicial decisions, an expert appraisal involving comparative cultivation of the registered variety and the variety suspected of infringement is important. The method of proof must be considered according to the case, also taking account of the presumption based on examination characteristics and the determination system effective in 2022. In this regard, the Center for Seeds and Seedlings, NARO (https://www.naro.go.jp/laboratory/ncss/) is an institution that, under Article 15-2(1) of the Plant Variety Protection and Seed Act, conducts "growing tests" to obtain data, such as distinctness between an applied-for variety and existing

varieties, necessary for the national government's examination of variety registration, and has an extremely high level of expertise in comparative growing tests. Litigation parties are therefore thought often to request an expert appraisal from the Center for Seeds and Seedlings, NARO as a fair and neutral third-party institution. This judgment demonstrates the importance, in doing so, of conducting the expert appraisal with extreme care, including asking the institution conducting the expert appraisal to prepare the test tubes and asking a third party to preserve the parent strain after the expert appraisal.
[Supplement] Reference: Ministry of Agriculture, Forestry and Fisheries, Overview of the Act Partially Amending the Plant Variety Protection and Seed Act: https://www.maff.go.jp/j/shokusan/attach/pdf/shubyoho-22.pdf
[Supplement] The Act Partially Amending the Plant Variety Protection and Seed Act (Act No. 74 of 2020) introduced a provision presuming that a variety not clearly distinguishable by the examination characteristics of a registered variety recorded in the variety registry is a variety not clearly distinguishable from that registered variety by its characteristics (Article 35-2 of the Act) and a system of determination by the Minister of Agriculture, Forestry and Fisheries (Article 35-3 of the Act), both effective April 1, 2022. These provisions provide means of proof other than an expert appraisal involving comparative cultivation. This judgment does not refer to these provisions. Since April 1, 2022, the provision under which NARO (the Center for Seeds and Seedlings) conducts growing tests has been Article 15-2(1) of the Act. Further, what the judgment held to be indispensable was, when conducting the Subculturing Acts at Issue and Related Acts, to have a third-party institution prepare the test tubes and to preserve the parent strain without disposing of it (judgment, p. 22, lines 15-19), and preservation of the parent strain was required for subsequent verification of the subculturing acts (judgment, p. 22, lines 3-7).

[Keywords] Breeder's Right, Credibility of an Expert Appraisal, Actual-Object Principle
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2024 (Ne) No. 10056 [Van-Type Motor Vehicle for Cleaning Work] <Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10056%e3%80%90%e6%b4%97%e6%b5%84%e4%bd%9c%e6%a5%ad%e7%94%a8%e3%83%90%e3%83%b3%e5%9e%8b%e8%87%aa%e5%8b%95%e8%bb%8a%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2024 (Ne) No. 10056 [Van-Type Motor Vehicle for Cleaning Work] <Nakadaira>

* The appellee offered for sale Product 2, which differed from Product 1 sold by KCS. Product 2 was also found infringing at first instance, and an injunction and disposal were ordered; the appellee did not appeal. ⇒ The offer for sale was not found to have assisted or facilitated KCS's sales of Product 1, and a joint tort was denied.

(Excerpt from the Judgment)

Even if the appellee received delivery of Appellee Product 2 from KCS and offered it for sale under the name "ECO ACE JET," which differs from the name of Appellee Product 1 sold by KCS, it cannot be found that this assisted or facilitated KCS's sale of Appellee Product 1.

[Supplement] Regarding the statement in the original article that the appellee offered for sale a product different from the infringing product, the first-instance judgment also found Appellee Product 2 to fall within the technical scope of the invention and granted an injunction against its transfer and the like and an order for its disposal against the appellee (judgment, p. 2, line 26 to p. 3, line 4), and the appellee did not appeal (judgment, p. 4, lines 2-3). In the judgment, the excerpt above is followed by a parenthetical stating that this conclusion would not change even if the structure, performance, and the like of the vehicle and cleaning device of Appellee Product 2 were the same as those of Appellee Product 1 (judgment, p. 11, lines 7-9).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93950.pdf

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[New YouTube Video] Infringement Analysis (Other than Typical Literal Satisfaction) (Reading Through the Encyclopedia of Patent Judicial Decisions, 4th Edition) November 5, 2025

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e6%96%b0%e7%9d%80youtube%e3%80%91%e5%85%85%e8%b6%b3%e8%ab%96%ef%bc%88%e5%85%b8%e5%9e%8b%e7%9a%84%e3%81%aa%e6%96%87%e8%a8%80%e5%85%85%e8%b6%b3%e4%bb%a5%e5%a4%96%ef%bc%89%ef%bc%88%e7%89%b9/

[New YouTube Video] Infringement Analysis (Other than Typical Literal Satisfaction) (Reading Through the Encyclopedia of Patent Judicial Decisions, 4th Edition) November 5, 2025

<Catch up at once, in this single video, on the principal judicial decisions concerning infringement analysis, including the doctrine of equivalents, numerical limitations, and use inventions.>

https://youtu.be/IxWjTUBHpGQ

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[Contract] Tokyo District Court Judgment, 2022 (Wa) No. 9422 <Shibuya>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%a5%91%e7%b4%84%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c4%e5%b9%b4%e3%83%af9422%ef%bc%9c%e6%be%81%e8%b0%b7%ef%bc%9e/

[Contract] Tokyo District Court Judgment, 2022 (Wa) No. 9422 <Shibuya>

The defendant was found to have been in a "state of being objectively unable to pay" (Article 17(2) of the contract at issue), and the termination was held valid.

"According to the evidence (Exhibits Ko Nos. 27, 28, and 30), it can be found that, no later than February 7, 2025, the defendant was in a state of being objectively unable to pay."

[Supplement] The defendant stated that it did not actively dispute the ground for termination (judgment, p. 3, line 3). The judgment held that the contract at issue, a joint development and business alliance agreement, ended upon termination on February 7, 2025, and ordered payment of the contract fee of JPY 210 million and interest (judgment, p. 1, lines 10-11; p. 2, lines 1-2; p. 3, lines 7-10).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94059.pdf

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Tokyo District Court Judgment, 2023 (Wa) No. 70449 [Fastening Hardware] <Takahashi>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70449%e3%80%90%e7%b7%a0%e7%b5%90%e9%87%91%e7%89%a9%e3%80%91%ef%bc%9c%e9%ab%99%e6%a9%8b%ef%bc%9e/

Tokyo District Court Judgment, 2023 (Wa) No. 70449 [Fastening Hardware] <Takahashi>

The claim language "in order to induce deformation when an excessive load acts" does not limit the configuration of the invention.
("It merely indicates the purpose sought to be achieved, or an action or effect necessarily obtained, by the configuration in which the front portion and the rear-edge portion are integrated by a plurality of branch-shaped portions, and has no meaning that limits the configuration of the invention.")

⇒ Novelty: × based on the design publication
("Because the plurality of narrow plate portions of the column-member connecting fitting of the invention of Exhibit Ko No. 5 have a configuration identical in shape to the plurality of branch-shaped portions of the fastening hardware of the invention at issue, they necessarily obtain the action or effect expressed as 'in order to induce deformation when an excessive load acts.' ..."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94135.pdf

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Osaka District Court Judgment, 2023 (Wa) No. 10217 [Three-Dimensional Network Fiber Assembly] <Matsuami>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af10217%e3%80%90%e7%ab%8b%e4%bd%93%e7%b6%b2%e7%8a%b6%e7%b9%8a%e7%b6%ad%e9%9b%86%e5%90%88%e4%bd%93%e3%80%91%ef%bc%9c%e6%9d%be/

Osaka District Court Judgment, 2023 (Wa) No. 10217 [Three-Dimensional Network Fiber Assembly] <Matsuami>

Action Seeking Remuneration for an Employee Invention
⇒ Dismissed

(Excerpt from the Judgment)
Because the reward rules at issue were established after, in the course of their establishment and amendment, general employment rules and the like had been referred to, opinions had been obtained from persons knowledgeable about intellectual property, drafts had been disclosed to employees and others, and opinions had been heard, it cannot be found unreasonable for the defendant to pay remuneration for employee inventions made at the defendant in accordance with the reward rules at issue, which were established through lawful procedures. ...
Although it appears that the defendant's product had some possibility of being used as a cushioning material or the like as a general-purpose three-dimensional network fiber assembly, in the application as a bedding mattress asserted by the plaintiffs as the basis for excess sales, the product was once commercialized and achieved sales for a certain period, but appears to have received a low evaluation for its performance as a mattress, and commercialization was terminated. ...
Under these circumstances, there is nothing unreasonable in the defendant's determination that the condition for payment of an implementation reward—"when, through the exercise of an industrial property right, a major contribution has been made to the company"—was not met and that no implementation reward should be paid for the inventions at issue.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94104.pdf

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[Employee Invention] Tokyo District Court Judgment, 2023 (Wa) No. 70495 <Nakashima>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%81%b7%e5%8b%99%e7%99%ba%e6%98%8e%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70495%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e/

[Employee Invention] Tokyo District Court Judgment, 2023 (Wa) No. 70495 <Nakashima>

* The plaintiff was not recognized as a joint inventor.
—There was no reliable evidence substantiating the time of completion asserted by the plaintiff.

(Excerpt from the Judgment)
Although the plaintiff asserts that the plaintiff's invention was completed before the plaintiff prepared the plaintiff's explanatory document, there is no reliable evidence substantiating that assertion, and the invention at issue was, in the first place, conceived and reduced to a specific form without the plaintiff's involvement. ...
In addition, even after two rounds of assertions and evidence by both parties, the Court found that the actual nature of the plaintiff's involvement in the invention at issue remained unclear and repeatedly sought clarification ... from both parties on two occasions. Even after fully considering the results, in view of the actual nature of the plaintiff's involvement and other circumstances, the invention at issue was conceived and reduced to a specific form without the plaintiff's involvement, and the plaintiff cannot be found to be an inventor or joint inventor of the invention at issue.

[Supplement] According to the judgment, the plaintiff asserted the time of completion of the invention (judgment, p. 15, lines 17-18). However, the main reason in the judgment is the finding that the invention at issue had been independently conceived and embodied by Bi, Di, and others without the plaintiff's involvement (judgment, p. 14, lines 21-23).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94170.pdf

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Osaka District Court Judgment, 2022 (Wa) No. 11405 [Heterocyclic Derivative] <Takemiya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c4%e5%b9%b4%e3%83%af11405%e3%80%90%e8%a4%87%e7%b4%a0%e7%92%b0%e8%aa%98%e5%b0%8e%e4%bd%93%e3%80%91%ef%bc%9c%e6%ad%a6%e5%ae%ae%ef%bc%9e/

Osaka District Court Judgment, 2022 (Wa) No. 11405 [Heterocyclic Derivative] <Takemiya>

[Claim for Remuneration for an Employee Invention] Approximately JPY 94 million awarded.
* The employee-invention rules are redacted and unclear, but they were not applied to this invention.
⇒ Patent Act prior to the 2004 amendment
(Reason) Although the defendant had employee-invention rules, no agreement to apply them to a case such as the invention at issue was found, and the statutory "reasonable remuneration" was to be calculated.

Employer's own working portion (the calculation base includes domestic sales and amounts relating to Actelion):
(Excess sales) × (hypothetical royalty rate of 5.9%) × (1 − employer contribution rate of 99%) × (co-inventor's share of 1/3)

Third-party working portion (license revenue):
(License revenue) × (1 − employer contribution rate of 99%) × (patent contribution rate of 25%*) × (co-inventor's share of 1/3)
<* Considering the subject matter of the agreement and other circumstances, the court held that the contribution of the patent at issue did not exceed 25%. Part of the agreement’s contents is redacted in the published judgment.>

(Excerpt from the Judgment)
The employee-invention rules at issue provide that ●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●●

However, the employee-invention rules at issue contain no provision stating that the rules also apply to inventions, such as the invention at issue, that do not fall within the inventions described in the foregoing provision, and the record contains no evidence sufficient to find that an agreement was reached between the plaintiff and the defendant to apply the employee-invention rules at issue to such an invention.

[Supplement] Regarding "Employer's own working portion (domestic sales)" in the original article, the judgment held that, in addition to sales of the pharmaceutical at issue in Japan, the amount relating to Actelion (the content of which is redacted in the judgment) should also be included in the sales on which reasonable remuneration is calculated (judgment, p. 30, lines 17-21; p. 31, lines 6-7). The specific subject matter of

the license agreement is redacted in the judgment, and the published judgment does not identify that subject matter as know-how and data provision. The judgment held that the patent's contribution ratio did not exceed 25%, taking into account the technical information at issue, securing of a safety-monitoring system, and other matters (judgment, p. 35, lines 2-24). The awarded amount of approximately JPY 94 million is after deducting JPY 6,519,000 already paid (judgment, p. 36, lines 7-12).
https://t.co/fG0Rvflzyf

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2023 (Ne) No. 10107 "PCSK9 (Second Litigation)" <Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c%ef%bc%95%e5%b9%b4%e3%83%8d10107%e3%80%8epcsk9%ef%bc%88%e4%ba%8c%e6%ac%a1%e8%a8%b4%e8%a8%9f%ef%bc%89%e3%80%8f%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2023 (Ne) No. 10107 "PCSK9 (Second Litigation)" <Nakadaira>

* In the second litigation, declarations and empirical experiments by Dr B and Dr C and other materials were newly submitted, resulting in a finding of violation of the support requirement.

Amgen's patented invention does not limit the specific structure of the antibody (amino-acid sequence), but is an antibody defined by the following functions:
1. Neutralizes: inhibits binding between PCSK9 and LDLR.
2. Competes: competes for binding to PCSK9 with a specified "reference antibody (such as 21B12)" created by Amgen.

The court found that "competes" includes the following two patterns:
1. Direct competition (Direct Blocking): binds to the "same site" as the reference antibody and interferes with it.
2. Competition through steric hindrance (Steric Hindrance): binds to a "different site" from the reference antibody, but, because of the antibody's large size, physically interferes with and inhibits binding.

The specification at issue described "antibodies that bind to the same site (1 above)," but did not contain sufficient disclosure (support) as to whether "antibodies that bind to a different site and interfere through steric hindrance (2 above)" actually have a neutralizing action.
⇒ Violation of the support requirement

[Appellee's submission] The appellee submitted that, even if conditions concerning neutralization or competition by Fab fragments were added, the possibility of including antibodies that compete through steric hindrance and bind to different sites would remain (judgment, p. 41, line 19 to p. 44, line 2). [Supplement] Correction Items 3 and 4 add conditions concerning neutralization and competition, respectively, by the Fab fragments of the antibody; they do not limit the subject matter of the invention to Fab fragments themselves (judgment, p. 12, line 20 to p. 13, line 3).
[Court's holding] The court held that Correction Items 1 and 2 did not fall within the purposes of correction specified in the proviso to Article 134-2(1) of the Patent Act and stated: "Without needing to decide the remaining correction items, the appellant's rebuttal based on correction is without merit" (judgment, p. 67, lines 5-8 and 17-19). Accordingly, the court did not individually examine Correction Items 3 and 4 concerning Fab fragments and then decide a violation of the support requirement after those corrections.

[Supplement] The original article stated that, even if limited to Fab fragments by the correction, the possibility of including antibodies that compete through steric hindrance but bind to different sites would remain. That sentence presented the appellee's submission (judgment, p. 41, line 19 to p. 44, line 2) as if it were the court's holding and summarized Correction Items 3 and 4 as limiting the invention to Fab fragments. Further, regarding the professor's technical opinion mentioned in the original article, the judgment relied on the statements (verification experiments) of Dr. B and Dr. C (judgment, p. 54, line 25 to p. 55, line 10), and the published judgment does not state that they were professors. The "same site" in the original article is, in the judgment, a site on PCSK9 that is identical to or overlaps with the site at which the reference antibody binds to PCSK9 (judgment, p. 49, lines 10-11). The main reasons for the violation of the support requirement are that an antibody competing with a reference antibody cannot be said to neutralize by the same mechanism as the reference antibody (judgment, p. 53, line 13 to p. 54, line 4) and that, in the verification experiments, roughly 80% or more of the antibodies competing with the reference antibodies lacked binding-neutralizing activity (judgment, p. 55, lines 2-10).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94092.pdf

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Tokyo District Court Judgment, 2022 (Wa) No. 7976 [Communication Equipment] <Nakashima>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c4%e5%b9%b4%e3%83%af7976%e5%8f%b7%e3%80%90%e9%80%9a%e4%bf%a1%e6%a9%9f%e5%99%a8%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e/

Tokyo District Court Judgment, 2022 (Wa) No. 7976 [Communication Equipment] <Nakashima>

* Standard-essential patent—infringement.

⇒ The claim for an injunction constituted an abuse of rights (the parties failed to reach agreement because of the difference in royalty rates, and it could not be said that the defendant lacked willingness to obtain a license).

⇒ Damages were calculated as: "Sales of the accused products × aggregate royalty rate for the entire LTE standard ÷ total number of patents for the entire LTE standard (1,300 patents) × number of patents at issue (two patents counted as one because they belong to the same patent family)."

As to the "aggregate royalty rate for the entire LTE standard," the rate was 9% for products supporting LTE only and 8% for 5G-compatible products (because LTE's relative contribution is lower).

An increase based on an infringement premium (Article 102(4) of the Patent Act) was not allowed because the defendant was willing to obtain a licence on FRAND terms.

[Supplement] The patents at issue are two patents, Patent 1 and Patent 2 at issue (judgment, p. 2, lines 9-10); because they belong to the same patent family, the court held that they should be counted as one patent to match the unit of the 1,300 patents (judgment, p. 115, lines 18-22). An increase based on an infringement premium was not allowed because the defendant had been willing to take a license on FRAND terms (judgment, p. 112, lines 18-22).

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2024 (Ne) No. 10074 [Filler for Electronic Cigarette] <Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10074%e3%80%90%e9%9b%bb%e5%ad%90%e3%82%bf%e3%83%90%e3%82%b3%e7%94%a8%e5%85%85%e5%a1%ab%e7%89%a9%e3%80%91%ef%bc%9c%e5%a2%97%e7%94%b0%ef%bc%9e/

2024 (Ne) No. 10074 [Filler for Electronic Cigarette] <Masuda>

A review of the entries in various dictionaries on the meaning of "cut" (kirikomi) (Claim Element B) shows that they contemplate the active acts of "cutting into," "making a score," and "cutting," and several examples expressly state that the act is performed with a blade.

Accordingly, "cut" (kirikomi) means a structure or state in which a "score" or "slit" (kirime/kireme) has been artificially and actively formed using a blade.

The specification at issue merely gives examples such as a cutter blade, razor blade, and rotary cutter as means for forming the cuts, and contains no description or suggestion of any means of formation other than a blade.

⇒ Turning to the accused product, the three streak-like portions formed on the surface of the tobacco substrate, substantially parallel to one another, along the longitudinal direction of the tobacco stick (rod) were formed by controlling crimping conditions in the crimping process and were not formed by a blade.

⇒ Claim Element Not Satisfied (for the same reasons as the court of first instance, Tokyo District Court Judgment, 2023 (Wa) No. 70407)

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2024 (Gyo-Ke) No. 10109 [Assistance Device] <Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110109%e3%80%90%e4%bb%8b%e5%8a%a9%e6%a9%9f%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%ef%bc%9e/

2024 (Gyo-Ke) No. 10109 [Assistance Device] <Honda>

The subject of the petition for retrial is understood to be the original decision. The fact that the original decision, which became final before the fourth retrial decision, conflicts with the fourth retrial decision does not constitute a ground for retrial of the original decision under Article 338(1)(x) of the Code of Civil Procedure, as applied mutatis mutandis by Article 171(2) of the Patent Act.

Even assuming that the plaintiff's position is construed as making the fourth retrial decision the subject of the petition for retrial and asserting, as a ground for retrial, that it conflicts with the original decision, the original decision was a decision finding the appeal against the examiner's decision of refusal unsuccessful, whereas the fourth retrial decision was a decision dismissing the petition for retrial as unlawful. The fourth retrial decision therefore does not conflict with the original decision, and the plaintiff's claim has no merit.

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Tokyo District Court Judgment, 2024 (Gyo-U) No. 5001 <Shibuya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e6%b1%ba%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%a65001%ef%bc%9c%e6%be%81%e8%b0%b7%ef%bc%9e/

Tokyo District Court Judgment, 2024 (Gyo-U) No. 5001 <Shibuya>

Date of judgment: April 18, 2025.

The plaintiff, having filed an international patent application (PCT application), made a "request for examination" before submitting the "translation" prescribed by the Patent Act. The JPO dismissed the request as unlawful, and the plaintiff sought revocation of that disposition.

⇒ Action dismissed as inadmissible.

Article 184-17 of the Patent Act provides that, for a foreign-language patent application, a request for examination may not be made until "after" procedures such as submission of a translation have been completed.

This provision makes submission of a translation before a request for examination a procedural requirement, and a defect (error) in that sequence is not cured by subsequently submitting the translation.

In this case, it is clear that the translation had not been submitted when examination was requested.

Even if the court were to revoke the disposition at issue, the fact that the request for examination violated the Act would remain unchanged, and there would be no possibility of curing the defect. The JPO would therefore have no choice but to dismiss the request again. Revocation of the disposition at issue would accordingly provide no practical benefit to the plaintiff, and there is no legal interest in bringing the action.

[Supplement] The heading of the original article describes this case as a decision (kettei), but it is a judgment, rendered on April 18, 2025 (judgment, p. 1, line 1).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94034.pdf

* This article provides general information and does not include legal advice.

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2024 (Gyo-Ke) No. 10022 [... Antimicrobial Agent] <Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110022%e3%80%90%e6%8a%97%e5%be%ae%e7%94%9f%e7%89%a9%e5%89%a4%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%ef%bc%9e/

2024 (Gyo-Ke) No. 10022 [... Antimicrobial Agent] <Honda>

In order for it to have been obvious to change the treatment target of the primary cited invention (from tinea pedis or a cutaneous fungal disease) to "onychomycosis" and thereby adopt the configuration relating to the difference,
in light of the technical level at the filing date of the application at issue,
it is necessary that, when the therapeutic agent is simply applied to the nail plate, it could reasonably have been expected that the active ingredient KP-103 would penetrate and permeate into the interior of the nail plate, be delivered to the lower layer of the nail plate and the nail bed, which are the infected sites, and exert a therapeutic effect.

⇒ Inventive Step of the Medical-Use Invention: ○

(Summary of the Judgment)

(1) As common general technical knowledge at the filing date of the application at issue, it is found that: (i) Trichophyton rubrum and Trichophyton mentagrophytes accounted for most of the causative fungi of onychomycosis, as they did for tinea pedis; (ii) in order to treat onychomycosis effectively with a topical agent, it was necessary to cause the antifungal agent to penetrate the keratin of the nail plate and deliver it to the infected site, but, because of the nature of the nail plate, there was an obstacle in that antifungal agents did not readily penetrate or permeate into its interior, and treatment of onychomycosis with a topical agent was considered extremely difficult, while oral agents also presented problems of side effects and development of a topical agent was awaited; and (iii) both nails and hair contain hard keratin and have mutually similar amino-acid compositions.

(2) As technical findings known at the filing date of the application at issue, it is found that: (iv) attempts to deliver a topical antifungal agent to the infected site included development of nail-lacquer preparations and treatments involving chemical or surgical removal of the nail plate, application of an antifungal agent, and use in combination with occlusive dressing therapy (ODT); (v) the Exhibit Ko No. 6 study evaluating the antifungal agent tioconazole as a topical therapeutic agent for onychomycosis had been conducted; (vi) KP-103 had properties such as low adsorption to keratin and high release, without reduction of its anti-Trichophyton mentagrophytes activity even when human hair (keratin) was added; and (vii) there had been research using human hair to evaluate adsorption of antifungal drugs to keratin and reduction in activity upon adsorption to keratin.

(3) (Summary of the judgment) In order for a person skilled in the art to have readily conceived of changing the treatment target of the topical fungal-disease therapeutic agent of the primary cited invention (the invention of Exhibit Ko No. 1-1) to "onychomycosis" and adopting the configuration of the corrected invention at issue relating to the difference, in light of the technical level at the filing date of the application at issue, it is necessary that, when the therapeutic agent is simply applied to the nail plate, it could reasonably have been expected that the active ingredient KP-103 would penetrate and permeate into the interior of the nail plate, be delivered to the lower layer of the nail plate and the nail bed, which are the infected sites, and exert a therapeutic effect. Considering the common general technical knowledge and technical findings in (1) and (2) above as a whole, it cannot be said that a person skilled in the art could reasonably have had such an expectation at the filing date of the application at issue. Further, in light of the common general technical knowledge at the filing date of the application at issue, it would have been difficult for a person skilled in the art to predict the effects of the corrected invention at issue shown in the specification at issue and the like. Accordingly, at the filing date of the application at issue, a person skilled in the art could not readily have made the corrected invention at issue based on the invention of Exhibit Ko No. 1-1.

[Supplement] The second and subsequent sentences of (3) summarize the judgment rather than quote its original text. Further, regarding "external dermatomycosis" in the original article, the treatment target of the invention of Exhibit Ko No. 1-2 is dermatomycosis (judgment, p. 34, lines 4-5).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94078.pdf

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2024 (Ne) No. 10029 "Claim for Confirmation of the Right to Obtain a Patent" <Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%8d10029%e3%80%8e%e7%89%b9%e8%a8%b1%e3%82%92%e5%8f%97%e3%81%91%e3%82%8b%e6%a8%a9%e5%88%a9%e3%81%ae%e7%a2%ba%e8%aa%8d%e8%ab%8b%e6%b1%82%e3%80%8f%ef%bc%9c%e5%a2%97/

2024 (Ne) No. 10029 "Claim for Confirmation of the Right to Obtain a Patent" <Masuda>

Date of judgment: April 24, 2025.

* Y1 graduated from the Faculty of Environment and Information Studies at Keio University and started a business, but had no clinical knowledge.

⇒ Inventorship: ×

(The cooperating professor was the inventor.)

<Inventorship (Employee Invention)>

It is necessary to have actually participated in the creative act concerning the technical idea of the invention, particularly in completing the characteristic portion of the invention relating to the means for solving the prior technical problem.

The characteristic portion of Invention 1-3 at issue lies in the following: in a vascular plug comprising a pusher wire and a mesh portion for embolizing an aneurysm in order to prevent rupture of an aneurysm within a blood vessel, there were problems in that multiple vascular plugs of different sizes had to be prepared and that rapid expansion of the mesh portion risked damaging the aneurysm; therefore, a configuration was adopted in which, when not housed, the distal end of the stent is pushed out from the distal end of the catheter and expands while curling outward; this provides a high degree of freedom in size with respect to the aneurysm and does not damage a bifurcation aneurysm.

Y1 graduated from a humanities faculty and, after working for a financial institution, established the plaintiff company in the first instance together with Y1's elder brother, who held a doctorate in science; Y1, however, had no clinical knowledge.

By contrast, Professor A, who was a cooperating party, had extensive clinical experience, and Professor A's research notebook clearly described the problems and means for solving them in Invention 1-3 at issue. It is therefore appropriate to find that Professor A actually participated in completing the characteristic portion of Invention 1-3 at issue.

<Claim for Confirmation of the Right to Obtain a Patent Relating to a PCT Application>

The plaintiff in the first instance states that, after obtaining a judgment in this action confirming the right to obtain a patent, it will select, from among the Contracting States to the Patent Cooperation Treaty, the countries or regions in which it actually wishes to obtain patents and pursue new applications or procedures for restoration of rights.

However, in light of the principle of territoriality, how a right to obtain a patent is treated and what effect it has in foreign countries are understood to be determined by the law of the country in which a patent right is registered on the basis of that right to obtain a patent. At present, no new application, national-phase entry, or the like has been made for the invention in any foreign country, and no specific plan has been disclosed. Accordingly, ripeness of the dispute cannot be found with respect to confirmation of the right to obtain a patent for the invention.

[Supplement] The heading of the original article reads "2025 (Ne) No. 10029," but the case number of the judgment is 2024 (Ne) No. 10029 (judgment, p. 1, line 2). The reference to a humanities faculty in the original article does not appear in the judgment. The judgment found that Y1 graduated from the Faculty of Environment and Information Studies of Keio University and, after working at a bank, started a business (judgment, p. 23, lines 11-13), and held that Y1 could not be found to have such a background (judgment, p. 25, lines 17-21).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94055.pdf

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2023 (Gyo-Ke) No. 10078 [Audio Controller] <Shimizu> (Defendant: Pixie Dust)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e8%a1%8c%e3%82%b110078%e3%80%90%e3%82%aa%e3%83%bc%e3%83%87%e3%82%a3%e3%82%aa%e3%82%b3%e3%83%b3%e3%83%88%e3%83%ad%e3%83%bc%e3%83%a9%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4/

2023 (Gyo-Ke) No. 10078 [Audio Controller] <Shimizu> (Defendant: Pixie Dust)

C (the contractor) merely solved a problem different from that of the invention at issue.
⇒ Neither misappropriation nor violation of the joint-application requirement was established.

(Supplement: A and B were on the commissioning side (PDT).) (Excerpt from the Judgment)

It is found that A and B had conceived of a "phased-array speaker" before PDT placed an order with the plaintiff for the prototype at issue. ... A and B were researchers in ultrasound and are found to have understood the basic principle of the conventional parametric speaker. They had also developed the experimental device at issue, which, although subject to certain limitations, could generate audible sound at a focal position. Accordingly, the conception of A and B was not at the level of a mere idea, as the plaintiff asserts, but was a conception accompanied by a specific means of solution. ... ...

However, among the functions of the prototype at issue described in (3) A above, the function of emitting the audible-sound waveform with a phase difference such that it converges at the focal position and aligning the audible-sound waveform at the focal position ... improves the sound quality of the audible sound. However, the technical problem of the invention at issue is removal of restrictions on the environment of use, not improvement of the sound quality of audible sound. Therefore, that function of the prototype at issue does not constitute the characteristic portion of the invention at issue.

The remaining points are also merely one specific and objective mode of implementing the characteristic portion of the invention at issue. Depending on their content, they may be said to solve a problem different from that of the invention at issue, but cannot be said to solve the problem of the invention at issue.

In other words, the functions of the prototype at issue do not affect the foregoing finding that, through development of the experimental device at issue, the characteristic portion of the invention at issue had been configured in a sufficiently specific and objective manner to enable a person skilled in the art to implement it, and that the invention at issue had been completed.

Accordingly, C and the others cannot be said to be persons who configured the characteristic portion of the invention at issue in a sufficiently specific and objective

manner to enable a person skilled in the art to implement it, and they are not inventors (joint inventors) of the invention at issue. ...

[Supplement] The persons whom the judgment found to be the inventors of the invention at issue are "A and others" (A and D) listed in the patent gazette (judgment, p. 3, lines 15-16; p. 7, lines 5-7; p. 45, lines 11-13). Further, the passage in the excerpt beginning "Accordingly, among the functions provided in the prototype at issue, ..." begins with "However" in the original text of the judgment (judgment, p. 44, line 22).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94070.pdf

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2023 (Wa) No. 70563 [Transaction Management System] <Shibuya> (Keysoft v. Sankaku Kikaku)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70563%e3%80%90%e5%8f%96%e5%bc%95%e7%ae%a1%e7%90%86%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e6%be%81%e8%b0%b7%ef%bc%9e-%ef%bc%88%e3%82%ad%e3%83%bc/

2023 (Wa) No. 70563 [Transaction Management System] <Shibuya>
(Keysoft v. Sankaku Kikaku)

In the invention at issue, an "intermediary trader" means a person situated between a "downstream trader," which is the recipient of goods, and an "upstream trader," which is the shipper of goods, and who conducts stepwise sales transactions for specified goods—that is, a person who receives from the downstream trader an order concerning the sale of the subject goods and, based thereon, places with the upstream trader an order concerning the sale of those goods.

The accused system concerns the "Furusato Nozei system." Furusato Nozei is a gratuitous provision of an economic benefit (a donation), and provision of a return gift is likewise a gratuitous act of gratitude for the donation and has no relationship of consideration with the donation.
Accordingly, no sales transaction (transaction for consideration) with the donor can be found, and the local government does not qualify as an "intermediary trader."

Further, as to the operation of the accused system, although an application by a donor causes email notifications to be sent to the local government and the business operator, the system does not contemplate that the local government will receive order information and then notify the business operator, and there is no relationship in which the local government, based on an email from the donor, places an order for goods with the business operator.
Accordingly, the local government cannot be said to be a stepwise trader in goods and, on this ground as well, does not qualify as an "intermediary trader."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94153.pdf

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Tokyo District Court Judgment, 2023 (Wa) No. 70594 [Mattress]

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70594%e3%80%90%e3%83%9e%e3%83%83%e3%83%88%e3%83%ac%e3%82%b9%e3%80%91%ef%bc%9c%e5%8b%9d%e5%8f%88%ef%bc%9e/

Tokyo District Court Judgment, 2023 (Wa) No. 70594 [Mattress]

In the invention at issue, "pressure-bonded" does not require that the cushion bodies be strongly compressed and stuck together. In light of the purpose of preventing hands, feet, and the like from falling into a gap, it is construed to mean "a state in which some pressure is mutually applied to the cushion bodies to the extent that no gap is formed between them."

The plaintiff's measurements established that pressure of at least 0.2 MPa was applied between the inner materials of accused Products 1 and 4, and the same was inferred for the other accused products; accordingly, the accused product satisfies the requirement of being "pressure-bonded."

⇒ Satisfied

(Excerpt from the Judgment)

A. In the invention at issue, the mattress cover is defined as having a bottomed tubular cover member into which a plurality of cushion bodies can be fitted while being pressure-bonded (Claim Element G), and the plurality of cushion bodies are defined as being incorporated into the mattress cover in a pressure-bonded state (Claim Element H).

The term "pressure-bond" means "to strongly compress and stick together" (Kojien, 7th ed.; Exhibit Otsu No. 1). However, because "pressure" means "to hold down; to press so that something cannot move" (Appendix to Kojien, 7th ed.; Exhibit Ko No. 15), "pressure-bond" can also be said to have a meaning on the order of "to hold down and stick together."

B. Next, the specification at issue contains, with respect to "pressure-bonding," the statement: "For example, when incorporating three cushion bodies, first press the respective side surfaces of two cushion bodies against the inner surfaces on both longitudinal sides of the bottom-side cover, and then press the remaining cushion body (which may be mountain-folded) downward between those cushion bodies, thereby making it possible to readily incorporate all of the cushion bodies into the mattress cover in a pressure-bonded state" ([0017]); the statement: "Figure 5 is a conceptual diagram showing an example of the manner in which cushion bodies 21 to 23 are accommodated in the bottom-side cover 10b while being pressure-bonded, with respect to mattress 1" ([0050]); and the statement: "Figure 5 illustrates, as a method of incorporating a plurality of cushion bodies 21 to 23 into mattress cover 10, a method using side portions 13 on both longitudinal sides of bottom-side cover 10b (the front and rear sides of side portion 13). In this method, first, the side surfaces of two cushion

bodies 21 and 23 are respectively pressed against the front and rear sides of side portion 13, and cushion body 22 is thereafter pressed vertically downward. By this method, the plurality of cushion bodies 21 to 23 can be readily incorporated into mattress cover 10 in a pressure-bonded state" ([0051]). Figure 5, concerning a method of incorporating a plurality of cushion bodies into the mattress cover, depicts another cushion body being pressed downward between two cushion bodies, with the three cushion bodies installed in contact with one another without gaps inside the mattress cover, but does not express that the cushion bodies mutually exert strong pressure in the left-right direction.

In addition, as stated in 1(2) above, the invention at issue produces the effect of providing a mattress in which hands, feet, and the like are less likely to fall into grooves. According to the specification at issue, that effect results from the fact that "a stretch-preventing member is provided on the peripheral surface portion (side portion) of the mattress cover" ([0011]), and is not stated to result from the cushion bodies being strongly compressed and stuck together. Considering these matters as a whole, although the invention at issue can be said to contemplate that no gap into which hands, feet, and the like may fall is formed at the boundaries between the cushion bodies, so that hands, feet, and the like are less likely to fall in, it cannot be found to contemplate a state in which the cushion bodies are strongly compressed and stuck together.

Accordingly, it is appropriate to construe "pressure-bonded" in the invention at issue as meaning a state in which some pressure is mutually applied to the cushion bodies to the extent that no gap is formed between them.

[Supplement] The heading of the original article reads "<Katsumata>," but according to the judgment, Judge Katsumata is an associate judge, as shown by the statement that Judge Katsumata was unable to sign and seal owing to transfer and Judge Yoshikawa owing to retirement (judgment, p. 55). Further, regarding the statement in the original article that pressure of 0.2 MPa or more is applied between the inner materials of the accused product, the measurements were made on Accused Products 1 and 4, and the same was inferred for the other accused products (judgment, p. 37, lines 8-15). The appellate court (Intellectual Property High Court Judgment of November 17, 2025, 2025 (Ne) No. 10045) dismissed the appeal (that judgment, p. 1, lines 1-3 and 21). Appellate judgment: https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95075.pdf

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94144.pdf

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2023 (Ne) No. 10114 [Layered Body Having Cube-Corner Elements, and Retroreflective Sheet] <Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%8d10114%e3%80%90%e3%82%ad%e3%83%a5%e3%83%bc%e3%83%96%e3%82%b3%e3%83%bc%e3%83%8a%e3%83%bc%e7%b4%a0%e5%ad%90%e3%82%92%e6%9c%89%e3%81%99%e3%82%8b%e5%b1%a4%e7%8a%b6/

2023 (Ne) No. 10114 [Layered Body Having Cube-Corner Elements, and Retroreflective Sheet] <Nakadaira>

= 2023 (Gyo-Ke) No. 10102

* The technical significance of the numerical limitation is not stated in the specification.

⇒ Matter of design

(Excerpt from the Judgment)

The specification at issue states that "the elements preferably have a dihedral-angle error of 1 to 60 arcminutes" ..., but contains no statement whatsoever of the basis for describing that range as preferable.

On the other hand, all of the examples described in the specification at issue ... include examples having dihedral-angle errors of less than 1 arcminute, such as 0.1 arcminute, −0.5 arcminute, and 0.8 arcminute, and each of those examples is stated to have a uniformly distributed spot pattern and to produce the action and effects of the inventions at issue. With respect to the upper limit as well, Claim Elements 1-C4 and 4C-1 set it at 60 arcminutes, as stated above, whereas the maximum dihedral-angle error shown in the examples is −19.8 arcminutes ..., and there is no statement of any basis for setting the upper limit at 60 arcminutes. Moreover, even if spot patterns consisting only of values within the numerical range stated in the foregoing claim elements were extracted from the examples described in the specification at issue and compared, there is no example showing that the action and effect of uniform distribution of the spot pattern is produced. ...

Accordingly, it must be said that the numerical range of the foregoing dihedral-angle error stated in the claim elements of the inventions at issue has no particular technical significance, and it is found to be no more than an exercise of the ordinary creative ability of a person skilled in the art.

courts.go.jp/assets/hanrei/hanrei-pdf-94132.pdf?fbclid=IwY2xjawPuQg1leHRuA2FlbQIxMQBzcnRjBmFwcF9pZBAyMjIwMzkxNzg4MjAwODkyAAEegjztdni-hA9B68ybThlUwz0jZmfaQnMZKGrk-q2mzvspjovtVNX8KIk-vTw_aem_owvKftxWnemJdJR6czUekg

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2023 (Gyo-Ke) No. 10121 [Imaging Device] <Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e8%a1%8c%e3%82%b110121%e3%80%90%e6%92%ae%e5%83%8f%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e5%a2%97%e7%94%b0%ef%bc%9e/

2023 (Gyo-Ke) No. 10121 [Imaging Device] <Masuda>

The statement "orthogonal" in the claim does not define the angle of intersection between the first axis and the second axis, but indicates the positional relationship in which two sides of the rectangular display meet at a right angle at a corner.
The depiction in Figure 4B as if Axis A moves is an obvious error, and a person skilled in the art can readily understand the correct configuration (Axis A does not track the movement).

⇛ Support Requirement: ○

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94108.pdf

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2023 (Wa) No. 70004 [Portable Information Communication Device] <Takahashi>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70004%e3%80%90%e6%90%ba%e5%b8%af%e6%83%85%e5%a0%b1%e9%80%9a%e4%bf%a1%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e9%ab%99%e6%a9%8b%ef%bc%9e/

2023 (Wa) No. 70004 [Portable Information Communication Device] <Takahashi>
(Related cases: 2023 (Wa) No. 70035
and 2022 (Wa) No. 70131)

At the priority date of the patent at issue, a person skilled in the art who encountered the invention of Exhibit Otsu No. 6 could readily have conceived of applying the common general technical knowledge described in A above to that invention and adopting the configuration relating to Difference (1), in which, as a configuration for externally importing image information that could not be clearly displayed on simplified liquid-crystal display panel 23, communication unit 12 receives a radio signal transmitting that image information, converts it into a digital signal, and transmits it to CPU 11, and CPU 11 receives that digital signal.

⇒ Inventive Step: ×

[Supplement] The excerpt in the original article omits, without an ellipsis, the words referring to a person skilled in the art who had access to the invention of Exhibit Otsu No. 6 (judgment, p. 81, lines 16-17). The judgment also held that Difference (2) (reading of bitmap data of an image having the same resolution as the screen resolution) could readily have been conceived (judgment, p. 83, lines 15-20), and dismissed the claim under Article 104-3(1) of the Patent Act because the patent lacked inventive step (judgment, p. 83, lines 22-25). The related case numbers "= 2023 (Wa) No. 70035" and "= 2022 (Wa) No. 70131" in the original article do not appear in the judgment.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94112.pdf

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Tokyo District Court Decision, 2023 (Yo) No. 30214, Petition for a Preliminary Injunction <Sugiura>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e6%b1%ba%e4%bb%a4%e5%92%8c5%e5%b9%b4%ef%bc%88%e3%83%a8%ef%bc%89%e7%ac%ac30214%e5%8f%b7%e4%bb%ae%e5%87%a6%e5%88%86%e5%91%bd%e4%bb%a4%e7%94%b3%e7%ab%8b%e4%ba%8b%e4%bb%b6/

Tokyo District Court Decision, 2023 (Yo) No. 30214, Petition for a Preliminary Injunction <Sugiura>

[Supplement] The original article states: "★ Same Presiding Judge Sugiura; in the main action, the patentee lost on reversal." This means that the preliminary-injunction decision (granting an injunction) and the judgment in the main action and counterclaim (2023 (Wa) No. 70527; main action dismissed as inadmissible and counterclaim dismissed on the merits) by the same Presiding Judge Sugiura reached different conclusions. This does not mean that an appellate court set aside a first-instance judgment.
Tokyo District Court Judgment, 2023 (Wa) No. 70527 [Cyclic Protein Tyrosine Kinase Inhibitor] <Sugiura> | Attorney Hideki Takaishi's Patent Channel (Attorney-at-Law / Patent Attorney / California Attorney; Passed the Patent Agent Examination)
[Text of the decision] Apart from the statement that the creditor's petition is found to be reasonable, the published copy (certified copy) of the decision contains no detailed statement of reasons. Copy of the decision:
https://www.bms.com/assets/bms/japan/pressrelease/20231129-pdf.pdf
* This article provides general information and does not include legal advice.
Author: Hideki Takaishi, Attorney-at-Law and Patent Attorney (Daini Tokyo Bar Association)
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Tokyo District Court Judgment, 2023 (Wa) No. 70527 [Cyclic Protein Tyrosine Kinase Inhibitor] <Sugiura>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70527%e3%80%90%e7%92%b0%e7%8a%b6%e3%82%bf%e3%83%b3%e3%83%91%e3%82%af%e8%b3%aa%e3%83%81%e3%83%ad%e3%82%b7%e3%83%b3%e3%82%ad/

Tokyo District Court Judgment, 2023 (Wa) No. 70527 [Cyclic Protein Tyrosine Kinase Inhibitor] <Sugiura>

The "scope of effect of an extended patent right" extends to the product that was the subject of the disposition designated by Cabinet Order (the originator drug "Sprycel Tablets") and to products "substantially identical thereto as pharmaceuticals."
For a patented invention characterized only by the active ingredient of a pharmaceutical product, where the subject product differs in components other than the active ingredient, it is included within substantial identity if the change is based on "well-known and commonly used art."

In this case, the "Sprycel Tablets" that were the subject of the disposition contained "dasatinib hydrate" as the active ingredient and PEG as an excipient, whereas the plaintiff's product contained "dasatinib (anhydrous)" as the active ingredient, did not contain PEG, and added carnauba wax and other substances.
The court held that this difference appeared to be based on the plaintiff’s own technology or other measures addressing problems of stability and dissolution properties arising from adoption of the anhydrous form (for example, its lower photostability and higher solubility than the hydrate).
Specifically, replacing PEG with HPC and adjusting the components of the coating agent (including addition of carnauba wax) was not supported by reliable evidence sufficient to find that it was based on well-known or commonly used art, and appeared to be based on the plaintiff’s own technology or other measures.
Accordingly, the plaintiff's product was not found to be "substantially identical as a pharmaceutical" to Sprycel Tablets, and the effect of the extended patent right at issue did not extend to the plaintiff's product.
⇒ The court dismissed as inadmissible all claims in Sawai Pharmaceutical's main action for a negative declaration and dismissed on the merits the defendant patentee's counterclaim for damages.

[Supplement] The operative part of the judgment dismissed the main action as inadmissible and dismissed the defendant's counterclaim (judgment, p. 1, lines 8-9).
Regarding the statements in the original article that the difference resulted from the plaintiff's own measures and is inferred to have resulted from active formulation design, the judgment held that there was no reliable evidence sufficient to find that the addition or replacement of excipients was based on well-known or commonly used art and that

it appeared that the plaintiff had made it on the basis of its own technology (judgment, p. 38, lines 16-24). Further, regarding the statement in the original article that a change based on well-known or commonly used art falls within substantial identity, the judgment cited, as one category falling within substantial identity, a case in which the target product adds or replaces some different components on the basis of well-known or commonly used art at the time of the application for the cabinet-order disposition (judgment, p. 24, lines 18-23).

[Comment at the time the original article was written] ★ The same Presiding Judge Sugiura reached a different conclusion from the preliminary injunction proceeding (2023 (Yo) No. 30214, Petition for a Preliminary Injunction)!!

⇒ The appeal requires close attention.

Many practitioners and academics have expressed the view that, in light of the Oxaliplatin Intellectual Property High Court judgment, the generic product may well fall within the scope of the extended patent right (i.e., the claim elements are satisfied), and I have not heard the contrary view, so the appeal is noteworthy.

Looking at Remitch as well, the Intellectual Property High Court is pro-patent when it comes to pharmaceuticals.

Even if the conclusion of the dasatinib judgment at first instance does not change, it is also important to watch whether the court maintains the logic of treating the technical significance associated with the problem arising from the difference in excipients as an issue, or whether the scope of the judgment is limited to cases in which the active ingredient differs. If the former is maintained as it stands, a generic company could readily place its product outside the scope of effect by formulating a problem + using different excipients + obtaining a patent.

https://www.bms.com/assets/bms/japan/pressrelease/20231129-pdf.pdf

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94154.pdf

* This article provides general information and does not include legal advice.

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2024 (Ne) No. 10080 [Under-Coping Ventilation Structure] <Nakadaira> = Court of First Instance: Osaka District Court Judgment, 2023 (Wa) No. 8403

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10080%e3%80%90%e7%ac%a0%e6%9c%a8%e4%b8%8b%e6%8f%9b%e6%b0%97%e6%a7%8b%e9%80%a0%e4%bd%93%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e-%ef%bc%9d%e5%8e%9f%e5%af%a9/

2024 (Ne) No. 10080 [Under-Coping Ventilation Structure] <Nakadaira>
= Court of First Instance: Osaka District Court Judgment, 2023 (Wa) No. 8403

In light of the language "a ventilation member that exhibits ventilation performance and waterproofing performance" and the description in the specification at issue (the problem, means for solving the problem, and effects), it is natural to construe the claim as requiring the ventilation member "itself" to have ventilation performance and waterproofing performance.

⇒ The plate-shaped portion of the appellee's product cannot be found, by itself, to satisfy the requirement.

The appellant also asserted that the determination should be based on whether the member "contributes" to waterproofing and ventilation, but the court held that there was neither assertion nor proof of common general technical knowledge or other circumstances supporting the reasonableness of that method.

Even if that method were used, Inclined Portion ⑤ of the appellee's product narrows the ventilation passage and reduces ventilation performance compared with the case in which it is absent. It therefore cannot be said to contribute to ventilation performance, and Claim Element C is not satisfied.

[Supplement] Regarding the statement in the original article concerning the absence of a reasonable basis for that method, the judgment held that there was neither assertion nor proof of common general technical knowledge or other circumstances supporting the reasonableness of the appellant's "second determination method" (judgment, p. 14, lines 11-13), and that, even if that method were used, satisfaction of Claim Element C could not be found (judgment, p. 14, lines 21-23). The judgment also held that, although a ventilation passage (ventilation gap) exists, Inclined Portion ⑤ itself narrows the area through which ventilation is possible (judgment, p. 14, lines 14-20).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94137.pdf

* This article provides general information and does not include legal advice.

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2024 (Ne) No. 10072 [Draft Difference Measuring Device] <Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10072%e3%80%90%e3%83%89%e3%83%a9%e3%83%95%e3%83%88%e5%b7%ae%e6%b8%ac%e5%ae%9a%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

2024 (Ne) No. 10072 [Draft Difference Measuring Device] <Nakadaira>

"Of the patent maintenance expenses and other expenses at issue, the expenses incurred for the opposition proceedings were expenses for responding to oppositions to the grant of the patent at issue filed by the defendant in the first instance and Nippon Steel (Exhibit Ko No. 10). However, because the foregoing oppositions to the grant of the patent cannot be found to have been unlawful, no tort by the defendant in the first instance can be found.

As to the expenses other than those for the opposition proceedings among the patent maintenance expenses and other expenses at issue, the plaintiff in the first instance incurred them, at its own discretion, in applying for and maintaining the patent at issue. In the first place, the conduct of the defendant in the first instance did not cause the plaintiff in the first instance to have to incur those expenses. Accordingly, no adequate causal relationship can be found between the conduct of the defendant in the first instance and the expenditures of the plaintiff in the first instance."

[Supplement] The original text of the judgment includes "(Exhibit Ko No. 10)" (judgment, p. 6, line 4). In the original text of the judgment, the quoted passage begins with "Further," and the two sentences form a single paragraph (judgment, p. 6, lines 2-10).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94136.pdf

* This article provides general information and does not include legal advice.

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[Copyright Act ★] Case in Which, Regarding the Appellee's (Defendant's) Acts of Photographing, to the Extent Included in a Single Smartphone Photograph, Articles (Headlines, Article Text, and the Photographs at Issue) in a Newspaper Published by the Appellant (Plaintiff), and Posting Them Together with the Text of Posts on Twitter (X) via the Internet on 25 Occasions, the Appellant Alleged Infringement of Copyright (Right of Making Transmittable) in the Photographs at Issue and Sought Damages in Tort, and the Court Held that the Quotation Defense (Article 32(1) of the Copyright Act) or the Defense of Exploitation of Incidentally Included Works (Article 30-2 of the Copyright Act) Applied and that the Appellant's Claims Should Be Dismissed

Original Article URL:
https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e8%91%97%e4%bd%9c%e6%a8%a9%e6%b3%95%e2%98%85%e3%80%91%e8%a2%ab%e6%8e%a7%e8%a8%b4%e4%ba%ba%ef%bc%88%e8%a2%ab%e5%91%8a%ef%bc%89%e3%81%8c%e3%80%81%e6%8e%a7%e8%a8%b4%e4%ba%ba%ef%bc%88%e5%8e%9f/

Intellectual Property High Court Judgment of July 31, 2025 (2024 (Ne) No. 10075) (Presiding Judge Hibiku Shimizu)

◆ Full Text of the Judgment

[Overview of the Case]

This case concerns the appellee (the "defendant"), a member of the plaintiff, photographing, to the extent that they were captured in a single smartphone photograph, articles appearing in the Seikyo Shimbun newspaper issued by the appellant, a religious corporation (the "plaintiff")—including the headlines, article text, and the photographs at issue (Photographs 1-37 at issue)—and posting them on Twitter (X), together with the text of the posts, on 25 occasions via the Internet. The plaintiff alleges infringement of copyright in the photographs at issue (the right of making transmittable, Article 23 of the Copyright Act) and seeks damages in tort (Article 709 of the Civil Code and Article 114(3) of the Copyright Act).

The court of first instance (Tokyo District Court, 2023 (Wa) No. 70388) upheld the quotation defense (Article 32(1) of the Copyright Act) with respect to the photographs at issue and dismissed the plaintiff's claims. The plaintiff filed this appeal.

This judgment held that the quotation defense or the defense of exploitation of incidentally included works (Article 30-2(1) of the Copyright Act) applied to the photographs at issue, that the plaintiff's claims should be dismissed, and dismissed the appeal.

[Summary of the Judgment]

1. Quotation Defense (Article 32(1) of the Copyright Act)

(1) Requirements for the Quotation Defense and Their Construction

According to the language of Article 32(1) of the Copyright Act, in order to include and use all or part of a work in one's own creation without the consent of the copyright owner, each of the following requirements must be satisfied: (i) the work being used has been made public; (ii) the use of that work constitutes quotation; (iii) the quotation is consistent with fair practices; and (iv) the quotation is made within a scope justified by the purpose of news reporting, critique, study, or other purposes of quotation.

Considering the purpose of the Copyright Act—to protect the rights of authors and others while giving due regard to the fair exploitation of cultural products such as works, and thereby to contribute to the development of culture (see Article 1 of the Copyright Act)—and the purpose of Article 32(1) of the Copyright Act, which enables fair exploitation of works and other cultural products while protecting copyright, it is appropriate to construe requirement (ii), "quotation," as generally requiring that the work being used be clearly distinguishable and recognizable from the creation in which it is used, and that there be a principal-subordinate relationship between them, with the using creation being principal and the work being used being subordinate. However, this principal-subordinate relationship should not be determined formally based solely on a quantitative comparison; rather, after considering various factors such as the nature of the using creation and of the work being used, the purpose of the quotation, and the method and manner of quotation, it should be determined substantively in light of social conventions. In that event, the determination will partly overlap with the determination under requirement (iv), whether the use is "within a scope justified by the purpose of the quotation."

As to whether the quotation under requirement (iii) is "consistent with fair practices," if fair practices concerning quotation exist in the relevant field, publication medium, or the like, the determination is made based on whether the method and manner of use by quotation are found to conform to those practices. If no such practices exist, the determination is made based on whether the method and the like are found to be reasonable under social conventions. In this connection, disclosure of the source of the work being used may be considered as one factor in determining compliance with the fair practices or with a method that is reasonable under social conventions.

Further, as to whether the quotation under requirement (iv) is made "within a scope justified by the purpose of news reporting, critique, study, or other purposes of quotation," the matter must be comprehensively assessed, in light of the foregoing purpose of the Copyright Act and the purpose of the provision, by considering the content and legitimacy of the purpose of the quotation, the relationship between the

purpose of the quotation and the work being used, the nature of the work being used, the scope and quantity quoted, the method and manner of quotation, the benefit obtained by the user, the degree of disadvantage suffered by the person whose work is used, and other matters.

(2) Application

A. Introduction

The Photographs at Issue (Quotation) (Photographs 1-9, 11-26, and 30-37 at issue) are news photographs published on the same newspaper pages together with the articles in order to report events as an integrated whole. Accordingly, even if they are themselves photographic works, if the purpose of the quotation has a certain relationship to the events reported by the articles, a similar relationship is recognized with respect to the news photographs forming part of those articles. Further, since the language of Article 32(1) of the Copyright Act does not go so far as to require inevitability or strict necessity of quotation, in light of the nature of articles and news photographs, which are intended broadly to inform readers of current events and contribute to the formation of readers' opinions and the like, from the standpoint of harmonizing copyright protection and exploitation, where a relationship is found between the events reported by the articles and news photographs and the purpose of the quotation, the court is not precluded from finding that quotation of the Photographs at Issue (Quotation) is "within a scope justified by the purpose of the quotation," after considering whether there was commercial use, whether the principal-subordinate relationship requirement was satisfied, and other circumstances.

B. Constituting Quotation

The portions consisting of the text of the posts at issue and the quoted portions containing the Photographs at Issue (Quotation) can be clearly distinguished and recognized. Further, in light of the content of the posts at issue, the nature of the photographs at issue and other materials, the purpose of the quotation, the method and manner of expression of the quotation, and other matters, it is found, under social conventions, that the portions posted as the body text on Twitter are principal and the Photographs at Issue (Quotation) are subordinate.

C. Consistency with Fair Practices

The defendant, by stating in the text of the posts at issue that the material was quoted from Seikyo Shimbun, by publishing a photograph in which the "Seikyo Shimbun" masthead was captured, or the like, generally continued to post materials, all in a similar format consisting of a photograph of a newspaper page and text criticizing it. In light of this and of the fact that many readers of the posts at issue are thought to have been members of the plaintiff or related persons, the source of the published Photographs at Issue (Quotation) could readily be understood by referring to the content of the post and the preceding and following posts, and the manner of use conforms to a method that is reasonable under social conventions.

D. Within a Scope Justified by the Purpose of the Quotation

Each post at issue consisted of the text of the post and a photograph taken to the extent that the article and the Photographs at Issue (Quotation) on a page of the Seikyo Shimbun were captured in a single smartphone photograph. The purpose of each post at issue is found to have been to criticize the plaintiff's activities and the like as perceived by the defendant through the article text or the Photographs at Issue (Quotation) in Seikyo Shimbun, the plaintiff's organ newspaper, and no unreasonable or inappropriate aspect is found in that purpose. Each of the Photographs at Issue (Quotation) is found to be related to the purpose of the quotation. It cannot be found that including the Photographs at Issue (Quotation) appearing on the newspaper pages, to the extent captured in a single smartphone photograph, was excessive in scope as quotations for the purpose of enabling the criticism in the posts at issue to be understood. The scope and quantity of the works used through the quotation at issue must therefore be regarded as reasonable. Further, there is no finding that the defendant obtained any commercial benefit from the posts at issue, and there is no evidence sufficient to find that allowing quotation of the Photographs at Issue (Quotation) would cause the plaintiff any economic disadvantage, such as a reduction in circulation.

E. Conclusion

Accordingly, the quotation defense (Article 32(1) of the Copyright Act) applies to the Photographs at Issue (Quotation) published in the posts at issue.

2. Defense of Exploitation of Incidentally Included Works (Article 30-2(1) of the Copyright Act)

With respect to the defense of exploitation of incidentally included works concerning the Photographs at Issue (Incidental) (Photographs 10 and 27-29 at issue), in light of the absence of transitional provisions, the history and purpose of the statutory amendment, and other matters, it is appropriate to construe Article 30-2 of the Copyright Act, as amended by the 2020 Amendment Act, as also applying to acts performed before the 2020 Amendment Act entered into force.

Based on the proportion occupied by the Photographs at Issue (Incidental) in the photographs of the newspaper pages (the creation/transmission materials) published in the posts at issue, the Photographs at Issue (Incidental) are found to be minor constituent portions (incidentally included works). Further, the defendant had no purpose of obtaining a benefit through their use; because they were adjacent to the newspaper articles that were the subject of criticism, it was difficult to photograph them separately; and they played no particular role in the creation/transmission materials. In light of these and other circumstances, they can be said to have been used, as incidentally included works and within a justified scope, in connection with the reproduction/transmission acts.

Accordingly, the defense of exploitation of incidentally included works applies to the Photographs at Issue (Incidental).

[Comment]

1. Regarding Summary of the Judgment 1(1)

The Supreme Court Judgment of March 28, 1980, Minshu Vol. 34, No. 3, p. 244 [Mad Amano Case], held that requirements (i) and (ii) below were necessary for the quotation defense under the former Copyright Act.

(i) The quoted work must be clearly distinguishable from the work quoting it.

(ii) The quoted work must be subordinate to the work quoting it.

By contrast, Article 32(1) of the current Copyright Act provides as follows concerning the quotation defense:

"It is permissible to quote and thereby exploit a work that has been made public. In such a case, the quotation must be consistent with fair practices and must be made within a scope that is justified for the purpose of news reporting, critique, study, or other purposes of quotation."

Further, with respect to the obligation to indicate the source of a quoted work, Article 48(1) of the current Copyright Act requires the source of the quoted work to be indicated in a manner and to the extent considered reasonable.

[Supplement] The original article begins the preceding sentence with "Further, with respect to the quotation defense," instead. However, this obligation is distinguished from the requirements for lawful quotation under Article 32(1) of the Copyright Act. This judgment states that "indication of the source is not made a direct requirement for lawful quotation" and considers the fact that the source is made clear as one factor of the fair practices or of a method or the like that is reasonable under social conventions (judgment, p. 19, lines 6-9 and 12-15).

It is generally considered that the Supreme Court judgment in the Mad Amano Case, which construed the former Copyright Act, may also be applied to the construction of Article 32(1) of the current Copyright Act. Accordingly, concerning the relationship between requirements (i) and (ii) above and the quotation defense under Article 32(1) of the current Copyright Act, there are many divided judicial decisions and academic views, including the following:

A) Requirements (i) and (ii) above are necessary and sufficient requirements (Tokyo High Court Judgment of October 17, 1985, Mutai-shu Vol. 17, No. 3, p. 462 [Tsuguharu Foujita Case], among others).

B) Requirements (i) and (ii) above may be important factors for consideration, but other important factors may also exist, and the determination is made through comprehensive consideration according to the case (Intellectual Property High

Court Judgment of October 13, 2010, Hanrei Jiho No. 2092, p. 135 [Painting Appraisal Certificate Case], among others).

C) Requirements (i) and (ii) above are necessary requirements, and other requirements also exist. (Intellectual Property High Court Judgment of March 29, 2022 (2021 (Ne) No. 10060), Courts Website [KuToo Case], among others.)

There are also many divided judicial decisions and academic views concerning the relationship between requirements (i) and (ii) above and each of the terms "quotation," "consistent with fair practices," and "within a scope justified by the purpose" in Article 32(1) of the current Copyright Act, including the following:

a) Requirements (i) and (ii) above may relate to each of the phrases "quotation," "consistent with fair practices," and "within a scope justified by the purpose" (Tokyo High Court Judgment of October 17, 1985, Mutai-shu Vol. 17, No. 3, p. 462 [Tsuguharu Foujita Case]; Intellectual Property High Court Judgment of October 13, 2010, Hanrei Jiho No. 2092, p. 135 [Painting Appraisal Certificate Case], among others).

b) Requirements (i) and (ii) above relate to the term "quotation" (Intellectual Property High Court Judgment of March 29, 2022 (2021 (Ne) No. 10060), Courts Website [KuToo Case]).

c) Requirement (i) above relates to the term "quotation," and requirement (ii) above relates to the term "within a scope justified by the purpose" (Tamotsu Shoji, "The Quotation Defense," in Makiko Takabe (ed.), Intellectual Property Litigation II: Latest Court Practice Series 11 (Seirin Shoin, 2018), pp. 713-714).

The Intellectual Property High Court Judgment of October 13, 2010, Hanrei Jiho No. 2092, p. 135 [Painting Appraisal Certificate Case], held that the material on the quoting side need not itself be a work.

Against this background of judicial decisions and academic views, Summary of the Judgment 1(1) is understood to have basically adopted C) and b) above.

2. Regarding Summary of the Judgment 1(2)

With respect to whether the quotation defense applies, Summary of the Judgment 1(2) carefully applies to the facts of this case not only the requirements for constituting quotation—clear distinguishability and the principal-subordinate relationship—but also the other requirements of consistency with fair practices and being within a scope justified by the purpose of quotation, under the specific constructions of those requirements stated in Summary of the Judgment 1(1), and is useful in practice.

3. Regarding Summary of the Judgment 2

Whereas the court of first instance upheld the quotation defense with respect to all of the photographs at issue, the appellate court upheld the quotation defense, as stated

in Summary of the Judgment 1(2), only with respect to the Photographs at Issue (Quotation) (Photographs 1-9, 11-26, and 30-37 at issue), and upheld the defense of exploitation of incidentally included works, as stated in Summary of the Judgment 2, with respect to the Photographs at Issue (Incidental) (Photographs 10 and 27-29 at issue). On this point, it is inferred that the appellate court considered it difficult to uphold the quotation defense with respect to the Photographs at Issue (Incidental) (Photographs 10 and 27-29 at issue) because they were not the subject of criticism in the text of the defendant's posts and were unrelated to that text.

[Supplement] According to the judgment, the classification into the Photographs at Issue (Quotation) and the Photographs at Issue (Incidental) depends on which defense the defendant asserted (judgment, p. 2, lines 7-13; p. 12, lines 14-15), and the judgment did not decide whether the quotation defense would be established for the Photographs at Issue (Incidental). The finding that they were unrelated to the text of the posts was made in determining the defense of exploitation of incidentally included works (judgment, p. 39, lines 9-10).

[Keywords] Soka Gakkai, Seikyo Shimbun, Quotation Defense, Clear Distinguishability, Principal-Subordinate Relationship, Defense of Exploitation of Incidentally Included Works

* This article provides general information and does not include legal advice.

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Legal Update

Articles Published in March 2026

Scope: Articles with publication dates in March 2026 on the list page

Number of articles: 29 (15 patent, 9 general IP, 3 trademark, 1 foreign, and 1 copyright article)

List page: https://www.nakapat.gr.jp/ja/note/

<Highlights of This Month> Key Points in the March 2026 Intellectual Property and Legal Affairs Update

This issue contains 29 articles published on the list page in March 2026: 15 patent, 9 general IP, 3 trademark, 1 foreign, and 1 copyright article. They range from patent amendments and inventive step to trademark distinctiveness, character protection, and contractual liability. Applying them in practice begins with distinguishing judicial and administrative holdings from the questions raised by articles and presentations.

1. Understanding the Limits of Disclaimer Claims through Domestic and Overseas Decisions

In [Pet Matching System], 2024 (Gyo-Ke) No. 10081, inventive step was denied despite a disclaimer excluding animal hospitals and similar locations. The court's rejection of the premise that the cited invention limited the handover location is significant. Kenji Tanaka and coauthors' "A Study of the Limits of Disclaimer Claims" organizes four categories: design choices, new references, insufficient exclusion, and exclusion of nonessential features. Kazuo Shibata's "The Umbrella Theory Has Also Returned! But Should Disclaimer Claims Really Be This Unrestricted?" examines the umbrella theory concerning the exclusionary effect of priority and transformation of inventions through amendment. Read together with In re Butler, these materials call for examination of disclosure of excluded features, distinctions from alternatives, and support for the remaining scope. The article's recommendation to explain the difference in technical concepts, beyond merely removing overlap with a reference, also merits attention.

2. Examining Inventive Step, Disclosure Requirements, and Procedure through Specific Technical Content

In [Motor Vehicle], [Embossed Bag], and [Gaming Machine], common technical fields, actions, or functions supported findings of obviousness. [Wood-Based Board] treats differences separately in light of the absence of disclosed synergy. By contrast, [Electronic Money Remittance Method] recognizes inventive step based on the different technical significance of electronic certificates and identifiers such as IDs and account numbers. [System for Electronic Patient Care] establishes the meaning of terms through common general technical knowledge and rejects the finding of a lack of clarity and the finding of non-enablement premised on it. In addition, 2025 (Gyo-Ko) No. 10001 rejects curing the defect of requesting examination before submitting translations for a foreign-language international application. Managing the filing sequence is essential alongside assessing technical substance. Similar numbers or terminology should not automatically be equated with identical technical meaning.

3. Separating Distinctiveness and Similarity in Brand Analysis

Rui Asada and Tomohiko Yamada's article on the current status and issues in distinctiveness appeal decisions addresses falling reversal rates since 2022 and decompositional assessment of composite marks. It considers the problem of being able to use a mark without obtaining exclusivity, together with the structure producing few court challenges. Yamada's article on recent trademark similarity decisions uses Holmes-kun, 富富富, and AWG Treatment to organize separate observation, comprehensive assessment of appearance, pronunciation, and concept, and the limits of similarity group codes. Masako Nishimura's article on onomatopoeia as trademarks compares the relationship to quality descriptions and national approaches. Registrability, conflict with others' rights, and consumer impressions each require examination. The figures' registration-decision rates and factors for separate observation are also worth consulting alongside the text.

4. Reading Monjiro Ika, Avatars, and Generative AI through Expression and Rights

The IP High Court's September 24, 2025 judgment in Monjiro Ika found adaptation and public-transmission infringement because the essential expressive characteristics of images from the Kogarashi Monjiro television works could be directly perceived. Kei Iida's commentary examines the relationship to Popeye Necktie, Candy Candy, and Article 28 of the Copyright Act, and also questions the treatment of individual rights. The holding and commentary should be read separately. Yasuyuki Echi's article on avatar names and likenesses organizes protection of names, appearance, movement, and voice. Taichi Kakinuma's "Generative AI and Intellectual Property Rights, etc." distinguishes development and training from generation and use, and examines non-enjoyment purposes and technical measures. All share a focus on specifying the expression, conduct, and rights involved. The distinction between motion capture and controller operation for avatar movement also deserves attention.

5. Checking the Facts Supporting Enforcement, Contracts, and International Negotiations

In [Wine Cellar], temperature settings and experiments matter; in [Seawall], watertightness throughout the space and its proof matter; and in [Wild Animal Slaughtering Tool], component and circuit structures bear on the findings that limitations were unsatisfied. In [Spindle Motor], proposal timing, communication, and differences in concept underlie the denial of inventor status. Two contract articles on Tokyo District Court case 2023 (Wa) No. 70680 address a representative's personal joint and several guarantee arising from a payment pledge. [Development of Green Laver Spore Collection Technology Using a Waterwheel] distinguishes an existing idea from joint research results and rejects breach of contract. Akiko Araki's SEP presentation, EPO decision T0070/23, and Tatsuya Yabuuchi's patent translation presentation also provide material for considering how differences in jurisdictions, claims, and language affect negotiations and the scope of rights. These articles show the importance of reading contractual wording, research history, actual device behavior, and other evidence in relation to the issue in dispute.

Three-Line Summaries of All Articles

Category	Article Title and Three-Line Summary
Patent	**Osaka District Court, 2023 (Wa) No. 10237 [Wild Animal Slaughtering Tool] <Presiding Judge Takemiya>** **① The dispute concerned satisfaction of limitations relating to the rod's telescopic nature, carrying equipment on the back, the physical parallel arrangement of two electric cords, and the grounding circuit in a wild animal slaughtering tool.** **② The court found the limitations unsatisfied because the defendant's product used a fixed-length rod, required no carrying on the back, had a switch inserted in series along the cord, and had no circuit through the soil.** **③ Infringement analysis requires separate comparison of each limitation's specific structure with the accused product.**
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10008 [Methods and Apparatus for Using Reference Signals for Time and Frequency Tracking in New Radio] <Presiding Judge Hibiku Shimizu>** **① The case concerned construction of an "indication as part of a CSI-RS resource set definition" and inventive step in an amended new-radio reference-signal invention.** **② The court denied inventive step because both inventions received information indicating part of a resource set and configuring that information as part of a definition was obvious.** **③ Inventive-step analysis requires comparison of the information conveyed, as well as the terminology used for the indication.**
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10005 [System for Electronic Patient Care] <Presiding Judge Hibiku Shimizu>** **① The dispute concerned clarity and enablement of "transaction-based web services" in a system for electronic patient care.** **② The court revoked the appeal decision because the terms were clear in light of common general technical knowledge at the filing date, and the finding of non-enablement premised on a lack of clarity was also erroneous.** **③ Assessment of an alleged explanatory deficiency should consider whether skilled persons can understand the terminology through common general technical knowledge.**
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10018 [Motor Vehicle] <Presiding Judge Miyasaka> = IP High Court, 2023 (Ne) No. 10042** **① The case concerned inventive step in prohibiting engine-stop operation upon detecting a braking-force holding device failure.** **② The court denied inventive step, finding motivation to combine based on the common technical field and failure problem, with the choice between a warning and an operation prohibition being a design matter.** **③ Where failure-response control is the distinguishing feature, analysis should address both the cited invention's problem and the available response choices.**
General IP	**<IP Practice Online> "How English-to-Japanese Patent Translators Think in Supporting the Application Process…" (Tatsuya Yabuuchi)** **① Tatsuya Yabuuchi's presentation examines the decisions and thinking that connect technology, law, and language in English-to-Japanese patent translation.** **② It introduces examples from the lecture materials, including the translation of treatment, and considers legal terminology, listing syntax, modifier relationships, and consistency of notation as practical supplementary points.** **③ Translation review should preserve the original technical content and scope of rights while producing natural Japanese.**
Patent	**Tokyo District Court, 2023 (Wa) No. 70495 [Spindle Motor] (Claim for Employee Invention Compensation) <Presiding Judge Nakashima>** **① A claim for employee invention compensation concerning a spindle motor raised the relationship between the plaintiff's proposal and the invention and the plaintiff's inventor status.** **② The court denied inventor status and dismissed the claim based on chronology, absence of contact or circulation to the developers, and differences in concept and configuration.** **③ Inventorship analysis should examine the proposal's substance together with evidence of its communication and involvement in development.**

Category	Article Title and Three-Line Summary
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10081 [Pet Matching System] <Presiding Judge Nakadaira>** **① The case concerned inventive step in a pet matching system limited to exclude animal hospitals and places where a veterinarian is present.** **② The court rejected the plaintiff's premise that the cited invention confined handover to those locations and found the disclaimer obvious.** **③ Use of a disclaimer claim requires careful examination of whether the excluded feature is truly essential to the cited invention.**
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10039 [Embossed Bag] <Presiding Judge Hibiku Shimizu>** **① The dispute concerned combining film-pattern embossing technologies and inventive step in numerical ranges for surface irregularities.** **② The court denied inventive step because the references shared a technical field and function, while the overlapping numerical ranges were design choices responsive to visibility and similar considerations.** **③ Numerical limitations require examination of overlap with prior-art ranges and the technical significance of the selected values.**
Patent	**Tokyo District Court, 2023 (Wa) No. 70738 [Wine Cellar] <Presiding Judge Takahashi>** **① The dispute concerned whether a wine cellar restarted its compressor at a third temperature higher than the second temperature after heater shutdown.** **② The court found the limitation unsatisfied despite a delay timer because the settings were identical and experiments sometimes showed a lower restart temperature.** **③ Satisfaction of temperature-control limitations should be assessed against both settings and measured operation.**
Patent	**IP High Court, 2025 (Gyo-Ko) No. 10001 "Appeal in an Action Seeking Revocation of an Administrative Disposition" <Presiding Judge Masuda>** **① The case concerned legal interest in revoking dismissal of an examination request made before translations were submitted for a foreign-language international application and the procedural defect involved.** **② The court recognized legal interest but dismissed the appeal because later submission did not cure the sequencing defect and the disposition was lawful.** **③ For foreign-language international applications, procedures must be managed so that translations and related formalities precede the examination request.**
General IP	**[EPO Board of Appeal Decision] T0070/23 (Immunogenic Composition/GSK)** **① EPO decision T0070/23 addresses whether unrecited therapeutic efficacy can be read into a claim as an implicit functional feature from the description.** **② This decision rejected restrictive construction of a clear claim and found no support for specific efficacy in the cited passage. The main request and auxiliary requests 2 to 6 lacked inventive step; auxiliary request 1 was not admitted, and the patent was revoked.** **③ Subsequently, G 1/24 required consultation of the description and drawings whenever claims are interpreted. Consultation and importing an unrecited limitation require separate consideration.**
General IP	**<IP Practice Online> The Front Line of Standard Essential Patents (SEPs): Practice in Light of Global Litigation Trends — Akiko Araki** **① Akiko Araki's presentation examines FRAND negotiations and international litigation concerning standard essential patents.** **② It discusses UPC injunctions, Chinese global rate setting, monetary resolution in the United States, ASIs and AASIs, and the proposed EU regulation. The proposal was withdrawn in October 2025.** **③ International SEP negotiations require an integrated understanding of jurisdictional developments, injunctions, and royalty determination across forums.**
Foreign	**[United States] In re Butler (CAFC, September 17, 2025)** **① In re Butler is a nonprecedential decision concerning the written description supporting a negative claim limitation.** **② The CAFC generally required disclosure indicating a reason for exclusion, for which distinguishing alternatives may provide a basis, while recognizing cases where skilled artisans necessarily understand an exclusion despite silence.** **③ A proposed disclaimer should be checked against disclosure of the excluded component and its distinction from alternatives.**

Category	Article Title and Three-Line Summary
General IP	[Article] Protection of Avatar Names and Likenesses under Intellectual Property Law and Other Laws (Yasuyuki Echi, Patent Supplement, 2025, Vol. 78, No. 31, pp. 217–226) ① Yasuyuki Echi's article examines legal protection of avatar names, likenesses, movements, and voices. ② It organizes copyright, trademark and unfair-competition protection, performers' rights, and portrait and publicity rights; the author argues that continued use after awareness of a coincidental likeness should constitute infringement. ③ Avatar protection requires examination of the rights applicable to each name, appearance, movement, voice, and mode of use.
Trademark	[Trademark/Article] "Onomatopoeia as Trademarks—The Current Situation in Japan and Other Countries—" (AIPPI (2025), Vol. 70, No. 11, Masako Nishimura) ① Masako Nishimura's article examines distinctiveness of onomatopoeic trademarks in Japan and other jurisdictions. ② It reviews the relationship to designated goods, dictionary checks, and national examples, emphasizing both registrability and consumer impressions. ③ Adoption of onomatopoeia should consider whether it directly describes quality and what impression it gives consumers.
Patent	[Article/Patent] A Study of the Limits of Disclaimer Claims (Kenji Tanaka et al., Patent, 2025, Vol. 78, No. 7, pp. 85–97) ① Kenji Tanaka and coauthors analyze cases where disclaimer claims fail to overcome inventive-step objections and limits arising from disclosure requirements. ② They organize four categories of denied inventive step and issues of added matter, clarity, support, and enablement, and recommend approaches to exclusions and original disclosure. ③ A disclaimer requires joint assessment of essential prior-art features, clarity of the exclusion, and support for the remaining scope.
Trademark	[Article/Trademark] Recent Court Decisions on Trademark Similarity: Focusing on Article 4(1)(xi) of the Trademark Act (Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 20–41) ① Tomohiko Yamada's article examines recent treatment of composite marks, pronunciation, goods and services, and trade conditions, focusing on Article 4(1)(xi). ② Using cases including Holmes-kun, 富富富, and AWG Treatment, it reviews separate observation, comprehensive assessment, and similarity group codes. ③ Similarity analysis should examine appearance, pronunciation, concept, and general enduring trade conditions, avoiding sole reliance on codes or company-specific circumstances.
General IP	<IP Practice Online> "Generative AI and Intellectual Property Rights, etc." (Attorney Taichi Kakinuma) ① Taichi Kakinuma's presentation separates generative-AI copyright issues into development and training, and generation and use. ② It reviews non-enjoyment purposes under Article 30-4, mixed enjoyment purposes, limits on inferences from outputs, and technical measures. ③ Corporate practice should examine training data, infringement-prevention measures, and operational governance including internal guidelines.
Trademark	[Article/Trademark] Current Status and Issues in Recent Appeal Decisions on Trademark Distinctiveness Following Decisions of Refusal (Rui Asada and Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 42–60) ① Rui Asada and Tomohiko Yamada examine stricter distinctiveness assessments in appeals against refusals and difficulties in correcting that trend. ② They analyze falling reversal rates since 2022, decompositional treatment of composite marks, and the structure resulting in few revocation actions. ③ Brand strategy should distinguish the ability to use a mark from the ability to obtain exclusive rights.
Patent	IP High Court, 2024 (Gyo-Ke) No. 10035 [Gaming Machine] <Presiding Judge Honda> ① The case concerned inventive step in associating vibration and jackpot likelihood in a gaming machine's image displacement effect. ② The court denied inventive step because both references displayed images appearing different from a reference image and applying vibrating means was routine. ③ Arguments based on different presentation methods should also examine shared display characteristics and the role of added vibration.

Category	Article Title and Three-Line Summary
Copyright	[Copyright Law ★★] A Case Partially Upholding the Appellants' Claims for an Injunction and Damages against the Appellee on the Ground That Manufacturing Products Such as "Monjiro Ika" with Particular Designs on Their Labels or Outer Bags and Posting Images of Those Products on a Website Infringed Copyright (the Rights of Adaptation and Public Transmission) in a Television Drama Based on the Novel "Kogarashi Monjiro" ① The dispute concerned copyright infringement in the Kogarashi Monjiro television works through manufacturing products bearing the Monjiro Ika design and posting them online. ② The IP High Court found adaptation and public-transmission infringement because the images' essential expressive characteristics were directly perceptible, partially upholding injunction and damages claims. ③ Analysis should address Article 28 and identification of the protected expression while distinguishing the court's treatment of individual rights from the author's differing views.
Patent	IP High Court, 2023 (Gyo-Ke) No. 10105 [Electronic Money Remittance Method] <Presiding Judge Nakadaira> ① The case concerned inventive step in an electronic money remittance method, comparing "certification information" with IDs, account numbers, and other cited data. ② The court recognized inventive step because certification information including digital signatures differed technically from mere IDs, and Alipay account numbers and passwords did not qualify. ③ Information-related inventions require comparison of the technical significance of data beyond their names or apparent form.
General IP	[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima> ① A royalty claim under a patent license agreement concerned whether a payment pledge submitted by the company's representative created a personal joint and several guarantee. ② The court found a personal guarantee agreement and ordered the company and representative jointly and severally to pay JPY 22 million plus delay damages. ③ When a representative submits a document concerning company debt, the obligations assumed in a personal capacity require careful review.
Patent	Osaka District Court, 2023 (Wa) No. 12280 [Seawall] <Presiding Judge Takemiya> ① The dispute concerned satisfaction of a seawall limitation requiring "packing for watertightness" between a transparent resin plate and its frame. ② The court required watertightness throughout the intervening space and found the rubber gasket insufficient, with proof still lacking when the glazing bead was included. ③ Functional limitations require attention to the extent of the required effect and proof of actual operation involving multiple components.
General IP	[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima> ① A royalty claim under a patent license agreement concerned whether a payment pledge submitted by the company's representative created a personal joint and several guarantee. ② The court found a personal guarantee agreement and ordered the company and representative jointly and severally to pay JPY 22 million plus delay damages. ③ When a representative submits a document concerning company debt, the obligations assumed in a personal capacity require careful review.
General IP	[Contract] IP High Court, 2024 (Ne) No. 10058 [Development of Green Laver Spore Collection Technology Using a Waterwheel] <Presiding Judge Hibiku Shimizu> ① The dispute concerned whether publication about waterwheel-based green laver spore collection breached a joint research agreement or obstructed patent acquisition. ② The court found neither unauthorized publication of research results nor contractual nonperformance through patent obstruction, because the idea predated the research and no specific technical details were disclosed. ③ Joint research requires distinguishing preexisting ideas from concrete research results and examining what a publication actually discloses.
General IP	<IP Practice Online> The Umbrella Theory Has Also Returned! But Should Disclaimer Claims Really Be This Unrestricted? (Shibata) ① Kazuo Shibata's presentation examines the umbrella theory concerning the exclusionary effect of priority and amendment practice using disclaimer claims as respective topics. ② It raises concerns that later exclusion of undisclosed matter may substantively transform an invention and reviews cases allowing and denying inventive step. ③ A proposed disclaimer requires examination of the invention's technical content before and after amendment, alongside its ability to overcome an objection.

Category	Article Title and Three-Line Summary
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10050 [Information Processing Device] <Presiding Judge Miyasaka>** **① The dispute concerned whether an information processing device qualified as an invention utilizing laws of nature despite not expressly reciting depreciation calculation.** **② The court recognized invention eligibility because software processing was concretely implemented using CPU and memory resources and supported by described embodiments, and dismissed the claim for revocation of the decision rejecting the invalidation request.** **③ Even business-related information processing requires examination of concrete hardware implementation and the description.**
Patent	**IP High Court, 2024 (Gyo-Ke) No. 10053 [Wood-Based Board] <Presiding Judge Hibiku Shimizu>** **① The dispute concerned differences in flake length, homogeneity, and absence of knots in a wood-based board and whether synergistic effects existed.** **② The court denied inventive step, endorsing separate treatment of differences in the absence of disclosed synergy and finding length adjustment obvious and other features insubstantially different or obvious.** **③ Arguments based on combined features require scrutiny of disclosed interrelationships or synergy and the technical significance of numerical ranges.**

Osaka District Court, 2023 (Wa) No. 10237 [Wild Animal Slaughtering Tool] <Presiding Judge Takemiya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af10237%e3%80%90%e9%87%8e%e7%94%9f%e5%8b%95%e7%89%a9%e5%b1%a0%e6%ae%ba%e7%94%a8%e5%85%b7%e3%80%91%ef%bc%9c%e6%ad%a6%e5%ae%ae/

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Osaka District Court, 2023 (Wa) No. 10237 [Wild Animal Slaughtering Tool] <Presiding Judge Takemiya>

⇒ Claim limitations not satisfied (according to the original article, the limitations were also not satisfied on appeal).

Limitation A (telescopic nature of the rod):

The invention refers to a structure in which the rod itself extends and contracts, whereas the rod of the defendant's product has a fixed length.

Limitation F (carried on the back):

The invention requires a configuration in which the battery and other equipment are carried on the back, whereas the defendant's product is assembled and used at the site, does not need to be carried on the back, and has no such accessories.

Limitation G (physical parallel arrangement of two electric cords):

In the invention, the electric cord connecting the power switch unit to the DC/AC inverter is physically parallel to the electric cord connecting the metal needle to the DC/AC inverter, and the operator holds the rod with one hand and operates the power switch unit with the other. In the defendant's product, the power switch unit is inserted in series along the electric cord connecting the metal needle to the DC/AC inverter, and the distance between the rod and the power switch unit is also short.

Limitation H (grounding electrode in the soil):

The invention forms a circuit passing through the soil, whereas the defendant's product does not use a grounding rod or the like and has a circuit configuration that does not pass through the soil.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93555.pdf

IP High Court, 2024 (Gyo-Ke) No. 10008 [Methods and Apparatus for Using Reference Signals for Time and Frequency Tracking in New Radio] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110008%e3%80%90%e6%96%b0%e7%84%a1%e7%b7%9a%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e6%99%82%e9%96%93%e5%8f%8a%e3%81%b3%e5%91%a8%e6%b3%a2%e6%95%b0%e3%83%88/

Publication date on the list page: March 27, 2026

IP High Court, 2024 (Gyo-Ke) No. 10008 [Methods and Apparatus for Using Reference Signals for Time and Frequency Tracking in New Radio] <Presiding Judge Hibiku Shimizu>

The “indication as part of a CSI-RS resource set definition” in the amended invention of the application is information constituting part of the information (definition) that clearly limits the content of the CSI-RS resource set, and indicates “part of the CSI-RS resource set.”

Accordingly, the amended invention of the application and the cited invention are common in having “means for receiving information indicating part of a CSI-RS resource set.”

⇒ Configuring the cited invention’s “information indicating part of a set of single-symbol CSI-RS resources” as an “indication as part of a definition,” as in the amended invention of the application, could readily have been conceived by a person skilled in the art.

⇒ No inventive step.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93574.pdf

IP High Court, 2024 (Gyo-Ke) No. 10005 [System for Electronic Patient Care] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110005%e3%80%90%e9%9b%bb%e5%ad%90%e6%82%a3%e8%80%85%e4%bb%8b%e8%ad%b7%e7%94%a8%e3%81%ae%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c%e6%b8%85/

Publication date on the list page: March 27, 2026

IP High Court, 2024 (Gyo-Ke) No. 10005 [System for Electronic Patient Care] <Presiding Judge Hibiku Shimizu>

The court found that “web services,” meaning “technology that links multiple application systems distributed over the Internet (conforming to standards such as XML),” and “transaction,” meaning “multiple processes treated as a single unit that can ensure data consistency,” were each common general technical knowledge.

Accordingly, “transaction-based web services” clearly means “web services based on transactions” and cannot be said to be unclear even without a specific explanation in the description.

⇒ The court revoked the appeal decision because both its finding of a lack of clarity and its finding of non-compliance with the enablement requirement based on that lack of clarity were erroneous.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93571.pdf

IP High Court, 2024 (Gyo-Ke) No. 10018 [Motor Vehicle] <Presiding Judge Miyasaka> = IP High Court, 2023 (Ne) No. 10042

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110018%e3%80%90%e5%8e%9f%e5%8b%95%e6%a9%9f%e4%bb%98%e8%bb%8a%e4%b8%a1%e3%80%91%ef%bc%9c%e5%ae%ae%e5%9d%82%e8%a3%81%e5%88%a4%e9%95%b7%ef%bc%9e-%ef%bc%9d/

Publication date on the list page: March 27, 2026

IP High Court, 2024 (Gyo-Ke) No. 10018 [Motor Vehicle] <Presiding Judge Miyasaka>

= 2023 (Ne) No. 10042 <Presiding Judge Miyasaka>

The invention prohibits operation of the engine stopping device when a failure is detected.

The invention of Exhibit Ko 1 (a vehicle equipped with an idle-stop device and a braking-force holding device) and the matters described in Exhibit Ko 5 (abnormality detection and warning in a hill-start assist device) share a technical field: both concern vehicles equipped with a braking-force holding device and using a function that maintains the brakes in the applied state.

A failure of the braking-force holding device is also an anticipated problem in the invention of Exhibit Ko 1, and it is clear that an abnormality in that device would prevent the brake fluid pressure from being maintained; there is therefore motivation to add the matters described in Exhibit Ko 5 (an abnormality detection signal) to solve that problem.

The invention of Exhibit Ko 1 embodies the technical concept of resolving problems such as sudden acceleration upon restarting after an idle stop by operating the braking-force holding device.

Accordingly, where the braking-force holding device fails and cannot operate, using that detection result as a condition for idle stop and adopting a configuration that prohibits its operation (Difference 3) could readily have been achieved by a person skilled in the art.

Whether simply to issue a warning upon failure (Exhibit Ko 5), prohibit operation of the device (the invention), or do both is a matter of design choice.

⇒ No inventive step.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93661.pdf

<IP Practice Online> “How English-to-Japanese Patent Translators Think in Supporting the Application Process…” (Tatsuya Yabuuchi)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%ef%bc%9c%e7%9f%a5%e8%b2%a1%e5%ae%9f%e5%8b%99%e3%82%aa%e3%83%b3%e3%83%a9%e3%82%a4%e3%83%b3%ef%bc%9e%e3%80%8c-%e5%87%ba%e9%a1%98%e3%83%97%e3%83%ad%e3%82%bb%e3%82%b9%e3%82%92%e6%94%af%e3%81%88%e3%82%8b/

Publication date on the list page: March 27, 2026

<IP Practice Online> “How English-to-Japanese Patent Translators Think in Supporting the Application Process: Translators’ Decisions and Thinking That Connect Technology, Law, and Language” (Tatsuya Yabuuchi)

The presentation opens up “what goes on inside translators’ heads (the black box)” and articulates the logic and risk hedging on which their choices of translation terms are based.

1. The Translator’s Role in Connecting “Technology, Law, and Language”

“Word-for-word translation (literal or mirror translation)” is frequently discussed in patent translation, but English and Japanese have fundamentally different linguistic structures.

Translators exercise sophisticated judgment while balancing the following three elements.

• Technology

Accurately visualizing and understanding the invention’s physical operation and mechanism (its actual substance), rather than merely the words on the surface.

• Law

Conforming to Japan’s Patent Act, examination guidelines, and IP industry conventions (established practices), so that the translation functions as a legal document that will not be disadvantageous in examination.

• Language

Constructing natural Japanese that examiners and patent attorneys can understand smoothly and without misunderstanding, without changing the scope of rights by even a millimeter.

2. Translators’ “Thinking” and Specific Examples of Decisions

Distinguishing translations of treatment: The lecture materials present an example translating treatment as ‘処置’ in light of the difference in meaning between therapy and treatment. Where therapeutic treatment and prophylactic treatment appear together, translating them as ‘治療的処置’ and ‘予防的処置’ preserves the relationship between the original terms, avoids unnatural Japanese, and reduces subsequent corrections.

Legal consideration: Whether an invention falls within methods of surgery, therapy, or diagnosis of humans must be examined in light of the substance of the invention; translating ‘治療’ as ‘処置’ alone cannot avoid the issue of industrial applicability.

Lecture materials (Tatsuya Yabuuchi, January 22, 2026, slide 17):
https://drive.google.com/file/d/10HKuyknaSRHI4g7EB1qdaI0h965vco6l/view

Appropriate selection of legal terminology (practical supplementary point): The expression ‘without wishing to be bound by theory’ in an English patent description may be translated as ‘理論に拘束されることを望むものではないが’. The choice between ‘束縛’ and ‘拘束’ should be considered in light of the original context and consistency with terminology throughout the document.

• Handling syntax without changing the scope of rights (practical supplementary points: the “to” listing format and modifier relationships)

In claims listing elements (A, B, and C), rather than simply translating this as “A、B、及び C,” use the “to” listing format, such as “A と、B と、C と,” to indicate at an early stage whether the relationship is inclusive (and) or alternative (or).

In complex English claims containing lengthy sequences of postmodifiers for constituent elements, avoid “free translation” that prioritizes readability in Japanese and arbitrarily limits or narrows the scope of rights.

Logically distinguish whether “at least one of” should be translated as “～の少なくとも 1 つ” (at least one of ~) or “～のうちの少なくとも 1 つ” (at least one among ~).

Style guides and consistency of notation: The importance of maintaining consistency throughout the description, including full-width versus half-width numerals and letters, and the use of kanji versus hiragana, such as “及び／および” (and) and “又は／または” (or).

https://www.youtube.com/live/JzBCX4A6yPM?si=n1eV0NT79XBR27Qb

Tokyo District Court, 2023 (Wa) No. 70495 [Spindle Motor] (Claim for Employee Invention Compensation) <Presiding Judge Nakashima>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70495%e3%80%90%e3%82%b9%e3%83%94%e3%83%b3%e3%83%89%e3%83%ab%e3%83%a2%e3%83%bc%e3%82%bf%e3%80%91%ef%bc%88%e8%81%b7%e5%8b%99/

Publication date on the list page: March 27, 2026

Tokyo District Court, 2023 (Wa) No. 70495 [Spindle Motor] (Claim for Employee Invention Compensation) <Presiding Judge Nakashima>

⇒ Claim dismissed (inventor status denied).

By the time the plaintiff submitted an explanatory document to the plaintiff's supervisor, the invention by Di and others had already been announced.

At the time, the plaintiff worked in Shiga while Bi and others worked in Kyoto; they had no work-related contact, and there was no evidence that the plaintiff's proposal had been circulated to Bi and others.

The plaintiff's proposal was clearly different from the concept underlying the patent at issue.

The plaintiff did not attend the meeting at which Di and others' invention was announced and did not belong to the development department.

The plaintiff's proposal differed in configuration from the invention by Di and others.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94170.pdf

IP High Court, 2024 (Gyo-Ke) No. 10081 [Pet Matching System] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110081%e3%80%90%e6%84%9b%e7%8e%a9%e5%8b%95%e7%89%a9%e3%83%9e%e3%83%83%e3%83%81%e3%83%b3%e3%82%b0%e3%82%b7%e3%82%b9%e3%83%86%e3%83%a0%e3%80%91%ef%bc%9c-2/

Publication date on the list page: March 27, 2026

IP High Court, 2024 (Gyo-Ke) No. 10081 [Pet Matching System] <Presiding Judge Nakadaira>

* No inventive step in the disclaimer claim.

A limitation 'excluding animal hospitals and locations where a veterinarian is present' was added to distinguish the invention from the prior art (a system encompassing handover at animal hospitals and similar locations, but whose handover location was not found to be limited to those locations), but it was held to be obvious.

(Excerpt from the Holding)

The plaintiff argues that … the handover location in the cited invention being "at least one of a veterinarian or an animal hospital" forms the core of the cited invention's technical concept and is an essential requirement for solving its problem; changing the handover location from "at least one of a veterinarian or an animal hospital" to a location other than an animal hospital or a place where a veterinarian is present would change an essential requirement that forms the core of the cited invention's technical concept and solves its problem, and would thus contradict that technical concept, so there is no motivation and, rather, there is a teaching away.

However, this argument by the plaintiff assumes that the animal handover location in the cited invention is limited to an animal hospital or a location where a veterinarian is present; because this assumed premise is not established …, the plaintiff's argument lacks its premise and cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94642.pdf

IP High Court, 2024 (Gyo-Ke) No. 10039 [Embossed Bag] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110039%e3%80%90%e3%82%a8%e3%83%b3%e3%83%9c%e3%82%b9%e3%82%92%e6%9c%89%e3%81%99%e3%82%8b%e8%a2%8b%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%e8%a3%81/

Publication date on the list page: March 27, 2026

IP High Court, 2024 (Gyo-Ke) No. 10039 [Embossed Bag] <Presiding Judge Hibiku Shimizu>

Cited Inventions 1 and 2 both belong to the same technical field of “embossing in which a film is pressed using a roll.”

The “pear-skin textured portion” of Cited Invention 1 and the “multiple rows of waves” in Cited Document 2 share the action and function of “expressing a pattern by forming minute irregularities on the film surface without providing a printing process.”

⇒ Obvious (no inventive step).

★ Numerical ranges are matters of design choice:

The numerical ranges for the period and height of the irregularities (the application’s 0.1 μm–1 mm, etc., overlap with Cited Document 2’s 500 μm–2 mm, etc.) are merely matters of design choice that a person skilled in the art could select as appropriate according to the visibility of the pattern and other considerations.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93697.pdf

Tokyo District Court, 2023 (Wa) No. 70738 [Wine Cellar] <Presiding Judge Takahashi>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70738%e3%80%90%e3%83%af%e3%82%a4%e3%83%b3%e3%82%bb%e3%83%a9%e3%83%bc%e3%80%91%ef%bc%9c%e9%ab%99%e6%a9%8b%e8%a3%81%e5%88%a4/

Publication date on the list page: March 27, 2026

Tokyo District Court, 2023 (Wa) No. 70738 [Wine Cellar] <Presiding Judge Takahashi>

Limitation E3: “Restarting the compressor when the temperature around the cooler after the heating heater has stopped reaches a ‘third temperature (second temperature < third temperature).’”

⇒ In the defendant’s product, the heater stop temperature (P11) and the compressor restart temperature (P6) were set to the same temperature.

The defendant’s product has a “compressor protection function (delay timer),” and restarting may take time even when the temperature settings are the same; however, the experimental results also included cases where the temperature at restart was lower than at heater stop, and it cannot be found that control consistently uses a “third temperature higher than the second temperature.”

⇒ Claim limitation not satisfied.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95140.pdf

IP High Court, 2025 (Gyo-Ko) No. 10001 “Appeal in an Action Seeking Revocation of an Administrative Disposition” <Presiding Judge Masuda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c7%e5%b9%b4%e8%a1%8c%e3%82%b310001%e3%80%8e%e5%87%a6%e5%88%86%e5%8f%96%e6%b6%88%e8%ab%8b%e6%b1%82%e6%8e%a7%e8%a8%b4%e4%ba%8b%e4%bb%b6%e3%80%8f%ef%bc%9c%e5%a2%97%e7%94%b0%e8%a3%81/

Publication date on the list page: March 27, 2026

IP High Court, 2025 (Gyo-Ko) No. 10001 “Appeal in an Action Seeking Revocation of an Administrative Disposition” <Presiding Judge Masuda>

The judgment below held that there was no interest in revocation because, even if the disposition were revoked, the procedure for the request for examination of the application would inevitably be dismissed as procedurally unlawful.

⇒ The appellate judgment found that the appellant had a legal interest in revocation: if the disposition were revoked by judgment, the Commissioner of the Japan Patent Office could not again dismiss the procedure on the same grounds, and the appellant would be able to receive examination.

Next, as to the unlawfulness of the disposition, the Patent Act provides that a request for examination of an international patent application filed in a foreign language cannot be made until after procedures such as submission of translations have been completed (Article 184-17).

The appellant requested examination before submitting the translations, which does not satisfy the requirements of that provision.

The Patent Act contains no provision permitting a defect in this sequence to be cured.

A request for examination lacking translations should be treated in the same way as a patent application lacking an attached description and other documents; because substantive examination cannot be conducted, the defect is fundamental and cannot be cured by amendment.

Accordingly, even though translations were submitted later, the defect was not cured, and the disposition was not unlawful.

The appellant also argued that the Commissioner of the Japan Patent Office made the disposition only after it had become impossible to request examination again, contrary to the purpose of Article 7 of the Administrative Procedure Act and in excess of discretionary authority; the court rejected this argument, holding that the Commissioner could not be understood to have a general duty to issue a dismissal while it was still possible to request examination again.

⇒ Appeal dismissed. Although the first-instance judgment's reasoning for dismissing the action as inadmissible was erroneous, the claim was found to lack merit. Because the appellee had filed neither an appeal nor an incidental appeal, the prohibition on a change disadvantageous to the appellant prevented replacing the judgment with a dismissal on the merits, and the court confined its disposition to dismissing the appeal.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95134.pdf

[EPO Board of Appeal Decision] T0070/23 (Immunogenic Composition/GSK)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90epo%e5%af%a9%e6%b1%ba%e3%80%91t0070-23-%e5%85%8d%e7%96%ab%e5%8e%9f%e6%80%a7%e7%b5%84%e6%88%90%e7%89%a9-gsk/

Publication date on the list page: March 27, 2026 (Date displayed on the individual article page: March 26, 2026.)

[EPO Board of Appeal Decision] T0070/23 (Immunogenic Composition/GSK)

<Issue>

Whether “therapeutic efficacy,” which is not expressly recited in the claim, should be included in claim construction as an implicit functional feature based on the description.

<Board of Appeal’s Findings in This Decision>

Where the claim itself is clear, the description cannot be used to adopt a restrictive interpretation.

Moreover, the wording of the relevant paragraph is general and does not substantiate any particular efficacy.

⇒ The main request and auxiliary requests 2 to 6 lacked inventive step; auxiliary request 1 was not admitted on procedural grounds, and the patent was revoked.

https://www.epo.org/en/boards-of-appeal/decisions/t230070eu1

Supplement (subsequent Enlarged Board decision): This decision was issued on January 28, 2025. Subsequently, G 1/24 (June 18, 2025) held that, when assessing patentability under Articles 52 to 57 EPC, the description and drawings must always be consulted when interpreting claims, and not only where the claims are unclear or ambiguous. Consulting the description and determining whether an unrecited limitation can be imported into a claim require separate consideration.

Reference: EPO Enlarged Board of Appeal, G 1/24 (June 18, 2025)

<IP Practice Online> The Front Line of Standard Essential Patents (SEPs): Practice in Light of Global Litigation Trends — Akiko Araki

Original Article URL: https://www.nakapat.gr.jp/ja/note/%ef%bc%9c%e7%9f%a5%e8%b2%a1%e5%ae%9f%e5%8b%99%e3%82%aa%e3%83%b3%e3%83%a9%e3%82%a4%e3%83%b3%ef%bc%9e-%e6%a8%99%e6%ba%96%e5%bf%85%e9%a0%88%e7%89%b9%e8%a8%b1%ef%bc%88sep%ef%bc%89%e3%81%ae%e6%9c%80/

Publication date on the list page: March 27, 2026 (Date displayed on the individual article page: March 26, 2026.)

<IP Practice Online> "The Front Line of Standard Essential Patents (SEPs): Practice in Light of Global Litigation Trends" (Akiko Araki, Attorney at Law, Patent Attorney, and California Attorney)

1. Current Status of SEPs and FRAND Licenses

SEPs are patents essential to implementing standardized technology. Their holders' obligations to offer licenses on FRAND (fair, reasonable, and non-discriminatory) terms are based on the applicable standard-setting organization's IPR policy and the holders' declarations or undertakings.

Basis and scope of FRAND obligations: ETSI's official explanation states that "holders are requested to provide an irrevocable undertaking in writing". In summary, the specific basis and scope of FRAND licensing obligations must be examined in relation to each standard-setting organization's IPR policy and the holder's FRAND declaration or undertaking; the statement does not mean that identical obligations automatically arise solely because a patent is standard-essential. Source: ETSI official materials

However, disputes over royalty rate determination and the availability of injunctions are intensifying; in particular, licensing negotiations are becoming more complex as the technology spreads to AI and IoT devices.

2. Changes in International Litigation Trends

Europe (use of the UPC): With the European Unified Patent Court (UPC) becoming operational, right holders can obtain injunctions covering a broad area of Europe in a single proceeding.

This is a powerful weapon for right holders and a factor substantially changing the balance of negotiating power.

• Expansion of Chinese Judicial Authority

Chinese courts are actively asserting jurisdiction to determine worldwide licensing rates (global rate-setting jurisdiction), and China has become a focal point of international jurisdictional disputes.

• Developments in the United States

Injunctions remain difficult to obtain, and the principal issue continues to be monetary resolution: "What is the appropriate royalty?"

3. Battles over Injunctions (ASI/AASI)

Exchanges of anti-suit injunctions (ASIs), prohibiting the continuation of litigation in other countries, and countervailing anti-anti-suit injunctions (AASIs) are occurring frequently.

Conflicts of judicial jurisdiction are particularly evident between China and Europe (including Germany), increasing the importance of strategic selection of jurisdictions (forum shopping).

4. Impact of the Proposed EU SEP Regulation

The SEP regulation proposed by the European Commission included essentiality checks and a procedure for determining FRAND terms through a competence centre to be established at the European Union Intellectual Property Office (EUIPO).

Had it been implemented, the proposal could have prompted a rethinking of conventional negotiation processes.

https://youtu.be/Y3YND0nJzd4

Supplement (status of the proposal): According to the European Parliament's legislative procedure file, the Commission formally withdrew the proposal in October 2025. In November 2025, Parliament approved maintaining its action before the Court of Justice seeking annulment of the withdrawal decision. Accordingly, a March 2026 account should not present the proposal as continuing through the legislative process without mentioning its withdrawal.

Reference: European Parliament, legislative procedure 2023/0133(COD)

[United States] In re Butler (CAFC, September 17, 2025)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e7%b1%b3%e5%9b%bd%e3%80%91in-re-butler%ef%bc%88cafc%e3%80%812025-9-17%ef%bc%89/

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[United States] In re Butler (CAFC, September 17, 2025)

The written description requirement for a negative limitation (disclaimer claim) is assessed by whether the original disclosure conveys to skilled artisans that the inventor possessed the claimed invention remaining after exclusion as of the filing date. Generally, the description must contain some disclosure indicating a reason for exclusion, but the negative limitation need not be recited verbatim.

Distinguishing an element from its alternatives in the description is one way of indicating a reason to exclude it. Even where the description is silent, the requirement may be satisfied if it is established that skilled artisans would always understand the element to be necessarily excluded.

In this case, such support for the limitation excluding germanium was insufficient. Source: judgment, pp. 5 and 7–9.

https://www.cafc.uscourts.gov/opinions-orders/23-2380.OPINION.9-17-2025_2574190.pdf

Supplement: This decision is designated nonprecedential (without binding precedential effect). Its opening note states: “NOTE: This disposition is nonprecedential.”

[Article] Protection of Avatar Names and Likenesses under Intellectual Property Law and Other Laws (Yasuyuki Echi, Patent Supplement, 2025, Vol. 78, No. 31, pp. 217–226)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf%e3%80%91%e3%82%a2%e3%83%90%e3%82%bf%e3%83%bc%e3%81%ae%e5%90%8d%e7%a7%b0%e3%83%bb%e8%82%96%e5%83%8f%e3%81%ae%e7%9f%a5%e7%9a%84%e8%b2%a1%e7%94%a3%e6%b3%95%e7%ad%89%e3%81%ab/

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[Article] Protection of Avatar Names and Likenesses under Intellectual Property Law and Other Laws (Yasuyuki Echi, Patent Supplement, 2025, Vol. 78, No. 31, pp. 217–226)

Bibliographic information: Yasuyuki Echi's "Protection of Avatar Names and Likenesses under Intellectual Property Law and Other Laws" appears in Patent Supplement, 2025, Vol. 78, No. 31, pp. 217–226. Source: J-STAGE publication information

1. Copyright Act

① Names: As with character names, copyright protection is denied because they are merely ideas.

② Likenesses (appearance): Avatars completed by combining parts and finely adjusting parameters using 3D avatar creation software (such as VRoid Studio) are generally recognized as copyrightable works.

Individual parts: If individual parts (eyes, hairstyles, etc.) themselves are creative, unauthorized use of those parts may also constitute infringement.

2. Trademark Act and Unfair Competition Prevention Act

If an avatar serves to indicate the "source" of goods or services (for example, use as a VTuber's logo), protection is possible under trademark rights or the Unfair Competition Prevention Act (Article 2(1)(i) and (ii)).

3. Avatar "Movements" and Neighboring Rights

① Use of motion capture: If the movements of the "person behind the avatar" are reflected with a reasonable degree of accuracy, they are considered a "performance" by the performer (the person behind the avatar), allowing neighboring rights to be exercised against unauthorized recording or live streaming.

② Controller operation: Conduct similar to controlling a game character does not, in principle, constitute a "performance."

③ Voice: Voice acting through an avatar is protected directly by performers' rights (oral performance, recitation, etc.).

4. Examination of Views Concerning Portrait and Publicity Rights

Echi introduces Shinichiro Harada's view that, if a person's likeness is understood as something that identifies or specifies that person, a VTuber's CG avatar may be recognized as the person's likeness even if

it does not reflect the actual appearance of the person behind it. The quoted wording by Harada is ‘彼女・彼の『肖像』と認めることに障害はないはずである’ (translation: ‘there should be no obstacle to recognizing it as her or his likeness’). In summary, this view recognizes protection of an avatar as a likeness on the basis of identification of the person. Echi himself, however, states that there is ‘疑問の余地もある’ (translation: ‘room for doubt’) as to whether identifying information always constitutes a symbol of personality, and also examines the connection with the person’s personality. Source: original article, pp. 223–224 and footnote 41.

5. “Coincidental Similarity” and Liability for Infringement

<Liability after becoming aware> Even if negligence is not established at the time of generation, for example where the likeness was not included in the training data, Echi argues that continued avatar use after becoming aware, through a warning or otherwise, that the likeness is identical to another person’s likeness should constitute infringement of portrait or publicity rights and should give rise to an injunction and damages. This is the author’s view. The original article also states ‘警告前の過去の行為に対する損害賠償は否定される’ (translation: ‘damages for past acts before the warning are denied’), distinguishing generation before awareness from continued use after awareness. Source: original article, p. 226.

https://www.jstage.jst.go.jp/article/patentsp/78/31/78_217/_pdf/-char/ja

[Trademark/Article] “Onomatopoeia as Trademarks—The Current Situation in Japan and Other Countries—” (AIPPI (2025), Vol. 70, No. 11, Masako Nishimura)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%95%86%e6%a8%99-%e8%ab%96%e7%a8%bf%e3%80%91%e3%80%8e%e5%95%86%e6%a8%99%e3%81%a8%e3%81%97%e3%81%a6%e3%81%ae%e3%82%aa%e3%83%8e%e3%83%9e%e3%83%88%e3%83%9a%e3%83%bc%e6%97%a5%e6%9c%ac%e3%81%ae/

Publication date on the list page: March 13, 2026

[Trademark/Article] “Onomatopoeia as Trademarks—The Current Situation in Japan and Other Countries—” (AIPPI (2025), Vol. 70, No. 11, Masako Nishimura)

Original title and author: The Japanese title is “商標としてのオノマトペ―日本の現状と各国の状況―”; the author is Masako Nishimura. Source: AIPPI Japan official contents

1. Current Status and Distinctiveness of Onomatopoeic Trademarks in Japan

Japanese makes extensive use of onomatopoeia (sound-imitating and mimetic words), and numerous onomatopoeic expressions have been registered as trademarks, including “mochimochi” and “sakusaku,” which describe food textures, and the newly coined word “mofumofu.”

In assessing distinctiveness, registration is generally not permitted where an expression indicates the quality of goods or services (is descriptive), but it is registered where that is not the case.

Trends in Court and Appeal Decisions:

In a past case involving “Sasatto” for designated goods including “tea and coffee,” the IP High Court (judgment of April 26, 2006, 2005 (Gyo-Ke) No. 10851) denied distinctiveness because the expression conveyed meanings such as “can be prepared quickly.”

There has also been a case denying distinctiveness to the newly coined word “pien” for designated apparel goods because it expressed a “feeling of disappointment” and similar sentiments.

Judgment (IP High Court, 2005 (Gyo-Ke) No. 10851, April 26, 2006): https://www.courts.go.jp/assets/hanrei/hanrei-pdf-32931.pdf

When assessing distinctiveness, it is necessary to check entries not only in general dictionaries such as Kojien but also in specialized dictionaries such as onomatopoeia dictionaries.

2. Situation in Other Countries and Regions

According to responses to inquiries addressed to law firms and other entities in various countries and regions, no special examination standards exist for onomatopoeic trademarks; they are assessed under general distinctiveness standards.

Europe and North America (Germany, France, the United States, and Canada): In the United States and Germany, there are examples of animal calls and similar expressions being registered for related goods (for example, “BOW-WOW” for dog toys in the United States and “MUH” for dairy products in Germany). In France, expressions such as “Miam” (delicious) have been registered, but there has recently been a trend toward stricter assessment. In Canada, onomatopoeia expressing sounds inherent in the goods (for example, “DING-DING” for bells) is likely to be refused as descriptive.

Asia (China, Hong Kong, South Korea, and Taiwan): In China, distinctiveness is more likely to be recognized where the connection with the designated goods is weak, but it is denied where the expression directly describes texture or similar qualities. Hong Kong is relatively strict, and registration of the tram sound “Ding Ding” is exceptional. In South Korea, distinctiveness is denied where an expression intuitively conveys the nature of the designated goods (for example, “ppodeuk-ppodeuk,” the sound of wiping something clean, for cleaning implements).

3. Conclusions and Recommendations

Japanese is rich in onomatopoeia, so it is frequently adopted for trademarks, but this is not necessarily the case abroad, where it has not become an issue.

When adopting an onomatopoeic trademark, it is important to consider not only registrability but also whether it creates a favorable impression on consumers; future research is needed in “trademark linguistics,” bridging linguistics and trademark practice.

https://www.aippi.or.jp/info/view/515

[Article/Patent] A Study of the Limits of Disclaimer Claims (Kenji Tanaka et al., Patent, 2025, Vol. 78, No. 7, pp. 85–97)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e9%99%a4%e3%81%8f%e3%82%af%e3%83%ac%e3%83%bc%e3%83%a0%e3%81%ae%e9%99%90%e7%95%8c%e3%81%ab%e3%81%a4%e3%81%84%e3%81%a6%e3%81%ae%e6%a4%9c%e8%a8%8e/

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[Article/Patent] A Study of the Limits of Disclaimer Claims (Kenji Tanaka et al., Patent, 2025, Vol. 78, No. 7, pp. 85–97)

1. Analysis of Trends in Japan Patent Office Decisions

A study of examination and appeal cases from fiscal year 2021 found that arguments for inventive step based on disclaimer claims were unsuccessful in approximately 12% of cases. The original article treats this proportion as a reference value because different criteria for removing irrelevant cases were used for cases where the grounds for refusal were overcome and those where they were not.

2. Four Categories in Which Inventive Step in Disclaimer Claims Is Denied

Cases where introducing a disclaimer claim did not overcome a lack-of-inventive-step objection fall into the following four categories.

① Design choices: Cases where the technical difference at the excluded boundary was small and considered to fall within the range a person skilled in the art could modify as appropriate.

② New references: Cases where the original reference was avoided but refusal followed based on different prior art.

③ Insufficient scope of exclusion: Cases where the overlapping portion of the cited invention was found not to have been completely excluded.

④ Not an essential configuration of the reference: Cases where only an optional feature of the reference was excluded and omitting that configuration was considered easy.

⇒ Where a nonessential configuration of the primary reference was excluded, a greater tendency toward refusal on the grounds of “design choices” or “not an essential configuration” was found than where an essential configuration was excluded.

Scope of the original article: The article states (translation): ‘When a nonessential configuration of the primary reference was excluded, a tendency toward refusal on grounds of “(i) design matter” or “(iv) not an essential configuration” was found compared with cases where an essential configuration of the primary reference was excluded’ (p. 90). It further assesses claims excluding an essential configuration of the primary cited invention as having ‘進歩性が認められる可能性が比較的高いと考えられる’ (translation: ‘a comparatively high likelihood of recognition of inventive step’) (p. 92). In summary, while recognizing the comparatively high potential effectiveness of excluding essential configurations, the authors caution that a configuration formally recited in a claim is not necessarily essential and that the cited invention’s problem-solving principle must be understood. Excluding an essential configuration does not automatically establish inventive step; the

guidance below on ‘what to exclude’ also requires examination of the particular cited invention and the invention remaining after exclusion. Source: Kenji Tanaka et al., A Study of the Limits of Disclaimer Claims, pp. 90 and 92–93. Original source

3-1. “Addition of New Matter” Arising from Disclaimer Claims

Using a boundary value absent from the original description (such as a numerical value in a reference) creates a risk of being regarded as introducing new technical matter.

3-2. “Failure to Satisfy the Clarity Requirement” Arising from Disclaimer Claims

Functional or abstract exclusionary expressions such as “those not falling within ~” are considered to prevent an unambiguous understanding of the scope of rights.

3-3. “Failure to Satisfy the Support and Enablement Requirements” Arising from Disclaimer Claims

An insufficiency of specific working examples or supporting disclosure is identified in the description for the scope remaining after the exclusion.

4. Guidelines for Using Disclaimer Claims

① What to exclude: Prioritize exclusion of an essential configuration of the primary reference (an element without which its problem cannot be solved).

② Drafting techniques: Rather than copying unclear wording from the reference, define the excluded scope clearly in light of common general technical knowledge.

③ Arguments in written opinions: Do not merely state that “the overlap has been excluded”; logically explain how the exclusion clarifies the “difference in technical concepts” from the reference.

④ Preparation at filing: Preserve options for ordinary narrowing amendments by including extensive disclosure of varied subordinate concepts and alternative configurations in the original description.

https://jpaa-patent.info/patent/viewPdf/4660

[Article/Trademark] Recent Court Decisions on Trademark Similarity: Focusing on Article 4(1)(xi) of the Trademark Act (Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 20–41)

Original Article URL: https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e8%ab%96%e7%a8%bf-%e5%95%86%e6%a8%99%e3%80%91%e5%95%86%e6%a8%99%e3%81%ae%e9%a1%9e%e5%90%a6%e3%81%ab%e9%96%a2%e3%81%99%e3%82%8b%e8%bf%91%e5%b9%b4%e3%81%ae%e8%a3%81%e5%88%a4%e4%be%8b%e3%81%ab/

Publication date on the list page: March 13, 2026

[Article/Trademark] Recent Court Decisions on Trademark Similarity: Focusing on Article 4(1)(xi) of the Trademark Act (Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 20–41)

1. <The Courts' Latest Approach>

The "Tsutsumi no Ohinakkoya" case (Supreme Court, September 8, 2008) has tended to be interpreted as permitting separation only in cases such as where "the portion creates a strongly dominant impression."

Regarding recent Intellectual Property High Court decisions (for example, judgment of February 22, 2021, 2020 (Gyo-Ke) No. 10088, the Holmes-kun case), the article argues that, although the trends in similarity determinations do not differ greatly from those in pre-Reiwa decisions, the framework for determining when separation is permissible is becoming clearer. The following organizes that framework.

Judgment (Holmes-kun case)：https://www.courts.go.jp/assets/hanrei/hanrei-pdf-90043.pdf

① "Separation is permissible if the elements are not inseparably integrated": Returning to the standard in the Lila Supreme Court decision (December 5, 1963), separation is permissible unless the combination is so firmly integrated that separation would be unnatural in trade.

② "A 'considerable' impression is enough": There is a tendency to allow separate observation not only at the high threshold of "strongly dominant" in the Tsutsumi decision, but also at the level of "capable of functioning independently as a source-identifying sign (a considerably strong impression)."

2. Similarity in Pronunciation: The Importance of the "Ear" in the Internet and AI Era

The original article explains that, from the middle of the Heisei period onward, decisions began to consider appearance and concept together with pronunciation in light of actual trade conditions. It also points out that many recent decisions continue to find similarity by placing weight on identical pronunciation.

Comprehensive Assessment: There are examples finding non-similarity despite identical pronunciation where appearance or concept differs markedly (for example, 2020 (Gyo-Ke) No. 10014, the 富富富 case). However, the original article also states '観念・外観において相違していても称呼が同一のケースは類似と判断される判決も多い' (translation: 'there are also many judgments finding similarity in cases with identical pronunciation even though concept and appearance differ'). In summary, alongside examples of non-similarity, the continuing importance of pronunciation must be considered in light of the goods or services and actual trade conditions. Source: original article, p. 24.

Dominance of Visual Information: Appearance carries greater weight in transactions where consumers “see and buy,” such as online shopping.

Voice Search as a Countervailing Force: Meanwhile, the spread of AI speakers and voice search creates situations in which the importance of pronunciation is being reassessed. In practice, identical pronunciation remains a significant risk factor for refusal and infringement.

3. Similarity of Goods and Services: How Can the “Presumption” of Similarity Group Codes Be Overcome?

The Japan Patent Office’s “similarity group codes” are a powerful benchmark, but the courts are not bound by them.

Even where the codes indicate non-similarity, goods or services may be found similar if, in actual practice, they are recognized as being provided by the same business operator (for example, 2024 (Gyo-Ke) No. 10028, the AWG Treatment case).

Congestion in 11C01 (Programs): Today, when every industry handles software, similarity group code 11C01, which includes “computer programs” in Class 9, is saturated and presents a major practical obstacle.

4. Taking Actual Trade Conditions into Account: Selecting the “Facts” to Be Considered

Arguments that “there will be no confusion because our company sells in this particular way” (special or limited circumstances) are, in principle, not accepted.

https://jpaa-patent.info/patent/viewPdf/4716

考慮される事情（一般的・恒常的）	考慮されない事情（特殊的・限定的）
業界全体の慣習、周知・著名性の度合い	自社独自の販売キャンペーン、季節限定の使用
需要者の一般的な注意力の程度	引用商標権者との個別の住み分け合意

English translation of the original figure

Circumstances considered (general and enduring): industry-wide practices; degree of recognition or fame; the general level of consumer attention.

Circumstances not considered (special or limited): the company’s own sales campaigns; seasonally limited use; individual coexistence arrangements with the owner of the cited trademark.

●要部とできるかどうかは、商標において占める割合・独自性・造語性・著名性等の要素を考慮する
ということを考慮することは従前から変わっていない。
これをバロメータ化すると以下のように表現でき、これらを総合的に勘案し、また後述するような取引の実情を加味して分離するか否かが決せられるといえよう。



English translation of the original figure

• The approach of considering factors such as the proportion occupied in the mark, originality, coined character, and fame when determining whether a component can be treated as the essential portion has not changed. Expressed as indicators, these factors appear as shown below. Whether to separate the components is determined by considering them comprehensively, together with the actual trade conditions discussed later.

Separation — easier at the left; more difficult at the right.

Visual unity: absent → present.

Pronunciation of the whole: long → short.

Conceptual connection: weak → strong.

Distinctiveness of a constituent element: absent → present.

Recognition or fame of a constituent element: high → low.

Originality of a constituent element: high → low.

<IP Practice Online> “Generative AI and Intellectual Property Rights, etc.” (Attorney Taichi Kakinuma)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%ef%bc%9c%e7%9f%a5%e8%b2%a1%e5%ae%9f%e5%8b%99%e3%82%aa%e3%83%b3%e3%83%a9%e3%82%a4%e3%83%b3%ef%bc%9e%e3%80%8c-%e7%94%9f%e6%88%90ai%e3%81%a8%e7%9f%a5%e7%9a%84%e8%b2%a1%e7%94%a3%e6%a8%a9%e7%ad%89/

Publication date on the list page: March 13, 2026 (Date displayed on the individual article page: March 12, 2026.)

<IP Practice Online> “Generative AI and Intellectual Property Rights, etc.” (Attorney Taichi Kakinuma)

1. The “Development and Training Stage” and the “Generation and Use Stage”

When legally examining generative AI and copyright issues, it is necessary to distinguish clearly between two phases: the “development and training stage,” in which data is fed into AI to create a model, and the “generation and use stage,” in which users enter prompts and obtain outputs.

2. Copyright Act at the “Development and Training Stage” (Article 30-4)

• General rule (lawful)

Under Article 30-4 of Japan’s Copyright Act, works can generally be collected and used for training without the copyright owner’s permission if the purpose is “non-enjoyment,” such as machine-based “information analysis,” rather than enjoying works by viewing or listening to them.

• Exceptions (cases that may constitute copyright infringement)

However, where a “purpose of enjoyment” is included, such as targeting a particular creator’s works to “output their expression as it is (reflecting it in generated outputs for human enjoyment or use),” the exception under that article does not apply, and copyright infringement may arise under the general rule (for example, intentional overfitting).

3. Assessment at the “Generation and Use Stage” and “Technical Measures”

• The “unlawfulness of training” cannot immediately be inferred retrospectively from “output results.”

Even if an output happens to contain expression in common with an original work used to train the AI (similarity), it is ordinarily not possible, “solely from the fact (result) that a similar output was generated,” immediately to infer retrospectively that “a purpose of enjoyment existed (= the training itself was unlawful)” at the earlier development and training stage.

• The Importance of “Technical Measures” to Prevent Infringement

On the other hand, it is important whether AI developers and service providers implement “restrictive technical measures (safeguards such as filters and guardrails)” to avoid generating infringing material similar to existing works.

Implementing effective technical measures may be one circumstance supporting the argument that there was “no purpose of enjoyment” at the development stage.

Purpose of enjoyment: A purpose of enjoyment under Article 30-4 of the Copyright Act is not synonymous with a subjective intent to infringe. The Legal System Subcommittee of the Copyright Subdivision of the Council for Cultural Affairs, in “AI と著作権に関する考え方について” (March 15, 2024), states (translation): “If even one of these multiple purposes includes a purpose of ‘enjoyment,’ the requirements of that article are not met.” In summary, the issue is whether a purpose of enjoyment exists. Footnote 22 on p. 20 of those materials introduces an opinion that effective technical measures may be a circumstance supporting an inference of a non-enjoyment purpose. The presence or absence of technical measures must be evaluated in light of their content, effectiveness, and other circumstances. Source: Subcommittee materials, pp. 19–21. Original source

4. Risk Management and Responses in Corporate Practice

• Risks of Using Pirated Data

Using unlawfully uploaded pirated material (infringing content) as training data while knowing its nature carries very high legal risks in practice.

• Establishing Internal Systems (Governance)

Compliance-conscious operation is required, including implementation of technical measures and establishment of internal guidelines.

https://youtu.be/pRu-6HkTZMc

[Article/Trademark] Current Status and Issues in Recent Appeal Decisions on Trademark Distinctiveness Following Decisions of Refusal (Rui Asada and Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 42–60)

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[Article/Trademark] Current Status and Issues in Recent Appeal Decisions on Trademark Distinctiveness Following Decisions of Refusal (Rui Asada and Tomohiko Yamada, Patent, 2025, Vol. 78, No. 11, pp. 42–60)

1. The Reality of Rapidly "Stricter" Distinctiveness Assessment

In recent years, in appeals against decisions of refusal based on Article 3(1) of the Trademark Act (distinctiveness), the proportion in which the grounds for refusal are overturned and registration is achieved (the reversal rate) has fallen markedly.

After peaking in 2021, the proportion of appeal decisions allowing registration has dropped sharply since 2022.

2. Changes in Assessment Methods: From Overall Observation to "Arbitrary" Decomposition

There is a clear difference in how composite marks (A+B) were viewed through 2021 and how they have been viewed since 2022.

Former approach (through 2021): Where there were few examples of use of the mark as a whole, or where the word order was recognized as coined, there was a tendency to recognize distinctiveness as a kind of coined expression (for example, "Jun-nama Udon" was registered).

Current approach (from 2022): Even without examples of use of the mark as a whole, there is a tendency to scrutinize the meanings of its individual words and arbitrarily combine them to conclude that the mark "produces a particular meaning (such as an indication of quality)" (for example, "Jun-nama Sanuki Udon" was refused).

A Method of Concern (Risk of Hindsight): Keeping the goods or services in mind and adding related words to the meanings of individual characters to force a meaning from them resembles the "hindsight" prohibited in patent inventive-step assessment.

3. Impact on Business and Branding

Stricter distinctiveness assessment may dampen corporate brand strategies.

Difficulty Securing Rights in Suggestive Marks: There is a risk of widespread refusal of “bold naming (suggestive marks)” such as “Oi Ocha” and “Hobo Kani,” which evoke the appeal of the goods while stimulating demand.

4. Why Does “Correction” Not Occur? The Barrier to Actions Seeking Revocation of Appeal Decisions

The mechanism for checking stricter appeal practice is not functioning sufficiently. The principal reason is the extremely small number of actions seeking revocation of appeal decisions based on lack of distinctiveness.

<Survey Results (Why Is Litigation Not Pursued?)>

Lack of Distinctiveness: The survey covered 46 members of the relevant Japan Patent Attorneys Association (JPAA) committee and 28 members of the Japan Intellectual Property Association (JIPA) Trademark Committee for fiscal year 2024. According to the paper, the proportions not proceeding to a revocation action where distinctiveness alone was at issue were 89.1% (41 of 46) and 82.1% (23 of 28), respectively. These are not the percentages selecting “there is no problem with use” as their reason. The paper discusses the fact that refusal prevents exclusivity but does not prevent actual use, together with litigation costs, as factors behind decisions not to sue.

Similarity: Because use may conflict with another party’s rights and risk being stopped, the paper explains that litigation is considered on a roughly fifty-fifty basis where similarity is at issue. However, its JPAA non-filing figure of 54.1% is inconsistent with the stated count of 28 out of 46 people. This should not be presented as a definitive actual filing rate of “approximately 50–60%.”

As a result, a structure has developed in which the Intellectual Property High Court has few opportunities to “check the appropriateness of distinctiveness assessments.”

https://jpaa-patent.info/patent/viewPdf/4717

拒絶条文	2021年（転覆率）	2023年（転覆率）	傾向
第3条第1項第3号（品質・地名等）	**76.6%**	**24.7%**	大幅低下
第3条第1項第6号（その他識別力欠如）	**77.1%**	**32.9%**	半減

English translation of the original figure

Ground for refusal | 2021 (reversal rate) | 2023 (reversal rate) | Trend

Article 3(1)(iii) (quality, geographical names, etc.): 76.6% | 24.7% | Sharp decline.

Article 3(1)(vi) (other lack of distinctiveness): 77.1% | 32.9% | Halved.

IP High Court, 2024 (Gyo-Ke) No. 10035 [Gaming Machine] <Presiding Judge Honda>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110035%e3%80%90%e9%81%8a%e6%8a%80%e6%a9%9f%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%e8%a3%81%e5%88%a4%e9%95%b7%ef%bc%9e/

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IP High Court, 2024 (Gyo-Ke) No. 10035 [Gaming Machine] <Presiding Judge Honda>

The invention of the application is characterized by providing, in an “image displacement effect” in which an image moves, a “normal mode” in which no vibration occurs and a “special mode” in which vibration occurs and the likelihood of a jackpot is high.

⇒ The Japan Patent Office found it obvious from a combination of the cited invention (Exhibit Ko 1: an image displacement effect with first and second effect modes having different likelihoods) and the technical matters in Exhibit Ko 2 (technology in which an operation button vibrates together with a stereoscopic display effect at times of high expectation, such as a super-reach state).

The plaintiff argued that the cited invention’s “image displacement effect” and Exhibit Ko 2’s “stereoscopic display effect” differ in method and presentation effect, leaving no motivation to combine them.

⇒ The judgment held that “the effects are common in that they display an image that appears different from the reference image, and it cannot be said that there is no motivation to combine them”; it also held that “applying vibrating means to perform an effect involving vibration in the gaming machine of the cited invention is merely something that would naturally be done.”

⇒ No inventive step.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93753.pdf

[Copyright Law ★★] A Case Partially Upholding the Appellants' Claims for an Injunction and Damages against the Appellee on the Ground That Manufacturing Products Such as "Monjiro Ika" with Particular Designs on Their Labels or Outer Bags and Posting Images of Those Products on a Website Infringed Copyright (the Rights of Adaptation and Public Transmission) in a Television Drama Based on the Novel "Kogarashi Monjiro"

Original Article URL: https://www.nakapat.gr.jp/ja/legal_updates_jp/%e3%80%90%e8%91%97%e4%bd%9c%e6%a8%a9%e6%b3%95%e2%98%85%e2%98%85%e3%80%91%e8%a2%ab%e6%8e%a7%e8%a8%b4%e4%ba%ba%e3%81%8c%e3%80%81%e3%83%a9%e3%83%99%e3%83%ab%e3%82%84%e5%a4%96%e8%a2%8b%e3%81%ab%e7%89%b9/

Publication date on the list page: March 6, 2026

Intellectual Property High Court, September 24, 2025 (2024 (Ne) No. 10007) (Presiding Judge Ken Nakadaira)

◆Judgment Text

Judgment date: September 24, 2025.

[Overview of the Case]

The late novelist Saho Sasazawa (B) wrote the serialized novels in the "Kogarashi Monjiro" series (the Novels), whose protagonist is a wandering gambler named "Monjiro." Manga, television dramas, and films were then produced based on the Novels. After B's death, copyright in the Novels was inherited by B's wife, Plaintiff A. The plaintiff company (Company X) obtained an exclusive license from Plaintiff A to use B's works. The defendant company (Company Y) is a stock company engaged in manufacturing and selling food products and other businesses.

In this case, claims were made on the grounds that Company Y's manufacture and sale of dried squid products under names including "Monjiro Ika" (the Y Products) with the Y Design shown below on their packaging (labels or outer bags), and its posting of images of the Y Products on a website, infringed copyright (the right of reproduction or adaptation, the right of public transmission, and the right of transfer) in the Novels, manga based on the Novels, the television dramas (the Television Works), or films, as well as Company X's status as an exclusive licensee; and that manufacturing and selling the Y Products bearing the Y Design constituted unfair competition under Article 2(1)(i) or (ii) of the Unfair Competition Prevention Act (UCPA). The claims sought an injunction against the manufacture, sale, and other handling of the Y Products and their disposal under Article 112(1) and (2) of the Copyright Act or Article 3(1) and (2) of the UCPA, and damages in tort or under the main clause of Article 4 of the UCPA.

First-instance proceedings and appeal: The first-instance case was Tokyo District Court, 2023 (Wa) No. 70139. The features that the plaintiffs identified as a work in the Novels were those of a wandering

gambler wearing an oversized conical straw hat low over his eyes and a long travelling cape, holding a long bamboo toothpick in his mouth, and carrying a long wakizashi sword. The first-instance court did not recognize these features as concrete creative expression in themselves and also held that the indication asserted by the plaintiffs was not an indication of goods or business under Article 2(1)(i) or (ii) of the UCPA. It dismissed all claims. After the plaintiffs appealed, A died while the appeal was pending, and A's children, the X parties, succeeded to the proceedings. As described below, the appellate court found copyright infringement in relation to the Television Works, modified the first-instance judgment, and partially upheld the claims.



Y Design

[Summary of the Judgment]

1. Ownership of Rights

(1) The late author B held copyright in the Novels; after B's death, the late A acquired that copyright by inheritance, and after A's death, Appellants X2, X3, and X4 acquired the copyright by inheritance.

(2) With respect to the Television Works, which are derivative works based on the Novels, the late B, the author of the original work—the Novels—exclusively held copyright of the same types (the right of reproduction or adaptation, the right of transfer, and the right of public transmission) as, and coexisting with, the copyright held by the authors of the Television Works (the right of reproduction or adaptation, the right of transfer, and the right of public transmission) (Article 28 of the Copyright Act; Supreme Court, First Petty Bench, October 25, 2001, 2000 (Ju) No. 798, Shumin Vol. 203, p. 285). After B's death, the late A acquired those rights by inheritance, and after A's death, Appellants X2, X3, and X4 acquired those rights by inheritance.

2. Reliance on the Existing Work

On a page of its website, Company Y stated, under "Origin of Monjiro Ika," that the product originated from likening the long toothpick held in the mouth of Kogarashi Monjiro, who was popular on television in 1972, to a skewer. This fact establishes that the name "Monjiro Ika" derives from Monjiro, the protagonist of the Television Works, and also permits an inference that the Y Design was created in reliance on the Television Works.

3. Whether Reproduction or Adaptation Occurred

(1) Monjiro in the Image shown below from the Television Works specifically depicts an image of Monjiro in the Television Works. Comparing the Image with the Y Design therefore clarifies the comparison between the image of Monjiro in the Television Works and the Y Design. Moreover, since the Television Works are derivative works of the Novels, such an image of Monjiro from the Television Works is recognized as a derivative work of the Novels.



The Image

(2) Monjiro in the Image is depicted as a person combining all of the following features: ① wearing a sandogasa traveling hat larger than those ordinarily used in television dramas, films, and the like; ② wearing a vertically striped traveling cape longer than those ordinarily used in television dramas, films, and the like; ③ holding a long, thin toothpick in his mouth; and ④ carrying a long wakizashi sword. No drama, film, novel, or similar work featuring a person combining all of these expressive features ① through ④ is established to have existed before the Television Works were broadcast or the Novels written. Accordingly, the combination of all four expressive features constitutes a creative expressive part of the Image and is recognized as forming its essential expressive characteristics.

(3) The Y Design, on the other hand, is a hand-drawn picture exaggerating the person's characteristics; its mode of expression differs from the Image, which is a live-action depiction of an actor. Compared with the Image, it is a separate work to which new creativity has been added through hand drawing, and therefore it does not constitute a reproduction of the Image or the image of Monjiro in the Television Works.

(4) Nevertheless, the person in the Y Design wears a sandogasa traveling hat, and that hat is large. Relative to the size of the person's face, the hat in the Y Design is even larger than the hat worn by Monjiro in the Image; however, this results from emphasizing feature ①, that the hat is large, in the Y Design. It does not prevent perception of feature ①; rather, it makes that perception easier. Accordingly, expressive feature ① of the Image can be directly perceived from the Y Design.

The person in the Y Design also wears a traveling cape, and that cape is long and vertically striped. Relative to the person's height, the cape in the Y Design is even longer than that worn by Monjiro in the Image; however, this results from emphasizing feature ②, that the cape is long, in the Y Design. It does not prevent perception of feature ②; rather, it makes that perception easier. In addition, while the cape

worn by the person in the Image has narrow stripes, those on the cape worn by the person in the Y Design are depicted as wider. This, too, results from emphasizing, in the Y Design, the part of feature ② that the cape is vertically striped, and does not prevent perception of feature ②; rather, it makes that perception easier. Accordingly, expressive feature ② of the Image can be directly perceived from the Y Design.

Furthermore, while Monjiro in the Image holds a long, thin toothpick in his mouth, the person in the Y Design holds a long, thin, rod-like object in his mouth, and it may not be immediately apparent that it is a toothpick. However, it is easy to infer that the long, thin, rod-like object held in the mouth is a toothpick; even if this is not immediately apparent, that does not prevent perception of feature ③. Accordingly, expressive feature ③ of the Image can be directly perceived from the Y Design.

In addition, both the person in the Y Design and Monjiro in the Image carry a long wakizashi sword, so expressive feature ④ of the Image can be directly perceived from the Y Design.

(5) Accordingly, all of expressive features ① through ④, which constitute a creative expressive part of the Image and are recognized as its essential expressive characteristics, can be perceived from the Y Design.

(6) The Image specifically depicts an image of Monjiro in the Television Works, and comparing the Image with the Y Design clarifies the comparison between the image of Monjiro in the Television Works and the Y Design. It is therefore recognized that all of expressive features ① through ④, which constitute a creative expressive part of the image of Monjiro in the Television Works and are recognized as its essential expressive characteristics, can be perceived from the Y Design.

(7) In light of the foregoing, the Y Design relies on the image of Monjiro in the Television Works and, while maintaining the identity of that image's essential expressive characteristics, alters the specific expression to express thoughts or sentiments creatively anew. A person encountering the Y Design can directly perceive the essential expressive characteristics of the image of Monjiro in the Television Works. The Y Design is therefore recognized as an adaptation of the image of Monjiro in the Television Works.

4. Whether Copyright Infringement or Other Infringement Occurred

By manufacturing the Y Products with the Y Design on their packaging (labels or outer bags) and posting images of the Y Products on a website, Company Y is recognized as having infringed the rights of adaptation and public transmission in the Television Works. By contrast, the right of transfer is the right to offer a work to the public through transfer of its original or copies, so transfer of an adaptation of a work is not recognized as having infringed the right of transfer. Company X's status as an exclusive licensee is also recognized as having been infringed by Company Y's copyright infringement.

[Comments]

1. Regarding Judgment Summary 1(2)

Judgment Summary 1(2) follows the Supreme Court decision in the Candy Candy case, October 25, 2001, Hanrei Jiho No. 1767, p. 115. That decision held that the original author of a story manuscript in novel form constituting the original work underlying a derivative serialized manga exclusively holds, under Article 28 of the Copyright Act, rights of the same types as those held by the manga's author, with both

sets of rights coexisting, not only in the serialized manga and thus its panels and cover illustrations featuring the protagonist, but also in newly drawn original illustrations of that protagonist.

2. Regarding Judgment Summary 2

Judgment Summary 2 infers, from the explanation of the Y Products' origins on Company Y's website and the product name "Monjiro Ika" itself, that the Y Design was created in reliance on the Television Works. It may be surmised that this clear inference of reliance had a substantial practical influence on the assessment of reproduction or adaptation in Judgment Summary 3.

3. Regarding Judgment Summary 3

(1) Regarding Judgment Summary 3(1)

At first instance, the plaintiffs identified and asserted as the infringed work the description in the Novels of a wandering gambler who ① wears a larger-than-usual sandogasa traveling hat pulled low over his eyes, ② wraps himself in a longer-than-usual sweeping traveling cape, ③ holds a long bamboo toothpick in his mouth, and ④ carries a long wakizashi sword. However, the Supreme Court decision in the Popeye Necktie case, July 17, 1997, Minshu Vol. 51, No. 6, p. 2714, held: "In a serialized manga consisting of self-contained episodes in which a person with particular characteristics such as a name, appearance, and role is repeatedly depicted, each individual episode depicting that person constitutes a work, but the so-called character of that person cannot be regarded as a work apart from the specific manga. This is because what is called a character is an abstract concept, which might be described as the personality of the person distilled from the manga's specific expression, rather than the specific expression itself, and cannot itself be said to express thoughts or sentiments creatively." Under that decision, the judgment below held that, although "when a copyright owner alleges infringement of copyright in a serialized novel consisting of self-contained episodes, the owner must specifically identify the textual expression in the particular episode of that serialized novel whose copyright has been infringed," "on the premise of X and the others' arguments concerning identification, they fail to identify specifically the work in the books whose copyright is said to have been infringed, and their arguments must therefore be regarded as untenable in themselves." This holding of the judgment below accords with the judicial research official's commentary on the Popeye Necktie Supreme Court decision (Ryoichi Mimura, Commentary on Supreme Court Decisions, Civil Cases, Fiscal Year 1997, Middle Volume, p. 943).

On appeal, by contrast, under Judgment Summary 1(2) based on the Candy Candy Supreme Court decision, the infringed work was identified as a visual image of Monjiro in the Television Works, which are derivative works of the Novels, rather than the verbal descriptions of Monjiro in the Novels relied upon at first instance. In particular, as stated in Judgment Summary 3(1), although it was identified directly by the Image of Monjiro in the Television Works, it was ultimately identified as images of Monjiro generally, as specifically depicted by Monjiro in the Image from the Television Works. It is understood that the images of Monjiro in the Television Works generally, identified in this way, were made the subject of examination and determination as to whether the Y Design constituted reproduction or adaptation.

(2) Regarding Judgment Summary 3(2)

Further, Judgment Summary 3(2) addresses the visual expression of Monjiro in the Image as a person combining all of the following characteristics, common to images of Monjiro in the Television Works generally and scarcely different from the verbal descriptions of Monjiro in the Novels that the plaintiffs identified and asserted as the infringed work at first instance: ① wearing a sandogasa traveling hat larger than those ordinarily used in television dramas, films, and the like; ② wearing a vertically striped traveling cape longer than those ordinarily used in television dramas, films, and the like; ③ holding a long, thin toothpick in his mouth; and ④ carrying a long wakizashi sword. Because no drama, film, novel, or similar work featuring a person combining all of expressive features ① through ④ is established to have existed before the Television Works were broadcast or the Novels written, the court recognized this as a creative expressive part of the Image and as forming its essential expressive characteristics.

In this respect, unlike the judgment below, Judgment Summary 3(1) and (2) may be evaluated as accepting identification, as the infringed work, of creative expressive elements or features generalized and abstracted from individual, specific expressions as features common to multiple works or expressions, although they are visual expressions of a character substantially equivalent to the verbal expressions. It may be evaluated as attempting to open a path to substantive protection of creative character expression under copyright law, even under the Popeye Necktie Supreme Court decision denying copyrightability to a "character" itself. In this connection, even after the Popeye Necktie Supreme Court decision, the view recognizing copyrightability in creative character expression as a persona, rather than illustrations, pictures, designs, images, or the like, remains influential in academic commentary (Tatsuhiro Ueno, "Legal Protection of Characters," Patent Vol. 69, No. 4 (2016), p. 50; Satoshi Ikemura, "Considering 'Characters and Copyright' Today," Copyright Vol. 58, No. 687 (2018), pp. 38–39; Shunji Matsuda, "Legal Protection of Characters in a New Era," Copyright Vol. 62, No. 742 (2023), p. 15; and others).

Nevertheless, disagreement may arise over Judgment Summary 3(2)'s recognition of features ① through ④ alone as the essential expressive characteristics of Monjiro in the Image, as in the judgment below, which rejected this in obiter dicta on the ground that they were commonplace.

(3) Regarding Judgment Summary 3(3)

Judgment Summary 3(3) rejects the proposition that the Y Design reproduces the Image of Monjiro in the Television Works and, by extension, images of Monjiro generally, and is appropriate.

(4) Regarding Judgment Summary 3(4)–(7)

Judgment Summary 3(4)–(7), probably influenced considerably in practice by the clear inference of reliance in Judgment Summary 2, proceeds on the premise of Judgment Summary 3(2) and follows the Supreme Court decision in the Esashi Oiwake case, June 28, 2001, Minshu Vol. 55, No. 4, p. 837. That decision held: "Adaptation (Article 27 of the Copyright Act) means the act of creating another work by relying on an existing work and, while maintaining the identity of its essential expressive characteristics, making modifications, additions, deletions, changes, or the like to its specific expression to express thoughts or sentiments creatively anew, in such a way that a person encountering it can directly perceive the essential expressive characteristics of the existing work." Judgment Summary 3(4)–(7) thus affirms that the Y Design adapts the Image of Monjiro in the Television Works and, by extension, images of

Monjiro generally; in light of Judgment Summary 2 and on the premise of Judgment Summary 3(2), this is appropriate.

On the other hand, if one disagrees with Judgment Summary 3(2), adaptation might also be denied, as in the judgment below, under the Esashi Oiwake Supreme Court decision's further holding that "where a work created in reliance on an existing work shares identity with that work only in portions that are not expression itself, such as thoughts, sentiments or ideas, facts or events, or in portions lacking expressive creativity, it does not constitute adaptation."

4. The Purpose, Interpretation, and Application of Article 28 of the Copyright Act and Copyright Protection of Creative Character Expression

Under the Popeye Necktie Supreme Court decision denying copyrightability to a "character" itself, attention turns to the interpretation and application of Article 28 of the Copyright Act, which prescribes the original author's rights concerning exploitation of derivative works, as a legal framework for nonetheless providing substantive copyright protection to creative character expression, as this judgment does. Neither the Candy Candy Supreme Court decision nor this judgment based on that decision directly or expressly states the purpose of Article 28 itself. Nevertheless, the application of Article 28 in the Candy Candy Supreme Court decision and in this judgment based on it resulted in findings that use of character pictures, designs, and the like infringed the rights of the original authors in the story manuscripts in novel form, novels, and other works in which those characters appear. In relation to the copyright law principle of protecting creative expression, these findings should be substantively justified rather than treated as exceptions to that principle. If so, it does not seem impossible to understand those findings of infringement as substantively affirming, as the purpose and interpretation of Article 28, protection as a work for creative character expression as a persona in the original story manuscripts in novel form, novels, and similar works.

5. Regarding Judgment Summary 4

Through the application of Articles 21–27 of the Copyright Act via Article 28, which prescribes the original author's rights concerning exploitation of derivative works, it is considered that, generally under case law and academic commentary and contrary to Judgment Summary 4, infringement could be recognized separately as follows: creation of the Y Design infringes the right of "adaptation" (Article 27); manufacture of the packaging (labels or outer bags) of the Y Products bearing the Y Design infringes the right of "reproduction" (Article 21); sale of the Y Products in packaging (labels or outer bags) bearing the Y Design infringes the right of "transfer" (Article 26-2(1)); and posting images of those Y Products on a website infringes the right of "public transmission" (Article 23(1)).

[Keywords] Kogarashi Monjiro; Monjiro Ika; characters; verbal expression; visual expression; Popeye Necktie Supreme Court decision; Article 28 of the Copyright Act; Candy Candy Supreme Court decision

Written by: Kei Iida, Attorney at Law and Patent Attorney (Daini Tokyo Bar Association)

IP High Court, 2023 (Gyo-Ke) No. 10105 [Electronic Money Remittance Method] <Presiding Judge Nakadaira>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e8%a1%8c%e3%82%b110105%e3%80%90%e9%9b%bb%e5%ad%90%e3%83%9e%e3%83%8d%e3%83%bc%e9%80%81%e9%87%91%e6%96%b9%e6%b3%95%e3%80%91%ef%bc%9c%e4%b8%ad%e5%b9%b3%ef%bc%9e/

Publication date on the list page: March 6, 2026

IP High Court, 2023 (Gyo-Ke) No. 10105 [Electronic Money Remittance Method] <Presiding Judge Nakadaira>

= 2023 (Gyo-Ke) No. 10106

* Inventive step recognized.

(1) Inventive step recognized (primary reference: a Chinese patent application)

The patented invention's "certification information (electronic certificate)" and Exhibit Ko 1's "identity information (ID or telephone number)" differ in technical significance.

⇒ The patented invention's "certification information" includes digital signatures and the like created on a server or similar device and is distinguished from a mere ID; it therefore could not readily have been conceived from Exhibit Ko 1.

(2) Inventive step recognized (primary reference: Alipay-related technology)

The "account number" and "password" in Exhibit Ko 7 (Alipay's payment system) do not constitute the patented invention's "certification information."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93773.pdf

[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%a5%91%e7%b4%84%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af7068%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e-2/

Publication date on the list page: March 6, 2026

[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima>

Claim for Royalties and Other Payments under a Patent License Agreement

⇒ Granted (joint and several personal guarantee by the defendant company's representative).

Plaintiff: Patent owner

Defendant company: Licensee

Defendant B: Representative director of the defendant company

C (not a party): Finance officer of the defendant company; the contact person with the plaintiff who had been postponing payment.

Defendant B issued a written statement saying: "I, B, pledge to make payment to the fullest extent in the event of default."

The plaintiff argued that because it said "I, B," it meant payment from B's personal assets (= a joint and several guarantee).

⇒ The judgment found that a joint and several guarantee agreement had been formed by Defendant B personally.

Summary of the Disposition

The court ordered the defendants (the company and B personally) jointly and severally to pay JPY 22 million plus delay damages at 8% per annum from July 31, 2023 until payment in full.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93851.pdf

The two contract articles concern the same judgment, 2023 (Wa) No. 70680, and were published at different URLs. Both are included in this collection of 29 articles.

Osaka District Court, 2023 (Wa) No. 12280 [Seawall] <Presiding Judge Takemiya>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e5%a4%a7%e9%98%aa%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c7%e5%b9%b4%e3%83%af12280%e3%80%90%e9%98%b2%e6%bd%ae%e5%a3%81%e3%80%91%ef%bc%9c%e6%ad%a6%e5%ae%ae%ef%bc%9e/

Publication date on the list page: March 6, 2026

Osaka District Court, 2023 (Wa) No. 12280 [Seawall] <Presiding Judge Takemiya>

In light of the description and the meaning of the terms, “packing for watertightness between the transparent resin plate and the frame” (Limitation B③) does not mean that “it is sufficient for packing to exist at any part between the transparent resin plate and the frame”; it requires “packing for rendering the entirety of the space between the transparent resin plate and the frame watertight (preventing water leakage).”

⇒ Claim limitation not satisfied (the defendant’s product’s “rubber gasket” alone does not render the whole space watertight).

+ Even treating the aluminum “glazing bead” as metal packing, watertightness was insufficiently proven.

Cf. 2018 (Ne) No. 10034 [Solenoid] <Presiding Judge Kanno>

* “Sealing fit” does not require the end member itself to produce the effect of preventing corrosion of the solenoid.

⇒ The limitation is satisfied because the effect is achieved together with an O-ring.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93806.pdf

[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%a5%91%e7%b4%84%e3%80%91%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af7068%ef%bc%9c%e4%b8%ad%e5%b3%b6%ef%bc%9e/

Publication date on the list page: March 6, 2026

[Contract] Tokyo District Court, 2023 (Wa) No. 70680 <Presiding Judge Nakashima>

Claim for Royalties and Other Payments under a Patent License Agreement

⇒ Granted (joint and several personal guarantee by the defendant company's representative).

Plaintiff: Patent owner

Defendant company: Licensee

Defendant B: Representative director of the defendant company (individual)

C (not a party): Finance officer of the defendant company; the contact person with the plaintiff who had been postponing payment.

Defendant B issued a written statement saying: "I, B, pledge to make payment to the fullest extent in the event of default."

The plaintiff argued that because it said "I, B," it meant payment from B's personal assets (= a joint and several guarantee).

⇒ The judgment found that a joint and several guarantee agreement had been formed by Defendant B personally.

Summary of the Disposition

The court ordered the defendants (the company and B personally) jointly and severally to pay JPY 22 million plus delay damages at 8% per annum from July 31, 2023 until payment in full.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93851.pdf

The two contract articles concern the same judgment, 2023 (Wa) No. 70680, and were published at different URLs. Both are included in this collection of 29 articles.

[Contract] IP High Court, 2024 (Ne) No. 10058 [Development of Green Laver Spore Collection Technology Using a Waterwheel] <Presiding Judge Hibiku Shimizu>

Original Article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%a5%91%e7%b4%84%e3%80%91%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10058%e3%80%90%e6%b0%b4%e8%bb%8a%e3%82%92%e5%88%a9%e7%94%a8%e3%81%97%e3%81%9f%e9%9d%92%e3%83%8e%e3%83%aa%e3%81%ae%e6%8e%a1/

Publication date on the list page: March 6, 2026

[Contract] IP High Court, 2024 (Ne) No. 10058 [Development of Green Laver Spore Collection Technology Using a Waterwheel] <Presiding Judge Hibiku Shimizu>

1. Whether the Joint Research Agreement Was Breached (Unauthorized Publication of Research Results)

The idea itself of collecting green laver spores using a waterwheel had existed since 1998, before the joint research at issue.

The purpose of the joint research was to clarify specific conditions for spore collection and related matters, whereas the publication at issue merely indicated that “attachment using a waterwheel-type spore collection device is possible” and did not disclose specific technical details (suitable circumstances, conditions, etc.).

The idea itself was a premise of the joint research, not an outcome, and the publication did not constitute publication of “research results”; no breach of contract was therefore found.

2. Whether Patent Acquisition Was Obstructed

Since the idea itself of collecting green laver spores using a waterwheel was well known, merely stating that it “had become possible” would not secure a patent; regardless of whether the publication occurred, disclosure of specific technical details was necessary to obtain a patent.

Accordingly, even if the publication was cited during patent examination, it was not recognized as obstructing the plaintiff’s patent acquisition and did not constitute nonperformance of contractual obligations.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93787.pdf

<IP Practice Online> The Umbrella Theory Has Also Returned! But Should Disclaimer Claims Really Be This Unrestricted? (Shibata)

Original Article URL: https://www.nakapat.gr.jp/ja/note/%ef%bc%9c%e7%9f%a5%e8%b2%a1%e5%ae%9f%e5%8b%99%e3%82%aa%e3%83%b3%e3%83%a9%e3%82%a4%e3%83%b3%ef%bc%9e%e5%82%98%e7%90%86%e8%ab%96%e3%82%82%e5%be%a9%e6%b4%bb%e3%81%97%e3%81%9f%ef%bc%81%e3%81%97%e3%81%8b/

Publication date on the list page: March 6, 2026

<IP Practice Online> "The Umbrella Theory Has Also Returned! But Should Disclaimer Claims Really Be This Unrestricted? A Horizontal and Vertical Overview of Amendment Practice" (Kazuo Shibata)

In current Japanese practice, disclaimer claims are frequently used as a de facto "standard tactic" for easily avoiding prior-art objections (such as lack of novelty or inventive step).

Drawing on experience as an examiner and appeal examiner, the speaker asks: "Should this really be so unrestricted?"

The Umbrella Theory Concerning Priority and the Risk of Transforming an Invention through Disclaimer Claims

The lecture materials state '証拠除外効＝傘理論' (translation: 'exclusionary effect on evidence = umbrella theory'). In summary, this is a discussion of multiple and partial priority under which publications and other events during the priority period corresponding to a constituent part entitled to priority are excluded as evidence for refusal or invalidation of a later application. The speaker examines this principle of priority and discusses recent examples. Source: lecture materials, slides 2 and 5–6.

As to amendments using disclaimer claims, the presentation examines the risk that later exclusion of matters not originally disclosed may substantively transform the invention before and after amendment. The permissibility of an amendment excluding part of a broader concept must be examined as an issue of added matter and related requirements in relation to the original description and other documents; it is not the same principle as the umbrella theory concerning the exclusionary effect of priority.

The presentation explains, from a distinctive perspective, court cases in which inventive step was recognized for disclaimer claims and cases in which it was not.

https://youtu.be/nsDZxujMcak

Lecture materials (Kazuo Shibata, January 15, 2026, slides 2 and 5–6):
https://docs.google.com/presentation/d/1RdCOufWS2WiBrweGsKZAV4_qhMGy55rf/edit

IP High Court, 2024 (Gyo-Ke) No. 10050 [Information Processing Device] <Presiding Judge Miyasaka>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110050%e3%80%90%e6%83%85%e5%a0%b1%e5%87%a6%e7%90%86%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e5%ae%ae%e5%9d%82%ef%bc%9e/

Publication date on the list page: March 6, 2026

IP High Court, 2024 (Gyo-Ke) No. 10050 [Information Processing Device] <Presiding Judge Miyasaka>

The decision rejecting the invalidation request was upheld (the claim for revocation of the decision was dismissed).

Judgment text: The operative part of the judgment states (translation): “1. The plaintiff’s claim is dismissed.” In summary, the procedural outcome was dismissal of the claim for revocation of the decision rejecting the invalidation request, leaving that decision in place. Source: IP High Court, 2024 (Gyo-Ke) No. 10050, pp. 1–2

<Qualification as an “Invention” (Utilization of Laws of Nature)>

The plaintiff argued that processing that does not include calculation of depreciation costs is abstract and cannot be described as specific information processing using hardware resources, and is merely a human-made arrangement (business rule), so it is not an “invention.”

⇒ In the invention, information processing by software, such as the respective calculation units and the product optimization unit, is concretely implemented using the hardware resources of a computer (CPU, memory, etc.).

Even if calculation of depreciation costs is not expressly recited in the claim, it is not excluded, and working examples are provided in the description; the subject matter is therefore recognized as a creation of a technical idea (an invention).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93778.pdf

IP High Court, 2024 (Gyo-Ke) No. 10053 [Wood-Based Board] <Presiding Judge Hibiku Shimizu>

Original Article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110053%e3%80%90%e6%9c%a8%e8%b3%aa%e3%83%9c%e3%83%bc%e3%83%89%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%ef%bc%9e/

Publication date on the list page: March 6, 2026

IP High Court, 2024 (Gyo-Ke) No. 10053 [Wood-Based Board] <Presiding Judge Hibiku Shimizu>

No inventive step.

The description contains no statement that the respective configurations function in relation to one another or produce a synergistic effect beyond the effects that each achieves individually, nor does it describe a mechanism of action or similar matters. The configurations were not found to act in relation to one another to produce a synergistic effect. The patent revocation decision did not err in identifying Differences 1 and 2 separately.

Judgment text: The court held (translation) that the configurations “are not found to act in relation to one another to produce a synergistic effect.” In summary, even taking account of the description and the experimental-results certificate, a synergistic effect was not established, and there was no error in the patent revocation decision’s identification of the differences separately. Source: IP High Court, 2024 (Gyo-Ke) No. 10053, pp. 24–26

(1) Obviousness of Difference 1 (Length of the Small Wood Flakes)

Although the publication in Exhibit Ko 1 states that the length of the wood flakes “preferably has an average value within the range of 40.0–115.0 mm,” that numerical range is not recognized as having the same technical significance as thickness or width as a means of solving the problem, and selecting a value outside that range does not depart from the technical concept.

On the other hand, it is common general technical knowledge among persons skilled in the art that, as the dimensions of the constituent elements become smaller, the resulting wood-based board becomes more homogeneous and its surface smoother. In light of that knowledge, adjusting the dimensions in the invention of Exhibit Ko 1 according to the intended use of the wood-based board and setting the length to “10 mm or more and 35 mm or less,” as in Invention 1 at issue, is an exercise of the ordinary creative ability of a person skilled in the art and could readily have been conceived. Nor is there any teaching away.

(2) Obviousness of Difference 2 (Homogeneity and Absence of Knots)

In the invention, “uniformly consistent in size and shape” means that dimensions fall within a certain range, which the invention of Exhibit Ko 1 also satisfies.

Moreover, “absence of knots” is a configuration ordinarily present in reconstituted material made by breaking raw wood into small pieces.

⇒ Difference 2 is either not a substantive difference or, even if it is, could readily have been conceived by a person skilled in the art based on the invention of Exhibit Ko 1 and common general technical knowledge.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93878.pdf

Legal Update (April 2026 articles)

Scope: Articles with an April 2026 publication date on Nakamura & Partners' listing page.

Articles: 29 (27 patents, 1 intellectual property generally, 1 trademark).

Authors: Hideki Takaishi (28 articles); Kei Iida (1 article).

Listing page: https://www.nakapat.gr.jp/ja/note/ (section "高石弁護士の知財速報" [Attorney Takaishi's IP News]; 28 articles);

https://www.nakapat.gr.jp/ja/legal_updates_jp/ (section "法情報提供" [Legal Update]; 1 article)

Differences between the original articles and the judgments

[Lighting device] The original article gives "2024 (Ne) No. 10101," but page 1 of the linked judgment gives 「令和５年（ネ）第１０１０１号」 (2023 (Ne) No. 10101; judgment of June 18, 2024). According to the judgment, Tamotsu Shoji was the presiding judge (judgment, p. 18). Judgment

[Hand-pushing member] The original article gives "2023 (Gyo-Ke) No. 10100," but page 1 of the linked judgment gives 「令和５年（行ケ）第１０１４３号」 (2023 (Gyo-Ke) No. 10143; judgment of September 25, 2024). Judgment

[Filling material for an electronic cigarette] The original article gives "2024 (Wa) No. 70407," but page 1 of the linked judgment gives 「令和５年(ワ)第70407号」 (2023 (Wa) No. 70407; judgment of September 26, 2024). Judgment

[Ground solidification material] The original article gives "2024 (Gyo-Ke) No. 10132," but page 1 of the linked judgment gives 「令和５年（行ケ）第１０１３２号」 (2023 (Gyo-Ke) No. 10132; judgment of October 30, 2024). Judgment

[Jig for a lifeline support post] The original article also refers to the "second requirement of equivalence," but page 35 of the judgment states 「均等の第１要件を満たすとは認められない。」 (it cannot be found that the first requirement of equivalence is satisfied) and 「その余の要件を検討するまでもなく」 (without needing to examine the remaining requirements). The term 「小型化」 ("reduced size") in the original article does not appear in the judgment. Judgment

<This Month's Highlights> Key Points of the April 2026 IP and Legal Updates

This month's Legal Update comprises 29 articles: 27 on patents, one on intellectual property generally and one on trademarks. The patent articles cover motivation in inventive step, claim interpretation, the doctrine of equivalents, enablement, addition of new matter and litigation procedure. They are accompanied by the revision of the Trade Secret Management Guidelines and a trademark judgment concerning similarity between machinery goods and rental services. Articles are included according to their April publication dates on the listing page; their judgment dates differ.

1 Circumstances supporting and negating motivation in inventive step

The two articles on [Electric impact fastening tool] address the relationship between the well-known problem of increasing torque and the known advantages of an outer rotor type. In [Combustor and boiler], the societal demand to reduce carbon dioxide emissions at filing and common general technical knowledge concerning ammonia use supported motivation to combine. Conversely, in [Sales system], the secondary references were held not to contain the configuration of the differences, so that the premise for combination was lacking, and, even if list creation were well known, the added list creation and output were held incompatible with the primary cited invention's purpose of reducing retailers' workload; in [Hand-pushing member], motivation was denied because the reference (Exhibit Ko 8) has the technical significance of being premised on attachment to the curved part of a squared U-shaped handle, and a factor teaching away was also found. [Ground solidification material] likewise rejected application of injection conditions because solution-type and suspension-type grouts have different solidification principles. In addition to a shared technical field, it is necessary to examine specifically whether the problem, the mechanism of action and the modified configuration are compatible with the cited invention.

2 Grounds for limiting and not limiting claim language

In [Induction heating coil unit], "composed of" was not limited to that material alone, and "unit" was construed as a constituent unit, while specific differences in cooling paths and merging functions supported inventive step for Claims 2 and 3. In [Intraoral OCT with color texture], the alternatives "with or without registration" were held not to change the matters specifying the claimed invention in substance, and "combining" was held not to be limited to particular data dimensionality or display forms. In contrast, "cuts" in [Filling material for an

electronic cigarette], “pivoting plate-like member” in [Tiltable and stowable temporary protective fence], “vertical plate portion” in [Eave] and “oxygen supply means” in [Wastewater treatment apparatus] were considered in relation to dictionary meanings, distinctions between configurations in the claims, and the means for solving the problems and the functions and effects described in the description. It is important to verify the basis for a limitation for each term.

3 Fulfillment of functional configurations requires concrete proof

[Rolling device] is a case in which, although findings of fulfillment differing from the original judgment were obtained for the rolling-path and other elements, a no-load region could not be said to be formed in the appellee’s products, which are used under preload, and proof of the frictional-force relationship was also insufficient. In [Commercial transaction system], seller-entered HS codes and a response of “registration complete” alone could not establish the specified acquisition and notification of customs-duty information. In [Vehicle guidance system], a driver’s ability to return to the destination independently after entering a general road or similar location was distinguished from the specified guidance by the system. [Remotely controlled unmanned boat] addresses the relationship between an activation condition of “at least one” and a mechanism capable of assessing both communication interruption and insufficient power. Functional wording must be related to actual processing, information paths, conditions of use and device configurations.

4 Limits of disclosure in description requirements and corrections

In [Device... formed of a very low resistance material], reduced resistance was distinguished from a superconducting state of zero resistance, and support for a phenomenon contradicting common general technical knowledge and specific methods of implementation were at issue. In [Moving image decoding device], information that changes the candidate count as a consequence was distinguished from control information having the purpose of changing that count, and the correction was held to add new matter, and the claims before correction were also held to violate the support requirement. Showing a technical result is not the same as disclosing the configuration or function required by the claim.

5 Timing of submissions and the substance of what is examined

In [Women’s clothing], the court found untimeliness and gross negligence concerning an invalidity ground added in the statement of reasons for appeal, but also considered its substance because the opposing party had responded and

there had been no rebuttal, so that, to this extent, conclusion of the litigation would not be delayed. A finding of untimeliness must not be replaced with a conclusion that the argument was actually dismissed. In [DC ultra-high-voltage power supply for a food electric-field treatment apparatus], the addition of documents corroborating well-known status was distinguished from a new refusal ground; in [Gaming machine], an unfair surprise was denied because no notice of reasons for refusal is required by statute for dismissal of an amendment for violating the independent patentability requirement, and, even if an exception were considered, Cited Inventions 1 and 2 were based on the same document, had contents in common to some extent, and that document had already been cited in a notice of reasons for refusal.

6 Trade secret management and similarity between goods and rental services

"Overview of the revision of the Trade Secret Management Guidelines" sets out the positioning of reasonable classification, employees' recognizability of the intention to maintain secrecy, access management for cloud services and the risks to non-public status associated with generative AI use. In the "ゴミサー" case, goods and services were found similar for a combination with different similar group codes (according to the article's commentary; the judgment does not refer to similar group codes), based on actual circumstances in which manufacturers and the like both sell and rent construction machinery in Class 7, the same class as the cited designated goods, and on overlapping consumers. Both show the need to understand actual management and trading circumstances specifically, rather than relying only on formal classifications.

Three-point summaries of all articles

Category	Article title and three-point summary
Patents	**2023 (Ne) No. 10063 [Electric impact fastening tool] <Presiding Judge Hibiku Shimizu>** **① The case concerned obviousness of differences in motor type and magnet retention in an electric impact fastening tool.** **② The court held replacement with an outer rotor type obvious because the invention of Exhibit Otsu 15 had the problem of increasing output torque and Exhibit Otsu 6 suggested the application, and held adhesive attachment of magnets obvious based on well-known technology; it accepted the invalidity defense, also rejected the counter-defense of correction, set aside the portions of the original judgment granting the claims, and dismissed those claims.** **③ The case illustrates how shared problems within the same technical field and the well-known nature of technology addressing the differences support motivation to combine.**
Patents	**2023 (Ne) No. 10101 [Lighting device] <Presiding Judge Shoji>** **① The case concerned whether a product equipped with warm-white and daylight LEDs literally fulfilled Element A (the red, blue and green light-emitting means) of a lighting device, and whether equivalence was established with respect to Element A and Elements C/D (the adjustment unit responsive to biological information).** **② The court held that the statement of wavelength ranges in the description does not mean that every light-emitting means emitting light including those wavelengths falls within the light-emitting means of each color, and that Element A requires each of the red, blue and green light-emitting means; it therefore denied literal fulfillment, and also found the first requirement of equivalence not satisfied in light of the contribution over the prior art.** **③ The case shows that a statement of wavelength ranges in the description does not by itself determine whether a light-emitting means falls within the means of each color, and that the essential part must be identified in light of the contribution over the prior art.**

Category	Article title and three-point summary
Patents	**2024 (Ne) No. 10022 [System for providing inspection and analysis services] <Miyasaka>** **① The case concerned whether "inspection and analysis" in a system for providing inspection and analysis services means analysis of a sample or remote operation itself.** **② The court rejected the appellant's argument because the claims contained no exclusion of semiconductor inspection equipment, held that verification of remote control is also merely a step in sample analysis, upheld the original judgment finding non-fulfillment and dismissed the appeal.** **③ The case shows that interpretations based on prosecution history must also accord with the claims and that a step for inspection and analysis must be distinguished from inspection and analysis itself.**
Patents	**2023 (Gyo-Ke) No. 10061 [Combustor and boiler] <Miyasaka>** **① The case concerned motivation to apply ammonia-use technology to the primary cited invention and differences including temperature regions in a combustor and boiler.** **② The court found motivation based on the societal demand for reduced carbon dioxide emissions and common general technical knowledge at filing, held Differences 1 and 2 obvious, and upheld the revocation decision.** **③ The case shows that societal demands and common general technical knowledge at filing can support a shared problem, and that temperature expressions are assessed with regard to their comparators.**
Patents	**2023 (Gyo-Ke) No. 10110 [Intraoral OCT with color texture] <Honda>** **① The case concerned interpretation of "with or without registration" and "combining" in intraoral OCT.** **② The court upheld the JPO appeal decision denying inventive step, holding that the presence or absence of the specifying matter "with or without registration" did not change the matters specifying the claimed invention in substance and that combining was not limited to a particular dimensionality or display form.** **③ The case illustrates that language listing alternatives or referring to data combination is not automatically limited to a particular embodiment in the description.**

Category	Article title and three-point summary
Patents	**2023 (Gyo-Ke) No. 10084 [Electric impact fastening tool] <Hibiku Shimizu>** **① The case concerned obviousness of replacing an inner rotor type with an outer rotor type and adhesively attaching magnets in an electric impact fastening tool.** **② The court rejected the ground for rescission concerning the requirements for correction, but denied inventive step because increasing torque was a well-known problem and the advantages of the outer rotor type and fixation using adhesive were also well known, and rescinded the JPO trial decision that had dismissed the request for invalidation.** **③ The case shows that, when considering component replacement, the relationship between the primary cited invention's problem and the known advantages of the replacement affects motivation.**
Patents	**2023 (Gyo-Ke) No. 10103 [Optical ferrule] <Honda>** **① The case concerned interpretation of a "parting line artifact" in an optical ferrule and the position of the parting line when the cited invention is molded in a die.** **② The court denied inventive step because no specific size or similar limitation applied to the artifact and molding the cited invention would produce it at the same position.** **③ The case shows the need to assess structures arising from manufacture by relating the limits of the wording to what inevitably occurs during manufacture.**
Patents	**2023 (Gyo-Ke) No. 10107 [Induction heating coil unit] <Presiding Judge Hibiku Shimizu>** **① The case concerned the interpretation of material and unit language and the inventive step of individual claims concerning cooling paths and flow-straightening portions in an induction heating coil unit.** **② The court denied inventive step for Claims 1 and 4, held that the determination for Claims 5 and 6 also lacked its premise, and rescinded the part of the JPO trial decision concerning Claims 1 and 4 to 6, while recognizing inventive step for Claims 2 and 3 in light of differences in cooling paths and merging functions, among other matters.** **③ The case shows the need to distinguish general wording such as "composed of" and "unit" from the specific configuration and functions of cooling paths.**

Category	Article title and three-point summary
Patents	**2023 (Gyo-Ke) No. 10104 [Device... formed of a very low resistance material] <Hibiku Shimizu>** **① The case concerned sufficiency of the disclosure supporting the realization of a superconducting state and the Josephson effect in a device using a low-resistance material.** **② The court found failure of enablement because there were no test results showing zero resistance or specific methods for using a superconducting portion, and no basis for statements contradicting common general technical knowledge.** **③ The case shows the need for concrete disclosure supporting the phenomenon and its implementation where an invention presupposes a phenomenon departing from common general technical knowledge.**
Patents	**2024 (Ne) No. 10010 [Women’s clothing] <Presiding Judge Nakadaira>** **① The case concerned the interpretation of the connecting and adjusting functions in women’s clothing and the treatment of an invalidity ground added in the statement of reasons for appeal.** **② The court maintained the infringement finding and, while finding the new invalidity ground untimely, also examined its merits because, to this extent, doing so would not delay the conclusion of the litigation, and did not find the patent invalid.** **③ The case shows that timing and gross negligence may be at issue even for arguments in a statement of reasons for appeal, and that actual dismissal also requires consideration of delay to the conclusion of litigation.**

Category	Article title and three-point summary
Patents	**2023 (Gyo-Ke) No. 10124 [Moving image decoding device] <Presiding Judge Miyasaka> = 2023 (Gyo-Ke) No. 10125** **① In an action against a decision revoking a patent for a moving image decoding device, the case concerned whether "control information for changing the number of motion vector candidates," a matter common to the claims before and after correction, is described in the description (whether change flags, thresholds Th or the maximum number of vectors fall under it).** **② The court held that the control information requires a purpose–means relationship with changing the number of candidates and that consequential or indirect effects are insufficient, so that it is not described in the description; it refused the correction as adding new matter, held that Claims 1 and 2 before correction also violate the support requirement, and upheld the revocation decision.** **③ In this case, for a claim containing functional "for" language, where the description describes only a consequential change in the number of candidates, a correction further limiting that language was not allowed and the support requirement was not satisfied.**
Patents	**2023 (Gyo-Ke) No. 10148 [Sales system] <Presiding Judge Nakadaira>** **① The case concerned whether combining the matters described in Exhibits Ko 2 to Ko 4 with the primary cited invention (the invention of Exhibit Ko 1) in a sales system would arrive at Elements (D) and (E), the differences (extraction of order information based on group information and output of order lists in a form viewable by the group's person in charge), and motivation to do so.** **② The court held that Exhibits Ko 2 to Ko 4 do not describe Elements (D) and (E), so that the premise for combination is lacking, and further that, even if list creation were well known, output in a form viewable by school personnel would be incompatible with the primary cited invention's purpose of reducing retailers' workload and there was no motivation; it upheld the JPO trial decision recognizing inventive step.** **③ The case shows the need to examine whether an added configuration accords with the purpose of the primary cited invention when assessing obviousness of a combination.**

Category	Article title and three-point summary
Patents	**2024 (Ne) No. 10019 [Rolling device] <Presiding Judge Miyasaka>** **① The case concerned fulfillment of rolling-path structures as well as formation of a no-load region and the relative magnitudes of frictional forces in a rolling device.** **② The court found Elements 1-A and 2-A fulfilled, but rejected the patentee's claim because a no-load region could not be said to be formed in the appellee's products, which are used under preload, the appellant's argument concerning centrifugal force lacked specific support, and there was no specific evidence of the frictional-force relationship.** **③ The case shows that a broad construction of some elements does not eliminate the need to prove other elements concerning loads, friction and other conditions during use.**
Patents	**2023 (Gyo-Ke) No. 10143 [Hand-pushing member] <Presiding Judge Hibiku Shimizu>** **① In an action against a JPO trial decision dismissing a request for invalidation, the case concerned motivation, among other things, to apply a safety cover for a squared U-shaped handle (Exhibit Ko 8) to a long hand-pushing member extending vertically.** **② The court denied motivation to apply the safety cover of Exhibit Ko 8 to a long vertical hand-pushing member, and also found a factor teaching away, because the cover has the technical significance of using the horizontal part of a squared U-shaped handle as the grip and being attached to its curved part; it also denied obviousness for combinations using Exhibit Ko 9 as the primary reference, and upheld the JPO trial decision.** **③ The case shows that the shape of the attachment object presupposed by a cited component, and the component's technical significance, bear on the examination of motivation to apply it to a component of a different shape and of factors teaching away.**

Category	Article title and three-point summary
Patents	**Tokyo District Court, 2023 (Wa) No. 70407 [Filling material for an electronic cigarette] <Presiding Judge Sugiura>** **① The case concerned whether breaks arising during crimping and related processing of electronic-cigarette filling material constituted "cuts."** **② Based on dictionaries, the description, and functions and effects, the court construed "cuts" as structures artificially and actively formed with a blade and held that tears or cracks did not fulfill the "cuts" element.** **③ The case shows that visual similarity alone is insufficient and that the relationship between the claimed structure, its formation means and its functions and effects matters.**
Patents	**Tokyo District Court, 2023 (Wa) No. 70393 [Tiltable and stowable temporary protective fence] <Presiding Judge Nakashima>** **① The case concerned whether square tubular pivoting members in a tiltable and stowable temporary protective fence constituted "pivoting plate-like members."** **② The court construed the term as a thin plate-like member in light of the description's statements on reducing thickness and making the structure compact, and denied literal infringement and infringement by equivalents.** **③ The case shows that claim language expressing shape is interpreted in relation to the means of solving the problem disclosed in the description.**
Patents	**2024 (Ne) No. 10045 [Wastewater treatment apparatus] <Presiding Judge Hibiku Shimizu>** **① The case concerned whether means that adds ozone, together with oxygen, to a tank using microorganisms constituted "oxygen supply means" in a wastewater treatment apparatus.** **② The court found non-fulfillment because actively adding ozone was incompatible with the technical idea of promoting biological treatment and reducing residual ozone and because the claims distinguish ozone supply means from oxygen supply means, and dismissed the exclusive licensee's appeal.** **③ The case shows that possessing part of a function may not bring a configuration within claim language when an additional function is incompatible with the invention's solution to its problem.**

Category	Article title and three-point summary
IP generally	**<IP Practice Online> "Overview of the revision of the Trade Secret Management Guidelines" (Attorney Naoki Kurokawa, Ministry of Economy, Trade and Industry)** **① The article explains the 2025 revision of the Trade Secret Management Guidelines in relation to teleworking, cloud services, generative AI and recent court decisions.** **② It sets out the positioning of reasonable classification, objective recognizability of the intention to maintain secrecy, access management, and the assessment of usefulness and non-public status.** **③ It states that the emphasis of the revision has shifted from formal management to ensuring recognizability in line with actual circumstances, predicts that companies will be required to account for the objective recognizability of their management measures, and introduces the addition of statements on, among other things, the risk of losing non-public status through use of data input into generative AI for training.**
Patents	**2023 (Gyo-Ke) No. 10132 [Ground solidification material] <Presiding Judge Hibiku Shimizu>** **① The case concerned obviousness of applying injection conditions for solution-type grout to suspension-type grout in a ground solidification material.** **② The court recognized inventive step and rescinded the revocation decision because solidification by hydraulic properties differed from reaction with alkaline components in soil and no suggestion of applicability existed.** **③ The case shows that even within ground improvement technology, transferring injection conditions unchanged may not be obvious where solidification mechanisms differ.**

Category	Article title and three-point summary
Patents	**2025 (Ne) No. 10043 [Vehicle guidance system] <Presiding Judge Honda>** **① The case concerned whether "guidance" to a specified route in a vehicle guidance system is established when a vehicle can return to the destination by a route chosen at will.** **② Unlike the original judgment, the court found non-fulfillment because merely being able to return at the driver's discretion after entering a general road or similar location was not the specified guidance (some of the systems had no return route at all) and the defendant's systems had no "entrance/exit for general vehicles," a term that does not include an entrance/exit for general vehicles at another adjacent interchange; it set aside the part of the original judgment against the appellant and dismissed the claim.** **③ The case shows the need to distinguish the connections leading to the guidance destination and the range to which the device actually guides the vehicle from reachability through the driver's voluntary actions.**
Patents	**2024 (Ne) No. 10033 [Eave] <Presiding Judge Nakadaira>** **① The case concerned whether a squared U-shaped portion of an eave's front edge plate constituted a "vertical plate portion" whose front face guides rainwater.** **② The court denied literal fulfillment based on the shape including a horizontal portion and the separation between the guide surface and the abutting portion, and dismissed the appeal without recognizing infringement by equivalents, finding the first and second requirements of equivalence not satisfied.** **③ The case shows the need to examine plate sections, contact locations and the positional relationship of guide surfaces in relation to the purpose of reducing the eave's size.**

Category	Article title and three-point summary
Patents	**Tokyo District Court, 2023 (Wa) No. 70272 [Jig for a lifeline support post] <Presiding Judge Kokubu>** **① The case concerned fulfillment of the position of a bent portion and the relationship between plate length and flange width in a jig for a lifeline support post, and, in the counterclaim, whether the plaintiff's infringement notice constituted unfair competition (damage to business reputation).** **② The court found that the defendant's product did not literally fulfill either configuration and that the first requirement of equivalence was not satisfied because the differing portions constituted the essential part, and dismissed the main claims. On the counterclaim, it held that the plaintiff's infringement notice posted on social media constituted dissemination of a false fact under Article 2(1)(xxi) of the Unfair Competition Prevention Act, and granted the injunction and damages to the extent of 550,000 yen.** **③ The case shows that continuity between members and dimensional relationships bear on literal fulfillment and on identifying the essential part in light of comparison with the prior art, and that the conclusion of non-infringement is also directly linked to the determination of whether the content of an infringement notice constitutes a false fact.**
Patents	**Tokyo District Court, 2023 (Wa) No. 70607 [Remotely controlled unmanned boat] <Presiding Judge Sugiura>** **① The case concerned a configuration assessing two return conditions involving communication interruption and remaining power in a remotely controlled unmanned boat.** **② The court construed the first control device (Element J) as presupposing a mechanism capable of dealing with both critical situations, and held that the defendant's products, in which the remaining charge falls to the 20% range of full charge even when the return-start lower-limit voltage is set to 49 V, the upper limit settable by ordinary methods, did not fulfill Element J; it also denied equivalence for lack of the fifth requirement.** **③ The case shows the need to distinguish an activation condition of "at least one" from whether the device must be capable of assessing both conditions, in light of the invention's problem.**

Category	Article title and three-point summary
Patents	**Tokyo District Court, 2023 (Wa) No. 70219 [Commercial transaction system] <Presiding Judge Sugiura>** **① The case concerned fulfillment of the elements of acquisition of advance customs clearance information including customs-duty information and notification to a commercial transaction device in a commercial transaction system.** **② The court held Element D not fulfilled because seller-entered HS codes and receipt of "registration complete" did not establish acquisition of the specified customs-duty information, and held Element E also not fulfilled because, without acquisition of the advance customs clearance information, there could be no notification of it, even leaving aside the uncertainty in the evidence concerning the content transmitted.** **③ The case shows the need to identify information content, source and destination, not just its name, and to prove execution of each information-processing step.**
Patents	**2023 (Gyo-Ke) No. 10144 [DC ultra-high-voltage power supply for a food electric-field treatment apparatus] <Presiding Judge Nakadaira>** **① The case concerned procedure when adding documents corroborating well-known technology and obviousness of power circuits and related features in a power supply for food electric-field treatment.** **② The court held that the additional documents corroborated well-known status rather than introducing a new refusal ground, and denied inventive step based on well-known power circuit and voltage measurement technology.** **③ The case shows the need to distinguish whether the addition of cited materials constitutes a new refusal ground or corroboration of an existing finding, and to consider the technical fields of related components as part of the skilled person's knowledge.**

Category	Article title and three-point summary
Patents	**2024 (Ne) No. 10044 [Hair iron] <Presiding Judge Nakadaira>** **① The appellant sought, under Article 74(1) of the Patent Act, registration of transfer of the patent right from the appellee registered as the patentee, on the ground that the right to obtain a patent for the invention titled "hair iron" had been assigned by a person without authority to represent the appellant.** **② The court upheld the original judgment dismissing the claim by analogous application of Article 94(2) of the Civil Code, finding that the appellant bore serious culpability because its own internal circumstances and conduct were a cause of the creation of the false appearance and its true representative left the false appearance unaddressed for a long period, and finding that the appellees were in good faith and without negligence.** **③ The case shows the importance, when disputing ownership, of when the false appearance of authority was recognized and whether subsequent corrective measures were taken.**

Category	Article title and three-point summary
Patents	**2023 (Gyo-Ke) No. 10139 [Gaming machine] <Presiding Judge Hibiku Shimizu>** **① The case concerned novelty and inventive step of leaving important presentations to manual operation in a gaming machine's partial auto mode, and the propriety of dismissing an amendment in the appeal based on a cited invention different from that in the refusal decision without a notice of reasons for refusal.** **② The court denied inventive step of the amended invention based on the cited document's disclosure of non-auto operation only for high-expectation presentations and upheld the dismissal of the amendment, and held the claimed invention substantially identical to Cited Invention 2 (and, in the alternative, lacking inventive step). It further held that no notice of reasons for refusal is required by statute for dismissal of an amendment for violating the independent patentability requirement and that, even if an exception were considered, there was no unfair surprise because Cited Inventions 1 and 2 were based on the same document, had contents in common to some extent, and the document had already been cited in a notice of reasons for refusal.** **③ The case shows that, when an amendment filed with a request for appeal is dismissed for violating the independent patentability requirement, a notice of reasons for refusal is in principle not required even if a cited invention not presented in the refusal decision is relied on, and that, if a procedural-safeguard exception is considered, the identity of the source document, the common content and whether that document had already been presented in a notice of reasons for refusal are taken into account.**

Category	Article title and three-point summary
Patents	**Tokyo District Court, 2023 (Wa) No. 70619 [Device for measuring the difference in draft between both sides of a ship] <Presiding Judge Nakashima>** **① Following repeated litigation over a ship draft-difference measuring device, a former employee sought damages, alleging that false assertions by the company in earlier litigation had caused unnecessary payment of patent maintenance costs, together with confirmation that the patent right belonged to the former employee, and the company counterclaimed for wrongful litigation.** **② The court dismissed the action for confirmation of ownership of the patent right as lacking the interest in bringing an action or as unlawful in light of the purpose of the Patent Act, found neither false statements by the company nor responsibility for patent maintenance costs, and rejected the counterclaim because it could not be said that bringing the action markedly lacked reasonableness.** **③ The case shows the need to examine the business, expenses and testing underlying an employee-invention finding (a determination made for the sake of caution after the action for confirmation had been dismissed) and the unlawfulness of filing an action according to their respective requirements.**

Category	Article title and three-point summary
Trademarks	**[Trademark law ★] A case in which the court held that the designated services in Class 40, "rental of food waste processing machines; rental of chemical machinery and equipment," of the trademark at issue consisting of the standard characters "ゴミサー" are similar to the cited designated goods in Class 7, "food waste processing machines; liquid fertilizer manufacturing apparatuses," of the cited trademark consisting of the standard characters "ゴミサー" (falling under Article 4(1)(xi) of the Trademark Act), and rescinded the JPO trial decision dismissing the request for invalidation of the trademark registration at issue, which had held, among other things, that "rental of food waste processing machines" in Class 40 among the designated services at issue was not similar to "food waste processing machines" in Class 7 among the cited designated goods (not falling under Article 4(1)(xi) of the Trademark Act),** **① This action for rescission of a JPO trial decision in a trademark invalidation trial concerned similarity between machinery rental services in Class 40 and machinery goods in Class 7 for "ゴミサー."** **② The court found similarity based on actual trading circumstances in which the same business operators and the like sell and rent machinery and on common consumers, and rescinded the JPO trial decision dismissing the request for invalidation.** **③ The case shows the need to prove actual trading circumstances in related machinery fields and consumer overlap rather than deciding solely by the difference in similar group codes pointed out in the article's commentary.**

Full texts of the articles

2023 (Ne) No. 10063 [Electric impact fastening tool] <Presiding Judge Hibiku Shimizu>

Publication date: April 23, 2026

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%8d10063%e3%80%90%e9%9b%bb%e5%8b%95%e5%bc%8f%e8%a1%9d%e6%92%83%e7%b7%a0%e3%82%81%e4%bb%98%e3%81%91%e5%b7%a5%e5%85%b7%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf/

2023 (Ne) No. 10063 [Electric impact fastening tool] <Presiding Judge Hibiku Shimizu>

Inventive step: ×

<Difference A> With respect to the electric motor, the invention at issue is of an "outer rotor type," whereas the invention in Exhibit Otsu 15 is of an "inner rotor type."

<Difference B> With respect to how the magnets are held, in the invention at issue, "the magnets are adhesively attached, with a gap provided, on the outer peripheral side of the stator," whereas the invention in Exhibit Otsu 15 does not expressly disclose how the magnets are held.

1. Obviousness of Difference A (outer rotor type)
Increasing output torque and reducing size and weight were general problems in this technical field.
+ Exhibit Otsu 6 describes a high-torque machine for application to electric hand tools and an outer-rotor laminated-structure machine, and indicates application to electric hand tools. The advantage of the outer-rotor type over the inner-rotor type in increasing torque is also stated in Exhibits Otsu 21 and 22. The judgment also referred to a similar statement in Exhibit Otsu 23, while noting that it was unclear whether that document had been distributed before the priority date.
⇒ It would have been obvious for a person skilled in the art to apply invention A in Exhibit Otsu 6, which belongs to the same technical field, to solve the problem of the invention in Exhibit Otsu 15 and replace the inner rotor type with the outer rotor type.

2. Obviousness of Difference B (magnet fixing structure)

The technique of attaching magnets to a rotor with a gap provided, using an adhesive, in an electric motor was well-known technology as of the priority date of the patent at issue.

Judgment note: Regarding the statement in the original article that 「出力トルクの増大及び小型・軽量化が一般的な課題であった」 (increasing output torque and reducing size and weight were general problems), the judgment states 「工具の小型化及び軽量化を図るとの観点からも、パワーハンドツール（電動手工具）である電動式衝撃締め付け工具においては、電動モータの出力トルクを大きくすることが一般的に要請されていたものと認められる。」 (it is found that, also from the viewpoint of reducing the size and weight of tools, increasing the output torque of the electric motor was generally demanded in electric impact fastening tools, which are power hand tools (electric hand tools)) (judgment, p. 20, lines 2–5). Further, whereas the original article states 「乙６文献には、電動手工具用のアウタロータ型電動モータが高トルク化に有利であることが記載されている」 (the document in Exhibit Otsu 6 states that an outer rotor electric motor for an electric hand tool is advantageous for increasing torque), the judgment cites statements such as that the outer rotor type achieves higher torque than the inner rotor type as statements in Exhibits Otsu 21 to Otsu 23 (judgment, p. 21, line 11 – p. 22, line 13), and cites, for the document in Exhibit Otsu 6, statements such as 「電動手工具（パワーハンドツール）への応用のための高トルク機械」 (a high-torque machine for application to electric hand tools (power hand tools)) (judgment, p. 21, lines 22–23). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93022.pdf

Note: The content of this article provides general information and does not include legal advice.

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2023 (Ne) No. 10101 [Lighting device] <Presiding Judge Shoji>

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2023 (Ne) No. 10101 [Lighting device] <Presiding Judge Shoji>

Case-number note: As stated in the introductory note, the case number in the judgment is 2023 (Ne) No. 10101. The case number in the original article heading differs from that in the judgment. Judgment, p. 1

<Element A (respective red, blue and green light-emitting means)>

<Literal non-fulfillment>
⇒ The court held that not every light-emitting means producing light that includes wavelengths of approximately 610–670 nm can be construed as the red-light-emitting means in Element A. The assertion that the LEDs of the products at issue constituted red-light-emitting means was not accepted.
Furthermore, the patented invention requires having the “three light-emitting means” for red, blue and green, each distinguished from the others, but the products at issue have only two types of light-emitting means, warm white and daylight, and do not fulfill Element A.

<Equivalence not established>
Exhibit Otsu 3 had already disclosed technology that changes the ratio of the amounts of light from two light sources according to biological information (degree of wakefulness) while maintaining a constant total amount of light; therefore, the contribution of the invention at issue over the prior art cannot be said to be substantial, and its essential part is close to the wording of the claims (having an adjusting unit that changes the ratio of the amounts of red, blue and green light in response to biological information concerning wakefulness while keeping their total amount substantially constant). — First requirement: ×

Judgment note: The statement in the original article 「明細書において各発光手段は特定の波長帯域（赤色は概ね610〜670nm等）を持つものとして定義されており」 (in the description, each light-emitting means is defined as having a particular wavelength band (approximately 610–670 nm for red, for example)) corresponds to the appellant’s argument; the judgment states 「「概ね６１０～６７０ｎｍの波長」を含む光を発する発光手段が全て構成要件Ａの「赤色光を発光する赤色発光手段」に含まれると解することはできない。」 (it cannot be construed that every light-emitting means emitting light including “wavelengths of approximately 610–670 nm” falls within the “red light-emitting means that emits red light” of Element A) (judgment, p. 10, lines 11–13). Further, what the judgment identified as the essential part of the invention at issue is having an “adjustment unit” for changing the ratio of the light amounts of the three light-emitting means for red, blue and green according to biological information on the degree of wakefulness while keeping their total substantially constant (judgment, p. 15, lines 8–13). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93282.pdf

Note: The content of this article provides general information and does not include legal advice.

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2024 (Ne) No. 10022 [System for providing inspection and analysis services] <Miyasaka>

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2024 (Ne) No. 10022 [System for providing inspection and analysis services] <Presiding Judge Miyasaka>

Concerning the meaning and subject of “inspection and analysis,” the appellant argued that, in light of matters including the exclusion of inspection equipment for semiconductors and the like during prosecution, the subject of “inspection and analysis” in the invention at issue was “remote operation” itself, rather than a “sample.”

<This judgment>
There is no statement in the claims excluding semiconductor inspection equipment; accordingly, the appellant’s argument is not based on the claim language and cannot be accepted.
The statement in the description that one “checks whether remote control is possible” merely refers to one step for inspecting and analyzing a “sample,” and does not itself mean inspection and analysis.

⇒ Non-fulfillment

Judgment note: 「リモート制御できるか確認する」 (checks whether remote control is possible) in the original article is not the wording of the description itself; the statement in paragraph [0034] of the description at issue cited in the judgment is 「・・・ユーザ自身でユーザのワークステーションまたはパソコンを用いて、検査分析装置のリモート制御できるか、否か、確認できるようにした。」 (… the user can check, using the user’s own workstation or personal computer, whether or not remote control of the inspection and analysis device is possible) (judgment, p. 4, lines 7–9). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93334.pdf

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2023 (Gyo-Ke) No. 10061 [Combustor and boiler] <Miyasaka>

Publication date: April 23, 2026

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2023 (Gyo-Ke) No. 10061 [Combustor and boiler] <Miyasaka>

* Inventive step: × (societal demand at the filing date — motivation existed)

The invention in Exhibit Ko 2 (the primary reference) and the technology in Exhibit Ko 1 both belong to the same technical field as devices that use combustion heat.
At the time of filing the patent application at issue, reducing carbon dioxide emissions was a societal demand, and using the combustion heat of ammonia as a heat source was common general technical knowledge.
⇒ They share the problem and the means of solving it, and a motivation existed for a person skilled in the art to apply the technology in Exhibit Ko 1 to the invention in Exhibit Ko 2.

<Obviousness of Difference 1 (burner structure)>
The technology in Exhibit Ko 1 likewise supplies ammonia to a reducing atmosphere with little oxygen (the second reaction region), thermally decomposes it, and suppresses the formation of nitrogen oxides, and does not differ from the invention at issue in its basic mechanism of action.

<Obviousness of Difference 2 (high-temperature region)>
“Relatively low temperature” in Exhibit Ko 1 is merely a relative expression compared with the hottest region on the outside of the flame. The “second reaction region” in Exhibit Ko 1 is at a temperature sufficient to thermally decompose ammonia, and corresponds to the “high-temperature region” of the invention at issue. Accordingly, Difference 2 also could have been readily conceived by a person skilled in the art.

(Excerpt from the judgment)
It is found that reducing carbon dioxide emissions was a societal demand or a well-known problem at the time of filing the patent application at issue. Furthermore, regarding the use of ammonia combustion heat as a heat source, it is also mentioned as prior art in Exhibit Ko 1 that “it is known to economically utilize the heat generated when ammonia gas is burned,” and, moreover, the evidence (Exhibits Otsu 5–7) permits a finding that the use of ammonia combustion heat as a heat source was common general technical knowledge at the time of filing the patent application at issue. Accordingly, the invention in Exhibit Ko 2 and the technology in Exhibit Ko 1 can be said to belong to the same technical field of devices utilizing combustion heat; furthermore, in light of the above well-known problem and common general technical knowledge, it is apparent to a person skilled in the art that they share the problem and the means of solving it, and there is a motivation to apply the technology in Exhibit Ko 1 to the invention in Exhibit Ko 2....

Judgment note: Regarding the statement in the original article that 「炎の外側の最も高温な領域と比較した相対的な表現にすぎない」 (it is merely a relative expression compared with the hottest region on the outside of the flame), the judgment states 「甲１の「比較的低温で燃焼」という上記記載は、酸素が直接燃焼ガス流に当たって高温を発する「一方の反応領域」との対比において、相対的に低温であると説明するものと理解することができ、そのような理解が不自然ともいえない。」 (the above statement in Exhibit Ko 1, “burning at a relatively low temperature,” can be understood as explaining that the temperature is relatively low in comparison with “one reaction region,” where oxygen directly strikes the combustion gas flow and generates high temperatures, and such an understanding cannot be said to be unnatural) (judgment, p. 26, lines 17–20). Further, regarding 「本件発明の「高温度領域」」 (the “high-temperature region” of the invention at issue) in the original article, the judgment states 「そのような領域は本件発明３及び４の「高温度領域」に相当するものといえる。」 (such a region can be said to correspond to the “high-temperature region” of Inventions 3 and 4 at issue) (judgment, p. 26, lines 12–13). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93197.pdf

Note: The content of this article provides general information and does not include legal advice.
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2023 (Gyo-Ke) No. 10110 [Intraoral OCT with color texture] <Honda>

Publication date: April 23, 2026

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2023 (Gyo-Ke) No. 10110 [Intraoral OCT with color texture] <Honda>

* Inventive step: × (appeal decision maintained)

Regarding “with or without registration” in Element D, the description discloses both a form in which data are acquired using a common optical path without additional processing (without registration), and an alternative form in which additional processing is performed using a separate camera (with registration).
⇒ If the cited invention satisfies the “combining” requirement, the presence or absence of this specifying matter, “with or without registration...,” does not change the substantive matters specifying the invention.

Regarding the technical significance of “combining,” the claims do not specify the dimensionality of the data.
Even in light of the description, although “combining” means correlating each of the R, G and B values and the IOCT measurement value for each coordinate (X, Y), it is not understood to limit the form of the image when displayed to any particular dimensionality, texture mapping, or the like.

⇒ There is no error in the findings of the appeal decision.

Judgment note: Regarding 「座標（X、Y）」 (coordinate (X, Y)) in the original article, the judgment writes 「座標（x、y）」 (coordinate (x, y)) (judgment, p. 13, lines 17–18). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93166.pdf

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2023 (Gyo-Ke) No. 10084 [Electric impact fastening tool] <Hibiku Shimizu>

Publication date: April 23, 2026

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2023 (Gyo-Ke) No. 10084 [Electric impact fastening tool] <Hibiku Shimizu>

* Inventive step: ×

<Difference 1 (replacement of an inner rotor type with an outer rotor type)>
“Increasing torque” was a well-known problem in the technical field of the cited invention (Exhibit Ko 2: electric tool), and it was also well known that an outer rotor motor (Exhibit Ko 1) was advantageous for increasing torque.
⇒ A motivation existed to replace the inner rotor motor of Exhibit Ko 2 with the outer rotor type of Exhibit Ko 1, and a person skilled in the art could readily have done so.

<Difference 2 (adhesive attachment of magnets)>
Fixing (adhesively attaching) motor magnets with an adhesive was well-known technology.

Judgment note: The judgment refers to the differences corresponding to 「相違点１」 and 「相違点２」 (Differences 1 and 2) in the original article as 「相違点Ⅰ」 and 「相違点Ⅱ」 (Differences I and II) (judgment, p. 22, line 12 and line 17). Further, whereas the original article states 「アウタロータ型モータ（甲１）が高トルク化に有利であることも周知であった」 (it was also well known that an outer rotor motor (Exhibit Ko 1) was advantageous for increasing torque), the judgment states 「本件優先日当時、甲１発明のようなアウタロータ型モータは、インナロータ型モータよりも高トルク化が容易であることは周知であったと認められる（甲１８から２０まで）。」 (it is found that, as of the priority date at issue, it was well known that an outer rotor motor such as the invention of Exhibit Ko 1 can more easily achieve higher torque than an inner rotor motor (Exhibits Ko 18 to 20)) (judgment, p. 29, lines 10–12), identifying Exhibits Ko 18 to Ko 20 as the basis for the well-known status. Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93258.pdf

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2023 (Gyo-Ke) No. 10103 [Optical ferrule] <Honda>

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2023 (Gyo-Ke) No. 10103 [Optical ferrule] <Honda>

The “parting line artifact” in the claimed invention means a parting line (a step or burr) that arises during molding with a mold, and there is no further limitation as to specific size or the like.
When the cited invention is “molded” with a mold, its external shape (a design that avoids undercuts or makes burrs less conspicuous) inevitably causes parting lines, namely parting line artifacts, to arise at the same positions as in the claimed invention (the outer edges or ridges of mating surfaces).
⇒ Inventive step: ×

Judgment note: The judgment states 「金型を用いた成型における「分割線」（パーティングライン）とは、金型の合わせ目のことを意味し」 (a “parting line” in molding using a mold means the joint of the mold) (judgment, p. 15, lines 6–7), and 「本願発明の「分割線加工物」とは、成型品上に生じる金型の合わせ目に起因する段差状ライン又はバリ状ラインのことを意味するものと解される。」 (the “parting line artifact” of the claimed invention is construed to mean a step-like line or burr-like line arising on a molded product due to the joint of the mold) (judgment, p. 15, lines 9–10). The judgment distinguishes the parting line (the joint of the mold) from the parting line artifact arising on the molded product due to it, which differs from the terminology in the original article, 「パーティングライン、すなわち分割線加工物」 (parting lines, namely parting line artifacts). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93253.pdf

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2023 (Gyo-Ke) No. 10107 [Induction heating coil unit] <Presiding Judge Hibiku Shimizu>

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2023 (Gyo-Ke) No. 10107 [Induction heating coil unit] <Presiding Judge Hibiku Shimizu>

1. Claim 1 (inventive step: ×)
The statement “composed of...” in the claims is not limited to being composed “only” of that material, and also permits that material to be included as part of the composition.

(Excerpt from the judgment)
Claim 1 merely states, regarding the composition of the case, “a case composed of electrically insulating ceramic or resin and housing the heating coil,” and contains no wording indicating that the case is composed “only” of the element of electrically insulating ceramic or resin. Moreover, even upon considering the statements in the detailed description of the invention in the description at issue, there is no statement suggesting that the case recited in the claims is intended to be composed only of the foregoing element. Accordingly, the case of Invention 1 at issue cannot be construed as limited to one composed only of the foregoing element; thus, it is appropriate to construe “a case composed of electrically insulating ceramic or resin and housing the heating coil” in Invention 1 at issue as requiring only a composition that includes that element.
Next, regarding the “induction heating coil unit” of Invention 1 at issue, Claim 1 of the claims of the patent at issue also contains no wording indicating that “unit” has a special meaning. Even upon considering the statements in the detailed description of the invention in the description at issue, there is no statement suggesting any limitation on the composition of the “induction heating coil unit.” Accordingly, it is appropriate to construe the “induction heating coil unit” of Invention 1 at issue as simply meaning “a constituent unit including an induction heating coil” (a unit means a constituent unit).

2. Claim 2 (inventive step: ○)
The cooling path structure of the invention in Exhibit Ko 4 (induction heating cooker) is unclear, while the arrangement of the intake and exhaust openings and the cooling path configuration (division into multiple flow paths) in the invention in Exhibit Ko 5 (electric cooker) differ from Invention 2 at issue (acute-angle arrangement + partitioning portion).
There is no motivation to combine or modify these, and Invention 2 at issue is not obvious.

3. Claim 3 (inventive step: ○)
The “flow-straightening portion” of Invention 3 at issue causes gas to branch or “merge.”
The “partition plate” of the invention in Exhibit Ko 5 discharges gas while keeping it branched, and does not have a function of merging it inside the case.

4. Claim 4 (inventive step: ×)
An “induction heating coil unit” simply means a constituent unit including a coil, and even the finished “electric cooker” of the invention in Exhibit Ko 5 falls within “unit” because it can be a constituent unit of another system.

Judgment note: Regarding Claim 2, the determination based on the invention in Exhibit Ko 4 is 「甲４発明については、その冷却経路の構造が明らかではなく、甲４発明に基づき、相違点１（第１冷却経路）及び相違点２（第２冷却経路）の構成とすることが当業者にとって容易想到であったと認めるに足りない。」 (as for the invention in Exhibit Ko 4, the structure of its cooling path is not clear, and it cannot be found that a person skilled in the art could readily have conceived of the configurations of Difference 1 (first cooling path) and Difference 2 (second cooling path) based on the invention in Exhibit Ko 4) (judgment, p. 34, lines 17–20), and it was in its determination based on the invention in Exhibit Ko 5 that the judgment stated 「このような構成とすることの動機付けは認められない。」 (no motivation to adopt such a configuration is found) (judgment, p. 47, line 4). Further, although the original article does not refer to Claims 5 and 6, the judgment held that, for Claims 5 and 6 as well, the JPO trial decision’s determinations premised on inventive step being recognized for all of Claims 1 to 4 (for Claim 6, Claims 1 to 5) lacked their premise (judgment, p. 59, lines 23–25; p. 60, lines 8–10), and rescinded the parts of the JPO trial decision concerning Claims 1 and 4 to 6 (judgment, p. 1, lines 16–19). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93344.pdf

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2023 (Gyo-Ke) No. 10104 [Device... formed of a very low resistance material] <Hibiku Shimizu>

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2023 (Gyo-Ke) No. 10104 [Device... formed of a very low resistance material] <Hibiku Shimizu>

⇒ Enablement requirement: ×

Although the test results stated in the description and other documents (Figures 14A–21B) show resistance decreasing as temperature falls, none shows that the resistance value became zero.
Resistance and resistivity must be distinguished, and the absence of test results or other evidence showing zero resistance means that the material's superconducting state has not been substantiated.
Even if part of the material became superconducting, no specific method is disclosed for extracting only that part and using it as a conductor.

⇒ Regarding the occurrence of the Josephson effect, the statement in the description that a Josephson current flows through the barrier material despite the absence of support for the conductor being in a superconducting state (zero resistance) contradicts common general technical knowledge.
The description does not state test results or other evidence supporting that such a phenomenon can occur, and the affidavits submitted by the plaintiff also lack a specific basis.

Judgment note: Whereas the original article states 「抵抗値がゼロでない以上、超伝導状態にあるとはいえない。」 (unless the resistance value is zero, the material cannot be said to be in a superconducting state), the judgment did not find that the resistance value was not zero, but stated 「超伝導状態とは抵抗値がゼロの状態であり（技術常識１）、その場合は抵抗率もゼロとなるが、本願発明の材料の抵抗値がゼロとなった試験結果等が記載されていないことは、前記のとおりである。」 (a superconducting state is a state in which the resistance value is zero (common general technical knowledge 1), in which case the resistivity is also zero, but, as stated above, no test results or the like showing that the resistance value of the material of the claimed invention became zero are described) (judgment, p. 14, lines 14–17). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93330.pdf

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2024 (Ne) No. 10010 [Women’s clothing] <Presiding Judge Nakadaira>

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2024 (Ne) No. 10010 [Women’s clothing] <Presiding Judge Nakadaira>

* The original judgment finding patent infringement was maintained.
* The new invalidity ground asserted in the statement of reasons for appeal was held to be untimely. (It was nevertheless considered.)

<Fulfillment of the claim elements>
“Connects and also” means a configuration that has a connecting function and an adjusting function at the same time, and does not require “adjusting while maintaining the connected state,” as argued by the appellant.
“Connection width” means the amount of overlap in the horizontal direction of the torso.

<Invalidity ground>
Although the argument based on the document in Exhibit Otsu 31 constituted an “untimely allegation or evidence,” the court also considered its merits because the appellee had responded in the alternative and the appellant had not rebutted that response, so that, to this extent, conclusion of the litigation could not be said to be delayed.
⇒ Whereas the invention in Exhibit Otsu 31 covers and compresses the entire breasts to restrain their movement, the invention at issue covers only the sides of the bust and draws them inward from the left and right, and the two clearly differ in mechanism of action and configuration.
Furthermore, there is a factor teaching away from changing a configuration that covers the whole to one that covers only the sides, and inventive step is not denied either.

(Excerpt from the judgment)
First, turning to whether the new assertion constitutes an untimely allegation or evidence: the appellant's assertion of a new invalidity ground in this appeal was made in the statement of reasons for appeal dated February 6, 2024. In patent infringement litigation, an invalidity defense may be asserted without awaiting a final and binding decision of invalidation in patent invalidation trial proceedings, so that disputes concerning infringement of a patent right may be resolved promptly, as far as possible, within the patent infringement proceedings. Since it is made within civil litigation proceedings that are separate from patent invalidation trial proceedings, if, in light of the course of the proceedings, it would unduly delay the proceedings, it should be dismissed as an untimely allegation or evidence.
Looking at the course of the proceedings in the court of first instance on this basis, the appellant, who was the defendant at first instance, in its answer dated October 22, 2021 and submitted on October 27 of that month, denied that the appellee's products fell within the elements of the invention at issue, and asserted an invalidity ground of lack of inventive step using the document in Exhibit Otsu 8 as the primary reference, combined with well-known technology or with the document in Exhibit Otsu 9 as a secondary reference. In response to counterarguments and other submissions by the appellee, who was the plaintiff at first instance, the appellant added an invalidity ground of lack of novelty based on the document in Exhibit Otsu 8 in Preparatory Brief (3), dated March 18, 2022. In response to further counterarguments by the appellee, the appellant added a further invalidity ground of lack of inventive step using the document in Exhibit Otsu 8 as the primary reference and the document in Exhibit Otsu 10 as a secondary reference in Preparatory Brief (4), dated May 27, 2022. It further responded to the appellee's counterarguments on this point in Preparatory Brief (5), dated August 29, 2022.
Then, on the premise that the parties had exhausted their allegations and proof on infringement, in the written preparatory proceedings conducted by web conference on August 31, 2022, the court disclosed its view that it would proceed to examine damages (the progress record of the written preparatory proceedings on August 31, 2022 states in the discussion results column: "Both parties have exhausted their allegations and proof on infringement" and "Presiding judge: The proceedings will now move on to damages"). The examination of damages proceeded, and at the oral argument held on September 22, 2023, the appellant stated that it had no further allegations or proof to present. The oral argument at first instance was closed, and the original

judgment was rendered.
In light of this course of proceedings at first instance, the assertion of a new invalidity ground in this appeal constitutes an untimely submitted allegation or evidence, and the appellant was grossly negligent regarding the delay in its submission; it would therefore ordinarily have to be dismissed. However, the appellee has, albeit in the alternative, presented counterarguments concerning the invalidity ground submitted in this appeal, and the oral argument in this appeal has concluded without any rebuttal by the appellant. To this extent, it cannot be said that the conclusion of the litigation would be delayed, and the court will therefore consider the matter below.

Judgment note: The judgment held that the assertion of the new invalidity ground constituted an untimely allegation or evidence and that the appellant was grossly negligent, and then, because the appellee had presented counterarguments and the oral argument had concluded without a rebuttal by the appellant, stated 「この限度では訴訟の完結を遅延させることになるとまではいえないため、以下、判断を加えることとする。」 (to this extent, it cannot be said that the conclusion of the litigation would be delayed, and the court will therefore consider the matter below) (judgment, p. 38, lines 10–16). The structure of the reasons for considering the matter differs from the original article's statement 「訴訟遅延を避けるため判断を行った」 (the court ruled on it to avoid delaying the litigation). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93355.pdf

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2023 (Gyo-Ke) No. 10124 [Moving image decoding device] <Presiding Judge Miyasaka> = 2023 (Gyo-Ke) No. 10125

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2023 (Gyo-Ke) No. 10124 [Moving image decoding device] <Presiding Judge Miyasaka>
= 2023 (Gyo-Ke) No. 10125

* This is an action seeking revocation of a cancellation decision in patent opposition proceedings. Information that merely affects the number as a consequence was not held to constitute “control information for changing the number of motion vector candidates.”
In addition to the correction adding new matter, cancellation of the patents for Claims 1 and 2 on the ground of violation of the support requirement was maintained.

— An “on” change flag includes both cases in which the number of candidate vectors changes and cases in which it does not, and does not constitute control information for changing that number. Threshold Th and the maximum vector count contribute only consequentially and indirectly to changing the candidate count and lack a purpose–means relationship. The correction was held to add new matter and not to comply with Articles 120-5(9) and 126(5) of the Patent Act.

“A purpose–means relationship with ‘changing the number of motion vector candidates’ is required, and it is insufficient that the number of motion vectors may merely be affected consequentially or indirectly.”
“The control information concerning the ‘change flag’ cannot be understood as having the purpose of changing the number of motion vector candidates, and the change flag does not constitute ‘control information for changing the number of motion vector candidates.’”
“Although the control information concerning the ‘threshold Th’ is information involved in changing the number of vectors, it merely contributes consequentially or indirectly to the change, and cannot be construed as having the purpose of changing the number of motion vector candidates.”

(Excerpt from the judgment)
...Although the description and other documents at issue contain no particular statement concerning the meaning of “control information for changing the number of motion vector candidates,” as an understanding based on the wording “for,” in light of the technical significance of that “control information,” a purpose–means relationship with “changing the number of motion vector candidates” is required, and it is insufficient that the number of motion vectors may merely be affected consequentially or indirectly.... ...
The description at issue... Although the control information concerning the “threshold Th” is information involved in changing the number of vectors, it merely contributes consequentially or indirectly to the change, and cannot be construed as having the purpose of changing the number of motion vector candidates; it therefore does not constitute “control information for changing the number of motion vector candidates.”

Judgment note: This is an action against a decision revoking a patent in opposition proceedings, and the judgment states that the correction 「特許法１２０条の５第９項、１２６条５項の規定に適合しない」 (does not comply with Article 120-5(9) and Article 126(5) of the Patent Act) (judgment, p. 20, lines 23–25). 「動きベクトル候補の数を変更するための制御情報」 (control information for changing the number of motion vector candidates) is a matter common to the claims before and after correction (judgment, p. 17, lines 1–2), and the judgment dismissed the claim, stating 「請求項１、２に係る本件特許はサポート要件違反を理由に取消しを免れない。」 (the patent for Claims 1 and 2 cannot escape revocation on the ground of violation of the support requirement) (judgment, p. 22, lines 7–8). Further, the term 「直接の目的」 (immediate purpose) in the original article does not appear in the judgment; the judgment states 「「動きベクトル候補の数の変更」との間に目的・手段の関係があることを要し、単に結果的、間接的に動きベクトルの数に影響する場合があるというのでは足りない」 (a purpose–means relationship with “changing the number of motion vector candidates” is required, and it is insufficient that the number of motion vectors may merely be affected consequentially or indirectly) (judgment, p. 17, lines 9–12). As for the change flag, the judgment stated 「「変更フラグ」オンは、候補ベクトル数が変わる場合と変わらない場合を含んでいることになる。」 (a “change flag” that is on includes both cases in which the number of candidate vectors changes and cases in which it does not) and then held that the change flag does not constitute 「動きベクトル候補の数を変更するための制御情報」 (control information for changing the number of motion vector candidates) (judgment, p. 18, lines 6–10); it was with respect to the threshold Th and the maximum number of vectors that the judgment stated 「変更に結果的、間接的に寄与するものにすぎず」 (merely contributes consequentially or indirectly to the change) (judgment, p. 18, lines 23–24; p. 19, lines 10–11). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93350.pdf

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2023 (Gyo-Ke) No. 10148 [Sales system] <Presiding Judge Nakadaira>

Publication date: April 16, 2026

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2023 (Gyo-Ke) No. 10148 [Sales system] <Presiding Judge Nakadaira>

Motivation to combine the primary reference with another technology
— “Because the purpose of the invention in Exhibit Ko 1 is to reduce the workload of the retailer, producing such a list and outputting it in a form that the school’s person in charge can view is incompatible with that purpose of the invention in Exhibit Ko 1, and there is therefore no such motivation.”
⇒ Inventive step: ○

https://t.co/5wU66BxRCB

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2024 (Ne) No. 10019 [Rolling device] <Presiding Judge Miyasaka>

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2024 (Ne) No. 10019 [Rolling device] <Presiding Judge Miyasaka>

★ The patentee lost for insufficient proof...

① Elements 1-A and 2-A were held fulfilled, reversing the original finding.
— The claims contain no limitation such as “absence of a retainer,” and the appellee’s products have “a rolling path constituted by at least one pair of rolling grooves” and “a plurality of rolling elements interposed so as to roll freely,” and thus literally fulfill the elements.
They are not narrowly construed on the basis of statements in the description (functions and effects).

② Element 1-C (formation of a no-load region) was held not fulfilled.
— Because the appellee’s products (angular contact ball bearings) are used under preload, there is no gap between the balls and the inner and outer rings, and they are always in contact.
⇒ A “no-load region in which the rolling elements contact only one of the rolling grooves” is not formed.
The appellant argued the effect of centrifugal force, but the load due to preload exceeded the centrifugal force, and formation of a no-load region was not proved.

③ Element 2-C (relative magnitudes of frictional forces) was held not fulfilled.
— It was not proved that the requirement is necessarily fulfilled merely because centrifugal force arises.

Judgment note: 「保持器がないこと」 (absence of a retainer) in the original article is not the wording of the judgment; the judgment states 「保持器を備えていることは、その充足を認める妨げになるものではない。」 (having a retainer does not prevent a finding of fulfillment) (judgment, p. 8, lines 2–3). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93425.pdf

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2023 (Gyo-Ke) No. 10143 [Hand-pushing member] <Presiding Judge Hibiku Shimizu>

Publication date: April 10, 2026

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e8%a1%8c%e3%82%b110100%e3%80%90%e6%89%8b%e6%8a%bc%e9%83%a8%e6%9d%90%e3%80%91%ef%bc%9c%e6%b8%85%e6%b0%b4%e9%9f%bf%e8%a3%81%e5%88%a4%e9%95%b7%ef%bc%9e/

2023 (Gyo-Ke) No. 10143 [Hand-pushing member] <Presiding Judge Hibiku Shimizu>

Case-number note: As stated in the introductory note, the case number in the judgment is 2023 (Gyo-Ke) No. 10143. The case number in the original article heading differs from that in the judgment. Judgment, p. 1

Exhibit Ko 8 is attached to the curved part of the “squared U-shaped handle” of a cart and prevents the hand from slipping onto the vertical pipe portion.
⇒ Exhibit Ko 8 has a shape and dimensions premised on attachment to the curve of a “squared U-shaped” handle, and there is no motivation to attach it to “a single vertical rod” as in the patent at issue.

For the invention of Exhibit Ko 9, the court began with Difference 2. The safety cover of Exhibit Ko 8 presupposes attachment to the curved portion of a squared-U-shaped handle, and no motivation to apply it to the vertically elongated hand-pushing member of Exhibit Ko 9 was found. The flange-shaped guard of Exhibit Ko 3 is an end stopper restricting the hand to the correct gripping position and does not disclose a technical idea solving the problem of the invention of Exhibit Ko 9. The court did not determine Difference 3 concerning the integral structure or difficulty of manufacture.

⇒ Inventive step: ○

Judgment note: The judgment’s 「当裁判所の判断」 (court’s determination) contains no finding on the difficulty of manufacture; the judgment states 「事案に鑑み、甲９相違点２の容易想到性から判断する。」 (in view of the nature of the case, the court first determines the obviousness of Difference 2 relative to Exhibit Ko 9) (judgment, p. 21, line 16) and does not determine Difference 3 relative to Exhibit Ko 9, which concerns the integral structure. Regarding Exhibit Ko 8, the judgment denied motivation and further stated 「甲８発明のハンドルをこのような形状に変更することには、むしろ阻害要因があるというべきである。」 (there is rather a factor teaching away from changing the handle of the invention of Exhibit Ko 8 to such a shape) (judgment, p. 19, lines 13–14). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93400.pdf

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Tokyo District Court, 2023 (Wa) No. 70407 [Filling material for an electronic cigarette] <Presiding Judge Sugiura>

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Tokyo District Court, 2023 (Wa) No. 70407 [Filling material for an electronic cigarette] <Presiding Judge Sugiura>

Case-number note: As stated in the introductory note, the case number in the judgment is 2023 (Wa) No. 70407. The case number in the original article heading differs from that in the judgment. Judgment, p. 1

“Cuts are formed in the sheet-like member along the first direction” (Element B) is not fulfilled.

• The dictionary meaning of “cut”
• Cutter blades and the like are given as examples of means of forming the cuts in the description at issue.
• The effects of the invention (preventing filling material from falling out and stabilizing the smoking feel) are obtained by controlling the length and other features of the cuts.
⇒ A “cut” means a structure or state in which an incision has been artificially and actively formed by cutting the surface of the sheet-like member with a blade.

⇒ Although three linear breaks along the longitudinal direction are observed in the tobacco substrate of the defendant’s products, these are “tears or cracks” formed when the surface tears or cracks along the ridges or valleys of a corrugated tobacco sheet during the process of crimping the tobacco sheet and gathering it to form a tobacco rod.
⇒ Non-fulfillment

The plaintiff argued, based on the dictionary meaning and articles about the defendant’s explanatory sessions, among other things, that “cuts” are not limited to those formed with a blade. However, the court rejected the plaintiff’s argument on grounds including that the dictionary meaning is also related to the action of “cutting,” and that the description also presupposes formation with a blade.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93589.pdf

Judgment note: Based on the dictionary meaning, the judgment stated 「「切込み」とは、刃物を用いて人為的・能動的に「切り目」ないし「切れ目」が形成された構造ないし状態を意味するものと理解される。」 (a “cut” is understood to mean a

structure or state in which a “cut” or “slit” has been formed artificially and actively using a blade) (judgment, p. 35, lines 2–4), and then held 「「切込み」（構成要件 B）とは、刃物でシート状部材の表面を切ることにより形成された、切れている部分をいうものと解するのが相当である。」 (it is appropriate to construe a “cut” (Element B) as a cut portion formed by cutting the surface of the sheet-like member with a blade) (judgment, p. 35, lines 9–11). The statement in the original article following 「⇒「切込み」とは、」 (⇒ A “cut” means) combines these two statements. Further, regarding control of the cuts and the effects of the invention, the judgment states only that 「何らかの方法により人為的・能動的に制御することが発明の効果を奏する上では少なくとも好ましいものとされていることがうかがわれる。」 (it can be inferred that artificially and actively controlling them by some method is regarded as at least preferable for achieving the effects of the invention) (judgment, p. 34, lines 14–16).
Judgment

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Tokyo District Court, 2023 (Wa) No. 70393 [Tiltable and stowable temporary protective fence] <Presiding Judge Nakashima>

Publication date: April 10, 2026
Original article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c5%e5%b9%b4%e3%83%af70393%e3%80%90%e8%b5%b7%e4%bc%8f%e5%8f%8e%e5%ae%b9%e5%bc%8f%e4%bb%ae%e8%a8%ad%e9%98%b2%e8%ad%b7%e6%9f%b5%e3%80%91%ef%bc%9c-2/

Tokyo District Court, 2023 (Wa) No. 70393 [Tiltable and stowable temporary protective fence] <Presiding Judge Nakashima>

“Pivoting plate-like member” is not fulfilled.

— In light of the statements in the description (that it is a “thin plate,” and the means of solving the problem by thereby reducing the overall width and making the structure compact), this was construed as literally referring to a “thin plate-like object,” excluding round tubes and square tubes.

⇒ The posts (pivoting members) of the defendant’s products are “square tubular (square pipe-shaped),” and the element is not literally fulfilled.
(Equivalence is also not established.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93477.pdf

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2024 (Ne) No. 10045 [Wastewater treatment apparatus] <Presiding Judge Hibiku Shimizu>

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2024 (Ne) No. 10045 [Wastewater treatment apparatus] <Presiding Judge Hibiku Shimizu>

* “Oxygen supply means” (Element D) is not fulfilled.

The defendant’s system = intentionally and actively adds “ozone” to the micro-nanobubbles supplied into the second containment tank (aeration tank).

The patent at issue aims to perform biological treatment using microorganisms in the second containment tank.
Because ozone may kill microorganisms, the invention at issue instead addresses the problem of “early reduction of residual ozone.”
Accordingly, deliberately supplying additional ozone to the second containment tank containing microorganisms goes against the purposes of the invention (promoting biological treatment and reducing residual ozone), and is incompatible with the technical idea of the invention at issue.
⇒ “Oxygen supply means” is for supplying oxygen and does not extend to means for actively supplying additional ozone that may harm microorganisms.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93482.pdf

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<IP Practice Online> “Overview of the revision of the Trade Secret Management Guidelines” (Attorney Naoki Kurokawa, Ministry of Economy, Trade and Industry)

Publication date: April 10, 2026

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<IP Practice Online> “Overview of the revision of the Trade Secret Management Guidelines” (Attorney Naoki Kurokawa, Ministry of Economy, Trade and Industry)

1. Overview of the revision of the Trade Secret Management Guidelines (2025)
This revision aims to reflect changes in social conditions such as the spread of teleworking, the rise of generative AI and increased labor mobility, as well as developments in recent court decisions.

① The position of “reasonable classification (distinguishing confidential information from general information),” which had previously been emphasized as a criterion for assessing secrecy management measures, was clarified.
⇒ Rather than making reasonable classification an absolute, independent requirement, the revised guidelines incorporate it as one factor in determining the “degree of necessary secrecy management measures.”
While this permits flexible management systems according to a company’s actual circumstances and the nature of the information, it reemphasizes that a state must be secured in which employees can objectively recognize the company’s intention that “this is confidential” (objective recognizability).

② In light of the spread of cloud services, the approach to access rights management was described in detail.
For example, even if access rights are widely granted within a particular department, the requirement of secrecy management may be found to be satisfied if access from outside that department is restricted.
Descriptions reflecting technological trends were also added, including the risk that input data may unintentionally be used for training when generative AI is used, resulting in loss of non-public status; reference to leaks through the dark web; and the relationship between reverse engineering and non-public status.

③ In light of recent court decisions, it was expressly stated regarding usefulness that “as long as the information is used or utilized in business activities, the requirement is satisfied unless there are special circumstances such as a violation of public order and morals,” and that “whether a person who wrongfully acquired it can effectively utilize it is irrelevant.”
Regarding non-public status, the guidelines clarify the standard that information readily ascertainable by analyzing a product is not protected, but non-public status is maintained when considerable time or special techniques are required.

★ This revision shifts the emphasis from “formal management” to “securing recognizability in line with actual circumstances.”
From a multifaceted perspective, it is an attempt to maintain the framework of legal protection while accepting changes in the IT environment as a given.
Examined critically, while management becomes more flexible, companies are predicted to face a heightened responsibility to explain and prove “whether their management measures are objectively recognizable.”

(Session 268) IP Practice Online: “Overview of the revision of the Trade Secret Management Guidelines” (Guest: Naoki Kurokawa, Attorney at Law and Patent Attorney, Deputy Director, Intellectual Property Policy Office, Economic and Industrial Policy Bureau, Ministry of Economy, Trade and Industry)

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2023 (Gyo-Ke) No. 10132 [Ground solidification material] <Presiding Judge Hibiku Shimizu>

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2023 (Gyo-Ke) No. 10132 [Ground solidification material] <Presiding Judge Hibiku Shimizu>

Case-number note: As stated in the introductory note, the case number in the judgment is 2023 (Gyo-Ke) No. 10132. The case number in the original article heading differs from that in the judgment. Judgment, p. 1

⇒ Inventive step: ○ (revocation decision rescinded)

The Japan Patent Office held that the configuration of the invention at issue (particularly the injection conditions) could readily have been conceived by combining the cited invention with technical matters such as the “magma action method.”

This judgment recognized inventive step for the following reasons.

① Difference in solidification principles
The ground solidification material of the invention at issue is a “suspension-type grout” that solidifies through the hydraulic properties of slag. In contrast, the technology described in documents such as Exhibit Ko 5 is a “solution-type grout” that solidifies according to the pH of the ground (reaction with alkaline components in the soil). Their principles of solidification differ.

② Inapplicability of injection conditions (arising from the difference in solidification principles)
The magma action method described in documents such as Exhibit Ko 5 concerns injection conditions (such as injecting for longer than the gelation time in the soil) where an acidic solution-type grout reacts with alkaline components in the soil and solidifies. Because the solidification principles differ, these injection conditions cannot be said to apply unchanged to the suspension-type grout of the invention at issue.

③ Absence of a suggestion
Documents such as Exhibit Ko 5 contain no statement suggesting that the magma action method can be applied to suspension-type grout. Although Exhibit Ko 9 mentions suspension-type grout, its solidification mechanism and relationship with the magma action method are unclear.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93495.pdf

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2025 (Ne) No. 10043 [Vehicle guidance system] <Presiding Judge Honda>

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2025 (Ne) No. 10043 [Vehicle guidance system] <Presiding Judge Honda>
— Reversed: non-fulfillment!!

* For “guidance... to a route returning to the point before...,” guidance only part of the way to the “route returning to the point before...” is insufficient.

1. Regarding “guidance means for guiding... to a route returning again to the point before...”:
In some accused systems, after being returned to a general road or a service area, a driver may find and return to the original ETC-only entrance/exit through the driver’s own will and judgment.
Other accused systems have no route returning to the ETC-only exit that the vehicle attempted to enter. Even where return is possible, “guidance” means “inviting and leading toward an objective,” and it is difficult to regard a driver as having been “guided” merely because the driver can return voluntarily.
The appellee argued that guidance to the “second lane” was sufficient, and that guidance beyond it to the “point before the ETC-vehicle-only entrance/exit” was unnecessary. However, this argument was rejected because construing a vehicle’s ability to reach the destination by any route as “leading to” it disregards a matter specifying the invention and also contradicts the description.

2. “Guidance means... leading to an entrance/exit for general vehicles”
The defendant’s respective systems are not found to have an “entrance/exit for general vehicles.”
The appellee argued that an “entrance/exit for general vehicles at another adjacent interchange” is also included, even if none is present at the facility concerned. However, guidance means leading to an entrance/exit for general vehicles at another adjacent interchange cannot be read from the description, and the fact that vehicles unable to use a smart interchange consequently have no choice but to use a nearby entrance/exit for general vehicles was held “difficult to regard as the result of guidance”; this interpretation was not adopted.

(Excerpt from the judgment)
To hold that “guiding to a second lane leading to a route returning again to the point before the aforementioned ETC-vehicle-only entrance/exit or to an entrance/exit for general vehicles” is fulfilled merely because a vehicle can reach the “point before the ETC-vehicle-only entrance/exit” or an “entrance/exit for general vehicles” by any route from the point where it has left the “second lane” is substantially equivalent to allowing the point to which the “second lane” connects to be any location. It must therefore be said to disregard the matter specifying the invention, “leading to a route returning again to the point before the aforementioned ETC-vehicle-only entrance/exit or to an entrance/exit for general vehicles.” Even looking at the description at issue, the matter specifying the invention, “leading to a route returning again to the point before the aforementioned ETC-vehicle-only entrance/exit or to an entrance/exit for general vehicles,” is based, for example, on the statements “proceeds to lane E, ...and returns again to the point of selecting one of lanes A, B and C” ([0035]) and “a configuration may be adopted in which it passes through lane E and merges at a point before the ticket-issuing box 6 in lane B or C; lanes B and C are lanes for general vehicles” ([0036]). These indicate that simply by traveling along the lane, a vehicle is led to reach the “point before the ETC-vehicle-only entrance/exit” or an “entrance/exit for general vehicles,” namely, is “guided.” There is no statement that a vehicle’s ability, after leaving the lane, to reach the point before the ETC-vehicle-only entrance/exit or an entrance/exit for general vehicles by any route constitutes “guidance.”

Judgment note: Returning on the driver’s own initiative was found possible only for some of the defendant’s systems; for the other systems, the judgment states 「当該車両が進入を試みたＥＴＣ車専用出口に再度戻る経路（ルート）はない。」 (there is no route for returning again to the ETC-vehicle-only exit that the vehicle attempted to enter) (judgment, p. 11, lines 19–21). The (Excerpt from the judgment) is taken from the judgment, p. 13, lines 3–19, with the opening word 「しかし、」 (however) omitted and the judgment’s 「・・・」 written as 「…」. Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94945.pdf

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2024 (Ne) No. 10033 [Eave] <Presiding Judge Nakadaira>

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2024 (Ne) No. 10033 [Eave] <Presiding Judge Nakadaira>

* Appeal dismissed (non-fulfillment)

The patented invention at issue is characterized by a configuration (Element B2) in which the “vertical plate portion” of a “front edge plate” attached to the front end of the eave “abuts the open front end face of the eave plate, and its front face forms a guide surface that guides rainwater downward.”
This eliminates the need for a conventional rain gutter and seeks to reduce the size of the eave and simplify its structure.

⇒ Literal non-fulfillment

Based on the claim language, the “vertical plate portion” is a section of plate extending vertically, separate from the “horizontal plate portion,” and its front face must form the guide surface.
The corresponding part of the defendant’s products is “squared U-shaped” and includes a horizontally extending portion, and therefore does not fall within this definition.
Furthermore, in the defendant’s products, the guide surface and the abutting portion are spaced apart, causing a corresponding forward projection. The court held that construing “vertical plate portion” to include such a configuration, in which the front face of the plate abutting the eave plate’s front end does not form the guide surface, would be inconsistent with the invention’s purpose, including making the eave smaller.

Infringement by equivalents: also ×

Judgment note: What the judgment held inconsistent with the purpose of the invention is not the defendant’s products themselves but the construction that includes such a configuration in the “vertical plate portion”; the judgment states 「このように、「庇板の開放された前端面に当接され」た板部の「前面が雨水を下方へ導くガイド面」となっていない構成が構成要件Ｂ２の「縦板部」に含まれるとの解釈は、本件明細書に記載された本件発明の上記目的に整合しない。」 (thus, the construction that a configuration in which the plate portion “abutting the open front end face of the eave plate” does not have “a front face forming a guide surface that guides rainwater downward” is included in the “vertical plate portion” of Element B2 is inconsistent with the above purpose of the invention at issue described in the description at issue) (judgment, p. 12, lines 5–8). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93501.pdf

Note: The content of this article provides general information and does not include legal advice.
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Tokyo District Court, 2023 (Wa) No. 70272 [Jig for a lifeline support post] <Presiding Judge Kokubu>

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Tokyo District Court, 2023 (Wa) No. 70272 [Jig for a lifeline support post] <Presiding Judge Kokubu>

* Non-fulfillment

1. Literal non-fulfillment
Element C: “A U-shaped bent portion formed at an end of a rectangular plate”
The “bent portion” of the invention at issue is construed as being bent at an end of the rectangular plate, but the hook portion of the defendant’s products is at an end of a side plate and is not continuous with the bottom plate (corresponding to the rectangular plate).
Element E: “Length of the rectangular plate > flange width”
The length of the bottom plate of the defendant’s products (100 mm) is not greater than the width of the flange to which it is attached (100 mm or 125 mm).

2. Equivalence not established
The portions differing between the invention at issue and the defendant’s products were held to constitute the essential part of the invention, which was not found in the prior art. The court held that the first requirement of equivalence was not satisfied and rejected infringement under the doctrine of equivalents without examining the remaining requirements.

Judgment note: Page 35 of the judgment states 「均等の第１要件を満たすとは認められない。」 (it cannot be found that the first requirement of equivalence is satisfied) and 「その余の要件を検討するまでもなく」 (without needing to examine the remaining requirements). That is, the court found the first requirement not satisfied and did not separately determine the second requirement. The original article refers to the second requirement; this is the original article’s explanation, rather than a determination made by the court. The term 「小型化」 (“reduced size”) in the original article does not appear in the judgment. On the counterclaim (Article 2(1)(xxi) of the Unfair Competition Prevention Act), the judgment granted the injunction and damages to the extent of 550,000 yen (judgment, p. 2, lines 3–9). The text in quotation marks for Elements C and E in the original article is a summary; in the judgment’s division into elements, Element C is 「前記矩形状の板の前記第１の方向の端部で上下方向に間隔を開けてＵ字状に折り曲げられた折り曲げ部とを含み、」 (and a bent portion bent into a U shape with a vertical interval at the end of the rectangular plate in the first direction,) (judgment, p. 5, lines 5–6), and Element E is 「前記矩形状の板の前記第１の方向端部より逆方向の端部までの長さは、前記治具が取付けられる形鋼のフランジの幅より長い、治具。」 (a jig wherein the length from the end of the rectangular plate in the first direction to the end in the opposite direction is longer than the width of the flange of the section steel to which the jig is attached) (judgment, p. 5, lines 9–10). Judgment, p. 35

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93577.pdf

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Tokyo District Court, 2023 (Wa) No. 70607 [Remotely controlled unmanned boat] <Presiding Judge Sugiura>

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Tokyo District Court, 2023 (Wa) No. 70607 [Remotely controlled unmanned boat] <Presiding Judge Sugiura>

★ Element J specifies a first control device that performs control to automatically return the boat to its initial position when at least one of the following determinations has been made: “no signal has been received from the remote control device for a specified period or longer” (Condition ①), or “the remaining power has been determined to be half or less” (Condition ②).

⇒ To solve the problem of the patented invention (preventing loss), a mechanism capable of dealing with both critical situations, “communication interruption” and “insufficient power,” must be provided.

⇒ Because the condition for the defendant’s products is “return when the remaining power is in the 20% range of the fully charged level, etc.,” the element is not fulfilled.

Judgment note: The defendant’s products return when a voltage below the lower-limit voltage (44 V by default; 49 V at most when set by ordinary methods) is detected for a certain period (judgment, p. 34, lines 4–11). The judgment found that, even with the upper limit of 49 V, the remaining charge at the start of return 「満充電時の電力量に対して 20%台にまで低下している」 (has fallen to the 20% range of the fully charged amount) (judgment, p. 37, line 25 – p. 38, line 3), and held Element J (first control device) not fulfilled. Infringement by equivalents was also denied as 「少なくとも均等の第５要件を欠き」 (lacking at least the fifth requirement of equivalence) (judgment, p. 40, lines 10–13). The text in quotation marks for Conditions ① and ② in the original article is a summary; the judgment organizes them as 「自動回帰発動条件①（「前記第１送受信アンテナにより一定時間以上前記遠隔操縦装置からの信号を受信しなかったと判断された場合」）、又は、同②（「前記電源の残量が半分以下になったと判断された場合」）」 (automatic return activation condition ① (“where it has been determined that no signal has been received from the remote control device via the first transmitting/receiving antenna for a specified period or longer”) or condition ② (“where it has been determined that the remaining power of the power source has become half or less”)) (judgment, p. 35, lines 9–11). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93590.pdf

Note: The content of this article provides general information and does not include legal advice.

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Tokyo District Court, 2023 (Wa) No. 70219 [Commercial transaction system] <Presiding Judge Sugiura>

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Tokyo District Court, 2023 (Wa) No. 70219 [Commercial transaction system] <Presiding Judge Sugiura>

Element D (“a step of acquiring advance customs clearance information, including information concerning customs duties, from a customs clearance authentication device”)
In the program at issue, the only item that can be called information concerning customs duties is the HS CODE, but this is information that, in principle, the seller is to input personally.
Although it is found that product information entered by executing the program at issue is examined by the authentication server and status information of “registration complete” is received, there is insufficient evidence to find that, apart from that status information, any information concerning customs duties is received.
According to the description at issue, “information concerning customs duties” is understood to mean customs duty rates and amounts and information for calculating customs duties (such as HS codes), whereas the status information “registration complete” itself cannot be called “information concerning customs duties.”
⇒ Non-fulfillment

Element E (the configuration concerning notification of advance customs clearance information; summary)
. The evidence does not necessarily make clear what specific information the program at issue sends to the e-commerce server (commercial transaction device).
 Even leaving that point aside, however, the program does not execute the step of acquiring advance customs clearance information and does not satisfy Element D, and therefore cannot be said to execute the step of notifying that information. ⇒ Element E is also not satisfied.

Judgment note: Regarding the HS CODE, the judgment states 「HS CODE は、出品者が自ら入力し、又は「システム推奨 HS CODE」を選択することとして、原則として出品者が入力すべき情報とされている。」 (the HS CODE is, in principle, information to be input by the seller, who either inputs it personally or selects a “system-recommended HS CODE”) (judgment, p. 27, lines 5–6). Regarding Element E, the judgment’s reason is that, because the program at issue cannot be said to cause execution of a step of acquiring advance customs clearance information and does not fulfill Element D, it also cannot be said to cause execution of a step of notifying the advance customs clearance information (judgment, p. 28, lines 9–12); the point that the content transmitted is not clear from the evidence is stated as 「その点を措くとしても」 (even setting that point aside) (judgment, p. 28, lines 13–14). Further, the text in quotation marks for Elements D and E in the original article is a summary; in the judgment’s division into elements, Element D is 「前記通関認証装置から、前記商品についての、関税に関する情報を含む事前通関情報を取得するステップと、」 (a step of acquiring, from the customs clearance authentication device, advance customs clearance information concerning the goods, including information concerning customs duties;) (judgment, p. 3, lines 1–2), and Element E is 「ユーザ端末と接続して電子商取引を実行する商取引装置に対し、当該商取引装置が前記商品情報とともに前記事前通関情報を前記ユーザ端末からアクセスされるサイトに掲載することができるように、前記事前通関情報を通知するステップと」 (a step of notifying a commercial transaction device that connects to user terminals and executes electronic commerce of the advance customs clearance information, so that the commercial transaction device can post the advance customs clearance information together with the product information on a site accessed from the user terminals; and) (judgment, p. 3, lines 3–5). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93576.pdf

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2023 (Gyo-Ke) No. 10144 [DC ultra-high-voltage power supply for a food electric-field treatment apparatus] <Presiding Judge Nakadaira>

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2023 (Gyo-Ke) No. 10144 [DC ultra-high-voltage power supply for a food electric-field treatment apparatus] <Presiding Judge Nakadaira>

References 1–4 added in the appeal decision were merely added as corroborating evidence to support that the technology was well known in various fields, in response to the plaintiff's disputing its well-known nature in a written opinion.
⇒ They did not establish a new reason for refusal, and it was therefore unnecessary to issue another notice of reasons for refusal.

A person skilled in the art of the claimed invention is familiar not only with common general technical knowledge concerning food electric-field treatment apparatuses, but also with technology in the technical field of "DC high-voltage power supplies," which are related components.
⇒ Regarding Difference 1 (supplying DC ultra-high voltage without using a high-voltage transformer), according to the statements in Cited Document 2, References 1–4 and other documents, the Cockcroft–Walton circuit is a well-known power supply circuit used in various fields requiring DC high voltage, including everyday electrical equipment. — Obvious
⇒ Regarding Difference 2 (connecting a high-resistance resistor between the high-voltage output terminal and the GND terminal), based on Cited Documents 2 and 3, the technique of connecting high and low resistances in series and measuring voltage through voltage division (a high-voltage measurement technique) is also well-known technology in high-voltage generators. — Obvious

⇒ Inventive step: ×

Judgment note: In the original article's statement concerning the person skilled in the art, the specification 「「直流高電圧電源装置」の技術分野」 (the technical field of "DC high-voltage power supplies") corresponds to a statement in the defendant's counterargument (judgment, p. 13, lines 3–8); the judgment states 「食品電場処理装置の技術分野の当業者は、食品電場処理装置に付随した各種部材についても、課題解決にあたり検討するものといえるから、食品電場処理装置に関連する部材に係る技術を知悉する者であるといえる。」 (a person skilled in the art in the technical field of food electric-field treatment apparatuses

can be said to consider, in solving problems, the various components accompanying food electric-field treatment apparatuses as well, and can therefore be said to be a person familiar with technology concerning components related to food electric-field treatment apparatuses) (judgment, p. 37, lines 7–10). Regarding Difference 1, the expression 「様々な分野で用いられる周知の電源回路」 (a well-known power supply circuit used in various fields) in the original article corresponds to the statement 「様々な分野において用いられる周知の電源回路」 (a well-known power supply circuit used in various fields) in the defendant's counterargument (judgment, p. 15, line 6), and the judgment, from the statements in Cited Document 2, Exhibit Otsu 5, Exhibit Otsu 6, Reference 1 and Reference 3, states 「直流高電圧を発生させるための電源回路として、コッククロフトウォルトン回路は周知技術であると認められる。」 (the Cockcroft–Walton circuit is found to be well-known technology as a power supply circuit for generating DC high voltage) (judgment, p. 34, line 16 – p. 35, line 14). Regarding Difference 2, the term 「高電圧測定手法」 (high-voltage measurement technique) was defined in the defendant's counterargument (judgment, p. 17, line 10), and the judgment states 「高電圧発生回路の出力に、高抵抗値の抵抗器と低抵抗値の抵抗器の直列回路を接続して出力電力を測定することは、高電圧を発生する装置における周知技術であると認められる。」 (connecting a series circuit of a high-resistance resistor and a low-resistance resistor to the output of a high-voltage generating circuit to measure the output power is found to be well-known technology in devices that generate high voltage) (judgment, p. 36, lines 8–10). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93471.pdf

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2024 (Ne) No. 10044 [Hair iron] <Presiding Judge Nakadaira>

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2024 (Ne) No. 10044 [Hair iron] <Presiding Judge Nakadaira>

* A case seeking procedures for registration of a transfer under Article 74(1) of the Patent Act against the appellee (defendant), the current patentee, on the ground that the right had been transferred by a person without authority to represent the company.
The court of first instance dismissed the appellant's claim by analogous application of Article 94(2) of the Civil Code.
⇒ Appeal dismissed (the original judgment was affirmed)

The appellant's true representative E was aware by around July, 2015 that B′ and others had become officers and that operations were in confusion, and was aware no later than November 29, 2016 that a false appearance existed that the right to obtain a patent had been transferred to C′.
Nevertheless, for approximately four years until 2021, E did not bring an action for confirmation of the nonexistence of the shareholders' meeting resolution or take similar steps. Even after the judgment recognizing the nonexistence of that resolution became final and binding in August, 2021, E took no action against C′ for approximately half a year until the patent right was transferred from C′ to the appellee's subsidiary.
⇒ The appellant bears serious culpability with respect to the creation, etc., of the false appearance, because it left that appearance unaddressed. The appellant's own internal circumstances and conduct also contributed to creation of the appearance. The appellee and the other relevant transferees were found to have acted in good faith and without negligence, and the claim was rejected through analogous application of Article 94(2) of the Civil Code.

Judgment note: Regarding the appellant's culpability, the judgment states, in addition to its leaving the false appearance unaddressed, 「そもそも、B'が本件譲渡契約①を締結し、C'が本件特許に係る特許を受ける権利を有しあるいは特許権者であるとの虚偽の外観を作出するに至ったのは、控訴人自身の内部事情や行為にその一因があるといえる。」 (in the first place, the fact that B′ concluded Assignment Agreement ① and that a false appearance came to be created that C′ held the right to obtain a patent for the patent at issue or was the patentee can be said to be partly attributable to the appellant's own internal circumstances and conduct) (judgment, p. 24, lines 10–13). The judgment also states, regarding the appellees, 「善意無過失であったと認めるのが相当である。」 (it is appropriate to find that they were in good faith and without negligence) (judgment, p. 26, line 7). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93473.pdf

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2023 (Gyo-Ke) No. 10139 [Gaming machine] <Presiding Judge Hibiku Shimizu>

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2023 (Gyo-Ke) No. 10139 [Gaming machine] <Presiding Judge Hibiku Shimizu>

Content of the invention: In “partial auto mode,” a button is deemed automatically pressed for presentations of low importance (first operation-request presentations), but important presentations relating to winning or losing (second operation-request presentations / win–loss branching) are excluded from automatic operation and left for the player to operate personally.

The cited document stated that “partial auto” could be selected as an “auto button” setting, and, for example, that “only during very high-expectation presentations, non-auto operation (where it is desired to have the player operate) may be selected.”
⇒ The amended claimed invention was held to lack inventive step, and dismissal of the amendment for failure to satisfy the independent patentability requirement was upheld. The unamended claimed invention was held to lack novelty because it was substantially identical to Cited Invention 2 and, in the alternative, to lack inventive step.

The Patent Act does not require notification of reasons for refusal when an amendment is dismissed for failure to satisfy the independent patentability requirement. Even assuming an exception from the standpoint of procedural safeguards, Cited Invention 2, indicated at the refusal decision stage, and Cited Invention 1, used in the appeal decision, were based on the same document (Exhibit Ko 1), had portions in common, and that document had already been cited in a notification of reasons for refusal. ⇒ There was no unfair surprise.

Judgment note: The judgment states that, as to Cited Inventions 1 and 2, 「その内容には共通の部分がある」 (their contents have parts in common) (judgment, p. 28, lines 1–3), and does not hold that their contents are substantially the same. The main reason for denying an unfair surprise is that, when an amendment is dismissed for violating the independent patentability requirement, 「拒絶の理由を通知することは要求されていない」 (notice of reasons for refusal is not required) (judgment, p. 27, lines 7–12); the point that they are based on the same document is a reason presented under 「仮に当事者の手続保障の観点から例外を認める場合でも」 (even if an exception were recognized from the viewpoint of procedural safeguards for the party) (judgment, p. 27, line 26 – p. 28, line 1). As for the claimed invention, the judgment held that it mainly falls under Article 29(1)(iii)

of the Patent Act (lack of novelty) and, in the alternative, that it lacks inventive step (judgment, p. 26, lines 14–18). Further, of the original article's 「激熱演出時（期待度の高い演出）のみ非オート（遊技者に操作させたい）にしてもよい」, the words 「（期待度の高い演出）」 (presentations with a high degree of expectation) are not the wording of Cited Document 1; the statement of Cited Document 1 cited in the judgment is 「激熱演出時のみ非オート（遊技者に操作させたい）にしてもよい」 (non-auto operation (where it is desired to have the player operate) may be selected only during very high-expectation presentations) (judgment, p. 22, lines 1–2). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93414.pdf

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Tokyo District Court, 2023 (Wa) No. 70619 [Device for measuring the difference in draft between both sides of a ship] <Presiding Judge Nakashima>

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Tokyo District Court, 2023 (Wa) No. 70619 [Device for measuring the difference in draft between both sides of a ship] <Presiding Judge Nakashima>

During employment, the plaintiff made an invention concerning a “device for measuring a ship’s draft difference (draft inspection).”
⇒ Nippon Steel filed an application on the basis that it had succeeded to the right to obtain a patent, but the refusal decision became final and no patent was obtained.

First lawsuit: The plaintiff sought confirmation against Nippon Steel of the right to obtain a patent, but the claim was dismissed because the invention was an employee invention and the right had been transferred to Technoresearch; the appeal was also dismissed. Second lawsuit: The plaintiff sought correction of the named inventors and confirmation of sole inventorship, among other relief. The action was dismissed in part as inadmissible and the claims were otherwise dismissed, including because the refusal decision had become final and the proceedings had ended, so correction could not be sought. The appeal was also dismissed.

⇒ Subsequently, the plaintiff filed an application individually and acquired a patent right (the patent at issue).

Third lawsuit: The plaintiff sought damages against Nippon Steel and the defendant for patent infringement. The first instance dismissed the claims, including because there was insufficient evidence that the inclination-measuring device fell within the technical scope of the corrected invention. The appellate court did not find use or sale of accused Device A after registration. Although accused Device B fell within the technical scope, the relevant patents had a

ground for invalidation under Article 123(1)(vi) of the Patent Act, so enforcement was denied under Article 104-3(1), and the appeal was dismissed.

Fourth lawsuit: Claim for compensation for an employee invention
⇒ The plaintiff lost because no benefit exceeding that from a non-exclusive licence was found to have accrued to the company.

The present lawsuit (the fifth): The plaintiff sued, asserting “I suffered loss because the company lied in the earlier litigation.” The company also counterclaimed, alleging that this was a “rehashing” and wrongful litigation.

<This judgment (the fifth)>
• The company is not found to have lied in court.
• The plaintiff paid the costs of maintaining the patent (such as annual fees) voluntarily, and these were not attributable to the company. • The claim for confirmation of ownership of the patent right in the main action was dismissed as inadmissible. The finding concerning an employee invention was stated for completeness after dismissal of that action.

★ Reasons for finding an “employee invention”
The company had been entrusted by Nippon Steel, a related company with “work to improve draft inspection (draft surveys),” and the invention was within the company’s scope of business.
The plaintiff purchased components at the company’s expense and performed tests in the capacity of an employee.

Note concerning the defendant company’s counterclaim
Although aspects of the plaintiff’s claims for confirmation and other relief conflict with earlier judgments, the earlier judgments merely involved matters such as “findings in the reasons of judgments in infringement litigation.”
⇒ The right of access to the courts is important, and the bringing of this action cannot be said to amount to an “unlawful act markedly lacking in reasonableness.”

Judgment note: With respect to the principal action, the judgment states 「特許権が原告に帰属することの確認を求める訴えを却下する。」 (the action seeking confirmation that the patent right belongs to the plaintiff is dismissed) (judgment, p. 1, lines 12–13). The application for the separate invention was filed by Nippon Steel (judgment, p. 3, lines 11–14), and the judgment describes 「株式会社日鐵テクノリサーチ」 (Nittetsu Techno Research Co., Ltd.), which was merged into the defendant, as 「関連会社」 (an affiliated company) of Nippon Steel (judgment, p. 2, lines 20–23). The second lawsuit ended in dismissal of the action and of the claims on grounds such as the refusal decision having become final (judgment, p. 4, lines 9–11), and the claim in the fourth lawsuit was dismissed on the ground that 「通常実施権を超える利益が被告に生じているとは認められない」 (no benefit exceeding that of a non-exclusive license is found to have accrued to the defendant) (judgment, p. 6, lines 13–15). As for the third lawsuit, the first-instance court 「別件発明に係る傾斜測定装置が本件訂正発明の技術的範囲に属することを認めるに足りないなどとして、請求棄却の判決を言い渡した」 (rendered a judgment dismissing the claim on grounds such as that it could not be found that the inclination measuring device relating to the separate invention fell within the technical scope of the

corrected invention at issue) (judgment, p. 5, lines 19–21), and it was the appellate judgment that held that the patent at issue had 「特許法１２３条１項６号に規定する無効理由があり」 (a ground for invalidation prescribed in Article 123(1)(vi) of the Patent Act) (judgment, p. 6, lines 4–5). Judgment

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93388.pdf

Note: The content of this article provides general information and does not include legal advice.

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[Trademark law ★] A case in which the court held that the designated services in Class 40, “rental of food waste processing machines; rental of chemical machinery and equipment,” of the trademark at issue consisting of the standard characters “ゴミサー” are similar to the cited designated goods in Class 7, “food waste processing machines; liquid fertilizer manufacturing apparatuses,” of the cited trademark consisting of the standard characters “ゴミサー” (falling under Article 4(1)(xi) of the Trademark Act), and rescinded the JPO trial decision dismissing the request for invalidation of the trademark registration at issue, which had held, among other things, that “rental of food waste processing machines” in Class 40 among the designated services at issue was not similar to “food waste processing machines” in Class 7 among the cited designated goods (not falling under Article 4(1)(xi) of the Trademark Act),

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Intellectual Property High Court judgment of December 1, 2025 (2024 (Gyo-Ke) No. 10056) (Presiding Judge Ken Nakadaira)

◆ Full text of the judgment

[Summary of the judgment]

1. Criteria for assessing similarity between designated services and designated goods for the purposes of Article 4(1)(xi) of the Trademark Act

Whether the designated goods of one trademark and the designated services of another trademark are similar should be determined by whether a relationship is found in which, because of circumstances such as those goods and services ordinarily being manufactured, sold or provided by the same business operator, use of identical or similar trademarks for those goods and services is likely to cause them to be mistaken for goods or services manufactured, sold or provided by the same business operator.

2. Actual trading circumstances concerning the sale and rental of goods, and similarity between the designated services at issue and the cited designated goods

At the time the decision to register the trademark at issue was made, actual trading circumstances are found in which manufacturers of construction machinery belonging to Class 7, the same class as the cited designated goods, or their affiliated companies engaged in rental as well as sales. In addition, among companies handling goods such as output equipment, including copying machines and printers, and office equipment, multiple companies list both the sale and rental of goods among their corporate purposes. It is ordinarily not particularly unexpected for a person who uses a trademark on machinery also to rent out that machinery; rather, it is within the range of what can be anticipated. Furthermore, consumers of the designated services at issue are persons who use food waste processing machines, and it is inferred that many consumers of the cited designated goods are also persons who use food waste processing machines; the consumers of both therefore overlap to a substantial extent.

Taking these circumstances into account, it can be said that there is a relationship in which use of identical or similar trademarks for the designated services at issue and the cited designated goods is likely to cause them to be mistaken for goods or services manufactured, sold or provided by the same business operator. Accordingly, the designated services at issue and the cited designated goods are found to be similar.

[Comments]

1. Regarding Point 1 of the Summary of the judgment

(1) Concerning similarity between goods and services prescribed in Articles 4(1)(xi), 37(i) and other provisions of the Trademark Act, Article 2(6) of that Act provides: “In this Act, the scope of things similar to goods may include services, and the scope of things similar to services may include goods.” As a confirmatory interpretative provision, it generally affirms the possibility of similarity between goods and services (Industrial Property System Revision Deliberation Office, General Affairs Division, General Affairs Department, Japan Patent Office, ed., Service Mark Registration System: Article-by-Article Commentary on the Amended Trademark Act (Yuhikaku, 1992), p. 41).

(2) As for the criteria for assessing such similarity between goods and services, according to the commentary of the Japan Patent Office, which administers the Trademark Act, it is appropriate to adopt the confusion theory rather than the

attributes theory, in the same manner as the precedent on the criteria for assessing similarity of goods under Article 2(1)(ix) of the former Trademark Act, which held that "whether designated goods are similar should not be determined, as the original judgment did, by whether the goods themselves are likely to be mistaken for or confused with each other in trade; rather, where, because of circumstances such as those goods ordinarily being manufactured or sold by the same business operator, there is a relationship in which use of identical or similar trademarks on those goods is likely to cause them to be mistaken for goods manufactured or sold by the same business operator, even if the goods themselves are not likely to be mistaken for or confused with each other, it is appropriate to construe those trademarks as falling within similar goods referred to in Article 2(ix) of the Trademark Act (Act No. 99 of Taisho 10)" (underlining added by the author; the same applies below) (Supreme Court judgment of June 27, 1961, Minshu Vol. 15, No. 6, p. 1730 [Tachibana Masamune case]) (Industrial Property System Revision Deliberation Office, General Affairs Division, General Affairs Department, Japan Patent Office, ed., Service Mark Registration System: Article-by-Article Commentary on the Amended Trademark Act (Yuhikaku, 1992), p. 39). Not only trademark examination practice concerning Article 4(1)(xi) of the Trademark Act (Trademark Examination Guidelines [16th revised edition], "Part 3," "X. Article 4(1)(xi) (Another person's registered trademark pertaining to an earlier application)," p. 20), but also numerous court decisions, including those concerning Article 37(i) of the Trademark Act, adopt the same view (Tokyo District Court judgment of April 28, 1999, Hanrei Jiho No. 1691, p. 136 [Virus Buster case]; Tokyo District Court judgment of October 21, 1999, Hanrei Times No. 1019, p. 250, affirmed by the Tokyo High Court judgment of September 28, 2000, Hanrei Times No. 1056, p. 275 [Village Hakusan case]; Osaka District Court judgment of June 30, 2011, Hanrei Jiho No. 2139, p. 92, affirmed by the Osaka High Court judgment of March 7, 2013 (2011 (Ne) No. 2238), courts' website [Mon Chouchou case]; Intellectual Property High Court judgment of November 11, 2024 (2024 (Gyo-Ke) No. 10028), courts' website [AWG treatment case]; and others).

In this respect, Point 1 of the Summary of the judgment likewise states the same view concerning the criteria for assessing similarity between designated services and designated goods for the purposes of Article 4(1)(xi) of the Trademark Act.

(3) More specifically, regarding the criteria for assessing such similarity between goods and services, trademark examination practice states: "In determining similarity between goods and services, for example, the following criteria shall be

considered comprehensively and a specific determination shall be made in each case. In this case, in principle, the Examination Guidelines for Similar Goods and Services shall be followed. ① Whether the manufacture and sale of the goods and the provision of the services are generally conducted by the same business operator; ② whether the uses of the goods and services coincide; ③ whether the places where the goods are sold and the services are provided coincide; ④ whether the range of consumers coincides" (Trademark Examination Guidelines [16th revised edition], "Part 3," "X. Article 4(1)(xi) (Another person's registered trademark pertaining to an earlier application)," p. 21). It also states that "goods and services assigned the same similar group code are presumed similar in examination," and that, even for goods and services assigned different similar group codes, where the remarks column states that they are "presumed similar," although cross-searching is not conducted in principle during examination, it is conducted to the extent possible when information is provided or in similar circumstances (Examination Guidelines for Similar Goods and Services [corresponding to the 12th edition of the International Classification, version 2024], "1-7" and "1-11").

On the other hand, in numerous court decisions (Tokyo District Court judgment of October 21, 1999, Hanrei Times No. 1019, p. 250, affirmed by the Tokyo High Court judgment of September 28, 2000, Hanrei Times No. 1056, p. 275 [Village Hakusan case]; Osaka District Court judgment of June 30, 2011, Hanrei Jiho No. 2139, p. 92, affirmed by the Osaka High Court judgment of March 7, 2013 (2011 (Ne) No. 2238), courts' website [Mon Chouchou case]; Intellectual Property High Court judgment of November 11, 2024 (2024 (Gyo-Ke) No. 10028), courts' website [AWG treatment case]; and others), as a starting point, in principle, irrespective of the above similar group codes and the like, a specific determination is made in each case by comprehensively considering factors similar to factors ①–④ in the Trademark Examination Guidelines. Particularly in recent years, an approach can be seen that somewhat relaxes those factors ①–④ to "the existence and degree of actual circumstances in which the manufacture and sale of goods and the provision of services are conducted by the same business operator, commonality in the uses of goods and services, identity of the places where goods are sold and services are provided, the extent of overlap between consumers of goods and services, and the like" (Intellectual Property High Court judgment of November 11, 2024 (2024 (Gyo-Ke) No. 10028), courts' website [AWG treatment case]; and others).

In this respect, although Point 1 of the Summary of the judgment itself does not state this directly and expressly, in light of the facts found in the application of the criteria in Point 2 of the Summary of the judgment, this judgment is understood as having made a specific determination in this case by comprehensively considering factors similar to factors ①–④ of the Trademark Examination Guidelines.

2. Regarding Point 2 of the Summary of the judgment

According to the Examination Guidelines for Similar Goods and Services and other sources, the designated services at issue in Class 40, "rental of food waste processing machines; rental of chemical machinery and equipment," and the cited designated goods in Class 7, "food waste processing machines; liquid fertilizer manufacturing apparatuses," are assigned different similar group codes: "40J09" and "40J10" for the former, and "09G63" and "11A06," and "09A06" for the latter, and the remarks column does not state that they are "presumed similar." Nevertheless, in applying the criteria, Point 2 of the Summary of the judgment affirmed similarity between the designated services at issue and the cited designated goods, unlike the trial decision at issue.

In this respect, whereas the trial decision at issue, in the absence of sufficient allegations and proof by the petitioner (plaintiff) and others, denied similarity between the designated services at issue and the cited designated goods by strictly and restrictively considering factors ①–④ above while considering only general and constant actual trading circumstances relating solely to the designated services at issue and the cited designated goods, Point 2 of the Summary of the judgment is understood as having affirmed similarity between the designated services at issue and the cited designated goods, following supplementation of the allegations and proof by the plaintiff (petitioner) and others, by considering factors ①–④ in a relaxed and expansive manner while also considering individual and specific actual trading circumstances concerning services and goods surrounding and related to the designated services at issue and the cited designated goods, including not only construction machinery but also output equipment such as copying machines and printers and office equipment.

Together with the Intellectual Property High Court judgment of November 11, 2024 (2024 (Gyo-Ke) No. 10028), courts' website [AWG treatment case], which generally affirmed similarity between the designated services in that other case in Class 44, "rental of medical machinery and equipment," and the cited

designated goods in Class 10, “medical machinery and equipment (excluding ‘walking aids and crutches’),” and the like, which likewise had different similar group codes and no statement in the remarks column that they were “presumed similar,” Point 2 of the Summary of the judgment may be thought to influence future decisions toward more broadly affirming similarity between machinery and equipment and their rental, where rental or leasing readily intervenes in trading in the goods, including medical machinery and equipment, construction machinery, output equipment such as copying machines and printers, and office equipment —items that are often expensive, used for short periods, subject to rapid technological development, and complex to maintain and manage.

[Excerpts from the judgment]

1. Criteria for assessing similarity between designated services and designated goods for the purposes of Article 4(1)(xi) of the Trademark Act

“Whether the designated goods of one trademark and the designated services of another trademark are similar should be determined by whether a relationship is found in which, because of circumstances such as those goods and services ordinarily being manufactured, sold or provided by the same business operator, use of identical or similar trademarks for those goods and services is likely to cause them to be mistaken for goods or services manufactured, sold or provided by the same business operator (see Supreme Court, 1958 (O) No. 1104, Third Petty Bench judgment of June 27, 1961, Minshu Vol. 15, No. 6, p. 1730).”

2. Actual trading circumstances concerning the sale and rental of goods, and similarity between the designated services at issue and the cited designated goods

“There are actual trading circumstances in which manufacturers of construction machinery belonging to Class 7, the same class as the cited designated goods, or their affiliated companies engage in rental as well as sales. In addition, among companies handling goods such as output equipment, including copying machines and printers, and office equipment, multiple companies list both the sale and rental of goods among their corporate purposes (Exhibits Ko 72–74; the defendant’s corporate purposes also include ‘manufacture, sale and rental of industrial machinery and equipment’ [the entire purport of the oral argument]). It is ordinarily not particularly unexpected for a person who uses a trademark on machinery also to rent out that machinery; rather, it is within the range of what can be anticipated. Furthermore, consumers of the designated services at issue are persons who use food waste processing machines, and it is inferred that

many consumers of the cited designated goods are also persons who use food waste processing machines; the consumers of both therefore overlap to a substantial extent.

Taking these circumstances into account, it can be said that there is a relationship in which use of identical or similar trademarks for the designated services at issue and the cited designated goods is likely to cause them to be mistaken for goods or services manufactured, sold or provided by the same business operator. Accordingly, the designated services at issue and the cited designated goods are found to be similar."

Judgment note: Item 1 of the [Excerpts from the judgment] is taken from the judgment, p. 15, lines 1–7, and Item 2 from the judgment, p. 17, lines 5–21; Item 2 omits the opening words 「以上のとおり、」 (as stated above). Judgment

[Keywords] Article 4(1)(xi) of the Trademark Act; similarity between goods and services; sale and rental of goods; actual trading circumstances; ゴミサー

Note: The content of this article provides general information and does not include legal advice.

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Legal Update May 2026

Scope: The 27 articles dated May 1–31, 2026 in Nakamura & Partners' Legal Updates and Hideki Takaishi's IP Updates.

Articles included: 27

Authors: Hideki Takaishi (26 articles); Kei Iida (the article published on May 27).

Article indexes: Legal Updates / Hideki Takaishi's IP Updates

This Month's Highlights May 2026 Intellectual Property and Legal Updates

This month covers 27 articles published in May 2026. The articles focus on identifying the subject matter protected and the scope of rights, including the copyrightability of mass-produced utilitarian articles, similarity of composite trademarks, video takedown requests, trade secrets, and patent term extensions. Articles on both the first-instance and appellate judgments in the same dispute also appear, inviting attention to the assessment of the facts underlying the conclusions.

1 Copyrightability of mass-produced utilitarian articles and the essential part of a design

The article on the Supreme Court judgment of April 24, 2026 introduces the standard of whether the shape of a children's chair can be perceived, conceptually and separately from its function-derived configuration, as a creative expression, and the application of that standard. Copyrightability of the chair was denied. Kei Iida's commentary examines the relationship with the previous separability theory and the omission of the purpose of creation and the term "aesthetic appreciation" from the standard. In the design field, Osaka District Court, 2023 (Wa) 10125, "Container for a Liquid Soap Dispenser," identified the specific rear shape as the essential part in light of use by attachment to a wall. The article indicates the need to compare the parts consumers examine when checking functionality, as well as the front appearance.

2 Separate observation of composite trademarks and differences in notation

Articles on both Osaka District Court, 2024 (Wa) 5007, and Osaka High Court, 2025 (Ne) 1750, concerning "Koi Ichigo," were published in the same month. The first-instance court regarded "awa" as an indication of origin and extracted "koi ichigo," whereas the appellate court understood the sign as a combination of "awa koi" and "ichigo," rejected separate observation, and found dissimilarity. Even when packaging and actual trading circumstances are considered, the conclusion may differ according to which portions are understood as a unit. The "VALENTINO" case permitted extraction and comparison because the famous lettering created a strong and dominant impression. In "Paku to Mogu," however, "パクモグ" was found similar and "PAKUMOGU" dissimilar. The article on Appeal 2024-18950 likewise reports that the decision found "ViCREA" and "BICREA" dissimilar on the basis of differences in appearance despite identical pronunciation, illustrating the need to examine the assessment of each element.

3 Circumstances of trademark acquisition and proof of distinctiveness

The "LEADER／リーダー" and "MYOFOCUS" cases offer a comparison of public order and morality assessments. The former set aside the invalidation decision in light of the acquisition from the lawful right holder and other circumstances; the latter found misappropriation based on close similarity down to details, the timing of filing and other circumstances, and, considering the issue date of the revenue stamp on the submitted receipt and the circumstances of its production, did not find that the related plaintiff's mark had been created in October 2015. The circumstances of acquisition and subsequent use of a trademark are examined separately. 2024 (Gyo-Ke) 10048, concerning a three-dimensional trademark, denied distinctiveness of a shape related to the product's function or aesthetics and found the sales record and survey results insufficient to establish acquired distinctiveness. In "Pon-chan," recognition within the city was distinguished from recognition outside it, raising the relationship between the geographic extent of recognition and the evidence.

4 Video takedown requests and permission to use works

Tokyo District Court, 2023 (Wa) 70125, did not regard notices requesting video removal and other measures as tortious, in part because they had reasonable factual grounds and were not found to have been abused for an improper purpose. In the Osaka High Court article concerning shogi game-record information, it was the video distribution using information obtained from paid distribution that was held tortious; the takedown requests directed against it were not held improper. Osaka High Court, 2024 (Ne) 1431, concerning a film screenplay, found acceptance of changes from consent to the co-screenwriter's participation and cooperation with revisions. 2024 (Ne) 10017, concerning programs, also found implied permission for reuse and modification while recognizing infringement of the right of attribution, requiring separate consideration of the acts of use and the individual moral rights.

5 Management of customer information and the substance of contractual wording

Osaka District Court, 2023 (Wa) 5749, denied secret management in light of circumstances including access to customer information by all employees using a shared ID and password. It also examined price differences and prospects of concluding contracts when considering causation for the failure to obtain orders. In the non-compete case, Osaka District Court, 2023 (Wa) 9115, the prohibition encompassed areas measured from establishments with which the employee had no involvement, and a restrictive interpretation was also rejected. Tokyo District Court, 2023 (Wa) 70680, recognized a personal joint and several guarantee from the memorandum's promise to make "the maximum possible payment" and the circumstances of its preparation. Actual information management, the objects of restrictions, and the identity of the payer are not determined solely by formal labels.

6 Scope of patent rights and preparation for use inventions

Osaka District Court Orders, 2025 (Yo) 20008 and 20009, examine the relationship between a later extension registration based on approval of a 12 μg formulation and a 24 μg formulation for which the earlier extended term had expired. The reasoning centers on harmonizing the scope and units of extension registration with the scope of the right's effect. In "Clothing," construction of the manner of joining the lifeline passage and motivation to apply ordinary garment technology to clothing for a special use were decided separately. "Bone Anchor with Improved Fixation Strength" focuses on adopting a well-known eyelet, while "Bag Processing Machine" focuses on identifying the earlier application's processes and waiting state. The introduction to Nobuhiro Tago's "Patent Protection for Food Use Inventions at the European Patent Office" recommends distinguishing embodiments and target groups for medical and non-medical uses in the application as filed.

Three-Point Summaries of All Articles

Category	Article title and three-point summary
Copyright	**【Copyright Law ★★★】 A precedent holding that, where the shapes and other features of all or part of a mass-produced utilitarian article can be perceived, conceptually and separately from the configuration derived from its function, as a creative expression of thoughts or sentiments, all or part of that article falls within the artistic domain among the works referred to in Article 2(1)(i) of the Copyright Act, affirming the lower court's denial of copyrightability of the plaintiff's products shown below, and dismissing the appeal** ① The issue was whether the shape of a mass-produced children's chair constituted an artistic work. ② The Supreme Court applied the test of whether creative expression could be perceived conceptually and separately from the function-derived configuration, denied copyrightability, and dismissed the appeal. ③ It is necessary to examine separable creative expression, rather than merely the aesthetic impression of a product's shape.
Design	**【Design】 Osaka District Court, 2023 (Wa) 10125, "Container for a Liquid Soap Dispenser" case ＜Presiding Judge Matsuami＞** ① The essential part of a design and similarity to the defendant's product were disputed for a wall-mounted liquid soap dispenser container. ② The court identified the specific rear shape attracting consumers' attention as essential and denied similarity and a utilization relationship because of differences in the magnets and other features. ③ Design comparison requires examination of the parts consumers observe in light of use and of differences in their specific shapes.
Copyright	**【Copyright】 Tokyo District Court, 2023 (Wa) 70125 ＜Presiding Judge Takahashi＞** ① The issue was whether notices alleging copyright and other infringements by videos constituted a tort interfering with the uploader's expressive activities. ② The court denied a tort in light of the review of removal requests, the notices' factual grounds, and the absence of abuse for an improper purpose. ③ The legality of a takedown request is examined in light of its grounds, purpose, and the platform's review system, as well as the form used.
IP General	**【Unfair Competition Prevention Act / Non-Compete】 Osaka District Court, 2023 (Wa) 9115 ＜Presiding Judge Matsuami＞** ① The validity of a clause prohibiting competing businesses within two kilometers of the corporation's establishments during employment and for six months thereafter was disputed. ② The court held the clause invalid as excessively restricting occupational freedom by covering unrelated establishments and also rejected a restrictive interpretation. ③ Non-compete clauses require specific consideration of the employee's relationship to the establishments, geographic scope, and compensatory measures.
IP General	**【Contract】 Tokyo District Court, 2023 (Wa) 70680 【Method for Screening Inhibitors of Phosphorylation of Telomerase Reverse Transcriptase】 ＜Presiding Judge Nakashima＞** ① The issue was whether a memorandum concerning an unpaid lump sum established a personal joint and several guarantee by the company representative. ② The court found an agreement to guarantee jointly and severally from the individual identity of the promisor, the wording, and the circumstances of preparation. ③ Even without the word "guarantee," the payer's identity and the performance promised upon the principal debtor's default may establish a guarantee.
Copyright	**【Copyright】 Osaka District Court, 2023 (Wa) 11871, "Method of Diagnostic Imaging Based on Relativization through Comparison" ＜Presiding Judge Matsuami＞** ① Ownership of copyright and other rights in a paper, flowcharts, screen layouts, and a diagnostic imaging system was disputed. ② The court recognized the plaintiff's rights in the paper, denied copyrightability of the flowcharts and layouts, and held that, even if the system were a copyright work, its author would be Hitachi Software or the defendant that commissioned it, and not the plaintiff. ③ Ideas, creative expression, and the identity of the actual system developer must be distinguished when determining ownership.

Category	Article title and three-point summary
IP General	**【Unfair Competition Prevention Act / Trade Secrets】 Osaka District Court, 2023 (Wa) 5749 ＜Presiding Judge Takemiya＞** ① Liability for former employees' acquisition and use of customer information, competition, and deletion of information was disputed. ② The court denied secret management given access by all employees with shared credentials and did not recognize causation for lost orders. ③ The actual secrecy measures and whether orders would have been obtained absent the competition each require proof.
Foreign	**【Paper / European Patents】 Patent Protection for Food Use Inventions at the European Patent Office (Nobuhiro Tago, Patent, September 2025)** ① This article introduces a paper on medical and non-medical food use inventions and obtaining protection at the European Patent Office. ② It organizes relevant Board of Appeal decisions, points for drafting specifications, and enforcement of use inventions in Germany. ③ The article recommends distinguishing medical and non-medical embodiments, examples, and target groups from the filing stage.
Trademark	**【Trademark】 Tokyo District Court, 2022 (Wa) 11316, "Paku to Mogu" ＜Presiding Judge Kokubu＞** ① Similarity of "パクとモグ" to the defendant's katakana and alphabetic signs, and damages, were disputed. ② The court found "パクモグ" similar and "PAKUMOGU" dissimilar and set a royalty rate of 1%, considering user numbers after removal of the sign and other circumstances. ③ Differences between katakana and alphabetic notation and trading circumstances can affect similarity, while the sign's contribution also matters for damages.
Trademark	**【Trademark (Violation of Public Order and Morality)】 Intellectual Property High Court, 2024 (Gyo-Ke) 10079 ＜Presiding Judge Honda＞** ① The issue was whether a former distributor's acquisition of "LEADER／リーダー" trademark rights violated public order and morality. ② The court denied such a violation and set aside the invalidation decision, considering acquisition from the lawful holder after the contractual relationship had ended. ③ Assessment of acquisition circumstances is distinct from remedies for confusing use after acquisition.
Copyright	**【Authors' Moral Rights】 Osaka High Court, 2024 (Ne) 1431 ＜Presiding Judge Morisaki＞** ① The issue was whether additions and revisions by a co-screenwriter infringed the right of integrity. ② The appellate court found acceptance of changes from consent to participation and cooperation with revisions and reversed the first-instance judgment, dismissing the claim. ③ Consent to participation, responses to revisions, and authority to decide the final script affect permission and liability in joint creation.
Trademark	**【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10089, "VALENTINO" case ＜Presiding Judge Miyasaka＞** ① Similarity between a trademark consisting of "GIANNI VALENTINO" and a figure and the cited trademark was disputed. ② The court permitted extraction of the famous "VALENTINO" portion because of its strong and dominant impression and found Article 4(1)(xi) of the Trademark Act applicable. ③ The fame of part of a composite mark may affect whether that part is extracted as its essential portion.
Trademark	**【Trademark Act】 Intellectual Property High Court, 2024 (Gyo-Ke) 10090, "Pon-chan" case** ① The issue was whether Tatebayashi City's mascot "Pon-chan" was a famous sign under Article 4(1)(vi) of the Trademark Act. ② The court required recognition across an appropriately sized geographic area in light of its regional nature and set aside the refusal decision because use outside the city was limited. ③ Recognition within a locality must be distinguished from its spread to surrounding areas when examining use and media exposure.

Category	Article title and three-point summary
Trademark	**【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10072 ＜Presiding Judge Nakadaira＞** ① The issue was whether emails to trading partners concerning “INTUITION” established trademark use sufficient to avoid cancellation for non-use. ② The court recognized transmission of product ledgers and materials as use and set aside the decision because lettering size and line breaks caused “INTUITION” to be recognized as a product name. ③ Evidence of use requires attention to materials sent to customers and how product names and model numbers are displayed.
Copyright	**【Copyright】 Intellectual Property High Court, 2024 (Ne) 10065 ＜Presiding Judge Miyasaka＞** ① Copyright and related infringement and the need for an injunction were disputed over photographs with mosaic processing and overlaid illustrations. ② The court found infringement because essential expressive features remained perceptible and found a risk of renewed infringement from continued retention of the data and other circumstances. ③ It is necessary to assess the original photograph’s remaining essential features and the risk of reuse indicated by data retention.
Trademark	**【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10048 ＜Presiding Judge Hibiku Shimizu＞** ① Inherent and acquired distinctiveness of a three-dimensional continuous glucose monitor shape were disputed. ② The court denied distinctiveness as a predictable functional or aesthetic shape and did not find acquisition from sales, combined use with a word mark, or survey results. ③ Proof of the shape’s own source-identifying capacity requires consideration of the word mark’s influence and the survey population.
IP General	**【Unfair Competition Prevention Act / Circulation or Communication of False Facts】 Osaka High Court, 2024 (Ne) 338 ＜Presiding Judge Morisaki＞** ① The legality of distributing real-time shogi game-record information obtained from paid distribution and of takedown requests against that distribution was disputed. ② The court held the video distribution tortious as exceeding free competition, found its business interests unprotected, and did not find the takedown requests improper. ③ Copyrightability of game records must be distinguished from business-interest infringement through information use and the evaluation of takedown requests.
Trademark	**【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10067, “MYOFOCUS” = 2024 (Gyo-Ke) 10068** ① The issue was whether acquiring Japanese marks closely resembling a foreign business’s “MYOFOCUS” marks violated public order and morality. ② The court found misappropriation based on detailed similarities and filing circumstances. Considering the issue date of the revenue stamp on the submitted receipt and the circumstances of its production, the court also assessed the credibility of the plaintiff’s assertions and evidence as low and did not find that the related plaintiff’s mark had been created in October 2015. ③ Details of signs, acquisition timing, and authenticity of evidence supporting independent creation affect the legality of trademark acquisition.
Copyright	**【Copyright】 Intellectual Property High Court, 2024 (Ne) 10017 ＜Presiding Judge Honda＞** ① Copyrightability of delivered programs, permission for reuse and modification, and infringement of attribution rights were disputed. ② The court recognized copyrightability and implied permission for reuse and modification but also found infringement of attribution rights concerning a creator’s name displayed at startup. ③ The scope of permission and attribution rights are examined separately in light of delivery, prior use, and display to customers.
Trademark	**【Trademark】 Appeal 2024-18950** ① This article introduces a decision on similarity between standard-character “ViCREA” and the figurative cited mark “BICREA.” ② According to the article, despite identical pronunciation as “Bikurea,” the marks were held dissimilar because their appearances differed markedly and were distinguishable. ③ Similarity requires consideration of appearance and concept as well as identical pronunciation.

Category	Article title and three-point summary
Patent	**Osaka District Court Orders, 2025 (Yo) 20008 and 20009 【Prostaglandin Derivatives for the Treatment of Abdominal Discomfort】** ① The issue was whether an extension based on approval of a 12 μg formulation also covered a 24 μg formulation whose earlier extended term had expired. ② The court emphasized harmony with the scope and units of extension registration and held that the later extension did not cover products identical to the subject of the earlier regulatory disposition and certain other products. ③ Multiple extensions require matching the ingredients and quantities of each approval with expiry of earlier extensions when examining scope.
Trademark	**【Trademark】 Appeal 2025-416** ① This article introduces a decision on similarity between standard-character “百香” and the cited mark “MOMOCA.” ② According to the article, the marks were held dissimilar in light of “ka” as the Roman-letter spelling of カ, distinguishable appearance, and differences in concept. ③ The concluding question about “CA” is the author’s interrogative comment and does not guarantee registrability generally.
Trademark	**Osaka High Court, 2025 (Ne) 1750 【Koi Ichigo】 ＜Presiding Judge Morisaki＞** ① This appeal disputed the first-instance assessment of similarity between “恋　苺” and “あわ恋いちご.” ② The appellate court rejected separating “awa” from “koi ichigo” and reversed on the basis of differences in appearance, pronunciation, and concept. ③ Even a sign containing a place name requires consideration of whether it is understood as a unit in light of other wording, packaging, and trading circumstances.
Trademark	**【Trademark】 Osaka District Court, 2024 (Wa) 5007, “Awa Koi Ichigo” ＜Presiding Judge Matsukawa＞** ① The first-instance case concerned extracting “koi ichigo” from “awa koi ichigo” and the defense of use of a registered trademark. ② The first-instance court found similarity by treating “awa” as geographic origin and rejected the registered-mark-use defense, but the appellate court reversed. ③ Use of the first-instance reasoning requires checking the appellate article published in the same month and the changed assessment of separate observation.
Patent	**Tokyo District Court, 2019 (Wa) 32779 【Clothing】 ＜Presiding Judge Kokubu＞** ① Satisfaction of the lifeline-passage joining limitation and alleged lack of inventive step based on ordinary garment technology were disputed. ② The court found satisfaction without limiting the joining manner and denied motivation to apply ordinary pocket technology to special-purpose clothing. ③ The joining structure required by the claim and motivation to apply prior technology each require specific examination.
Patent	**Intellectual Property High Court, 2023 (Gyo-Ke) 10062 【Bone Anchor with Improved Fixation Strength】 ＜Presiding Judge Shoji＞** ① Construction of the bone anchor’s outer surface, channels, and ribs and inventive step of providing an eyelet were disputed. ② The court regarded the outer surface as the circumference joining the rib tips and denied inventive step because adopting and placing a well-known eyelet was obvious. ③ Correspondence between prior-art parts and claim terms, and whether a “preferred” feature is indispensable, require attention.
Patent	**Intellectual Property High Court, 2023 (Gyo-Ke) 10092 【Bag Processing Machine】 ＜Presiding Judge Honda＞** ① The issue was whether transport-speed control and a bag waiting state in an earlier application differed from the claimed bag processing machine. ② The court recognized current control using electromagnetic coils as presupposed and upstream waiting as “stock,” finding a violation of Article 29-2 of the Patent Act. ③ The earlier application’s text and process timing must be examined to identify disclosure of the control method and waiting state.

【Copyright Law ★★★】 A precedent holding that, where the shapes and other features of all or part of a mass-produced utilitarian article can be perceived, conceptually and separately from the configuration derived from its function, as a creative expression of thoughts or sentiments, all or part of that article falls within the artistic domain among the works referred to in Article 2(1)(i) of the Copyright Act, affirming the lower court's denial of copyrightability of the plaintiff's products shown below, and dismissing the appeal

Source article: Nakamura & Partners

Publication date: May 27, 2026

Judgment date: April 24, 2026 Judgment

Supreme Court judgment of April 24, 2026 (2025 (Ju) No. 356) (Presiding Judge Kazumi Okamura)

◆ Full text of the judgment

	Plaintiff's products		
			

【Summary of the Judgment】

1. Standard for determining copyrightability of mass-produced utilitarian articles

Where the shapes and other features of all or part of a mass-produced utilitarian article can be perceived, conceptually and separately from the configuration derived from its function, as a creative expression of thoughts or sentiments, all or part of that mass-produced utilitarian article falls within the artistic domain among the works referred to in Article 2(1)(i) of the Copyright Act.

2. Copyrightability of the plaintiff's products

The chair in question is a mass-produced utilitarian article. Its having two legs rising from the floor in an approximately L-shaped form at an angle of approximately 66 degrees, with a seat board and footrest board fixed between the two legs parallel to the floor, is merely a circumstance supporting the proposition that the shape resulting from the arrangement of the legs, seat board, and footrest board, which are configurations derived from the function as a children's chair, gives rise to an aesthetic impression. The shapes and other features of all or part of the chair can only be perceived as configurations derived from its function as a children's chair and cannot be perceived, separately from those configurations, as a creative expression of thoughts or sentiments. Accordingly, the chair cannot be said to constitute a work.

【Comments】

1. Regarding point 1 of the summary of the judgment

In recent years, concerning the standard for determining copyrightability of so-called applied art, Intellectual Property High Court precedents have seen the coexistence of the separability theory (Intellectual Property High Court judgment of August 28, 2014, Hanrei Jiho No. 2238, p. 91 [Fashion Show case]) and the unrestricted theory (Intellectual Property High Court judgment of April 14, 2015, Hanrei Jiho No. 2267, p. 91 [TRIPP TRAPP II case]), both differing from the theory imposing heightened requirements based on a staged approach found in many earlier lower-court precedents. Subsequently, the separability theory became predominant in many lower-court precedents, particularly those of the Tokyo District Court. There was also an Intellectual Property High Court precedent understood as adopting the separability theory as a question of whether the subject matter was “a creative expression of thoughts or sentiments” under the first part of Article 2(1)(i) of the Copyright Act (Intellectual Property High Court judgment of December 8, 2021, 2021 (Ne) 10044, Courts website [Octopus Slide case]). However, the judgment below (Intellectual Property High Court judgment of September 25, 2024, 2023 (Ne) 10111, Courts website [TRIPP TRAPP III case]), like another Intellectual Property High Court precedent (Intellectual Property High Court judgment of June 29, 2021, 2021 (Ne) 10024, Courts website [Good Core case]), was understood as adopting the separability theory as a question of whether the subject matter “falls within the … artistic … domain” under the latter part of that item, while using whether it “is an independent object of aesthetic appreciation” as the standard for separability. The judgment below also stated a separate standard that did not address separability but asked whether the purpose of creation was “exclusively for aesthetic appreciation.”

In contrast, point 1 of the summary is understood, regarding the standard for determining copyrightability of mass-produced utilitarian articles, as adopting only the separability theory as a question of whether the subject matter “falls within the … artistic … domain” under the latter part of Article 2(1)(i) of the Copyright Act, without adopting a standard asking whether the purpose of creation was “exclusively for aesthetic appreciation.” Furthermore, it is understood as using whether the subject matter “can be perceived … conceptually and separately from the configuration derived from its function,” rather than whether it “is an independent object of aesthetic appreciation,” as the standard for separability.

These features of point 1 of the summary may be better understood through Justice Akira Ojima’s supplementary opinion, which states that “the opinion of the Court … determined whether, with respect to mass-produced utilitarian articles, their shapes and other features, for which design registration can be obtained, also separately constitute works falling within the artistic domain”; that “the opinion of the Court also indicates a standard delineating the respective areas of application of the Copyright Act and the Design Act to mass-produced utilitarian articles, taking into account their respective subject matter, purposes of protection, requirements and procedures for protection, content of rights and their duration, and other matters, from the perspective of what subject matter our intellectual property legal system has legislatively chosen to protect and how”; and that “the opinion of the Court … does not use the term ‘aesthetic appreciation.’ The intention is that … the term ‘aesthetic appreciation’ may give rise to the mistaken impression that a high degree of creativity or artistry is necessary, and, in the first place, it appears inappropriate for a court to determine whether something merits appreciation as aesthetic art.”

2. Regarding point 2 of the summary of the judgment

Point 2 of the summary applies the standard for copyrightability of mass-produced utilitarian articles in point 1 to the plaintiff’s products and denies their copyrightability. In this respect, as Justice Akira Ojima’s supplementary opinion states, “the … requirement stated in the opinion of the Court is also highly abstract, but, just as the opinion of the Court applies it to the chair in this case, accumulation of various cases will be expected in the future concerning the concrete application of that requirement.”

【Excerpts from the Judgment】

1. Standard for determining copyrightability of mass-produced utilitarian articles

“With regard to mass-produced utilitarian articles, it is inappropriate to adopt an interpretation under which, if their shapes and other features can be said to be creative expressions of thoughts or sentiments, they immediately constitute works as falling within the artistic domain.” “That is, … in light of the requirements for creation of rights, their content and duration, and other matters under Japan’s Design Act and Copyright Act, if

the above interpretation were adopted and broad protection under the Copyright Act in addition to the Design Act were recognized for the shapes and other features of mass-produced utilitarian articles, protection for a longer period and over a broader scope might be obtainable under the former Act without deliberately incurring costs and obtaining design registration, potentially undermining the significance of the Design Act's existence. Furthermore, if copyright protection broadly extended to the shapes and other features of mass-produced utilitarian articles, authors' moral rights could complicate legal relationships and impede use of such articles, or those shapes and other features could remain unavailable for free use for a long period even after expiry of the design right, potentially obstructing the above purpose of the Design Act of contributing to industrial development."

"Nevertheless, the shapes and other features of mass-produced utilitarian articles are ordinarily determined subject to certain constraints in relation to the functions necessary for their practical purpose (hereinafter simply 'functions') and cannot be perceived separately from configurations derived from those functions. Among them, however, are articles, for example those with decoration exceeding the level of mere patterns or surface treatment added to their surfaces, in which the shapes and other features of the added portions are unrelated to function and can conceptually be perceived as paintings or sculptures separate from the function-derived configurations. Such articles may be described as mass-produced utilitarian articles to which 'artistic works' (Article 10(1)(iv) of the Copyright Act) have simply been added, and it is natural that protection under that Act extends to those added portions.

Among mass-produced utilitarian articles are also those, for example articles that can be perceived as sculptures or the like as a whole, in which the shapes and other features of all or part of the article, although related to its function as a utilitarian article, can conceptually be perceived as sculptures or the like separate from the configurations derived from its function. Such shapes and other features can be said to be the same as the aforementioned case of an 'artistic work' simply being added, in that a creative expression of thoughts or sentiments can be perceived separately from the function-derived configuration, and it is therefore appropriate to extend copyright protection to them. Shapes and other features of the foregoing kind can be described as exceptional among the shapes and other features of mass-produced utilitarian articles, which are ordinarily subject to certain functional constraints, and the risk that extending copyright protection to them would produce the harmful effects discussed above is small.

On the foregoing basis, where the shapes and other features of all or part of a mass-produced utilitarian article can be perceived, conceptually and separately from the configuration derived from its function, as a creative expression of thoughts or sentiments, all or part of that mass-produced utilitarian article should be held to fall within the artistic domain among the works referred to in Article 2(1)(i) of the Copyright Act."

2. Copyrightability of the plaintiff's products

"Applying this to the present case, according to the facts described above, the chair is a mass-produced utilitarian article, and the appellants argue, in substance, that the chair constitutes a work because creativity is recognized in its having two legs rising from the floor in an approximately L-shaped form at an angle of approximately 66 degrees, with a seat board and footrest board fixed between those two legs parallel to the floor. However, this is merely a circumstance supporting the proposition that the shape resulting from the arrangement of the legs, seat board, and footrest board, which are configurations derived from the function as a children's chair, gives rise to an aesthetic impression. The shapes and other features of all or part of the chair can only be perceived as configurations derived from its function as a children's chair and cannot be perceived, separately from those configurations, as a creative expression of thoughts or sentiments. Accordingly, the chair cannot be said to constitute a work."

【Keywords】 Copyrightability of product configurations, copyrightability of applied art, TRIPP TRAPP, Torippu Torappu, Choice Kids

【Design】 Osaka District Court, 2023 (Wa) 10125, “Container for a Liquid Soap Dispenser” case ＜Presiding Judge Matsuami＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: March 17, 2025 Judgment

1. Identification of the “essential part”
The container’s shape (a rectangle with rounded corners) and the configuration of the lid: Because these previously existed, they are not regarded as special innovations (essential parts).
As to the magnet on the rear, because the product is used attached to a wall, consumers (purchasers) focus on the rear out of concern over whether it “attaches firmly to the wall.”
⇒ The “specific shape of the rear (wall-mounting surface)” is the most important part of the design (essential part).

2. Comparison of the registered design and the defendant’s products
Registered design: A large, simple, uncluttered rectangular magnet covering the entire rear.
Defendant’s products: “Anti-slip sheets” are arranged above and below the magnet, creating a complex “I-shaped” form as a whole.
⇒ Dissimilar

3. “Utilization relationship” also denied
Because the characteristics (essential part) of the designs themselves were held different, it cannot be said that another person’s design is being used as a base.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93970.pdf



Figure: The defendant’s container, showing front, rear, left and right side views, top and bottom views, and a perspective view; registered-design drawings are shown alongside.

【Copyright】 Tokyo District Court, 2023 (Wa) 70125 ＜Presiding Judge Takahashi＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: March 11, 2025 Judgment

The act of using YouTube notification forms to give notices of copyright infringement, privacy infringement, and defamation concerning uploaded videos was held not to constitute a tort interfering with expressive activities.

1. Google carefully reviews requests for removal based on infringement, and there are instances in which it seeks additional information or rejects requests; removal is therefore not “unconditional.”
The notices in this case complained of infringement of publicity or portrait rights and described corresponding facts (unauthorized use of names and facial photographs). Even if a copyright form was used because a suitable form could not be found, this cannot immediately be said to be unlawful.

2. Under Google’s terms (Community Guidelines), measures such as removal may be taken at its own discretion against videos that a person “finds uncomfortable” or that “harm [the person’s] reputation,” even if the legal requirements for “privacy infringement” or “defamation” are not met.

3. Because the notices had corresponding factual grounds (display of a name, wording calling the person a fraudster, etc.), they cannot be said to have been deliberately based on false facts, and they were not found to have been abused exclusively for an improper purpose (harassment, etc.).

https://jucc.sakura.ne.jp/precedent/precedent-2025-03-11.html

Tokyo District Court judgment

On appeal, the Intellectual Property High Court upheld the judgment and dismissed the appeal on October 16, 2025 (2025 (Ne) 10037). Judgment

【Unfair Competition Prevention Act / Non-Compete】 Osaka District Court, 2023 (Wa) 9115 ＜Presiding Judge Matsuami＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: January 27, 2025 Judgment

* The geographic scope of the non-compete provision was too broad and therefore invalid.
⇒ No restrictive interpretation, from the perspective of its chilling effect.
(Only a very small amount of damages was awarded for preparatory acts during employment as a breach of an ancillary duty under the employment contract.)

(Summary of the holding)

The non-compete provision prohibits operating a competing business “within a radius of 2 kilometers from this corporation,” without the plaintiff’s permission, during employment and for six months after resignation.

The plaintiff has approximately ten establishments in addition to its head-office location in its welfare business division alone, and “within a radius of 2 kilometers from this corporation” must be interpreted as prohibiting opening a business within a radius of two kilometers measured from all those establishments (the plaintiff’s assertion is also understood in that way).

However, given a business of the plaintiff’s kind, it may be reasonable to prohibit post-employment competition for a certain period within a certain distance of an establishment in which the employee was actually involved, but the non-compete provision, which includes establishments with which the employee had no involvement at all, excessively restricts freedom of occupational choice and should be held invalid as contrary to public order and morality (and, in light of the chilling effect of such a provision, it also cannot be regarded as valid within a limited scope through a restrictive interpretation).

It cannot be said that compensatory measures sufficient to justify such a broad prohibition on competition had been taken.

(The actual distance to the defendants’ establishment was not made a premise of the determination, and no specific distance was found.)

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93798.pdf

【Contract】 Tokyo District Court, 2023 (Wa) 70680 【Method for Screening Inhibitors of Phosphorylation of Telomerase Reverse Transcriptase】 ＜Presiding Judge Nakashima＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: January 30, 2025 Judgment

The wording in the memorandum, “I pledge to make the maximum possible payment in the event of non-performance,” constituted an expression of intent to guarantee, and a joint and several guarantee agreement concerning the obligation to pay the lump sum in question was formed by defendant B personally.

(Excerpts from the judgment)

Because the subject of “I pledge to make the maximum possible payment in the event of non-performance” is “I, B” at the beginning of that sentence, a reasonable interpretation of the contracting parties’ intent is that defendant B personally was to make payment in the event of non-performance by the defendant company.

…

Its content is the very meaning of a guarantee: providing performance of the same content if the principal obligation is not performed, and it is merely a paraphrase of wording synonymous with a guarantee. Accordingly, the memorandum cannot be understood to have been prepared with an intention different from that of a guarantee.

…

Considering not only the meaning of the wording of the memorandum but also the circumstances and situation of its preparation and the parties’ conduct after preparation, it is appropriate to find that defendant B expressed, through the memorandum, an intention jointly and severally to guarantee the obligation to pay the lump sum and agreed with the plaintiff jointly and severally to guarantee that obligation.

…

From a substantive perspective as well, even assuming that C, the defendant company’s finance and contracts officer, bore the principal responsibility for this dispute, defendant B held the position of representative director of the defendant company. It would therefore not be particularly unnatural, in light of the circumstances at the time, for B, taking that position into account, to have provided a joint and several guarantee in response to the request of the plaintiff, who was also B’s senior in the community of medical researchers and had been compelled by non-payment of the lump sum to seek its payment from defendant B.

https://ipforce.jp/Hanketsu/jiken/no/14565

【Copyright】 Osaka District Court, 2023 (Wa) 11871, “Method of Diagnostic Imaging Based on Relativization through Comparison” ＜Presiding Judge Matsuami＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: February 17, 2025 Judgment

The plaintiff sought confirmation of copyright and other relief against the employer concerning a paper, flowcharts, screen layouts, and a diagnostic imaging system based on them that the plaintiff had created.

1. Regarding the paper, the plaintiff’s copyright and moral rights were recognized, with copyright registration (registration of the date of first publication) as one of the reasons.

2. Regarding the flowcharts and screen layouts, copyrightability was denied as they merely illustrated ideas using commonplace expression.

3. Regarding the system, even if it were a work, the author would be Hitachi Software, the system developer, or the defendant that commissioned it, and not the plaintiff.

The judgment, p. 12, identifies Hitachi Software or the defendant that commissioned it as the author, on the assumption that the system constitutes a copyright work.

https://ipforce.jp/Hanketsu/jiken/no/14584

【Unfair Competition Prevention Act / Trade Secrets】 Osaka District Court, 2023 (Wa) 5749 ＜Presiding Judge Takemiya＞

Source article: Nakamura & Partners

Publication date: May 21, 2026

Judgment date: February 13, 2025 Judgment

The plaintiff alleged violations of the Unfair Competition Prevention Act and the duty of fidelity, claiming that former employees had improperly acquired and used customer information to conclude contracts at a competitor, but the allegations were not accepted.

— A password accessible to everyone within the company does not establish “secret management.” (As in numerous precedents.)

The court denied that the information qualified as a “trade secret” under the Unfair Competition Prevention Act (secret management).
The customer information was managed in the plaintiff’s core business system, but all approximately 1,708 employees could easily access it, including from personal devices, using a shared ID and password. No measures restricted viewing authority to specific persons, and general confidentiality provisions in the work rules alone were insufficient secrecy measures. The court held that the information was not in a state in which it could objectively be recognized as managed as secret.
As to breach of the duty of fidelity and the duty not to compete, although establishment of the defendant company and business activities during the individual defendant’s employment were regarded as problematic, causation with damage was denied.
For customers other than customer 6, the differences between the plaintiff’s expected amounts and the actual contract amounts ranged from approximately 7 million yen to slightly under 25 million yen. The difference for customer 6 was approximately 1.5 million yen. However, the plaintiff’s expected amount was already low, at 20 million yen, making a further reduction difficult; the prospect rating was “C” (a probability below 30% of confirmation that month), and no presentation had been made. The court therefore found no prospect that the plaintiff would have concluded that contract either.
The defendants’ ability to obtain the orders was merely the result of price competitiveness that enabled contracting at budgets substantially below the plaintiff’s; it was not recognized that the plaintiff would have obtained the orders without the defendants’ conduct.
Deletion of information from the system was also performed by the individual defendant, who was a branch manager, based on a determination that there was “no prospect of concluding a contract,” and was within the scope of business discretion, not an improper act of concealment.



IP Force intellectual property case reports

【Paper / European Patents】 Patent Protection for Food Use Inventions at the European Patent Office (Nobuhiro Tago, Patent, September 2025)

Source article: Nakamura & Partners

Publication date: May 15, 2026

1. Classification of use inventions at the EPO

The EPO operates by strictly distinguishing use inventions as “medical uses” and “non-medical uses.”

Claim type	Category	Legal basis	Example wording
First medical use	Product claim	EPC Article 54(4)	A composition for use as a medicament
Second medical use	Product claim	EPC Article 54(5)	A composition for use in a method for the treatment of X
Non-medical use	Method claim	Guidelines F–IV 4.16	Use of a composition for Y

2. Boundary and criteria between medical and non-medical uses

Because functional foods are situated at the boundary between “prevention of disease (medical)” and “maintenance of health or improvement of physiological functions (non-medical),” that distinction is key to obtaining rights.

In determining whether a use is medical, whether an act by a medical practitioner is contemplated and whether a specific disease or symptom is targeted may serve as factors. These are not stated as necessary conditions common to every case; the determination depends on the specific circumstances of each case.

＜Determinations in principal Board of Appeal cases＞

T 815/22 (infant formula): The use of “promoting bodily growth so that it is comparable to bodily growth when breast-fed” was not recognized as a medical use (second medical use) in light of specific circumstances including the purpose of ordinary nutrition for healthy infants and a setting involving use by persons other than medical practitioners.

T 158/13 (perfume): The use of “providing relief from physiological and psychological states such as drowsiness, fatigue, and listlessness” inseparably included pathological characteristics (such as depression) and was therefore not recognized as a non-medical use even with a disclaimer of “non-therapeutic use.”

T 1916/19 (antimicrobial composition): Where embodiments such as removal of bacteria in healthy persons, in which the disease-prevention effect is negligibly small, are included, protection as a non-medical use may be recognized.

T 0815/22, Reasons 1.39, states that the assessment “depends on the specific circumstances of each case.” As discussed by Tago at pp. 64 and 67, the involvement of medical practitioners is one contextual factor, rather than the sole basis for a uniform rule.

T 0815/22, Reasons 1.28–1.43

3. Practical recommendations for obtaining rights for functional foods

In view of the EPO’s strict amendment requirements (the gold standard), it is necessary to provide descriptions from multiple perspectives at the filing stage.

In preparing the specification, clearly distinguishing and describing embodiments and examples of medical uses (specific diseases and patient groups) and non-medical uses (healthy persons and groups at low risk of disease) is extremely important for securing rights in both.

4. Enforcement in Germany

Use inventions granted at the EPO can become powerful rights in Germany and elsewhere.

In Germany, acts accompanied by “manifest preparation (sinnfällige Herrichtung),” such as product design premised on the patented use or attachment of instructions, constitute infringement.

(However, the strictness of labeling under the European Union’s “health claims regulation” must also be considered.)

https://jpaa-patent.info/patent/viewPdf/4694

【Trademark】 Tokyo District Court, 2022 (Wa) 11316, “Paku to Mogu” ＜Presiding Judge Kokubu＞

Source article: Nakamura & Partners

Publication date: May 15, 2026

Judgment date: January 24, 2025 Judgment

Trademark in question: “パクとモグ”

Defendant’s sign 5: “パクモグ” — similar
Defendant’s sign 1: “PAKUMOGU” — dissimilar

Compared with the plaintiff’s trademark “パクとモグ,” the defendant’s sign “パクモグ” differs in the presence or absence of the middle “と,” but is similar in appearance and pronunciation and identical in concept.
⇒ Similar

For the sign in alphabetic notation, the court considered that its appearance differed markedly from the plaintiff’s trademark and actual trading circumstances, including the display of the defendant’s name on its webpages and elsewhere.
+ Even if “パクとモグ” were written in the alphabet with “と” omitted, that notation would not necessarily be “PAKUMOGU.”
⇒ Dissimilar

＜Damages＞

The number of unique users of the defendant’s website did not decrease after the sign “パクモグ” was removed from the defendant’s webpages.
⇒ Royalty rate of 1%

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93784.pdf

【Trademark (Violation of Public Order and Morality)】 Intellectual Property High Court, 2024 (Gyo-Ke) 10079 ＜Presiding Judge Honda＞

Source article: Nakamura & Partners

Publication date: May 15, 2026

Judgment date: February 5, 2025 Judgment

Trademark “LEADER／リーダー”

The plaintiff (BROTURES Co., Ltd.) was formerly a distributor of the U.S. company Leader Bike, but after that company’s bankruptcy, acquired the trademark right from Honda Motor Co., Ltd. (Honda) and registered a divided transfer.
In response, the defendant, which succeeded to the business of the U.S. company Leader Bike, requested a trial for invalidation of the trademark registration.
The Japan Patent Office issued an invalidation decision on the ground that Article 4(1)(vii) of the Trademark Act (violation of public order and morality) applied.
⇒ Decision set aside (trademark valid)

(Summary of the holding)

Article 4(1)(vii) of the Trademark Act (violation of public order and morality) is a general provision that should apply only where the circumstances of trademark registration markedly lack social propriety and are contrary to the legal order.
In this case, the plaintiff acquired the “LEADER” trademark, to which neither the U.S. company Leader Bike nor the defendant held rights, from the lawful right holder, Honda Motor Co., Ltd. (Honda).
Because the contractual relationship between the plaintiff and the U.S. company Leader Bike had terminated on that company’s bankruptcy, the acquisition took place in a state in which no subsequent duties existed; the acquisition itself therefore cannot be said markedly to lack social propriety.
Even if the plaintiff described itself as the “exclusive distributor” and engaged in conduct causing confusion with the defendant’s products, that is a matter to be resolved through civil litigation under the Unfair Competition Prevention Act or other laws and does not constitute a ground for invalidating the trademark registration itself (violation of public order and morality).

https://iwanagalaw.livedoor.blog/archives/27042185.html



【Authors' Moral Rights】 Osaka High Court, 2024 (Ne) 1431 ＜Presiding Judge Morisaki＞

Source article: Nakamura & Partners

Publication date: May 15, 2026

Judgment date: February 27, 2025 Judgment

The first-instance plaintiff, who created the original draft (tenth draft) of a film screenplay, sought damages and other relief against the first-instance defendant, who participated as a co-screenwriter and added to and revised that screenplay (creating the twelfth draft), claiming unauthorized alteration and infringement of the right of integrity.
The first-instance court found infringement in part, but this court reversed and dismissed the claim.

(Summary of the holding)

The first-instance plaintiff consented to the first-instance defendant's participation as a screenwriter and, during approximately two months in which the first-instance defendant independently performed additions and revisions, did not object and cooperated with research and other work.
⇒ It is appropriate to find that the first-instance plaintiff accepted the first-instance defendant's changing the screenplay by adding that defendant's own creation.
Because the first-instance defendant would display a name as a well-known screenwriter, creative additions and revisions were naturally foreseeable, and the first-instance plaintiff can be said to have understood this as well.
Authority to make the screenplay the "final draft" belonged to the production side, including the producer, not the first-instance defendant. Therefore, the first-instance defendant cannot be held legally responsible for the production side's making it the final draft without the first-instance plaintiff's express consent.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93886.pdf

【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10089, “VALENTINO” case ＜Presiding Judge Miyasaka＞

Source article: Nakamura & Partners

Publication date: May 15, 2026

Judgment date: February 27, 2025 Judgment

⇒ Violation of Article 4(1)(xi) of the Trademark Act

Trademark in question: “GIANNI VALENTINO (and figure)” (Young Sangyo)
Cited trademark: “VALENTINO (and figure)”

(Summary of the holding)

The lettering “VALENTINO” and other such lettering were recognized as well known and famous among consumers of the designated goods as the brand of the renowned designer Valentino Garavani at the time of the registration examination.
The trademark in question is a composite mark consisting of the words “GIANNI” and “VALENTINO,” but the well-known and famous “VALENTINO” portion creates a strong and dominant impression as a source identifier, so it may be extracted as the essential portion for comparison.
In the cited mark as well, the word “VALENTINO” is displayed prominently in the center and can likewise be extracted as the essential portion.
⇒ Similar

https://ipforce.jp/Hanketsu/jiken/no/14563

【Trademark Act】 Intellectual Property High Court, 2024 (Gyo-Ke) 10090, “Pon-chan” case

Source article: Nakamura & Partners

Publication date: May 15, 2026

Judgment date: March 12, 2025 Judgment

“Fame” under Article 4(1)(vi) of the Trademark Act denied
— Tatebayashi City has a population of slightly under 80,000, compared with approximately 1.97 million for Gunma Prefecture as a whole

For the trademark “ぽんちゃん,” applied for by an individual, the Japan Patent Office refused registration on the ground that, in relation to Tatebayashi City, Gunma Prefecture’s mascot character “ぽんちゃん” (the cited sign), Article 4(1)(vi) of the Trademark Act (a famous sign indicating a non-profit undertaking in the public interest) applied.
⇒ Decision set aside

(Summary of the holding)

To qualify as “famous” under Article 4(1)(vi) of the Trademark Act, recognition throughout Japan is not necessarily required in light of the regional nature of the organization or undertaking, but broad recognition across a “geographic area of an appropriate scale” is nevertheless necessary.

The Nichinan City Emblem judgment (Intellectual Property High Court, October 30, 2012, 2012 (Gyo-Ke) 10125) required broad recognition among traders and consumers across at least one trading area for the designated goods or services. The JPC judgment (Intellectual Property High Court, February 4, 2025, 2024 (Gyo-Ke) 10060) interpreted “famous” in item (vi) as having the same meaning as “well known among consumers” in item (x). The Pon-chan judgment assessed recognition across a geographic area of an appropriate scale in light of the regional character of the organization or undertaking.

The cited sign “ぽんちゃん” was recognized as widely known within Tatebayashi City through manholes, installations, and other uses.
However, outward-facing use beyond the city was limited and sporadic, social media followers numbered only in the thousands, and past media exposure (commercials, etc.) was temporary, so broad recognition in Gunma Prefecture and the surrounding region could not be recognized.
⇒ Does not qualify as “famous.”

Nichinan City Emblem, judgment p. 7 / JPC, judgment p. 9

https://note.com/shuwa_ip/n/nb9518317a838

<table>
<tr><th>本願商標</th><th>引用標章</th></tr>
<tr><td rowspan="3">商願 2021-154842

ぽんちゃん（標準文字）

第 9 類「アニメーションを内容とする記録済み媒体及び動画ファイル」等
第 16 類「パスポートホルダー」等</td><td>ぽんちゃん</td></tr>
<tr><td>引用キャラクター</td></tr>
<tr><td>
ぽんちゃん</td></tr>
</table>

Figure: Left — application 2021-15842 for “ぽんちゃん” (Pon-chan), in standard characters; Class 9 includes recorded media and video files containing animation, and Class 16 includes passport holders. Right — the cited “ぽんちゃん” sign and the cited mascot character.

【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10072 ＜Presiding Judge Nakadaira＞

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: January 22, 2025 Judgment

The decision cancelling the registration for non-use was set aside.
Trademark concerned: “INTUITION”

The act of an employee of the plaintiff’s non-exclusive licensee sending a product ledger and presentation materials by email to a trading partner during the period requiring proof was recognized as “use of the trademark.”
The defendant asserted, “These are continuous strings of letters and not use of ‘INTUITION’ alone,” but “INTUITION” appeared on a separate line and in larger letters than the other wording (WILL JP, etc.), and consumers would recognize “INTUITION” as the product name (brand name) and “WILL JP,” etc., as its model number or type.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93769.pdf

【Copyright】 Intellectual Property High Court, 2024 (Ne) 10065 ＜Presiding Judge Miyasaka＞

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: January 30, 2025 Judgment

The appellant asserted that mosaic processing and other measures made perception of the content impossible, but the mosaic was coarse, and even the portions with overlaid illustrations allowed perception of essential expressive features, such as the subject’s upper body and hair, angle, and lighting. Infringement of the reproduction right and right of integrity therefore could not be avoided.

Regarding the right of attribution, Article 19(2) of the Copyright Act is a provision for users’ convenience, but, at least where unauthorized alteration has been made as in this case, the premise for applying that paragraph is absent.

An injunction is necessary
— In light of the manner of infringement and the history between the parties, the appellant’s deliberate continued retention of the photograph data supports a risk of renewed infringement.
The fact that other persons can obtain the data is not a reason to deny the risk of infringement by the appellant.

https://ipforce.jp/Hanketsu/jiken/no/14539

【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10048 ＜ Presiding Judge Hibiku Shimizu＞

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: January 30, 2025 Judgment

* Distinctiveness of the three-dimensional trademark denied

＜Distinctiveness (Article 3(1)(iii) of the Trademark Act)＞
The shape of the applied-for trademark (a flattened, substantially circular cylinder, a disk on the bottom, a hole with a gear-like pattern, grooves on the side, etc.) is objectively recognized as adopted to serve the product's functions (attachment to the body, needle insertion, ventilation, etc.) or aesthetics.
Even if there are characteristic parts not found in other companies' products, they remain within the range foreseeable as choices for functional or aesthetic reasons in products of the same kind, and the shape, being represented in a commonly used manner, does not distinguish the applicant's goods from others'.

＜Applicability of Article 3(2) of the Trademark Act＞
The plaintiff's product has substantial sales volume and revenue, but its market share is not overwhelming and is declining, and it is always displayed together with the word mark "FreeStyle リブレ" in advertisements and elsewhere, so the shape itself is not recognized as independently creating a strong impression on consumers.
The questionnaire survey submitted by the plaintiff is problematic because its respondents were limited to persons with experience purchasing or providing guidance on CGM (continuous glucose monitors), and it does not reflect general recognition including potential consumers. Taking both the unaided and aided recall results into account, the court found that the shape itself had not acquired independent distinctiveness through use.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94002.pdf



Figure: The three-dimensional trademark applied for, depicting the continuous glucose monitor.

【Unfair Competition Prevention Act / Circulation or Communication of False Facts】 Osaka High Court, 2024 (Ne) 338 ＜Presiding Judge Morisaki＞

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: January 30, 2025 Judgment

The appellant, holding exclusive distribution rights for shogi competitions (the Osho and Ginga tournaments), made takedown requests and other requests alleging copyright infringement against the appellee's videos, which reproduced the tournaments' real-time moves (game-record information) on a board for distribution.

The appellee's video distribution was held to constitute a tort. Before deciding whether the game records were copyrightable, the court examined the infringement of business interests through the use of information obtained from the paid distribution.
Organizers such as the Japan Shogi Association use a business model in which, for shogi competitions that do not generate admission-fee revenue, operating costs are covered by consideration for licensing broadcast and distribution rights, and the appellant acquired distribution rights at considerable expense.
⇒ The appellee's video distribution provided viewers free of charge with real-time game-record information obtained from the appellant's paid distribution, reducing the number of fans who paid to receive distribution from the appellant and causing direct damage to the appellant.
The appellee, while understanding that business model, used real-time game-record information at only the cost borne by an individual viewer to earn revenue and obstructed the appellant's revenue structure. In circumstances where other video distributors were devising ways to compete within the rules, this was unlawful conduct exceeding the scope of free competition and infringing the appellant's business interests, and constituted a tort.
Because the appellee's distribution conduct constituted a tort, the benefits derived from that business were not legally protected interests.
Even assuming that copyrightability of the game records were denied, videos causing damage to third parties could be subject to removal under the platform's terms of use; in relation to the appellee, who was a tortfeasor, therefore, the takedown requests in question could not be said to have been improper.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93782.pdf

【Trademark】 Intellectual Property High Court, 2024 (Gyo-Ke) 10067, “MYOFOCUS” = 2024 (Gyo-Ke) 10068

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: January 16, 2025 Judgment 1 ／ Judgment 2

The defendant’s (an Australian corporation’s) trademark was misappropriated.
⇛ Violation of public order and morality (Article 4(1)(vii) of the Trademark Act)

The defendant used “MYOFOCUS” and other trademarks in Australia and also held seminars in Japan.
On September 27, 2019, the day after the defendant’s first seminar in Japan ended, the plaintiff applied in Japan for trademarks closely resembling the defendant’s marks. Registration followed on July 7, 2021. By a letter dated October 27, 2021, the plaintiff then demanded that the defendant cease use.
The marks closely resembled one another down to details, including the features of the figure and the mixed uppercase/lowercase arrangement (mYofocUs); the resemblance could not be regarded as coincidental.
The revenue stamp affixed to the designer’s receipt dated November 24, 2015, submitted by the plaintiff, bore a new design introduced in 2018. Considering this issue date, together with the circumstances in which the receipt was produced, the explanation concerning its reissuance and the failure to produce the original, the court assessed the credibility of the plaintiff’s assertions and evidence as low and did not find that the related plaintiff’s mark had been created in October 2015.

【Copyright】 Intellectual Property High Court, 2024 (Ne) 10017 ＜Presiding Judge Honda＞

Source article: Nakamura & Partners

Publication date: May 8, 2026

Judgment date: November 21, 2024 Judgment

The programs in question allow a range of choices in the specific description of the source code and reflect their creator’s individuality.
⇒ Copyrightability recognized

The court did not find that a program reproduced or modified from program 3 was used as the program for the first-instance defendant’s “Silent Robo” product.

As to the reproduction right and the right of integrity, the court found an implied agreement permitting reproduction and modification for use within the first-instance defendant’s business. Programs 3–5 were delivered with their source code. The defendant had previously reproduced and modified delivered programs for sites other than those that prompted the orders. The plaintiff, a former employee who continued to produce and deliver numerous programs after becoming independent, could have been aware of that practice.
For programs 1, 2 and 6, disclosure of source code at delivery was not established. Nevertheless, the specifications imposed no objective restriction on use at other sites, and the plaintiff had made no particular statement restricting reproduction or modification. Taking these circumstances together with the previous practice, the court found the same implied agreement.

For program 3, the creator’s name was displayed for approximately one second at startup, in circumstances in which customers could check it on site, so this constituted “presentation to the public,” and infringement of the right of attribution was established.

Judgment, pp. 15–17

【Trademark】 Appeal 2024-18950

Source article: Nakamura & Partners

Publication date: May 8, 2026

According to the article, the applied-for mark “ViCREA” (standard characters) and the cited figurative mark “BICREA” were held dissimilar.

The article reports that, although both marks are pronounced “Bikurea,” their appearances differ markedly and are clearly distinguishable, and neither conveys a specific concept.

Osaka District Court Orders, 2025 (Yo) 20008 and 20009 【Prostaglandin Derivatives for the Treatment of Abdominal Discomfort】

Source article: Nakamura & Partners

Publication date: May 8, 2026

Order date: February 6, 2026 Judgment

＜Issues＞

Extension 1: Extension based on approval of the originator's 24 μg formulation (expired)

Extension 2: Extension based on approval of the originator's 12 μg formulation (in force)

The creditor asserted that the effect of the subsisting "extension registration based on the 12 μg approval" also extended to the generic "24 μg formulation" (the products being substantially identical).

The scope and units of extension registration (the scope divided into strips) and the scope of the effect of the patent right whose term has been extended (a scope having breadth that includes substantial identity) do not necessarily coincide, and the latter generally has greater breadth. However, only when the two are "interpreted and operated consistently and harmonized with one another can the purpose of the system, equity between the patent holder and third parties, be realized."

The scope of effect "should be interpreted within the constraint that it not conflict with the scope and units of the registration of extension of duration."

The court held: "Where extension registrations have been made for the same patent right relating to a pharmaceutical on the grounds of multiple dispositions specified by Cabinet Order, the scope of effect of the patent right subject to a later extension registration … should be interpreted, at least, as not extending to production, assignment, etc., of products identical in ingredients, quantity, administration, dosage, efficacy, and effects to the product covered by the disposition specified by Cabinet Order that formed the basis of the earlier extension registration, because such products are not substantially identical to the product covered by the disposition specified by Cabinet Order that formed the basis of the later extension registration."

Furthermore, taking as a reference the product covered by the disposition specified by Cabinet Order that formed the basis of the later extension registration, (1) products with a quantitative difference greater than the quantitative difference from the product covered by the earlier disposition (for example, a larger difference in quantity), and (2) products having both the same quantitative difference as the product covered by the earlier disposition and a further qualitative difference (for example, a certain difference in ingredients in addition to the same difference in quantity), are more remote as products and likewise cannot be regarded as substantially identical.

If the creditor's position were accepted, where the earlier extended duration was shorter, third-party working of its subject product would be prohibited for a period longer than that regulated by the extension system, "greatly undermining the purpose of the patent term extension system, which divides the scope and units at the extension-registration application stage into strips according to ingredients, quantity, administration, dosage, efficacy, and effects, and seeks finely to adjust equity between the patent holder and third parties within those scopes and units."

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95654.pdf

【Trademark】 Appeal 2025-416

Source article: Nakamura & Partners

Publication date: May 8, 2026

According to the article, the applied-for mark “百香” (standard characters) and the cited mark “MOMOCA” were held dissimilar.

The article reports that, in Roman-letter spelling, the sound “カ” is spelled “ka,” the appearances are distinguishable, and there is no risk of confusion in concept.

Author’s comment: The original article raises the question whether representing “カ” with “CA” makes dissimilarity more likely and registration easier to obtain.

Osaka High Court, 2025 (Ne) 1750 【Koi Ichigo】
＜Presiding Judge Morisaki＞

Source article: Nakamura & Partners

Publication date: May 1, 2026

Judgment date: February 13, 2026 Judgment

(First instance: Osaka District Court, 2024 (Wa) 5007)

* Dissimilar (reversal)

Trademark in question: “恋　苺”

Defendant’s sign: “あわ恋いちご”

＜Separate observation denied (unlike the first instance)＞
The trademark holder’s assertion that “awa” means the place name “Awa” and therefore has no source-identifying function, making “koi ichigo” the essential portion, was not accepted.

＜Appearance＞
The trademark in question is written vertically in kanji, whereas the defendant’s sign is written horizontally in a POP-style typeface in hiragana except for “恋”; they are clearly different.

＜Pronunciation＞
The pronunciations are “Koi Ichigo” and “Awa Koi Ichigo,” and differ in the number of characters and are not similar.

＜Concept＞
“Love” and “faint love” evoke different concepts and are not similar.

(Excerpts from the judgment)

Even if the lettering “あわ” evokes the place name “阿波” because the defendant’s sign is affixed to packaging of the above design, in the actual trading circumstances in which that packaging is used for each of the defendant’s products accompanied by strawberries, the defendant’s sign is understood, on the premise that it is a composite mark combining “あわ恋” and “いちご,” merely as making a play on the geographic name “阿波,” the origin of the defendant’s products, in the “あわ” lettering of “あわ恋.” Accordingly, when determining similarity between the defendant’s sign and the trademark in question, it is impermissible to observe the defendant’s sign separately as “あわ” and “恋いちご” …. …

Whereas the trademark in question is written vertically in kanji, the defendant’s sign is written in hiragana except for “恋,” using slightly rounded POP-style lettering arranged at equal intervals in a slightly curved, single continuous horizontal line, and is clearly different in appearance. Moreover, the trademark in question produces the pronunciation “Koi Ichigo,” whereas the defendant’s sign produces “Awa Koi Ichigo”; although they overlap in part, the number of characters differs, and the pronunciations cannot be said to be similar. Both are words coined by combining the fruit name ichigo with a word describing a psychological or emotional state that does not ordinarily express taste, to express the fruit’s taste. However, because “love” and “faint love” evoke different concepts, the concepts resulting from combining each with ichigo likewise cannot be said to be similar. Accordingly, the trademark in question and the defendant’s sign cannot be said to be similar as a whole.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95619.pdf

被告商品目録

1



2



オ　登録商標

恋
苺

Figures: The defendant’s product packaging and the registered “恋 苺” (Koi Ichigo) mark.

【Trademark】 Osaka District Court, 2024 (Wa) 5007, “Awa Koi Ichigo” ＜Presiding Judge Matsukawa＞

Source article: Nakamura & Partners

Publication date: May 1, 2026

Judgment date: July 17, 2025 Judgment

Trademark in question: “恋　苺”

Defendant’s sign: “あわ恋いちご”

① Determination of similarity of composite trademarks (permissibility of separate observation and identification of the essential portion)

The “あわ” portion of the defendant’s sign “あわ恋いちご” has multiple meanings, such as “泡, 粟, 安房, 阿波,” but the packaging of each defendant product prominently displays the words “Produced in Tokushima Prefecture,” illustrations of the Awa dance, and other indications.

In light of these actual trading circumstances, consumers recognize “あわ” as the regional name “阿波” and take it as an indication of origin, so that portion has no distinctiveness.

⇒ It is permissible to extract “恋いちご” from the defendant’s sign and compare it with the trademark “恋苺.”

② Similarity of the trademark in question and the defendant’s sign

Comparing the separated “恋いちご” portion of the defendant’s sign with the trademark “恋苺,” although they differ in appearance, both have the identical pronunciation “Koi Ichigo.”
In concept as well, both are coined expressions combining “love” and “strawberry” and give rise to the same concept of a strawberry that attracts strongly, like romantic love.

The defendant asserted that “あわ恋” means “faint love” and is indivisible, but this was rejected on the facts.

⇒ Similar, with a risk of mistaken identification or confusion

③ Defense of use of a registered trademark

The court held that use of a sign similar to a prior registered trademark in a manner causing mistaken identification or confusion among consumers constitutes an abuse of rights in light of the purpose and intent of the Trademark Act, even if it is use of a registered trademark, and does not establish a defense.

Cf. Reversed on appeal by the Osaka High Court on February 13, 2026 (2025 (Ne) No. 1750).

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94495.pdf

Tokyo District Court, 2019 (Wa) 32779 【Clothing】 ＜Presiding Judge Kokubu＞

Source article: Nakamura & Partners

Publication date: May 1, 2026

Judgment date: April 26, 2024 Judgment

1. Satisfaction of the claim limitations
From the wording of the claims, the “lifeline passage” need only have one end joined to the back side of the garment fabric and be formed in a tubular shape; the manner of joining (cylindrical, at an edge, etc.) is not further limited.
⇒ Satisfied

2. Validity (inventive step)
In the sample in question, one end of the lifeline passage is joined to the “front side” of the garment fabric, whereas in the invention it is joined to the “back side.”
⇒ The invention concerns clothing for a special use addressing prevention of air leakage and other problems, and there is no motivation to apply technology for pockets and the like in ordinary garments.
⇒ Inventive step recognized

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94061.pdf

Intellectual Property High Court, 2023 (Gyo-Ke) 10062 【Bone Anchor with Improved Fixation Strength】 ＜Presiding Judge Shoji＞

Source article: Nakamura & Partners

Publication date: May 1, 2026

Judgment date: May 14, 2024 Judgment

The “outer surface of the anchor body” in the applied-for invention refers not to the uneven surface itself formed by multiple channels and ribs but to the outer perimeter (circumference) joining the rib tips.
⇒ Likewise, in the cited invention, if the outer perimeter joining the tips of the bone-engaging surface portions (corresponding to ribs) is regarded as the outer surface, the “portions between the bone-engaging surface portions” correspond to “channels” formed within the outer surface, and the “bone-engaging surface portions” defined thereby correspond to “ribs.”

The applied-for invention has a configuration in which the channel “intersects” an eyelet (a hole through which a suture passes) in a T shape.
Providing a suture anchor with a through-hole (eyelet) for passing a suture was well-known technology before the application’s priority date.
⇒ Providing a well-known “eyelet” in place of the cited invention’s “continuous groove” could readily have been conceived by a person skilled in the art. In doing so, placing the eyelet at a position communicating with the channel (suture-receiving groove) (a position intersecting in a T shape), within a range that does not impair structural integrity, is merely a design matter that a person skilled in the art could appropriately adopt.

In Exhibit Ko 1, the recess accommodating the knot in the cited invention is described only as a “preferred” configuration, not an indispensable one.

⇒ Inventive step denied

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93044.pdf

Intellectual Property High Court, 2023 (Gyo-Ke) 10092 【Bag Processing Machine】 ＜Presiding Judge Honda＞

Source article: Nakamura & Partners

Publication date: May 1, 2026

Judgment date: May 9, 2024 Judgment

* Violation of the expanded prior-application rule (Article 29-2)

1. Identification of the earlier-filed invention
From the description in the earlier application’s specification (paragraph 0046, Figure 3, etc.), it can be understood that the filling-process time T2 is twice the other-process time T1 and that filling and closing of two groups take place during that time.

2. Difference 1 (adjustment of transport speed)
Whereas the invention adjusts speed through current to electromagnets, the earlier-filed invention uses electromagnetic coils for control.
⇒ The earlier specification describes arbitrary setting of speed through linear transport, and using electromagnetic coils as electromagnets and adjusting speed through current are naturally presupposed in the earlier-filed invention.

3. Difference 2 (stock function)
In the invention, processed bags are “stocked” upstream of the downstream device.
⇒ “Stock” means having the bags wait upstream so that the downstream device can immediately begin the next process.
⇒ In the earlier-filed invention as well, the second group waits upstream (in the third filling region) during sealing of the first group and can move to the sealing process immediately after completion, and this constitutes “stock.”

https://ipforce.jp/Hanketsu/jiken/no/14334

Legal Update (Items Posted in June 2026)

Scope: Articles published in June 2026 by attorney Hideki Takaishi (Nakamura & Partners)

Number of entries included: 32 (30 distinct titles; two titles are each posted at two different URLs)

List page: https://www.nakapat.gr.jp/ja/legal_updates_jp/

Selection: Entries whose publication date on the list page is in June 2026, in descending order of publication date; entries published on the same date retain their list order.

<Highlights of This Month> Key Points in the June 2026 Intellectual Property and Legal Affairs Update

The June 2026 Legal Update contains articles on patent disclosure requirements and inventive step, overseas filing, U.S. designs, protection of intellectual property in virtual space, trade secrets, and litigation procedure. This issue includes all 32 entries based on the publication dates on the list page. Two pairs with identical titles are retained as articles with separate URLs. The following addresses the specific issues and practical points presented in the original articles.

1. Obviousness and Infringement Analysis for U.S. Designs

“New Standards for Determining Obviousness of U.S. Design Patents” (佐々木眞人) addresses the abolition of the Rosen-Durling test by the 2024 LKQ en banc judgment. The framework examines not only the relationship with the primary reference but also the ordinary designer’s viewpoint, differences, and secondary considerations. In contrast, “Changes in the Methods for Determining Design Right Infringement in the United States” (the same author) explains the ordinary observer test after the Egyptian Goddess en banc judgment. It is important to distinguish the person whose viewpoint is adopted and the role of prior designs in obviousness and infringement. Source 1 / Source 2

2. Reviewing Specifications by Distinguishing Clarity from Support

“Examination of Clarity Determinations in Recent Court Decisions” (岡田健太郎 et al.) states that clarity determinations cannot be said to have become stricter and introduces cases in which expressions of degree can be understood through common general technical knowledge. In contrast, 2024 (Ne) No. 10038 [Brake Control Device and Behavior Analysis Device for a Motorcycle] <Presiding Judge Honda> refused to read angular velocity as angular acceleration in a specification consistently using the former, and found a support violation. Supplementing the meaning of a term must be distinguished from understanding a physically contradictory formula by correcting it. “The Support Requirement for Numerical Range Limitations in China” (胡春豊 and 林軍) presents the viewpoint of whether non-working ranges can be excluded without excessive effort, and policies for describing numerical ranges and examples. Source 1 / Source 2 / Source 3

3. Designing Conditions for Overseas Filing and International Licensing

“Differences Between the Japanese and European Patent Systems That Require Attention” (野村和弘 and フロリアン キューベック) organizes the number of independent claims, self-collision, amendments, and descriptions of measurement methods. “Points to Note When Filing Food-Use Inventions in Different Countries” shows the need to examine claim forms such as purpose-limited substances, non-therapeutic uses, methods, and Swiss-type claims according to national practice. In the introduction to “The UK InterDigital v. Lenovo Litigation over the Calculation of FRAND Rates” (小林和人), the process by which the Court of Appeal revised the rate to $0.225 per unit based on analysis of a comparable agreement is important. The High Court rate and Court of Appeal rate must not be confused, and conditions must be understood together with past royalties, the basis for discounts, and compound interest. Source 1 / Source 2 / Source 3

4. Protection in Virtual Space and Avoiding Trademark Confusion

“Protection of Goods and Other Subject Matter in Virtual Space under U.S. Design Law” by 山口洋一郎 and “A Consideration of Future Responses under Japanese Design Law to Design Protection in Virtual Space — In Light of International

Trends” by 星野光秀 provide different viewpoints on registrable images and the effect of rights across physical and virtual spaces. The possibilities of protection should be read together with the issues arising from expansion of the system. In trademarks, the article by 星野 addresses specific identification of virtual goods and classification of services. 2025 (Gyo-Ke) No. 10111 “SORA” <Presiding Judge Moritomi> emphasized extraction of the word element and actual trading circumstances of beauty-related services. The article on the consent system also shows the need to explain distribution channels, consumers, and manner of use, in addition to the existence of a consent document. Source 1 / Source 2 / Source 3 / Source 4 / Source 5

5. Litigation Practice That Organizes Evidence and the Scope of Claims Early

“The Practice and Theory of Preservation of Evidence in Intellectual Property Cases and Related Matters” (高村隆司) addresses use of summary courts and the effects of refusing presentation, while “Patent Attorneys as Judicial Research Officials” (髙村和宗 and 岩永勇二) explains the importance of organizing grounds for cancellation and evidence in the first preparatory brief. In Tokyo District Court, 2024 (Wa) No. 4142 [Portable Information Communication Device and Personal Computer System Using the Portable Information Communication Device] <Presiding Judge Kokubu>, separately claiming as a remainder the amount equivalent to consumption tax that could have been asserted in the prior actions was held contrary to good faith. 2024 (Gyo-Ke) No. 10036 [Chip Detection Device] <Presiding Judge Honda> also denied an interest in cancelling the trial decision to grant a patent based on the last amendment. It is important not only to secure evidence but also to organize what is claimed and which amendment is ultimately chosen. Source 1 / Source 2 / Source 3 / Source 4

6. Business Protection through Trade Secrets and IP Mixes

“Infringement Risks Arising from the Use of Other Companies’ Trade Secrets Brought in by Employees Changing Jobs” (石本貴幸) proposes written pledges, training, consultation desks, and checking the process by which results were created. “Intellectual Property and Intangible Assets in the Food Industry” (藤原研

二郎) and the Agriculture, Forestry, and Fisheries Committee's article on IP mixes explain combinations of know-how, brands, plant breeders' rights, and GIs through specific examples. "Use of AI in Patent Examination" (五十嵐康弘) further addresses use in summarization and translation with attention to access to primary information. These articles provide a perspective on managing information to be protected, technology to be disclosed, and information used in work according to their respective purposes. Source 1 / Source 2 / Source 3 / Source 4

Three-Line Summaries of All Articles

Category	Article Title and Three-Line Summary
IP in General	**[Article / Unfair Competition Prevention Act] The Practice and Theory of Preservation of Evidence in Intellectual Property Cases and Related Matters (高村隆司, Patent, June 2025)** ① This introduces an article examining the choice of court, a prima facie showing of grounds for preservation of evidence, and the opposing party's response in intellectual property cases. ② The introductory article recommends using summary courts based on the author's experience of applications to summary courts and organizes the issues of refusing presentation and deeming allegations true. ③ It is necessary to consider the court and the content of the prima facie showing, while the opposing party should consider how refusal affects the evaluation of evidence in the litigation on the merits.

Category	Article Title and Three-Line Summary
Design	**[Article / U.S. Designs] New Standards for Determining Obviousness of U.S. Design Patents (佐々木眞人, Patent, June 2025)** ① This introduces an article on the change in the test for obviousness of U.S. design patents following the LKQ en banc judgment. ② It explains that the Rosen-Durling test was abolished and replaced by a framework evaluating prior art, differences, the designer's level of skill, and secondary considerations. ③ Obviousness should be examined not only through selection of the primary reference but also through the viewpoint of an ordinary designer and objective evidence such as commercial success.
IP in General	**[Article / Unfair Competition Prevention Act] Infringement Risks Arising from the Use of Other Companies' Trade Secrets Brought in by Employees Changing Jobs (石本貴幸, Patent, October 2025)** ① This introduces an article on the infringement risks arising when a receiving company uses another company's trade secrets brought in by employees changing jobs. ② It presents four defensive measures: written pledges on joining, employee training, internal consultation desks, and detection of unnatural inventions. ③ It is important to establish an internal system covering superiors and subordinates as well as the employee changing jobs, and to check how results produced immediately after joining were created.

Category	Article Title and Three-Line Summary
Patent	**[Article / Patents] Examination of Clarity Determinations in Recent Court Decisions (岡田健太郎 et al., Patent, June 2025)** ① This introduces an article comparing recent court decisions and Patent Office trends on clarity, including expressions of degree. ② It explains that clarity determinations cannot be said to have become stricter and that understandability for a person skilled in the art tends to be evaluated from the specification and common general technical knowledge. ③ Explaining definitions, assessment indicators such as public standards, and the relationship between processes and structures in the specification helps prevent disputes.
Patent	**2024 (Gyo-Ke) No. 10036 [Chip Detection Device] <Presiding Judge Honda>** ① An applicant who obtained a trial decision to grant a patent based on its own later amendment sought cancellation in order to obtain a patent based on an earlier amendment. ② The court dismissed the action as inadmissible because the plaintiff had no interest in cancelling a trial decision that accepted its request based on the last amendment. ③ Because amendments during trial proceedings change the subject of examination, attention is required to whether an interest exists in challenging the subsequent trial decision to grant a patent in a cancellation action.

Category	Article Title and Three-Line Summary
Patent	**[Article / Patents] Use of AI in Patent Examination (五十嵐康弘, Patent, August 2025)** ① This introduces an article testing the use of cloud and on-premises generative AI for practical patent examination tasks. ② It explains hallucination measures through limiting tasks to summarization and translation, and the need to incorporate patent-specific reasoning and vocabulary. ③ It is important to consider the scope of application suited to examination work while monitoring model updates and maintaining access to primary information.
Patent	**[Article / Chinese Patents] The Support Requirement for Numerical Range Limitations in China (胡春豊 and 林軍, Patent, September 2025)** ① This introduces an article examining the support requirement for inventions combining numerical ranges in light of a judgment of the Supreme People's Court of China. ② It emphasizes whether a skilled person can understand the relationships among ranges, obtain suitable embodiments with limited experiments, and exclude non-working ranges without excessive effort. ③ The specification should include guidance and examples for numerical ranges, while invalidity arguments require specific proof that effective ranges cannot be recognized with ordinary effort.

Category	Article Title and Three-Line Summary
Patent	**[Article / European Patents] Differences Between the Japanese and European Patent Systems That Require Attention (野村和弘 and フロリアン キューベック, Patent, September 2025)** ① This introduces an article addressing differences between the Japanese and European patent systems concerning claims, self-collision, amendments, and parameter inventions. ② It organizes points to note about Europe's restrictions on independent claims, strict amendment requirements, disclosure of numerical ranges, and identification of measurement methods and standards. ③ When European expansion is planned, diverse numerical ranges and dependencies should be described from filing, and the timing of related applications and disclosure risks should be considered.
Patent	**[Article / UK Patents] The UK InterDigital v. Lenovo Litigation over the Calculation of FRAND Rates (小林和人, Patent, September 2025)** ① This introduces an article on the calculation of FRAND rates in the UK InterDigital v. Lenovo litigation. ② It explains how the rate based on comparable agreements was revised from the High Court's $0.175 per unit to the Court of Appeal's $0.225, and the treatment of past periods and compound interest. ③ License terms should be considered with regard to selection and adjustment of comparable agreements, the basis for volume discounts, past implementation periods, and interest.

Category	Article Title and Three-Line Summary
Patent	**[Article / Patents] Intellectual Property and Intangible Assets in the Food Industry (藤原研二郎, Patent, September 2025)** ① This introduces an article examining the role of intellectual property and intangible assets in food industries from their industrial stages and the characteristics of flavor and skills. ② It explains the importance of manufacturing know-how, brand stories, and the passing down of skills in light of the history and regionality of food and the complexity of flavor. ③ It is important to combine not only exclusivity through patents but also know-how management and brand formation according to the business's role.
Design	**[Article / U.S. Designs] Protection of Goods and Other Subject Matter in Virtual Space under U.S. Design Law (山口洋一郎, Patent, August 2025)** ① This introduces an article examining article use and the scope of rights in the protection of goods and other subject matter in virtual space under U.S. design law. ② It discusses the treatment of limitations based on article use, image protection as part of a display, and enforcement between physical and virtual spaces. ③ In filing and enforcing designs for virtual goods, the relationship between displayed articles and their overall appearance should be considered.

Category	Article Title and Three-Line Summary
Design	**[Article / Designs] A Consideration of Future Responses under Japanese Design Law to Design Protection in Virtual Space — In Light of International Trends (星野光秀, Patent, October 2025)** ① This introduces an article comparing potential Japanese legal responses to design protection in virtual space with systems and discussions in Europe and the United States. ② It distinguishes expansion of image-design protection from the extension of rights in physical articles to virtual goods and examines the balance between industrial development and freedom of creation. ③ It is necessary to consider not only expansion of design law but also the allocation of roles with copyright and unfair competition prevention law and international harmonization.
Trademark	**[Article / Trademarks] Treatment under Trademark Law of Goods and Services Relating to Virtual Space — The Nice Classification and the Situations in Europe, the United States, South Korea, and Japan (星野光秀, Patent, June 2025)** ① This introduces an article on the Nice Classification and national practices concerning classification and identification of goods and services related to virtual space. ② It explains that virtual goods should be specifically identified and generally classified in Class 9, while the classification of services may change according to the purpose and result of provision. ③ Comprehensive descriptions such as virtual goods should be avoided, and designations should correspond to the content and the purpose of the services provided.

Category	Article Title and Three-Line Summary
Trademark	**[Article / Trademarks] Consideration of the Use of the "Consent System" through Model Cases (中山真理子 and 竹山尚治, Patent, October 2025)** ① This introduces an article using model cases to examine preparation of agreements and written opinions under the trademark consent system. ② It explains that consent alone does not lead to registration and that likelihood of confusion must be examined in light of goods and services, distribution channels, consumers, and manner of use. ③ It is important to agree specifically on measures to avoid confusion and prove in written opinions the actual trading circumstances not fully covered in the agreement.
Patent	**2023 (Gyo-Ke) No. 10149 [Multi-Branched Heat Exchanger with Independent Baffles] <Presiding Judge Miyasaka>** ① The issues were correspondence between an amended heat-exchanger invention and the baffle cells of a cited invention, and motivation to combine. ② The court held that the baffle cells corresponded to solid walls and that separate walls meant functional distinction regardless of physical separation, and affirmed motivation based on the common technical field and the baffles serving as a means of solving the problem. ③ Correspondence with cited inventions should be examined not only by component names but also by their effects on fluid and functional distinctions.

Category	Article Title and Three-Line Summary
Patent	**2024 (Ne) No. 10038 [Brake Control Device and Behavior Analysis Device for a Motorcycle] <Presiding Judge Honda>** ① The issue was whether a brake-control formula satisfied the support requirement by interpreting angular velocity as an erroneous reference to angular acceleration. ② The court refused that reading where the specification consistently referred to angular velocity and found a support violation, holding that physical meaninglessness alone did not establish an error in the description. ③ Physical consistency of formulas and definitions of symbols should be checked at filing, and arguments of erroneous description should be assessed against the specification as a whole.
Trademark	**[Trademarks / Similarity] 2025 (Gyo-Ke) No. 10111 “SORA” <Presiding Judge Moritomi>** ① The issues were separate observation of the SORA trademark’s device and word elements and similarity of beauty-related services. ② The court extracted the SORA word element as dominant and found the marks similar, also finding the designated services similar in light of actual trading circumstances. ③ It is necessary to examine distinctiveness of the word element and the reality of combined service provision, rather than seeking to avoid conflict merely by adding a device.

Category	Article Title and Three-Line Summary
Trademark	**[Article / Austrian Trademarks] A Consideration of the Protection of Well-Known Trademarks and Unfair Use through Packaging Imitation Learned from the "Jägermeister" Case (遠藤華英, Patent, November 2025)** ① This addresses protection of the well-known Jägermeister trademark and imitation of packaging, with the body introducing an Austrian Supreme Court decision. ② It examines association with a well-known mark, free riding on its reputation, and damage to reputation under both trademark law and unfair competition prevention law. ③ Adoption of packaging should be considered not only in terms of confusion but also association with the brand and use of its reputation.
IP in General	**[Article / Customs] Customs Expert Advisers (磯貝克臣, Patent, November 2025)** ① This introduces an article addressing the selection of customs expert advisers, conduct of proceedings, and preparation of written opinions. ② It explains how three expert advisers form their opinions through individual review, advance meetings, and a hearing, and how customs generally respects the majority opinion. ③ It is important to assemble supporting materials and reasoning through explanations and rebuttals at the hearing of opinions and responses to the expert advisers' questions.

Category	Article Title and Three-Line Summary
IP in General	**[Article / Intellectual Property in General] Patent Attorneys as Judicial Research Officials (髙村和宗 and 岩永勇二, Patent, November 2025)** ① This introduces an article on the position and duties of judicial research officials who are patent attorneys and points to note in litigation practice. ② It describes their advance research, attendance at hearings, and preparation of reports, emphasizing early submission of cancellation grounds and reliability of experimental proof. ③ Arguments and evidence should be assembled in the plaintiff's first preparatory brief, and responses should be prepared with attention to the intent of questions at technical explanation sessions.
IP in General	**[Article / Intellectual Property in General] A Note on the Prohibition of Abuse of Rights in Intellectual Property Infringement (森本晃生, Patent, December 2025)** ① This introduces an article examining the role of the prohibition of abuse of rights in intellectual property infringement through the Ricoh and Goldfish Telephone cases and others. ② It explains, as proposals of the article, solutions that separately adjust the availability of injunctions and disposal and payment equivalent to royalties. ③ In abuse-of-rights arguments, it is important to distinguish injunctions from monetary relief and examine their relationship with implementers' benefits and freedom of expression and business.

Category	Article Title and Three-Line Summary
Patent	**[Article / Patents] Research and Proposals on Lack of Unity of Inventions Expressed as Alternatives (Biotechnology and Life Sciences Committee, Patent, December 2025)** ① This introduces an article on unity and selection of the subject of examination for inventions expressed in alternatives, such as Markush form. ② It compares Japan's treatment of the first alternative with U.S. and European practices and examines addition or assertion of a common special technical feature and amendment to an inclusive relationship. ③ Filing and amendment policies should consider the order of alternatives and common structures, as well as shift amendments and the burdens of divisional applications.
IP in General	**[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)** ① This introduces an article on IP mixes and brand formation in agriculture, forestry, and fisheries with overseas expansion in view. ② It explains combinations of trademarks, plant breeders' rights, patents, and GIs through examples including Beni Madonna, Soratobu Pumpkin, Zentsuji-san Shikaku Suika, and Kobe Beef. ③ It is important to distinguish variety names from brand names and select which technologies to disclose and which cultivation techniques to manage as trade secrets.

Category	Article Title and Three-Line Summary
Design	**[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)** ① This introduces an article examining court decisions on consideration for employee-created designs through differences from employee inventions. ② It explains the effect of design substitutability on excess sales and hypothetical royalty rates and the assessment of creators' contributions. ③ It is necessary to examine alternative design choices and individual creative contributions instead of applying patent calculation examples unchanged.
Patent	**[Article / Patents] Cases and Issues in Patent Protection of Biopharmaceuticals (Biotechnology and Life Sciences Committee, Patent, December 2025)** ① This introduces an article on systems and issues surrounding patent protection of biopharmaceuticals and biosimilar entry. ② It explains the effects on entry and choice of de facto patent linkage, re-examination periods, and the high-cost medical expense benefit system. ③ Entry conditions should be examined with regard to use and formulation patents and the approval system, rather than judged solely by expiration of a substance patent.

Category	Article Title and Three-Line Summary
Patent	**[Article / Patents] Points to Note When Filing Food-Use Inventions in Different Countries (Biotechnology and Life Sciences Committee, Patent, December 2025)** ① This introduces an article on system differences in the United States, Europe, China, and South Korea concerning overseas protection of food-use inventions. ② It organizes permissible claim forms, U.S. inherency and laws of nature, and the European distinction between therapeutic and non-therapeutic uses. ③ Instead of translating Japanese claims unchanged, claim forms suited to the destination and distinctiveness of structures and methods should be considered.
Design	**[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)** ① This introduces an article examining court decisions on consideration for employee-created designs through differences from employee inventions. ② It explains the effect of design substitutability on excess sales and hypothetical royalty rates and the assessment of creators' contributions. ③ It is necessary to examine alternative design choices and individual creative contributions instead of applying patent calculation examples unchanged.

Category	Article Title and Three-Line Summary
IP in General	**[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)** ① This introduces an article on IP mixes and brand formation in agriculture, forestry, and fisheries with overseas expansion in view. ② It explains combinations of trademarks, plant breeders' rights, patents, and GIs through examples including Beni Madonna, Soratobu Pumpkin, Zentsuji-san Shikaku Suika, and Kobe Beef. ③ It is important to distinguish variety names from brand names and select which technologies to disclose and which cultivation techniques to manage as trade secrets.
Design	**[Article / U.S. Designs] Changes in the Methods for Determining Design Right Infringement in the United States (佐々木眞人, Patent, January 2026)** ① This introduces an article on changes in U.S. design infringement analysis from Gorham through Egyptian Goddess and thereafter. ② It explains that after abolition of the point of novelty test, overall ornamental impression is evaluated from the viewpoint of an ordinary observer familiar with prior designs. ③ Comparison with allegedly infringing products should include prior designs, functional aspects, and ornamental differences such as logos.

Category	Article Title and Three-Line Summary
Patent	**[United States] Focus Prod v. Kartri Sales (CAFC, 2025.9.30)** ① The issue was whether responses during an election of species in U.S. patent prosecution resulted in exclusion from claim scope. ② The CAFC held that the features of claim 73, which the examiner withdrew as drawn to a nonelected species without the patentee disputing the withdrawal, had been excluded from the claims of the ’248 and ’609 patents, and, as to Marquis, reversed the summary judgment of infringement of those patents (the infringement findings against Kartri were affirmed because Kartri waived its non-infringement arguments). ③ In electing species, it is necessary to check the examiner’s definitions and limitations and consider their effect on the claim scope for the features of unelected species.
Patent	**2024 (Gyo-Ke) No. 10017 [Optimized Nutritional Formulations, Methods for Selecting Tailored Diets Therefrom, and Uses Thereof] <Presiding Judge Miyasaka>** ① The issue was inventive step concerning numerical ranges and inclusion of polyphenols in a nutritional formulation. ② In light of the cited disclosure of 1–35 g of ω-6 fatty acid and well-known matters, the court held that setting 1–40 g and including polyphenols were matters a skilled person could appropriately implement. ③ It is necessary to examine whether differences are merely matters of design in light of inclusion relationships between numerical ranges and known properties of the components.

Category	Article Title and Three-Line Summary
Patent	**Tokyo District Court, 2024 (Wa) No. 4142 [Portable Information Communication Device and Personal Computer System Using the Portable Information Communication Device] <Presiding Judge Kokubu> (related case decided the same day: Tokyo District Court, 2024 (Wa) No. 70083, defendant SoftBank Corp.)** ① An amount equivalent to consumption tax that had not been claimed in prior actions was sought in a separate action as unjust enrichment arising from patent infringement. ② The court found no difficulty or reasonable ground for not asserting that amount earlier and dismissed the action as inadmissible for violating good faith because the remainder claim imposed a second defense burden on the defendant. ③ Monetary claims should be organized to include consumption tax amounts, with attention to restrictions on claims for the remainder following a partial loss.

[Article / Unfair Competition Prevention Act] The Practice and Theory of Preservation of Evidence in Intellectual Property Cases and Related Matters (高村隆司, Patent, June 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e4%b8%8d%e7%ab%b6%e6%b3%95%e3%80%91%e7%9f%a5%e8%b2%a1%e4%ba%8b%e4%bb%b6%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e8%a8%bc%e6%8b%a0%e4%bf%9d%e5%85%a8%e3%81%ae%e5%ae%9f%e9%9a%9b/

Publication date on list page: June 26, 2026

[Article / Unfair Competition Prevention Act] The Practice and Theory of Preservation of Evidence in Intellectual Property Cases and Related Matters (高村隆司, Patent, June 2025)

1. Selection of Jurisdiction

In the statistics of the Intellectual Property Division of the Tokyo District Court for 2013–2015 obtained through the author's own research, six out of 15 applications were granted, a grant rate of 40%. By contrast, all of the author's nearly ten applications, made mainly to summary courts (including one application to a district court's intellectual property division), were granted, and the author recommends using summary courts.

Note on the statistics: 高村隆司's article, p. 165, states 「認容率は 40%であり、筆者の経験における認容率 100%に比較して大幅に低い。」 ("the grant rate is 40%, substantially lower than the 100% grant rate in the author's experience"). The 40% figure concerns the specified court, period and sample, rather than district courts generally. The author's experience of nearly ten applications also includes one district-court application. The article presents these statistics as the result of the author's own research (p. 165: 「今回の執筆に当り調査した結果、東京地方裁判所知財部の下記の情報が入手できた。」, i.e., "as a result of research conducted for this article, the following information of the Intellectual Property Division of the Tokyo District Court was obtained"). Article, pp. 159 and 165

2. Theory and Legal Nature of Preservation of Evidence

The essence of preservation of evidence is "bringing forward the examination of evidence." A prima facie showing of the risk of concealment, disposal, or alteration of evidence (grounds for preservation of evidence) is necessary, but there is a dispute as to whether the degree of the showing may be "abstract" or must be "fairly specific," and the author's impression from experience is that practice in intellectual property cases follows the former view.

3. Defensive Measures as the Opposing Party

Because preservation of evidence has no physical compulsory force, refusing presentation is also an option.

In that case, there is a risk of “deeming allegations to be true (Articles 232 and 224 of the Code of Civil Procedure)” in the litigation on the merits, but it may be possible to avoid this by presenting the evidence in a later examination of evidence, and tactical consideration is necessary.

https://jpaa-patent.info/patent/viewPdf/4666

[Article / U.S. Designs] New Standards for Determining Obviousness of U.S. Design Patents (佐々木眞人, Patent, June 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%b1%b3%e5%9b%bd%e6%84%8f%e5%8c%a0%e3%80%91%e7%b1%b3%e5%9b%bd%e6%84%8f%e5%8c%a0%e7%89%b9%e8%a8%b1%e3%81%ae%e6%96%b0%e3%81%9f%e3%81%aa%e8%87%aa%e6%98%8e%e6%80%a7%e5%88%a4/

Publication date on list page: June 26, 2026

[Article / U.S. Designs] New Standards for Determining Obviousness of U.S. Design Patents (佐々木眞人, Patent, June 2025)

The CAFC en banc judgment of May 21, 2024 (the LKQ en banc judgment) abolished the “Rosen-Durling test,” which had been used for more than 40 years to determine the obviousness of U.S. design patents.

⇒Going forward, the four factual findings (Graham factors) will also apply to design patents, as they do to utility patents.

1. Previous Test: The End of the Rosen-Durling Test

Until now, in the United States, whether a design is obvious has been determined through the following two strict stages.

①First stage (selection of the primary reference): A single primary reference (a Rosen reference) having design characteristics that are “basically the same” as the claimed design is required.

②Second stage (application of secondary references): Secondary references must be “so related” to the primary reference that application of the features of one to the other is suggested.

This two-stage test was extremely strict compared with the obviousness test for utility patents, and it had been considered difficult to invalidate design patents in the United States.

2. Changes Made by the LKQ En Banc Judgment

The CAFC en banc judgment held that the above test did not accord with the “flexible approach” indicated by Supreme Court precedents (including the KSR Supreme Court judgment) and abolished it.

Going forward, the four factual findings (Graham factors) based on the Graham Supreme Court judgment will apply to design patents, as they do to utility patents.

<Four Elements of the New Determination Method>

①Determination of the scope and content of the prior art: The primary reference need not be “basically the same” as the claimed design. However, it must be analogous art, and the analysis starts with an actual prior design most visually similar in overall appearance. Secondary references must also be analogous art, and reasons for modification and other matters are considered from the perspective of an ordinary designer.

Judgment (LKQ en banc)：https://www.cafc.uscourts.gov/opinions-orders/21-2348.OPINION.5-21-2024_2321050.pdf

②Determination of differences between the claimed design and the prior art: Visual appearance is compared from the viewpoint of an “ordinary designer.”

③Identification of the level of skill in the art: The knowledge of a designer having ordinary skill in designing the article in question is considered.

④Evaluation of secondary considerations: Objective evidence, such as commercial success, industry praise, and copying by others, is considered.

https://jpaa-patent.info/patent/viewPdf/4664

意匠の非自明性判断―LKQ 大合議判決後

2024 年 5 月 22 日、USPTO（米国特許商標庁）は、この判決を受けた審査官向けガイダンス（覚書）を公表した。

項目	Rosen–Durling テスト（旧）	LKQ 大合議判決後の基準（新）
主引例要件	クレーム意匠と「基本的に同一」	類似技術であることを要する。全体の外観が最も近い実在する先行意匠を起点とする。「基本的に同一」である必要はない。
副引例	主引例と「密接に関連」	類似技術であることを要する。
結合動機	厳格な関連性が要求される。	通常の創作者の観点から、変更の理由等を柔軟に検討する。

English translation

On May 22, 2024, the USPTO (U.S. Patent and Trademark Office) published guidance (a memorandum) for examiners following this judgment.

Item	Rosen-Durling Test (Old)	Test after the LKQ En Banc Judgment (New)
Requirement for the primary reference	“Basically the same” as the claimed design	Must be analogous art; an actual prior design most visually similar in overall appearance is the starting point. “Basically the same” is not required.
Requirement for secondary references	“So related” to the primary reference	Must also be analogous art; the requirement that the references be “so related” is abolished.
Motivation to combine	Strict relatedness is required	A reason for a designer to modify is sufficient (flexible determination)

[Article / Unfair Competition Prevention Act] Infringement Risks Arising from the Use of Other Companies' Trade Secrets Brought in by Employees Changing Jobs (石本貴幸, Patent, October 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e4%b8%8d%e7%ab%b6%e6%b3%95%e3%80%91%e8%bb%a2%e8%81%b7%e8%80%85%e3%81%8c%e6%8c%81%e3%81%a1%e8%be%bc%e3%82%93%e3%81%a0%e4%bb%96%e7%a4%be%e5%96%b6%e6%a5%ad%e7%a7%98%e5%af%86/

Publication date on list page: June 26, 2026

[Article / Unfair Competition Prevention Act] Infringement Risks Arising from the Use of Other Companies' Trade Secrets Brought in by Employees Changing Jobs (石本貴幸, Patent, October 2025)

1. "Four Defensive Measures" That Intellectual Property and Legal Personnel Should Take

①Written Pledge at the Time of Joining the Company (Calling Attention)
Obtain a written pledge expressly stating that "no confidential information from the previous employment will be brought in." This also serves as evidence that the company does not tolerate wrongdoing.

②Effective Employee Training
Thoroughly instill awareness that "using another company's information is also unlawful." In particular, training "subordinates where a person changing jobs becomes their superior" is the key to preventing tragedies such as the conveyor-belt sushi case.

③Establishment of an Internal Consultation Desk (a Place of Refuge)
Build a system enabling consultation with the legal or intellectual property department when a superior orders the use of suspicious data.

④Detection of "Unnatural Inventions" Through Intellectual Property Activities
When a person changing jobs produces advanced results (such as formulation tables or design drawings) immediately after joining the company, closely examine

the process by which they were created (experimental data, etc.) and check for diversion of another company's information.

★Experience and Skills: Knowledge generally available in the industry and skills embodied in an individual are free.

https://jpaa-patent.info/patent/viewPdf/4722

転職者による営業秘密持込みの事例

事件	行為	論稿が紹介する結果
回転寿司原価情報事件	競合他社の元役員が原価データを持ち込み、転職先の部下に分析・使用させた。	元役員、転職先の部下、法人のすべてに有罪判決。
塗料配合情報事件	開発部長が配合表を持ち込み、転職後わずか数ヶ月で「発明」として開示。	本人は有罪。法人は和解金を含む訴訟費用 3 億 7200 万円を特別損失に計上。
リフォーム事業情報事件	原価・粗利データを共有フォルダに保存し、部内会議等で使用。	本人は有罪。法人に対して 1815 万円の損害賠償等が認められた。
自動車部品情報事件	退職後に元同僚の ID を使って情報を不正取得。	本人に有罪判決。

English translation

Conveyor-belt sushi cost information case	A former officer of a competitor brought in cost data and had subordinates at the new employer analyze and use it.	The former officer, subordinates at the new employer, and the corporation were all convicted.
Paint formulation information case	A development department head brought in formulation tables, disclosing them as an "invention" only a few months after changing jobs.	The individual was convicted. The corporation recorded ¥372 million in litigation costs, including the settlement, as an extraordinary loss.
Renovation business information case	Cost and gross-profit data were stored in a shared folder and used in departmental meetings and elsewhere.	The individual was convicted. Damages of ¥18.15 million and other relief were awarded against the corporation.
Automotive parts information case	Information was unlawfully acquired after leaving employment by using a former colleague's ID.	The individual was convicted.

Source for the table: 石本貴幸's article, p. 118, states that the company in the paint formulation information case recorded ¥372 million in litigation costs, including the settlement, as an extraordinary loss. For the renovation business information case, p. 119 states that damages of ¥18.15 million and other relief were awarded. Article, pp. 118–119

[Article / Patents] Examination of Clarity Determinations in Recent Court Decisions (岡田健太郎 et al., Patent, June 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e8%bf%91%e6%99%82%e3%81%ae%e8%a3%81%e5%88%a4%e4%be%8b%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e6%98%8e%e7%a2%ba%e6%80%a7%e5%88%a4%e6%96%ad%e3%81%ab/

Publication date on list page: June 26, 2026

[Article / Patents] Examination of Clarity Determinations in Recent Court Decisions (岡田健太郎 et al., Patent, June 2025)

It cannot be said that determinations of clarity have become stricter than before!!

1. Determination of Expressions Indicating Degree, Such as “Substantially” and “Approximately”
An Example Found Unclear
The Dies for Polygonal Cross-Section Wire case (No. 17): It was not possible to distinguish whether the expression “substantially polygonal” referred to rounding (tolerance) unavoidably occurring in the manufacturing process or to intentional changes in shape, and the scope of rights was held unclear.

An Example Found Clear
The Tillage Claw case (No. 10): Regarding “substantially” in “at substantially the same position” and “at a substantially constant distance,”
The expression could be understood to mean within the range of mechanical tolerances, and a person skilled in the art could identify the range in light of common general technical knowledge; it was therefore held clear.

2. Trends in Determinations by the Patent Office (Trial Decisions) and Courts (Judgments)
While the Patent Office emphasizes whether formal descriptions exist, courts tend to evaluate substantively whether a person skilled in the art can understand them.
<Patent Office> Where the specification does not describe a direct definition or

calculation method, the Patent Office tends to make a formal determination of “unclear.”
<Courts> Even if the specification is insufficiently described, courts consider common general technical knowledge at the time of filing and relevant research results and find the invention “clear” if a person skilled in the art can reasonably understand the scope of rights (examples: the Tape for Fixing In-Vehicle Components case and the Cell Separation Method case).

3. Proposals for Practice
Although determinations of clarity by courts remain flexible, the following measures are effective in preventing disputes.
Definitions of Terms: Include explanations providing guidance for interpretation in the specification even for general terms such as “simultaneously” and “integrally.”
Supplementation of Common General Technical Knowledge: Where numerical limitations are difficult, cite public standards such as JIS or ASTM standards and expressly indicate an objective basis for determination.
Avoidance of PBP: In principle, strive for drafting that identifies a product by its structure and characteristics; where describing a manufacturing process is unavoidable, logically explain the relationship between that process and the product’s structure.

https://jpaa-patent.info/patent/viewPdf/4661

2024 (Gyo-Ke) No. 10036 [Chip Detection Device] <Presiding Judge Honda>

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110036%e3%80%90%e5%88%87%e5%b1%91%e6%a4%9c%e5%87%ba%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e6%9c%ac%e5%a4%9a%ef%bc%9e/

Publication date on list page: June 26, 2026

2024 (Gyo-Ke) No. 10036 [Chip Detection Device] <Presiding Judge Honda>

*Cancellation of a trial decision to grant a patent was sought. ⇒Dismissed as inadmissible

In the trial against the decision of refusal of the patent application, the plaintiff sought a trial decision stating: “The decision dismissing the amendment is cancelled; on the basis of that amendment, the original decision is cancelled. A patent is to be granted for the invention of this application.” (that amendment being Amendment 1 at issue).
During the proceedings, the plaintiff made amendments on June 9 and December 4, 2023 (the latter being Amendment 2 at issue), and ultimately the Patent Office made a trial decision stating: “The original decision is cancelled. A patent is to be granted for the invention of this application.” This trial decision granted a patent for the invention based on Amendment 2 at issue (Amended Invention 2 at issue), which the plaintiff had submitted last.
⇒The plaintiff brought an action seeking cancellation of the trial decision at issue and other relief, asserting that the invention based on Amendment 1 at issue (Amended Invention 1 at issue) was the invention that should originally have been patented.

This judgment held that, because the trial decision at issue granted all of the requests of the plaintiff as the demandant, the plaintiff had no interest in cancelling it, and that it is impermissible to disavow an amendment previously made at one’s own discretion and seek cancellation of a trial decision made as

requested in order to obtain a patent for the invention that would have been granted had the amendment not been made.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93722.pdf

[Article / Patents] Use of AI in Patent Examination (五十嵐康弘, Patent, August 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e7%89%b9%e8%a8%b1%e5%af%a9%e6%9f%bb%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8bai%e3%81%ae%e6%b4%bb%e7%94%a8%ef%bc%88%e4%ba%94%e5%8d%81%e5%b5%90/

Publication date on list page: June 26, 2026

[Article / Patents] Use of AI in Patent Examination (五十嵐康弘, Patent, August 2025)

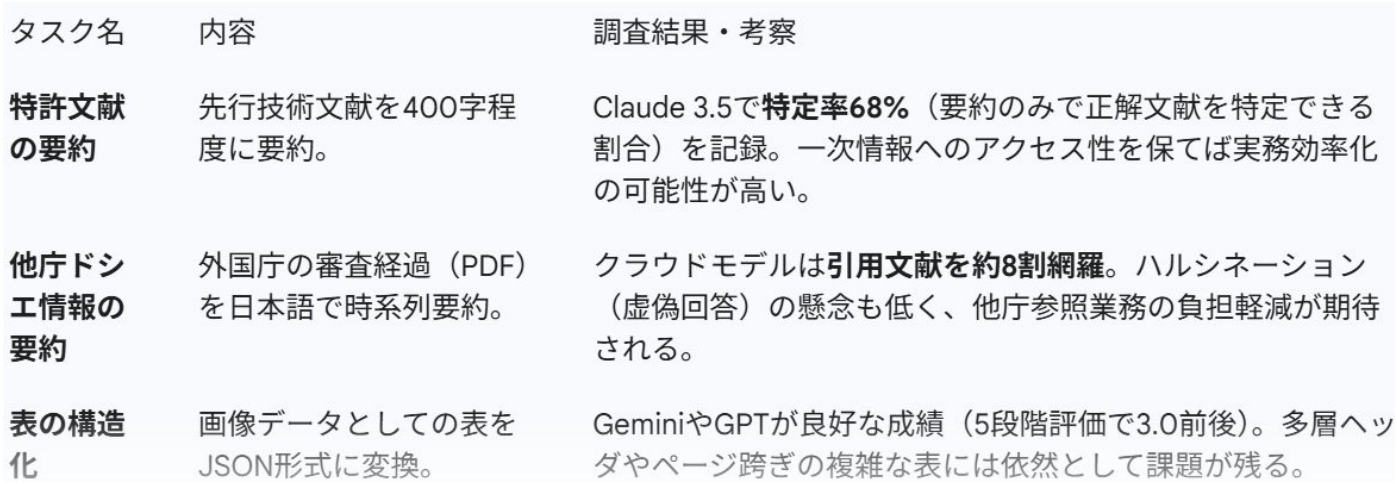
Practical tasks in patent examination were tested using cloud models (GPT, etc.) and on-premises models (Llama, etc.).

When introducing generative AI, there are distinctive issues that did not exist with conventional AI.
Addressing hallucinations: It is effective to minimize risks by limiting tasks to those that “reduce (summarize)” or “convert (translate)” information, rather than tasks that “increase” information (creative responses).
Responding to the speed of model evolution: Evolution is so rapid that new models appear during an investigation, making it necessary to prevent methods from becoming obsolete.
While watching the evolution of general-purpose models, incorporating “thought processes (reasoning)” specialized for the patent field will be the key going forward.

Generative AI is now evolving into “reasoning models,” which perform logical inference, and “agent models,” which operate external tools.

In specialized fields such as patent examination, continued “trial and error toward practical application” is necessary to reflect examiners’ comprehensive search methods and patent-specific vocabulary, rather than merely introducing general-

purpose models.
Going forward, it will be important to determine when to pursue specialization in particular fields while making maximum use of basic performance (such as context length), whose evolution has slowed.
https://jpaa-patent.info/patent/viewPdf/4704



タスク名	内容	調査結果・考察
特許文献の要約	先行技術文献を400字程度に要約。	Claude 3.5で**特定率68%**（要約のみで正解文献を特定できる割合）を記録。一次情報へのアクセス性を保てば実務効率化の可能性が高い。
他庁ドシエ情報の要約	外国庁の審査経過（PDF）を日本語で時系列要約。	クラウドモデルは**引用文献を約8割網羅**。ハルシネーション（虚偽回答）の懸念も低く、他庁参照業務の負担軽減が期待される。
表の構造化	画像データとしての表をJSON形式に変換。	GeminiやGPTが良好な成績（5段階評価で3.0前後）。多層ヘッダやページ跨ぎの複雑な表には依然として課題が残る。

English translation of text in the image

Task	Content	Investigation Results and Considerations
Summarization of patent documents	Summarize prior-art documents in approximately 400 characters.	Claude 3.5 recorded an identification rate of 68% (the proportion of correct documents identified using only summaries). There is strong potential for practical efficiency if accessibility to primary information is maintained.
Summarization of other offices' dossier information	Summarize the prosecution history (PDF) of a foreign office chronologically in Japanese.	Cloud models covered approximately 80% of cited documents. Concern over hallucinations (false responses) is also low, and a reduction in the burden of referring to other offices' information is expected.
Structuring of tables	Convert tables in image data into JSON format.	Gemini and GPT perform well (around 3.0 on a five-point scale). Challenges remain for complex tables with multilayer headers or spanning pages.

AI 技術の進展と特許審査への応用（論文掲載時点）

時代区分	主な技術と特徴
機械学習期（～2012 年）	SVM（サポートベクターマシン）や決定木など。分類付与支援、検索式の作成支援等に応用。
ディープニューラルネットワーク期（2012～2016 年ごろ）	DNN による深層学習が画像認識等で注目され、RNN による機械翻訳が実用化。

時代区分	主な技術と特徴
大規模言語モデルと応用拡大期（2017〜2021 年ごろ）	Transformer を基盤とした BERT や GPT が注目され、転移学習により応用が拡大。
生成 AI による普及期（2022〜2025 年現在）	GPT-4o、Claude 3.5、Gemini 1.5 などのモデルを用いた要約、翻訳、構造化等の生成タスクへの応用。

機械分類付与の精度比較に用いられた基準は非特許 BERT である。SVM・LightGBM 等に替わる手法として、DeBERTa の導入が順次進められている。

English translation

• Machine-learning period (up to 2012)
: SVM and decision trees; practical
applications include classification support and search-expression support.
• Deep-neural-network period (around 2012–2016): DNN-based deep learning gained attention through image recognition; RNN-based machine translation became practical. • Period of large language models and expanding applications (around 2017–2021)
: Transformer-based BERT and GPT attracted attention, and transfer learning broadened applications. • Generative-AI dissemination period (2022–2025, the article’s present): Models such as GPT-4o, Claude 3.5 and Gemini 1.5 were examined
for generation tasks including summarization, translation and structuring. For machine classification assignment, the accuracy comparison uses non-patent BERT as its baseline. DeBERTa was being introduced as a replacement for SVM, LightGBM and other methods.

Source for the chronology: 五十嵐康弘’s article, p. 33, identifies four periods: machine learning (up to 2012); deep neural networks (around 2012–2016); large language models and expanding applications (around 2017–2021); and dissemination through generative AI (2022–2025, the article’s present). The baseline for the accuracy comparison on p. 34 is non-patent BERT. On p. 35, SVM and LightGBM are methods being replaced by DeBERTa. Article, pp. 33–35

[Article / Chinese Patents] The Support Requirement for Numerical Range Limitations in China (胡春豊 and 林軍, Patent, September 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e4%b8%ad%e5%9b%bd%e7%89%b9%e8%a8%b1%e3%80%91%e4%b8%ad%e5%9b%bd%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e6%95%b0%e5%80%a4%e7%af%84%e5%9b%b2%e3%81%ae%e9%99%90%e5%ae%9a%e3%81%ab/

Publication date on list page: June 19, 2026

[Article / Chinese Patents] The Support Requirement for Numerical Range Limitations in China (胡春豊 and 林軍, Patent, September 2025)

<Supreme People's Court of China, (2020) Zui Gao Fa Zhi Xing Zhong No. 407>

1. Consideration of the Judgment of the Supreme People's Court of China
Content of the Patent: An invention with numerical limitations combining a charging cut-off voltage (greater than 4.2 V and not greater than 5.8 V) and a positive/negative electrode ratio (1:1.0 to 1:2.5).

Issue: The specification stated that "characteristics deteriorate when the parameters exceed the ranges," and Apple asserted that "ranges not covered by the examples (ranges in which the purpose of the invention cannot be achieved) are included, and the support requirement is not satisfied."

First-Instance Judgment: Holding that "a considerable part of the scope of claim 1 was expressly excluded by the specification, and the generalized scope of claim 1 is too broad relative to the scope disclosed in the specification," the court set aside the invalidation trial decision that had found Apple's invalidity grounds not established and ordered the China National Intellectual Property Administration to re-examine the case (Article, pp. 96–97).

Determination of the Supreme People's Court (Victory on Reversal)
"If a person skilled in the art reads the specification and can confirm mutually corresponding relationships between the technical features of the respective numerical ranges, obtain embodiments meeting the purpose of the invention

through a limited number of experiments, and exclude inventions that cannot achieve the purpose of the invention without excessive effort, the claim should be determined to be supported by the specification."

2. Practical Points to Note

In light of this Supreme People's Court judgment, the following measures for drafting specifications and handling invalidation proceedings in China are proposed.

①When Drafting Patent Specifications

Multiple Layers of Independent Claims: Consider a configuration that is readily recognizable, such as providing separate independent claims for each numerical group (data groups of examples) in which the effects can reliably be obtained, in addition to claims covering broad ranges.

②Arrangement of Examples

The basic approach is to cover specific data at the starting, ending, and intermediate values of a range in accordance with the Examination Guidelines.

③During Patent Invalidation Proceedings

Merely asserting that "there is a range in which the purpose of the invention cannot be achieved" is insufficient.

It is necessary to use more specific experimental results to prove that "even by following the guidance in the specification, a person skilled in the art cannot recognize the scope of protection (the range in which the effects are obtained) with ordinary effort."

3. Summary

The Supreme People's Court of China indicated a new criterion for the support requirement for numerical ranges: "whether a person skilled in the art can exclude non-working ranges without excessive effort."

It can therefore be said that, even for broad numerical limitations, the possibility of maintaining the rights has increased if the specification contains appropriate guidance.

https://jpaa-patent.info/patent/viewPdf/4697

[Article / European Patents] Differences Between the Japanese and European Patent Systems That Require Attention (野村和弘 and フロリアン キューベック, Patent, September 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e6%ac%a7%e5%b7%9e%e7%89%b9%e8%a8%b1%e3%80%91%e6%97%a5%e6%9c%ac%e3%81%ae%e7%89%b9%e8%a8%b1%e5%88%b6%e5%ba%a6%e3%81%a8%e6%ac%a7%e5%b7%9e%e3%81%ae%e7%89%b9%e8%a8%b1-%e5%88%b6/

Publication date on list page: June 19, 2026

[Article / European Patents] Differences Between the Japanese and European Patent Systems That Require Attention (野村和弘 and フロリアン キューベック, Patent, September 2025)

1. Differences Concerning “Claims”
①Number of Independent Claims:
Japan: No limitation.
Europe: In principle, one per category (Rule 43(2)). Multiple independent claims are not permitted except for exceptions such as interrelated products like a plug and socket, or alternative solutions.

②Categories and Use Limitations:
Japan: Three types: “product,” “process,” and “process for producing a product.” Use limitations (e.g., for anti-fatigue use) are given relatively strong effect.
Europe: Two types: “physical entity” and “activity.” A use limitation such as “a device for ...” is interpreted merely as “a device suitable for ...” and has weak limiting effect. Therefore, use claims in the form of “non-therapeutic use” are recommended.

③Multiple Dependency (Multiple-Multiple Dependent Claims):
Japan: Restricted since April 2022 (violation of requirements under the delegated ministerial ordinance).
Europe: No restriction. However, additional fees arise where the number of claims is 16 or more.

④Reference Signs:
Europe: It is strongly desirable to insert drawing reference signs in parentheses in the claims (Rule 43(7)).

2. “Prior Art and Publication of Earlier Applications” (Self-Collision and Grace Periods)
In Europe, “one’s own applications” can become powerful grounds for refusal, so attention to filing strategy is required.

3. “Restrictions on Amendments” (Europe’s Strict “Gold Standard”)
European amendment requirements are far stricter than those in Japan, and disclosure in the original specification must be “direct and unambiguous.”

<Amendments to Numerical Limitations>: In Europe, it is very difficult to adopt a value not expressly stated in the specification (for example, an intermediate value of examples) as a boundary value. Combinations of preferred ranges should be expressly stated in the specification in advance.

<Excluding Claims (Disclaimers)>
Japan: Cases in which they are used to overcome a lack of inventive step are increasing.
Europe: G 1/03 addresses undisclosed disclaimers, that is, exclusions without a basis in the application as filed. The decision identifies circumstances permitting restoration of novelty over prior art under Article 54(3) and (4) EPC 1973 (now Article 54(3) EPC) or an accidental anticipation, as well as exclusion of subject matter excluded from patentability for non-technical reasons. An undisclosed disclaimer relevant to assessing inventive step or sufficiency of disclosure is not allowable. Disclaimers disclosed in the application as filed must be distinguished.

Note on the scope of the source: G 1/03, Headnote II, refers to “not disclosed in the application as filed”; II.1 refers to “non-technical reasons”. In summary, the criteria concern undisclosed disclaimers and are not confined to restoring novelty. The source article is coauthored by 野村和弘 and フロリアン キューベック. Article, pp. 82 and 88 G 1/03

4. “Parameter Inventions”
Where an invention is identified by a special parameter, strict treatment of the “measurement method” is required in Europe.
Points to Note in Europe: The measurement method of a parameter may be

required to be stated in the claims themselves, as well as in the specification. In addition, when citing a standard such as an ISO standard, there is a risk of being found unclear unless the issue date (year) is specified, taking account of changes to the standard.

5. Summary and Proposals

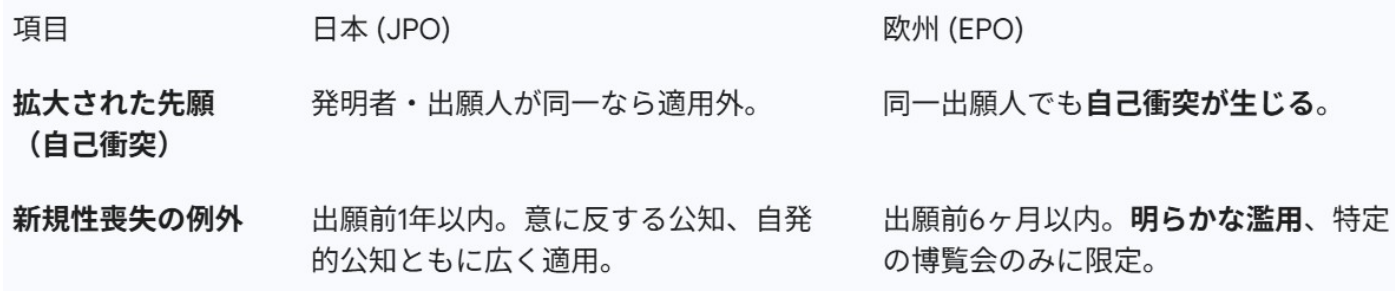
When considering expansion into Europe based on a Japanese application, the following preparations are essential.

①Considering Europe's distinctive restrictions on independent claims, file related inventions on the same day wherever possible.

②Because freedom to amend is limited, include diverse numerical ranges and sets in multiple-dependent form in the specification in advance.

③To minimize the risk of loss of novelty through disclosure, treat the European grace period, in principle, as "nonexistent."

https://jpaa-patent.info/patent/viewPdf/4696



項目	日本 (JPO)	欧州 (EPO)
拡大された先願（自己衝突）	発明者・出願人が同一なら適用外。	同一出願人でも**自己衝突が生じる**。
新規性喪失の例外	出願前1年以内。意に反する公知、自発的公知ともに広く適用。	出願前6ヶ月以内。**明らかな濫用**、特定の博覧会のみに限定。

English translation of text in the image

Item	Japan (JPO)	Europe (EPO)
Enlarged earlier applications (self-collision)	Excluded if the inventor or applicant is the same.	Self-collision occurs even for the same applicant.
Exceptions to loss of novelty	Within one year before filing. Broadly applies to both disclosure against one's will and voluntary disclosure.	Within six months before filing. Limited to evident abuse and certain exhibitions.

[Article / UK Patents] The UK InterDigital v. Lenovo Litigation over the Calculation of FRAND Rates (小林和人, Patent, September 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e8%8b%b1%e5%9b%bd%e7%89%b9%e8%a8%b1%e3%80%91frand%e3%83%ac%e3%83%bc%e3%83%88%e3%81%ae%e7%ae%97%e5%ae%9a%e3%82%92%e5%b7%a1%e3%82%8b-interdigital-v-lenovo-%e8%8b%b1/

Publication date on list page: June 19, 2026

[Article / UK Patents] The UK InterDigital v. Lenovo Litigation over the Calculation of FRAND Rates (小林和人, Patent, September 2025)

<Main Issues>
①Whether InterDigital's final offer (5G Extended Offer) conformed to FRAND terms.
②If not, what the specific FRAND rate was.
③Whether an injunction would be granted if Lenovo was not a "Willing Licensee."

1. Determination of the UK High Court (EWHC 539, 1578)
The High Court held that neither party's offer was FRAND.
Method of Calculating the FRAND Rate: LG (2017) was selected as the most comparable agreement. Based on it, sales regions and proportions of standards were adjusted, and the rate was calculated as $0.175 per unit (a blended rate).
Determination of the Lump Sum: The entire period from 2007 through the end of 2023 was covered, and $138.7 million was presented as royalties.
Addition of Interest: To eliminate the benefit from delayed payment, interest at 4% per annum, compounded quarterly ($46.2 million), was added, bringing the total to $184.9 million.
Criticism of Volume Discounts: Large discounts of as much as 60–80% applied to Samsung and Apple were identified as discriminatory acts against smaller implementers and as not FRAND.
Whether an Injunction Was Appropriate: Lenovo was given the choice of accepting the judgment's terms and would be subject to an injunction only if it refused.

2. Determination of the Court of Appeal (EWCA Civ 743)
As a result of both parties appealing, the Court of Appeal followed the High Court's logic but revised the figures.
Revision of the Rate: It reviewed the analysis of the LG agreement used for comparison and raised the base rate from $0.24 to $0.30 and the adjustment factor from 0.728 to 0.75.
Final Holding: The FRAND rate was revised upward to $0.225 per unit. As a result, the principal amount of the lump sum became $178.3 million, and the court ordered the addition of the same interest (4% per annum, compounded quarterly).

3. Conclusions and Implications
This is an important case in which UK courts emphasized the "comparative approach" and derived a specific global rate through their own calculations. In particular, the following points are important in practice.

①Payment for the Past: It was held that a willing licensee should pay royalties for the entire past period of implementation, irrespective of the limitation period for damages claims.

②Requirement of Transparency: The risk was shown that extreme preferential treatment of large companies (opaque volume discounts) would be rejected from the viewpoint of non-discrimination.

③Importance of Interest: The addition of compound interest was justified to offset the gains from "holdout" through prolonging negotiations.
https://jpaa-patent.info/patent/viewPdf/4695

項目	InterDigitalの主張	Lenovoの主張
最終オファー	5G Extended Offer（3億3700万ドル）	Lump Sum Offer（8000万ドル）
比較対象	「InterDigital 20」（20件の既契約）	「Lenovo 7」（大手業者を含む7件）
過去分	将来分と同じレートを適用	2016年以前分は無償リリースを主張
ボリュームディスカウント	大規模事業者に適用するのは正当	差別的であり不当と批判

English translation of text in the image

Item	InterDigital’s Arguments	Lenovo’s Arguments
Final offer	5G Extended Offer ($337 million)	Lump Sum Offer ($80 million)
Comparators	“InterDigital 20” (20 existing agreements)	“Lenovo 7” (seven agreements, including major businesses)
Past periods	Apply the same rate as for future periods	Argues for a free release for periods up to and including 2016
Volume discounts	Application to large businesses is justified	Criticized as discriminatory and unjust

[Article / Patents] Intellectual Property and Intangible Assets in the Food Industry (藤原研二郎, Patent, September 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e9%a3%9f%e5%93%81%e7%94%a3%e6%a5%ad%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e7%9f%a5%e8%b2%a1%e3%83%bb%e7%84%a1%e5%bd%a2%e8%b3%87%e7%94%a3%ef%bc%88/

Publication date on list page: June 19, 2026

[Article / Patents] Intellectual Property and Intangible Assets in the Food Industry (藤原研二郎, Patent, September 2025)

1. In the food industry, intellectual property strategies differ greatly depending on the role (from upstream to downstream).

2. Issues Particular to the Food Field
The food industry has difficulties arising from “history” and “sensation” that differ from those in other technical fields.

“Long History and Regionality”: This industry has continued since the beginning of recorded history, with considerable regional differences, making it difficult to understand what is “publicly known worldwide.”

“Flavor as a Complex System (Difficulty of Digitization)”: Food is not a pure substance but a complex composition that changes over time. It is extremely difficult to verify objectively “flavor,” in which taste, texture, and smell intertwine, resulting in a structure in which one must rely on skills (know-how) that cannot be verbalized.

“Monopoly Does Not Necessarily Mean Maximization of Profit”: The appearance of products similar to a new product can increase “eating experience” across the entire market and consequently expand the market.

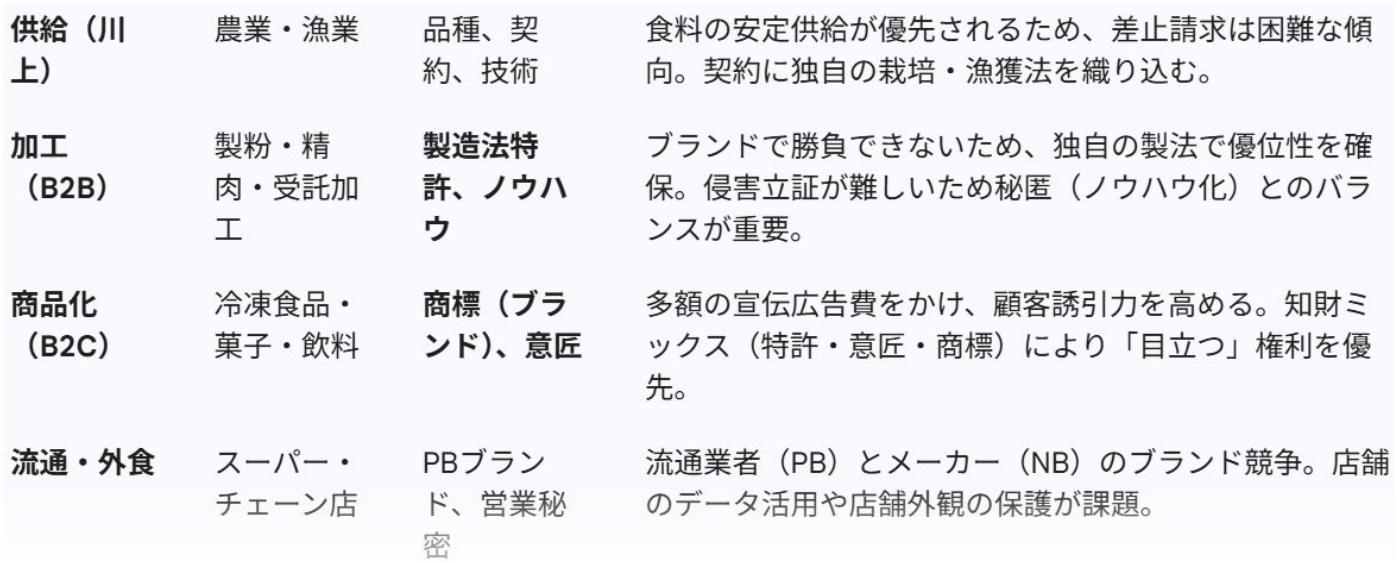
3. Use of Know-How and Intangible Assets
In the food industry, the key to continuing business after patent expiration lies in “management of know-how.”

“Manufacturing Know-How”: How to suppress variability in raw materials and how to guarantee quality standards.

“Brand Story”: Turn trust and stories into intangible assets, as in Mishima Foods’ response to a shortage of “aonori” and Sapporo Breweries’ use of place names.

“Skill Succession (Skills)”: Abandon verbalization and pass skills down as “bodily experience” through training and apprenticeship.

“Identification Know-How”: Incorporate the “uses” and “attachment” spontaneously generated by consumers into brand control.
https://jpaa-patent.info/patent/viewPdf/4690



供給（川上）	農業・漁業	品種、契約、技術	食料の安定供給が優先されるため、差止請求は困難な傾向。契約に独自の栽培・漁獲法を織り込む。
加工（B2B）	製粉・精肉・受託加工	**製造法特許、ノウハウ**	ブランドで勝負できないため、独自の製法で優位性を確保。侵害立証が難しいため秘匿（ノウハウ化）とのバランスが重要。
商品化（B2C）	冷凍食品・菓子・飲料	**商標（ブランド）、意匠**	多額の宣伝広告費をかけ、顧客誘引力を高める。知財ミックス（特許・意匠・商標）により「目立つ」権利を優先。
流通・外食	スーパー・チェーン店	PBブランド、営業秘密	流通業者（PB）とメーカー（NB）のブランド競争。店舗のデータ活用や店舗外観の保護が課題。

English translation of text in the image

Supply (upstream)	Agriculture and fisheries	Varieties, contracts, technology	Because stable food supply takes priority, injunction claims tend to be difficult. Incorporate distinctive cultivation and fishing methods into contracts.
Processing (B2B)	Flour milling, meat processing, contract processing	Manufacturing-process patents, know-how	Because competition through brands is not possible, secure advantages through distinctive manufacturing processes. Because proving infringement is difficult, a balance with secrecy (conversion into know-how) is important.
Commercialization (B2C)	Frozen food, confectionery, beverages	Trademarks (brands), designs	Spend substantial advertising expenses to enhance customer appeal. Give priority to “conspicuous” rights through an IP mix (patents, designs, trademarks).
Distribution and food service	Supermarkets, chain stores	Private-label brands, trade secrets	Brand competition between distributors (PB) and manufacturers (NB). Use of store data and protection of store appearance are issues.

[Article / U.S. Designs] Protection of Goods and Other Subject Matter in Virtual Space under U.S. Design Law (山口洋一郎, Patent, August 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%b1%b3%e5%9b%bd%e6%84%8f%e5%8c%a0%e3%80%91%e7%b1%b3%e5%9b%bd%e6%84%8f%e5%8c%a0%e6%b3%95%e3%81%ab%e3%82%88%e3%82%8b%e4%bb%ae%e6%83%b3%e7%a9%ba%e9%96%93%e3%81%ab%e3%81%8a/

Publication date on list page: June 19, 2026

[Article / U.S. Designs] Protection of Goods and Other Subject Matter in Virtual Space under U.S. Design Law (山口洋一郎, Patent, August 2025)

Note on the author's view and scope: The following introduces the view in 山口洋一郎's article. Page 83 states 「用途の異なる他の物品にも行使可能であると解される」 ("is understood to be enforceable also against other articles having different uses"). By contrast, MPEP 1504.02 states, in discussing novelty, "A design claim is limited to the article of manufacture identified in the claim". An article's use must be distinguished from the article identified in the claim, and novelty from infringement. The following does not mean that enforcement between physical and virtual goods is always available; nor does the MPEP statement alone establish that infringement between them is always excluded. In the table below, the image lists the article for US D1,053,219 S as 「仮想３次元キャラを伴うディスプレイ」 (display with a virtual three-dimensional character), whereas p. 84 of the article states 「仮想３次元のキャラクター・アイコンを伴うディスプレイ・スクリーン」 (a display screen with a virtual three-dimensional character icon). Article, pp. 81–87 MPEP 1504.02

1. Article Use and Claim Limitations in the U.S. Design System
U.S. design law is part of patent law (35 U.S.C. § 171), and patent principles apply. Yamaguchi's article identifies the principle that an article's use is disregarded, as in patent law, as a characteristic. Statements of use must nevertheless be distinguished from a limitation based on the article identified in the claim. Curver recognises the latter limitation.

Yamaguchi's Explanation Concerning Novelty: Even a known design in a technical field entirely different from that of the article of the application can form a basis for lack of novelty if its shape is substantially identical (for example, there is a case in which novelty of a capsule for compressed gas was denied based on the design of a "bottle").

Scope of Rights: Yamaguchi's article expresses the view that design rights may be exercised against other articles having different uses, and also discusses enforcement where the registered design constitutes a part of the allegedly

infringing article. Actual enforcement requires examination of the article identified in the claim and the overall visual appearance, among other matters.

2. Protection of Designs in Virtual Space
In the United States, “icons” and “GUIs” shown on a display are eligible for protection as part of the display.

Enforcement from the Physical to the Virtual: Yamaguchi’s article expresses the view that infringement of design rights for a real product, such as a shoe, may be asserted where that product is displayed and sold on a display in virtual space and is sufficiently similar to cause confusion for an ordinary observer. Individual examination in light of the article identified in the claim and other matters is required.

Enforcement from the Virtual to the Physical: Conversely, Yamaguchi’s article expresses the view that design rights for an article represented on a display in virtual space, such as a virtual three-dimensional shoe, may be enforced against a physical product of the same design. It does not introduce an established judicial rule that infringement between physical and virtual spaces generally occurs.

Related decision (Curver Luxembourg v. Home Expressions)：https://www.cafc.uscourts.gov/opinions-orders/18-2214.opinion.9-12-2019.pdf

3. Recent Registration Examples in the United States
Symbolic registration examples illustrating the flexibility of U.S. Patent and Trademark Office (USPTO) practice are given.

https://jpaa-patent.info/patent/viewPdf/4710

山口論稿で紹介された米国の意匠登録例

登録番号	物品名称（要約）	権利者	対象
US D975,724 S	仮想３次元の靴を伴うディスプレイ	NIKE	仮想空間でのスニーカーデザインに関する登録例。
US D1,053,219 S	仮想３次元のキャラクター・アイコンを伴うディスプレイ・スクリーン	NIKE	仮想オブジェクトとしてのキャラクターに関する登録例。
US D1,021,967 S	作業車両、玩具、仮想モデル等	DEERE	実車、玩具、仮想モデルを１出願に含む登録例。

English translation

Registration Number	Article Name (Summary)	Right Holder	Features
US D975,724 S	Display with a virtual three-dimensional shoe	NIKE	Protects sneaker designs in virtual space.
US D1,053,219 S	Display screen with a virtual three-dimensional character icon	NIKE	Protects a character as a virtual object.
US D1,021,967 S	Work vehicles, toys, virtual models, etc.	DEERE	Covers actual vehicles, toys, and virtual models in a single application.

[Article / Designs] A Consideration of Future Responses under Japanese Design Law to Design Protection in Virtual Space — In Light of International Trends (星野光秀, Patent, October 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e6%84%8f%e5%8c%a0%e3%80%91%e4%bb%ae%e6%83%b3%e7%a9%ba%e9%96%93%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e6%84%8f%e5%8c%a0%e4%bf%9d%e8%ad%b7%e3%81%ab%e9%96%a2%e3%81%99%e3%82%8b/

Publication date on list page: June 19, 2026

[Article / Designs] A Consideration of Future Responses under Japanese Design Law to Design Protection in Virtual Space — In Light of International Trends (星野光秀, Patent, October 2025)

1. Expansion of the Scope of Protection of Image Designs (Protection of GUIs)
Trends in Europe and the United States are contrasting.

Europe (EU): The article states that the amended CDR (Council Regulation on European Union Designs), adopted in October 2024, can be interpreted as allowing virtual objects to be protected without particular limitations and that it has become clear that virtual objects are included. However, because this can be interpreted as having long been the case in the EU, whose situation differs from that of the United States and Japan, where protection has long been limited, the article states that this suggests that the scope is too broad, at least as an expansion for the time being.

United States: In registration practice, if an image is integrated with an “article” in the form of a display screen, even content that does not fall within Japan’s operation images or display images (e.g., virtual shoes or models) may be eligible for protection.

<Implications for Japan>
There is concern that expansion without particular limitations, as in Europe, could chill creators’ creative activities. Meanwhile, the U.S. concept of “integration with

an article," which has a high degree of institutional affinity with Japan, is useful as a compromise that promotes industrial development while relaxing the connection with equipment.

2. Extending the Scope of Working of Design Rights into Virtual Space (from Physical to Virtual)
The issue is whether design rights for articles in the real world (such as cars and furniture) extend to digital objects in virtual space.

Europe (Positive Tendency): It adopts an "abstract view" and recognizes protection regardless of changes in dimensions (from real to digital). This is a position under which digital use of a non-digital design may be regarded as infringement.

United States (Negative Tendency): Negative views are strong due to concerns about giving design right holders unjust "windfall" benefits, the risk of infringing freedom of expression such as photography, and increased examination burdens.

<Consideration of Possible Responses in Japan>
①Proposal to Expand Design Rights Limited to Appearance: Extend rights based on similarity of appearance regardless of use. Although this contributes to protecting investment in design, it requires examination of an enormous amount of prior designs and presents substantial practical examination challenges.
②Proposal to Treat Physical and Virtual Articles as Equivalent: Treat articles as similar only where functions in virtual space are recognized as equivalent to those in the real world. The criteria become clear, but protection needs may not be sufficiently covered.

3. Conclusions and Proposals
Because virtual space has no national borders, responses with awareness of international harmonization of systems are indispensable. When Japan expands its system, it will be important to secure a balance between industrial development and freedom of creation.
Rather than seeking a solution solely through design law, a realistic response is to

advance legal development in stages while clarifying the allocation of roles with copyright law and unfair competition prevention law.

https://jpaa-patent.info/patent/viewPdf/4723

[Article / Trademarks] Treatment under Trademark Law of Goods and Services Relating to Virtual Space — The Nice Classification and the Situations in Europe, the United States, South Korea, and Japan (星野光秀, Patent, June 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e5%95%86%e6%a8%99%e3%80%91%e4%bb%ae%e6%83%b3%e7%a9%ba%e9%96%93%e3%81%ab%e9%96%a2%e3%81%99%e3%82%8b%e5%95%86%e5%93%81%e3%83%bb%e5%bd%b9%e5%8b%99%e3%81%ae%e5%95%86%e6%a8%99/

Publication date on list page: June 19, 2026

[Article / Trademarks] Treatment under Trademark Law of Goods and Services Relating to Virtual Space — The Nice Classification and the Situations in Europe, the United States, South Korea, and Japan (星野光秀, Patent, June 2025)

1. Classification and Identification of Goods and Services in Virtual Space
The following points are commonly recognized in examination practice across countries and regions.
Simply referring to “virtual goods” leaves the scope unclear, and it is necessary to identify the related content specifically, as in “downloadable virtual clothing.”
Treatment as Class 9 (Goods): Because virtual goods are treated as digital content, they are classified in Class 9 in principle.

Changes in the Classification of Services: In principle, classification does not change even if the means of provision is virtual space, but it does change if the “purpose or result of provision” changes (e.g., while real transportation is in Class 39, a travel experience in virtual space is treated as entertainment in Class 41).

2. Main Trends and Characteristics of Countries and Organizations
Distinctive characteristics in practical operations and approaches to classification can be seen in each region.

https://jpaa-patent.info/patent/viewPdf/4662

仮想商品・役務に関する主な取扱い（論稿の整理）

国・機関	主な特徴・取扱い
ニース国際分類	2024 年版より「ダウンロード可能な仮想被服」（9 類）やその小売（35 類）が追加。
欧州（EUIPO／UKIPO）	EUIPO は現実の商品と仮想商品は機能・目的・性質が同一ではないとする。UKIPO は仮想商品が明確に定義された場合にのみ認容する。
米国（USPTO）	現実と仮想の混同は「商業的関連性」に基づいて判断すべきと示唆。
韓国（特許庁）	仮想商品を画像ファイル等とは別の独自の類似群コードで管理。
日本（JPO）	2024 年 3 月にガイドライン公表。役務の代案（例：模擬レストラン）まで示す運用。

English translation

Country / Organization	Main Characteristics and Treatment
Nice Classification	The 2024 edition added “downloadable virtual clothing (Class 9)” and its retail services (Class 35).
Europe (EUIPO/UKIPO)	EUIPO states that real and virtual goods are not identical in function, purpose or nature. UKIPO accepts virtual goods only when they are clearly defined.
United States (USPTO)	Suggests that confusion between the real and virtual should be determined based on “commercial relatedness.”
South Korea (Patent Office)	A distinctive feature is management of virtual goods through separate, independent similarity-group codes, apart from image files and the like.
Japan (JPO)	Guidelines were published in March 2024. Careful operation even indicates alternative descriptions of services (e.g., simulated restaurants).

Source for the table: 星野光秀’s article, p. 112, attributes the statement that virtual goods are not identical in function, purpose or nature to their real-world counterparts to EUIPO material. For UKIPO, p. 113 states that virtual goods are accepted only when clearly defined. Article, pp. 112–113

[Article / Trademarks] Consideration of the Use of the “Consent System” through Model Cases (中山真理子 and 竹山尚治, Patent, October 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e5%95%86%e6%a8%99%e3%80%91%e3%83%a2%e3%83%87%e3%83%ab%e4%ba%8b%e4%be%8b%e3%82%92%e7%94%a8%e3%81%84%e3%81%9f%e3%80%8c%e3%82%b3%e3%83%b3%e3%82%bb%e3%83%b3%e3%83%88%e5%88%b6/

Publication date on list page: June 12, 2026

[Article / Trademarks] Consideration of the Use of the “Consent System” through Model Cases (中山真理子 and 竹山尚治, Patent, October 2025)

1. The Core of Japan’s Consent System: A System with Reservation
Unlike many foreign countries, Japan’s consent system is a “system with reservation.”
⇒Registration is not granted simply because there is “consent” from the holder of the cited trademark; registration under Article 4(4) of the Trademark Act is permitted only where the Patent Office ultimately determines that “there is no likelihood of confusion as to source.”

2. Important Practical Points (Insights from Model Cases)
①Devising the Wording of Agreements (Letters of Consent)
Identification of Goods and Services: Wording that the mark will be “used only for specified goods” is close to essential. However, even without stating specific product names, it is possible to indicate the intention to avoid future confusion by expressly stating differences in distribution channels or consumers.
Between Group Companies: Strong wording such as “take measures to avoid confusion with each other” becomes a strong consideration against confusion.
Addition of a House Mark: According to discussions at an exchange of views with the Japan Patent Office, where a house mark is added only to the applied-for trademark, that fact alone generally makes it difficult to find that there is no likelihood of confusion. However, the article states that agreeing on the wording

“always to be used together with the house mark” may be taken into account in the direction of denying a future likelihood of confusion, particularly where the applied-for and cited trademarks are not highly similar.

②Arguments in Written Opinions
Fact-Based Explanations: “Business realities (consumer groups, expertise, price ranges, and differences in production divisions)” that cannot be fully covered in the agreement should be proved in detail in the written opinion.
Treatment of Non-Use: Where the cited trademark is actually unused, stating that in the agreement may disadvantage the trademark holder; it is therefore recommended to devise “alternative wording (differences in distribution channels),” for example, to avoid the area of de facto non-use.
https://jpaa-patent.info/patent/viewPdf/4718

2023 (Gyo-Ke) No. 10149 [Multi-Branched Heat Exchanger with Independent Baffles] <Presiding Judge Miyasaka>

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c5%e5%b9%b4%e8%a1%8c%e3%82%b110149%e3%80%90%e7%8b%ac%e7%ab%8b%e3%83%90%e3%83%83%e3%83%95%e3%83%ab%e3%82%92%e6%9c%89%e3%81%99%e3%82%8b%e5%a4%9a%e5%88%86%e5%b2%90%e7%86%b1%e4%ba%a4/

Publication date on list page: June 12, 2026

2023 (Gyo-Ke) No. 10149 [Multi-Branched Heat Exchanger with Independent Baffles] <Presiding Judge Miyasaka>

From the description in Cited Document 2, the “baffle cell” itself has a configuration that obstructs fluid flow and changes its direction, and it corresponds to the “baffle” of the amended invention at issue.
In addition, the “baffle cell” includes a solid portion (solid domain) and has the function of blocking the flow path, so it can be described as a “solid wall.”
Furthermore, the meaning of a “wall separate (from the unit cell)” was interpreted as meaning that the elements are functionally “separated” or “different,” regardless of whether they are physically separated, and because the “baffle cell” and “path cell” are functionally distinguished in Cited Invention 2, this also corresponds.
⇒Both inventions concern “heat exchanger” technology in the same technical field and share the configuration of branching flow paths using unit cells. Using baffles to form flow configurations that increase heat transfer efficiency is well-known art (Cited Document 1 contains no description of baffles); therefore, in view of the common technical field and the baffles serving as a means of solving the problem, there is motivation to combine.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93719.pdf

2024 (Ne) No. 10038 [Brake Control Device and Behavior Analysis Device for a Motorcycle] <Presiding Judge Honda>

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%8d10038%e3%80%90%e8%87%aa%e5%8b%95%e4%ba%8c%e8%bc%aa%e8%bb%8a%e3%81%ae%e3%83%96%e3%83%ac%e3%83%bc%e3%82%ad%e5%88%b6%e5%be%a1%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c/

Publication date on list page: June 12, 2026

2024 (Ne) No. 10038 [Brake Control Device and Behavior Analysis Device for a Motorcycle] <Presiding Judge Honda>

Because the description in the specification at issue is consistent in referring to "angular velocity," reading it as "angular acceleration" by correcting an error in the description is not permitted.
⇒The invention stated in the claims (including a physically contradictory calculation formula) cannot be said to be described in the detailed description of the invention, and therefore violates the support requirement.

(Excerpt from the Holding)
Regarding Formula A, "Ghosei = Gken − (Ψ · Rhsen)," the appellant argues that, if Ψ is understood according to the ordinary meaning of the symbol, the formula subtracts a value having the dimension of velocity, obtained by multiplying angular velocity by the sensor mounting height, from Gken, which has the dimension of acceleration, and thus becomes a formula that has no meaning in physics; therefore, "Ψ · Rhsen" cannot be understood literally as a calculation multiplying angular velocity by the sensor mounting height, while it is clear that "Ψ · Rhsen," the correction term for lateral G (Gken) in Formula A, is a correction term for removing the change in velocity along a circular trajectory superimposed on Gken, in other words, circumferential acceleration; however, ... the fact that it has no meaning in physics does not mean that it is recognized as an error in the description, and Formula A is as stated above, so the appellant's argument cannot be accepted.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93712.pdf

[Trademarks / Similarity] 2025 (Gyo-Ke) No. 10111 “SORA” <Presiding Judge Moritomi>

Original article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e5%95%86%e6%a8%99-%e9%a1%9e%e5%90%a6%e3%80%91%e4%bb%a4%e5%92%8c7%e5%b9%b4%e8%a1%8c%e3%82%b110111%e3%80%8esora%e3%80%8f%ef%bc%9c%e6%a3%ae%e5%86%a8%e8%a3%81%e5%88%a4%e9%95%b7%ef%bc%9e/

Publication date on list page: June 12, 2026

[Trademarks / Similarity] 2025 (Gyo-Ke) No. 10111 “SORA” <Presiding Judge Moritomi>

⇒Similar (separate observation of the device and word elements is permissible)

(1) Similarity of the Trademarks
In both trademarks, the device element and word element are arranged with a space between them, and they cannot be said to be so inseparably combined that separate observation would be unnatural. Moreover, because the device elements do not give rise to a specific pronunciation or concept, it is permissible to extract as the dominant element the word element “SORA,” which gives a strong and dominant impression as a source-identifying sign. Comparing the two, their appearances are close and their pronunciation (sora) is identical; therefore, the two trademarks are similar.
⇒In a composite trademark consisting of a device and words, if the device element is abstract and does not give rise to a specific concept, there is a high risk that only the word element will be extracted as the dominant element.
In filing practice, even if a device is added to avoid conflict with an existing word mark, similarity is often found unless the two elements are inseparably combined (for example, through substantial stylization of the logotype or overlap).

(2) Similarity of the Services
Similarity of designated services is determined on the basis of “actual circumstances of trade,” such as the relationship of the means and purposes and

whether they are provided by the same business operator or at the same place. In light of trading conditions, such as massages and facial beauty treatments being provided at beauty salons (hair salons), the designated services of the application and the cited designated services share the purpose of beautification, and the business operators and places providing them overlap in reality. Therefore, regardless of differences in strict definitions under the Beauticians Act, the two services are similar.
⇒In determining similarity of services, the “actual circumstances of trade,” namely the combination of services in the actual market (such as the provision of massages in beauty salons), take precedence over whether national qualifications (such as a beautician’s qualification) are held and over distinctions in the legal scope of business. Diversification of corporate business may result in a likelihood of confusion being affirmed even between services previously regarded as dissimilar.
https://www.courts.go.jp/assets/hanrei/hanrei-pdf-95933.pdf

商　標　目　録

【出願番号】

商願２０２４－４０４０６

【商標】



【役務の区分及び指定役務】（注：令和７年８月６日付け手続補正後のもの）

第４４類　　マッサージが組み込まれた顔及び体の手入れ，マッサージが組み込まれた美容のための体の手入れ

English translation of text in the image

Trademark List
[Application Number] Trademark Application 2024-40406
[Trademark] SORA (device reproduced above)
[Class of Services and Designated Services] (Note: After the procedural amendment dated August 6, 2025)
Class 44: Facial and body care incorporating massage; body care for beauty purposes incorporating massage.

引　用　商　標　目　録

【登録番号】商標登録第５７２８３４０号

【商標】



【役務の区分及び指定役務】

第４４類　美容、理容

【登録日】平成２６年１２月１９日

【出願日】平成２６年１月１０日

English translation of text in the image

Cited Trademark List
[Registration Number] Trademark Registration No. 5728340
[Trademark] SORA (device reproduced above)
[Class of Services and Designated Services]
Class 44: Beauty care, hairdressing.
[Registration Date] December 19, 2014
[Filing Date] January 10, 2014

[Article / Austrian Trademarks] A Consideration of the Protection of Well-Known Trademarks and Unfair Use through Packaging Imitation Learned from the “Jägermeister” Case (遠藤華英, Patent, November 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e3%82%aa%e3%83%bc%e3%82%b9%e3%83%88%e3%83%a9%e3%83%aa%e3%82%a2%e5%95%86%e6%a8%99%e3%80%91%e3%80%8cjagermeister%e3%80%8d%e3%81%ae%e4%ba%8b%e4%bb%b6%e3%81%8b%e3%82%89/

Publication date on list page: June 12, 2026

[Article / Austrian Trademarks] A Consideration of the Protection of Well-Known Trademarks and Unfair Use through Packaging Imitation Learned from the “Jägermeister” Case (遠藤華英, Patent, November 2025)

Note on country and procedure: The article by 遠藤華英 states 「オーストリア最高裁判所（OGH）」 (“Supreme Court of Austria (OGH)”) on p. 49. The country concerned is Austria. The proceedings described on p. 54 concern an interim injunction. The Austrian legal information system RIS lists the OGH ruling (4Ob55/23a, May 31, 2023) as a “Beschluss” (decision) rejecting the defendant’s appeal and upholding the lower courts’ interim injunction. Article, pp. 49 and 54

A decision of the Austrian Supreme Court (OGH) in interim-injunction proceedings (4Ob55/23a, May 31, 2023) concerning protection of the well-known trademark “Jägermeister” and imitation of packaging.

1. Overview of the Case: Jägermeister vs SPAR
A case in which the plaintiff, the right holder for the world-famous herbal liqueur “Jägermeister,” brought an action and applied for an interim injunction on the grounds of trademark infringement and violation of unfair competition prevention law against the defendant (SPAR), which sold products imitating the packaging of the plaintiff’s products (an orange band, black lettering, a deer-head device, etc.). The lower courts issued the interim injunction, and the OGH rejected the defendant’s appeal and upheld their decision.

Issue: Whether the defendant’s imitation constituted “unfair exploitation of reputation (free riding)” or “impairment of distinctiveness” of the plaintiff’s well-known trademark.

Conclusion: Interim injunction upheld (the lower courts' grant of the plaintiff's application was maintained)

2. Points in the Austrian Court's Determination
From the perspectives of both trademark law and unfair competition prevention law, the court strictly rejected "parasitic exploitation" of a well-known trademark.

A. Trademark Law Aspect (§ 10 Abs 2 MSchG)
No Risk of Confusion Required: For a well-known trademark, protection is available if there is sufficient similarity for consumers to make a "mental connection (association) between the two brands."

Criterion of Similarity: If any one of the three aspects of appearance, pronunciation, or concept is similar, infringement is likely to be found.

Burden of Proof: In principle, the infringer (defendant) bears the burden of proving that there is no unfair use.

B. Unfair Competition Prevention Law Aspect (§ 1 UWG)
Unfair Exploitation of Reputation: Going beyond mere imitation of a design, free riding on the reputation as a "premium brand" built by the plaintiff over many years is an unfair commercial practice that undermines fairness of competition.

Aggressive Imitation: In particular, the use of brand elements highly popular among young people in a cartoonishly modified form was held to be an "aggressive act" damaging the reputation.
https://jpaa-patent.info/patent/viewPdf/4731

項目	日本	オーストリア
保護範囲	非類似商品・サービスにも及ぶ	非類似商品・サービスにも及ぶ
識別力の基準	一定の著名性を有していれば、識別力の基準は低く、使用実績等の証明により保護される	厳格
立体商標・形状	一定の識別力を有していれば登録・保護されやすい	登録・保護のハードルが高い
類似性判断	消費者認識を重視	視覚・音響・意味のいずれかで類似と判断
保護目的	信用・名声の保護、混同防止	信用・名声の強固な保護、不正利用防止

English translation of text in the image

Item	Japan	Austria
Scope of protection	Extends to dissimilar goods and services	Extends to dissimilar goods and services
Standard of distinctiveness	If a certain degree of fame exists, the distinctiveness threshold is low, and protection is available through proof of use and the like	Strict
Three-dimensional marks and shapes	Readily registered and protected if a certain degree of distinctiveness exists	High hurdle for registration and protection
Determination of similarity	Emphasizes consumer perception	Similarity found in any of visual, aural, or semantic aspects
Purpose of protection	Protection of goodwill and reputation; prevention of confusion	Strong protection of goodwill and reputation; prevention of unfair use



[Article / Customs] Customs Expert Advisers (磯貝克臣, Patent, November 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%a8%8e%e9%96%a2%e3%80%91%e7%a8%8e%e9%96%a2%e3%81%ae%e5%b0%82%e9%96%80%e5%a7%94%e5%93%a1%ef%bc%88%e7%a3%af%e8%b2%9d%e5%85%8b%e8%87%a3%e3%80%81%e3%83%91%e3%83%86%e3%83%b3/

Publication date on list page: June 12, 2026

[Article / Customs] Customs Expert Advisers (磯貝克臣, Patent, November 2025)

For each case, three customs expert advisers are selected (for example, a mixture of a university professor, an attorney, and a patent attorney).
Customs makes its determination respecting the majority opinion of the expert advisers unless there are special circumstances such as a clear error of fact.
The list for the term current when the article was written (a two-year term ending December 31, 2025) registered four university professors, 20 attorneys, and 20 patent attorneys.

<Actual Working Process of Expert Advisers>
1. Receipt of Materials and Individual Review

2. Advance Meeting of the Expert Advisers (Web Conference)
An introductory meeting of the three expert advisers and customs officials. Rather than reaching a conclusion here, they discuss whether to make a “request for additional materials” to the parties.

3. Hearing of Opinions (a Setting Similar to an Oral Hearing)
This is an extremely important occasion at which the parties appear in person and make presentations and rebuttals.
Proceedings take place in the order of statements of opinion by the applicant and interested parties, mutual rebuttals, questions from the expert advisers and customs, and final statements.

Through questions, the expert advisers have each party supplement its arguments and clarify the reasoning leading to the ultimate conclusion.

4. Preparation and Submission of Written Opinions
Based on the discussions at the “hearing of opinions” and supplementary written opinions, an expert adviser opinion is prepared in the form of an expert report. Where the opinions of the three members are divided, the majority opinion of two to one is adopted.

https://jpaa-patent.info/patent/viewPdf/4729

[Article / Intellectual Property in General] Patent Attorneys as Judicial Research Officials (髙村和宗 and 岩永勇二, Patent, November 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%9f%a5%e8%b2%a1%e5%85%a8%e8%88%ac%e3%80%91%e8%a3%81%e5%88%a4%e6%89%80%e8%aa%bf%e6%9f%bb%e5%ae%98%e3%81%a8%e3%81%97%e3%81%a6%e3%81%ae%e5%bc%81%e7%90%86%e5%a3%ab%ef%bc%88/

Publication date on list page: June 5, 2026

[Article / Intellectual Property in General] Patent Attorneys as Judicial Research Officials (髙村和宗 and 岩永勇二, Patent, November 2025)

1. Legal Position of Judicial Research Officials
They are court officials provided for in Article 57 of the Court Act, and under Article 92-8 of the Code of Civil Procedure, upon order of the presiding judge, they have authority to question parties on matters of fact and law and to ask questions directly during the examination of evidence.
Many have experience as trial examiners at the Patent Office, but one person is assigned to the Intellectual Property High Court (mechanical field) and one to the Tokyo District Court (chemical field) in patent-attorney positions. The term is three years.

2. Specific Duties of Judicial Research Officials
①Advance Research: Based on the plaintiff's arguments, submit materials organizing technical terminology and the logic of the trial decision to the judges.
②Attendance at Hearings
③Preparation of Research Reports

3. Points to Note for Advancing Litigation Advantageously from the Viewpoint of Research Officials
①Actions for Cancellation of Trial Decisions (Intellectual Property High Court)
Opportunities for argument and proof are limited. It is necessary to present all grounds for cancellation in the plaintiff's first preparatory brief and assemble the evidence.

One should identify errors in the reasoning of the trial decision that affect the conclusion, and not develop an independent line of reasoning excessively.

②Patent Infringement Litigation (District Courts)
Close Examination Before Filing Suit
Reliability of Experimental Proof: It is desirable to have analyses of allegedly infringing products and reproduction experiments conducted by highly reliable external institutions.
Responses to Questions: Questions from judges and research officials at technical explanation sessions and the like are often central questions affecting the outcome of the judgment; it is therefore necessary to grasp their intent accurately and respond.
https://jpaa-patent.info/patent/viewPdf/4728

表１　裁判所調査官の配置（論文掲載時点）

技術分野	知財高裁（11 人）	東京地裁（7 人）	大阪地裁（3 人）
機械	4 人（1 人は弁理士）	3 人	1 人
電気	3 人	2 人	1 人
化学	4 人（論文本文による）	2 人（1 人は弁理士）	1 人

English translation

Table 1 Assignment of Judicial Research Officials

	IP High Court: 11	Tokyo District Court: 7	Osaka District Court: 3
Mechanical	4 (one is a patent attorney)	3	1
Electrical	3	2	1
Chemical	4	2 (one is a patent attorney)	1

Source for the table: The body of the article by 髙村和宗 and 岩永勇二, p. 18, gives four mechanical, three electrical and four chemical research officials at the IP High Court. Table 1 in the original article gives two chemical officials. The table here follows the body text, whose breakdown is consistent with the stated total of 11. These are the figures published in the article, not a statement of current staffing. Article, p. 18

[Article / Intellectual Property in General] A Note on the Prohibition of Abuse of Rights in Intellectual Property Infringement (森本晃生, Patent, December 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%9f%a5%e8%b2%a1%e5%85%a8%e8%88%ac%e3%80%91%e7%9f%a5%e7%9a%84%e8%b2%a1%e7%94%a3%e6%a8%a9%e4%be%b5%e5%ae%b3%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b-%e6%a8%a9%e5%88%a9%e6%bf%ab/

Publication date on list page: June 5, 2026

[Article / Intellectual Property in General] A Note on the Prohibition of Abuse of Rights in Intellectual Property Infringement (森本晃生, Patent, December 2025)

①The Ricoh Case and the Appropriate Form of “Compulsory Mediation”
The first-instance judgment also rejected damages in their entirety, but as long as the implementer actually enjoys the benefits of the patented invention, a solution that does not grant an injunction but allows payment equivalent to a reasonable license fee (royalty) (in the line of the 1968 Supreme Court judgment) is desirable from the perspectives of legal consistency and equity.
This also accords with the purpose of “compulsory licensing (an award)” and prevents excessive favorable treatment of implementers who neglected license negotiations.

②Use as “Substantive Fair Use” in Copyright Law
The Goldfish Telephone case (Osaka High Court judgment, 2021) — Functional Constraints: Where there are few alternative choices of expression because of purposes such as attracting tourists or sustaining living organisms (aeration), there are situations in which the creator’s “freedom of expression” and “freedom of business” should be protected.
⇒Rather than forcing a finding of non-infringement through the determination of copyrightability (the elements), flexible and equitable solutions become possible

by using the abuse-of-rights doctrine (Type ④) to make an adjustment that does not grant an injunction or disposal but allows only damages (equivalent to a royalty).

https://jpaa-patent.info/patent/viewPdf/4750

権利濫用の類型と知財法の事例（森本論稿の整理）

類型	内容	知財法の該当例
① 不法行為型	加害目的のみの権利行使（シカーネ）。	古典的な濫用例。
② 権利範囲明確化型	法の欠缺を埋め、権利の限界を画定する。	ポパイ・マフラー事件、エマックス事件、キルビー事件（論者の最終整理）。
③ 法変化・限界設定型	社会情勢の変化に伴い権利を縮小させる。	キルビー事件は③とも解し得るが、論者の最終整理は②である。特許法 104 条の 3 へ結実。
④ 強制調停型	権利同士の衝突を調整し、衡平な解決を図る。	リコー事件（再生トナー）、やっぱりブスが好き事件。

English translation

Type	Content	Examples in Intellectual Property Law
① Tort type	Exercise of rights solely for the purpose of causing harm (chicane).	Classical examples of abuse.
② Clarification of the scope of rights	Fill gaps in the law and fix the limits of rights.	Popeye Scarf case; Eemax case; Kilby case (the author's final classification)
③ Legal change and setting of limits	Reduce rights in response to changes in social circumstances.	Kilby case (also interpretable under this type; the author's final classification is Type ②; now reflected in Article 104-3 of the Patent Act)
④ Compulsory mediation	Adjust conflicts between rights and seek equitable solutions.	Ricoh case (recycled toner); Yappari Busu ga Suki case

Note on classification: 森本晃生's article, p. 105, states 「③の法変化による権利の新たな限界設定事案と解することもできるが」 ("it can also be interpreted as a case of setting new limits on rights through the change in law under ③, but") and then 「②の法規欠缺の場合の権利内容の明確化を画する事案といえる。」 ("it can be said to be a case that delimits the clarification of the content of rights where there is a gap in the statutory law, under ②."). In summary, the author ultimately places Kilby in Type ② while also recognizing Type ③ as a possible interpretation. The table presents the author's final classification and the alternative interpretation. Article, p. 105

[Article / Patents] Research and Proposals on Lack of Unity of Inventions Expressed as Alternatives (Biotechnology and Life Sciences Committee, Patent, December 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e9%81%b8%e6%8a%9e%e8%82%a2%e3%81%a7%e8%a1%a8%e7%8f%be%e3%81%95%e3%82%8c%e3%81%9f%e7%99%ba%e6%98%8e%e3%81%ab%e5%af%be%e3%81%99%e3%82%8b%e5%8d%98/

Publication date on list page: June 5, 2026

[Article / Patents] Research and Proposals on Lack of Unity of Inventions Expressed as Alternatives (Biotechnology and Life Sciences Committee, Patent, December 2025)

1. The Japan Patent Office (JPO) “First Alternative” Principle
In the chemical and biotechnology fields, compounds and sequences are commonly expressed as alternatives (Markush form), such as “R is A, B, or C” or “any of SEQ ID NOs: 1–4.”
Under Japan’s Examination Guidelines, in determining unity (Article 37 of the Patent Act), the “first-listed alternative” is, in principle, the subject of examination. If the first-listed alternative is found to lack novelty, an amendment to a later alternative may be disallowed as a “shift amendment (Article 17-2(4)),” even where that is the alternative for which the applicant truly seeks rights, necessitating a divisional application at additional cost. However, adding or arguing a common special technical feature (STF), as discussed below, may enable later alternatives to be examined.

Note on the circumstances: Case 1 on p. 88 of the source article states 「2 番目以降のすべての選択肢を審査対象にできた。」 (“all alternatives from the second onward could be made subject to examination”). In summary, circumstances requiring a divisional application because amendment is disallowed must be distinguished from circumstances in which the measures described below enable examination to continue. Article, pp. 85 and 88

2. Comparison of the Systems of Japan, the United States, and Europe:
There is a decisive difference in operation between Japan and the United States

and Europe regarding the “selection of the subject of examination,” and the U.S. and European systems are user-friendly.

3. Types of Responses to Lack of Unity

①Addition of a New STF: Add an unexamined “new special technical feature (STF)” as a configuration common to all alternatives, thereby leading all alternatives to be examined together.

②Argument for a Common Structure: Demonstrate in a written opinion that the first alternative and the other alternatives have a common structure (STF) that has not been recognized in the examination.

③Amendment to an Inclusive Relationship: By making the first alternative an “essential configuration” and the other alternatives “additional configurations,” substantively include them within the subject of examination.

https://jpaa-patent.info/patent/viewPdf/4748

項目	日本（JPO）	米国（USPTO）	欧州（EPO）
選択の機会	明文化された規定なし（原則として順序通り）	**限定要求（Restriction Requirement）**により出願人が選択可能	**不完全なサーチ（規則63）**等により、審査対象の意見提出が可能
追加費用	分割出願が必要（高額）	特になし（選択のみ）	追加調査費の支払いで複数主題のサーチが可能

English translation of text in the image

Item	Japan (JPO)	United States (USPTO)	Europe (EPO)
Opportunity for selection	No express provision (in principle, in the listed order)	The applicant can select through a Restriction Requirement	An opinion on the subject of examination can be submitted through incomplete search (Rule 63) and the like
Additional costs	A divisional application is necessary (expensive)	None in particular (selection only)	Multiple subjects can be searched by paying additional search fees

[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e8%be%b2%e6%b0%b4%e3%80%91%e6%b5%b7%e5%a4%96%e5%b1%95%e9%96%8b%e3%82%92%e8%a6%8b%e6%8d%ae%e3%81%88%e3%81%9f%e7%9f%a5%e8%b2%a1%e3%83%9f%e3%83%83%e3%82%af%e3%82%b9-2/

Publication date on list page: June 5, 2026

[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

1. Branding by Vegetable Producers
Separation of Plant Breeders' Rights and Trademarks: Because a registered variety name becomes public domain after the protection period expires, also obtain trademark rights.
For a brand with strong regional ties, strategically distinguish between use of the GI system and the regional collective trademark system.

2. Specific Examples of Use of an IP Mix
①Trademark Rights × Plant Breeders' Rights: Examples include "Ruby Roman" and the trademark registration of the brand name "Beni Madonna" for the variety name "Ehime Kashi No. 28."

②Patent Rights × Trademark Rights: "Soratobu Pumpkin," which combines a patent for the cultivation method with a brand name.

③Patent Rights × Trademark Rights × GI: "Zentsuji-san Shikaku Suika," protected by a three-part set of a patent for the cultivation container, a trademark, and a GI.

④Trademark Rights × GI (Overseas): In the "Kobe Beef" case, the framework of mutual GI protection with Europe and other regions was used to successfully

remove false indications within Europe based on a geographical indication registration in Japanese.

3. Geographical Indications for Alcoholic Beverages and Management of Know-How

①GIs for Alcoholic Beverages: Administered by the National Tax Agency, they protect the characteristics of the place of origin (natural and human factors). Established approximately 20 years earlier than the GI system for agricultural products, the system first designated “Iki,” “Kuma,” and “Ryukyu” on June 30, 1995.

②Management of Know-How: For technologies such as cultivation techniques where disclosure through patenting is to be avoided, it is important to ensure thorough confidential management as trade secrets in the agricultural field.

https://jpaa-patent.info/patent/viewPdf/4767

[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e6%84%8f%e5%8c%a0%e3%80%91%e8%81%b7%e5%8b%99%e5%89%b5%e4%bd%9c%e6%84%8f%e5%8c%a0%e3%81%ab%e9%96%a2%e3%81%99%e3%82%8b%e8%a3%81%e5%88%a4%e4%be%8b%e3%81%ae%e6%a6%82%e8%a6%b3/

Publication date on list page: June 5, 2026

[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

Of the seven cases discussed in the article, consideration was claimed in five. Of those, only the Clothes-Drying Device case involved consideration claimed solely on the basis of an employee-created design; within the cases covered by the article, no published decision granting such a claim is identified.

Compared with patents (employee inventions), the following differences and points to note can be identified in the calculation process for “reasonable consideration.”

①“Proportion of Excess Sales”: For designs, because it is easier to choose alternative designs (other designs that do not share the same aesthetic impression) than for patents, the exclusive advantage in the market tends to be estimated lower.

②“Hypothetical Royalty Rate”: The cases examined in the article include assessments of approximately 1.5%–2.0%, about half the royalty rate for patent rights. These examples consider the substitutability of designs, but caution is needed in generalizing them as royalty rates for designs overall.

③“Employee’s Contribution”: The article’s reference to approximately 5%–10% concerns employee inventions and does not state a general range for employee-created designs. Because designs more readily express the creator’s individuality, there is room for a higher assessment depending on the case.

However, cases in existing court decisions in which a high contribution has been recognized involved special circumstances, such as an extremely high degree of dependence on the individual plaintiff.

Note on sources for case numbers and calculation examples: 藤本一's article, p. 147, states 「⑥〔物干し器〕のみが、原告がデザイナーで、職務創作意匠のみに基づいて相当の対価が請求された事案」 ("only ⑥ [Clothes-Drying Device] is a case in which the plaintiff was a designer and reasonable consideration was claimed on the basis of an employee-created design alone"). In summary, the five consideration cases must be distinguished from the single design-only claim. Case-specific calculation rates should not be generalized. The table below includes all seven cases discussed in the article, including case ② [Sluice Gate] (Osaka High Court decision of September 13, 1990). In addition, the entry "Excess sales attributable to the design portion denied" for the Infusion Container case reflects, according to p. 146 of the article, the first-instance judgment (Osaka District Court, October 16, 2012) (「⑤〔輸液容器〕の一審判決は、…職務創作意匠による超過売上の発生を否定したと理解される」, i.e., "the first-instance judgment in ⑤ [Infusion Container] … is understood to have denied that excess sales arose from the employee-created design"). Article, pp. 144–147

https://jpaa-patent.info/patent/viewPdf/4768

職務創作意匠に関する７事件（藤本論稿の紹介）

事件	裁判所・日付	論稿が紹介する位置付け
剛性物質穴あけ用ドリル	大阪地判昭和 62 年 1 月 26 日	法定通常実施権に関する判断。
水門扉	大阪高決平成 2 年 9 月 13 日	法定通常実施権に関する判断。
三角プレート（カネシン）	東京地判平成 4 年 9 月 30 日	職務考案と併せて対価を認容。
鉄筋曲げ機	東京高判平成 16 年 9 月 29 日	職務発明等と併せて対価を認容。
輸液容器（ニプロ）	知財高判平成 25 年 7 月 11 日	意匠部分の超過売上を否定したとするのは、一審（大阪地判平成 24 年 10 月 16 日）についての論稿の評価。
物干し器（タカラ産業）	大阪地判平成 29 年 10 月 12 日	デザイナーによる請求であるが棄却。
ファン（三菱電機）	知財高判令和 5 年 1 月 23 日	内部構造で見えない意匠の利益を否定。

English translation

Case	Court and Judgment Date	Overview
Drill for Drilling Rigid Materials	Osaka District Court, January 26, 1987	Determination concerning a statutory non-exclusive license.
Sluice Gate	Osaka High Court, September 13, 1990	A decision concerning a statutory non-exclusive licence.
Triangular Plate (Kaneshin)	Tokyo District Court, September 30, 1992	Consideration granted together with an employee utility-model creation.
Reinforcing-Bar Bending Machine	Tokyo High Court, September 29, 2004	Consideration granted together with employee inventions and the like.

Case	Court and Judgment Date	Overview
Infusion Container (Nipro)	IP High Court, July 11, 2013	The article interprets the first-instance judgment (Osaka District Court, October 16, 2012) as denying excess sales attributable to the employee-created design.
Clothes-Drying Device (Takara Industry)	Osaka District Court, October 12, 2017	Claim by a designer, but rejected.
Fan (Mitsubishi Electric)	IP High Court, January 23, 2023	Profit from an invisible design within an internal structure denied.

[Article / Patents] Cases and Issues in Patent Protection of Biopharmaceuticals (Biotechnology and Life Sciences Committee, Patent, December 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e3%83%90%e3%82%a4%e3%82%aa%e5%8c%bb%e8%96%ac%e5%93%81%e7%89%b9%e8%a8%b1%e4%bf%9d%e8%ad%b7%e3%81%ae%e4%ba%8b%e4%be%8b%e3%81%a8%e8%aa%b2%e9%a1%8c/

Publication date on list page: June 5, 2026

[Article / Patents] Cases and Issues in Patent Protection of Biopharmaceuticals (Biotechnology and Life Sciences Committee, Patent, December 2025)

1. “De Facto Patent Linkage” in Japan

Under the practice described in the article based on the Ministry of Health, Labour and Welfare’s former “Two Division Directors’ Notification,” a biosimilar (BS) is not approved where a patent on the active ingredient of the originator product prevents manufacture of that ingredient itself, and, where a patent exists for some indications of the originator product and manufacture of a product claiming the other indications is possible, the patented indications are not approved. The article states that, for this reason, even after the re-examination period expires, approval of a BS is effectively difficult as long as a substance patent or use invention remains in force.

Note on use patents and the updated notification: The Ministry of Health, Labour and Welfare’s notification of October 8, 2025, on pharmaceutical patents in approval examinations and reimbursement listing for prescription generic medicines and biosimilars repealed the former Two Division Directors’ Notification. Section 1(2), in line with the former Two Division Directors’ Notification, permits approval where manufacture or marketing for other indications is possible despite a use patent covering some indications, and states 「この場合、特許が存在する効能効果等については承認しない。」 (“In this case, the indications, etc. for which a patent exists are not approved.”). In summary, the patented indications are not approved; a use patent does not always bar approval of the product for other indications. MHLW notification, p. 2 Article, pp. 40–41 and 54

2. Re-Examination Period

Japan’s distinctive re-examination system functions as a de facto regulatory data

protection period (RDP), and in some cases remains a barrier to entry even after patent expiration.

3. Considerations and Future Issues

The existence of the high-cost medical expense benefit system makes it difficult for patients to perceive the benefits of choosing inexpensive BS products. Going forward, in order to reconcile the sustainability of medical finances with protection of innovation, a highly transparent system design involving the judiciary and the development of a market environment that is predictable for foreign companies as well are indispensable.

https://jpaa-patent.info/patent/viewPdf/4745

有効成分（先発品）	日本の状況	主な障壁・特徴
デノスマブ（ランマーク）	BS未承認（2025年8月時点）	物質特許が2027年まで存続。欧米では「承認と特許の分離」や和解により既にBSが承認されている。
エクリズマブ（ソリリス）	BS未承認	2032年までの延長特許。高額療養費制度により、患者側にBSへ切り替える経済的動機が乏しい点も指摘される。
トシリズマブ（アクテムラ）	2025年後半に承認見通し	物質特許満了後も、高粘度化防止や安定化等の「製剤特許」が厚い網（パテントシケット）を形成している。
アフリベルセプト（アイリーア）	一部適応でBS承認	先発品上市後の「用途特許」に基づき一部適応が制限された。パテントリンケージの運用基準が争点となっている。
アダリムマブ（ヒュミラ）	BS承認済	米国では60件以上の特許による「パテントシケット」によりBS参入が数年遅延。戦略的和解が上市時期を左右した。

English translation of text in the image

Active Ingredient (Originator Product)	Situation in Japan	Main Barriers and Features
Denosumab (Ranmark)	BS not approved (as of August 2025)	Substance patent continues until 2027. In Europe and the United States, BS products have already been approved through “separation of approval and patents” and settlements.
Eculizumab (Soliris)	BS not approved	Extended patent until 2032. It is also noted that the high-cost medical expense benefit system gives patients little economic incentive to switch to BS products.
Tocilizumab (Actemra)	Approval expected in the second half of 2025	Even after expiration of the substance patent, “formulation patents” concerning prevention of viscosity increases, stabilization, and similar measures form a dense network (patent thicket).

Active Ingredient (Originator Product)	Situation in Japan	Main Barriers and Features
Aflibercept (Eylea)	BS approved for some indications	Some indications were restricted based on “use patents” after launch of the originator product. Operational standards for patent linkage are in dispute.
Adalimumab (Humira)	BS approved	In the United States, a “patent thicket” of more than 60 patents delayed BS entry by several years. Strategic settlements determined the timing of market entry.

Note on the table’s reference date and approval information: “BS not approved (as of August 2025)” for denosumab (Ranmark) in the reproduced table is a statement of the position as of that date. Fuji Pharma’s release of October 31, 2025, concerning its agreement for a denosumab biosimilar states 「2025 年 9 月 19 日に製造承認を取得した」 (“obtained manufacturing approval on September 19, 2025”) for Denosumab BS Subcutaneous Injection 120 mg RM “F”. In summary, that product obtained approval on September 19, 2025; note 8 on p. 54 of the article also contains a post-submission addendum to this effect. Approval, launch, and reimbursement listing are separate matters. Fuji Pharma release, p. 1 Article, p. 54, note 8

[Article / Patents] Points to Note When Filing Food-Use Inventions in Different Countries (Biotechnology and Life Sciences Committee, Patent, December 2025)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%89%b9%e8%a8%b1%e3%80%91%e9%a3%9f%e5%93%81%e7%94%a8%e9%80%94%e7%99%ba%e6%98%8e%e3%81%ae%e5%90%84%e5%9b%bd%e5%87%ba%e9%a1%98%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e7%95%99/

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[Article / Patents] Points to Note When Filing Food-Use Inventions in Different Countries (Biotechnology and Life Sciences Committee, Patent, December 2025)

In Japan, protection for “food-use inventions” was strengthened by the 2016 revision of the Examination Guidelines, but in overseas expansion, there are significant differences in each country’s legal system and examination practice.

1. Permissible Claims
①United States: “Inventions directed to the use of a product” are not recognized and are described as methods. A use stated in the preamble often has no limiting effect.
②Europe: “Purpose-limited substance / use”; for therapeutic use, “Substance A for use in ...”; for non-therapeutic use, “Non-therapeutic use of ...”. Swiss-type claims are not permissible.
③China: Method / Swiss-type claims (use for manufacturing ...) are effective.
④South Korea: Product (food composition); similar to Japan, but novelty tends to be denied where the use does not create a difference in structure or form.

2. Difficulties in Obtaining Rights in the United States:
①INHERENCY — In the United States, even if an unknown use of a known substance is discovered, novelty is denied if it is considered “inherent” in the prior art.
②Laws of Nature — Effects within the body from ingestion are interpreted as being

governed by a “law of nature,” and even if new knowledge is merely added to the known step of “eating,” proof of a remarkable effect is extremely difficult.

3. Distinctions in Europe:
①Therapeutic Use: Where the use relates to treatment or prevention of a disease, employ a “purpose-limited substance claim” under EPC 54(4) or (5).
②Non-Therapeutic Use: For health-maintenance purposes such as “recovery from fatigue,” a use claim expressly stating “non-therapeutic” is effective in making clear that the use does not fall within therapeutic acts.
There is a dilemma in that an expression such as “improvement of ...” may be held unclear, while naming a specific disease may create a conflict with prior art (medical uses).

4. Strategic Conclusions
Rather than translating and filing unchanged a configuration that received a decision to grant a patent in Japan, amendment to a form appropriate for each country from the national or regional entry stage is indispensable.
In the United States, emphasize “structural differences” or “distinctiveness as a method” rather than use.
Reorganize claims into Swiss-type claims in China and purpose-limited substance claims in Europe.
Even broad rights at the subspecies level recognized in Japan (without limitation to a particular strain) are highly likely to require limitation to a specific deposit number (strain) overseas.

https://jpaa-patent.info/patent/viewPdf/4743

[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e6%84%8f%e5%8c%a0%e3%80%91%e8%81%b7%e5%8b%99%e5%89%b5%e4%bd%9c%e6%84%8f%e5%8c%a0%e3%81%ab%e9%96%a2%e3%81%99%e3%82%8b%e8%a3%81%e5%88%a4%e4%be%8b%e3%81%ae%e6%a6%82%e8%a6%b3/

Publication date on list page: June 5, 2026

[Article / Designs] An Overview of Court Decisions on Employee-Created Designs (藤本一, Patent, January 2026)

Of the seven cases discussed in the article, consideration was claimed in five. Of those, only the Clothes-Drying Device case involved consideration claimed solely on the basis of an employee-created design; within the cases covered by the article, no published decision granting such a claim is identified.

Compared with patents (employee inventions), the following differences and points to note can be identified in the calculation process for “reasonable consideration.”

①“Proportion of Excess Sales”: For designs, because it is easier to choose alternative designs (other designs that do not share the same aesthetic impression) than for patents, the exclusive advantage in the market tends to be estimated lower.

②“Hypothetical Royalty Rate”: The cases examined in the article include assessments of approximately 1.5%–2.0%, about half the royalty rate for patent rights. These examples consider the substitutability of designs, but caution is needed in generalizing them as royalty rates for designs overall.

③“Employee’s Contribution”: The article’s reference to approximately 5%–10% concerns employee inventions and does not state a general range for employee-created designs. Because designs more readily express the creator’s individuality, there is room for a higher assessment depending on the case.

However, cases in existing court decisions in which a high contribution has been recognized involved special circumstances, such as an extremely high degree of dependence on the individual plaintiff.

Note on sources for case numbers and calculation examples: 藤本一's article, p. 147, states 「⑥〔物干し器〕のみが、原告がデザイナーで、職務創作意匠のみに基づいて相当の対価が請求された事案」 ("only ⑥ [Clothes-Drying Device] is a case in which the plaintiff was a designer and reasonable consideration was claimed on the basis of an employee-created design alone"). In summary, the five consideration cases must be distinguished from the single design-only claim. Case-specific calculation rates should not be generalized. The table below includes all seven cases discussed in the article, including case ② [Sluice Gate] (Osaka High Court decision of September 13, 1990). In addition, the entry "Excess sales attributable to the design portion denied" for the Infusion Container case reflects, according to p. 146 of the article, the first-instance judgment (Osaka District Court, October 16, 2012) (「⑤〔輸液容器〕の一審判決は、…職務創作意匠による超過売上の発生を否定したと理解される」, i.e., "the first-instance judgment in ⑤ [Infusion Container] … is understood to have denied that excess sales arose from the employee-created design"). Article, pp. 144–147

https://jpaa-patent.info/patent/viewPdf/4768

職務創作意匠に関する７事件（藤本論稿の紹介）

事件	裁判所・日付	論稿が紹介する位置付け
剛性物質穴あけ用ドリル	大阪地判昭和 62 年 1 月 26 日	法定通常実施権に関する判断。
水門扉	大阪高決平成 2 年 9 月 13 日	法定通常実施権に関する判断。
三角プレート（カネシン）	東京地判平成 4 年 9 月 30 日	職務考案と併せて対価を認容。
鉄筋曲げ機	東京高判平成 16 年 9 月 29 日	職務発明等と併せて対価を認容。
輸液容器（ニプロ）	知財高判平成 25 年 7 月 11 日	意匠部分の超過売上を否定したとするのは、一審（大阪地判平成 24 年 10 月 16 日）についての論稿の評価。
物干し器（タカラ産業）	大阪地判平成 29 年 10 月 12 日	デザイナーによる請求であるが棄却。
ファン（三菱電機）	知財高判令和 5 年 1 月 23 日	内部構造で見えない意匠の利益を否定。

English translation

Case	Court and Judgment Date	Overview
Drill for Drilling Rigid Materials	Osaka District Court, January 26, 1987	Determination concerning a statutory non-exclusive license.
Sluice Gate	Osaka High Court, September 13, 1990	A decision concerning a statutory non-exclusive licence.
Triangular Plate (Kaneshin)	Tokyo District Court, September 30, 1992	Consideration granted together with an employee utility-model creation.
Reinforcing-Bar Bending Machine	Tokyo High Court, September 29, 2004	Consideration granted together with employee inventions and the like.

Case	Court and Judgment Date	Overview
Infusion Container (Nipro)	IP High Court, July 11, 2013	The article interprets the first-instance judgment (Osaka District Court, October 16, 2012) as denying excess sales attributable to the employee-created design.
Clothes-Drying Device (Takara Industry)	Osaka District Court, October 12, 2017	Claim by a designer, but rejected.
Fan (Mitsubishi Electric)	IP High Court, January 23, 2023	Profit from an invisible design within an internal structure denied.

[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e8%be%b2%e6%b0%b4%e3%80%91%e6%b5%b7%e5%a4%96%e5%b1%95%e9%96%8b%e3%82%92%e8%a6%8b%e6%8d%ae%e3%81%88%e3%81%9f%e7%9f%a5%e8%b2%a1%e3%83%9f%e3%83%83%e3%82%af%e3%82%b9-2/

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[Article / Agriculture, Forestry, and Fisheries] Protection and Use of Intellectual Property through an IP Mix with Overseas Expansion in View (Agriculture, Forestry, and Fisheries Committee, Patent, January 2026)

1. Branding by Vegetable Producers
Separation of Plant Breeders' Rights and Trademarks: Because a registered variety name becomes public domain after the protection period expires, also obtain trademark rights.
For a brand with strong regional ties, strategically distinguish between use of the GI system and the regional collective trademark system.

2. Specific Examples of Use of an IP Mix
①Trademark Rights × Plant Breeders' Rights: Examples include "Ruby Roman" and the trademark registration of the brand name "Beni Madonna" for the variety name "Ehime Kashi No. 28."

②Patent Rights × Trademark Rights: "Soratobu Pumpkin," which combines a patent for the cultivation method with a brand name.

③Patent Rights × Trademark Rights × GI: "Zentsuji-san Shikaku Suika," protected by a three-part set of a patent for the cultivation container, a trademark, and a GI.

④Trademark Rights × GI (Overseas): In the "Kobe Beef" case, the framework of mutual GI protection with Europe and other regions was used to successfully

remove false indications within Europe based on a geographical indication registration in Japanese.

3. Geographical Indications for Alcoholic Beverages and Management of Know-How

①GIs for Alcoholic Beverages: Administered by the National Tax Agency, they protect the characteristics of the place of origin (natural and human factors). Established approximately 20 years earlier than the GI system for agricultural products, the system first designated “Iki,” “Kuma,” and “Ryukyu” on June 30, 1995.

②Management of Know-How: For technologies such as cultivation techniques where disclosure through patenting is to be avoided, it is important to ensure thorough confidential management as trade secrets in the agricultural field.

https://jpaa-patent.info/patent/viewPdf/4767

[Article / U.S. Designs] Changes in the Methods for Determining Design Right Infringement in the United States (佐々木眞人, Patent, January 2026)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e3%80%90%e8%ab%96%e7%a8%bf-%e7%b1%b3%e5%9b%bd%e6%84%8f%e5%8c%a0%e3%80%91%e7%b1%b3%e5%9b%bd%e3%81%ab%e3%81%8a%e3%81%91%e3%82%8b%e6%84%8f%e5%8c%a0%e6%a8%a9%e4%be%b5%e5%ae%b3%e3%81%ae%e5%88%a4%e6%96%ad/

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[Article / U.S. Designs] Changes in the Methods for Determining Design Right Infringement in the United States (佐々木眞人, Patent, January 2026)

Determination of design right infringement in the United States originates in the “ordinary observer test” established by the 1871 GORHAM Supreme Court judgment.

Following the 1984 LITTON SYSTEMS judgment, the CAFC introduced the “point of novelty test” in addition to it. This test requires possession of a “novel design feature (point of novelty)” that distinguishes the patented design from prior designs.
⇒As a result, both substantial identity and appropriation of a novel point became necessary for a finding of infringement.

However, the “point of novelty test” was abolished by the 2008 EGYPTIAN GODDESS en banc judgment. That judgment reconfirmed that the ordinary observer test is the sole test for determining design right infringement. However, it clarified that the comparison in determining infringement should be made from the viewpoint of an “ordinary observer familiar with the prior designs,” and that the effect of differences on the overall design should be evaluated in comparison with the prior designs.

Subsequent judgments have indicated the following points.

①Consider the overall ornamental features after excluding functional aspects at the conceptual level.

②The scope of prior designs used for comparison is limited to those applied to the article identified in the claim.

③A logo affixed to the allegedly infringing product and its placement may also be considered as ornamental differences.

⇒Current determination of design right infringement in the United States is consolidated into the ordinary observer test, which emphasizes the “overall ornamental impression” after considering prior designs and separating functional elements, rather than simple visual similarity.

https://jpaa-patent.info/patent/viewPdf/4765

[United States] Focus Prod v. Kartri Sales (CAFC, 2025.9.30)

Original article URL:
https://www.nakapat.gr.jp/ja/note/%e3%80%90%e7%b1%b3%e5%9b%bd%e3%80%91focus-prod-v-kartri-sales%ef%bc%88cafc%e3%80%812025-9-30%ef%bc%89/

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[United States] Focus Prod v. Kartri Sales (CAFC, 2025.9.30)

Where a particular species is elected without challenging the definition or limitation of “species” presented by the examiner, there is a risk that unelected species will be regarded as excluded from the scope of the claims.
⇒Regarding claim 73, because the patentee did not dispute the examiner’s withdrawal of the claim as drawn to a nonelected species (Species V), the features of claim 73 (a ring with a flat upper edge) were held to have been excluded.
—The summary judgment of infringement of the ’248 and ’609 patents reversed as to Marquis (the infringement findings against Kartri affirmed because Kartri waived its non-infringement arguments)

Note on the appellate disposition: Page 16 states “we reverse the district court’s patent infringement determination for the ’248 and ’609 patents.” In summary, “reversed” is the disposition concerning those two patents. For the ’088 patent, page 24 states “Although we agree with the district court’s construction of ‘projecting edge,’ its infringement analysis on this issue was, at a minimum, inadequate to sustain summary judgment.” Thus, while agreeing with the district court’s claim construction, the court vacated and remanded the summary judgment because the infringement analysis was inadequate. These dispositions concern Marquis; as to Kartri, the ’248, ’609, and ’088 patent infringement findings were affirmed because Kartri waived its non-infringement arguments (pp. 3 and 40–41). These outcomes must be distinguished. CAFC judgment, pp. 3, 16–27 and 40–41

https://www.cafc.uscourts.gov/opinions-orders/23-1446.OPINION.9-30-2025_2580961.pdf

2024 (Gyo-Ke) No. 10017 [Optimized Nutritional Formulations, Methods for Selecting Tailored Diets Therefrom, and Uses Thereof] <Presiding Judge Miyasaka>

Original article URL: https://www.nakapat.gr.jp/ja/note/%e4%bb%a4%e5%92%8c6%e5%b9%b4%e8%a1%8c%e3%82%b110017%e3%80%90%e6%9c%80%e9%81%a9%e5%8c%96%e3%81%95%e3%82%8c%e3%81%9f%e6%a0%84%e9%a4%8a%e5%87%a6%e6%96%b9%e7%89%a9%e3%80%91%ef%bc%9c%e5%ae%ae%e5%9d%82/

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2024 (Gyo-Ke) No. 10017 [Optimized Nutritional Formulations, Methods for Selecting Tailored Diets Therefrom, and Uses Thereof] <Presiding Judge Miyasaka>

*No inventive step for an invention with numerical limitations
(The numerical range of the primary reference was included within the numerical range of the invention at issue.)

(Excerpt from the Holding)
... In Example 5 (Table 12) of Cited Document 2, ... ω-6 falls within a range of 1–35 g.
...
In view of the disclosed range of 1–35 g in Table 12 of Cited Document 2 referred to in item (a) above concerning the dose of ω-6 fatty acid in the composition of Cited Invention 2, which contains a daily optimal amount of fatty acids, making this the dose of “1–40 g of ω-6 fatty acid in an average daily amount” of the composition of the claimed invention was something a person skilled in the art could appropriately have done.
... Cited Document 2 states that nuts and seeds, which are components of the composition, contain antioxidants and polyphenols, and it can be said that polyphenols being antioxidants was well known before the priority date of the application; therefore, including polyphenols as antioxidants in the composition of

Cited Invention 2 was also something a person skilled in the art could appropriately have done. ...

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-93723.pdf

Tokyo District Court, 2024 (Wa) No. 4142 [Portable Information Communication Device and Personal Computer System Using the Portable Information Communication Device] <Presiding Judge Kokubu> (related case decided the same day: Tokyo District Court, 2024 (Wa) No. 70083, defendant SoftBank Corp.)

Original article URL: https://www.nakapat.gr.jp/ja/note/%e6%9d%b1%e4%ba%ac%e5%9c%b0%e5%88%a4%e4%bb%a4%e5%92%8c6%e5%b9%b4%e3%83%af4142%e3%80%90%e6%90%ba%e5%b8%af%e6%83%85%e5%a0%b1%e9%80%9a%e4%bf%a1%e8%a3%85%e7%bd%ae%e3%80%91%ef%bc%9c%e5%9c%8b%e5%88%86/

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Tokyo District Court, 2024 (Wa) No. 4142 [Portable Information Communication Device and Personal Computer System Using the Portable Information Communication Device] <Presiding Judge Kokubu>
(related case decided the same day: Tokyo District Court, 2024 (Wa) No. 70083, defendant SoftBank Corp.)

*The amount equivalent to consumption tax that had not been claimed in the prior actions was claimed in a separate action, but the action was dismissed as inadmissible for violating the principle of good faith.

The plaintiff argued, among other things, that ①the amount equivalent to consumption tax had not been the subject of examination in the prior actions and therefore the claim did not amount to rehashing the dispute, ②the loss from consumption tax arose from a cause different from the loss of royalties, and ③because the consumption tax rate is determined by the rate at the time the judgment becomes final and binding, it had been difficult to claim it in the prior actions.
⇒The court found that the amount equivalent to consumption tax had not been specifically examined in Prior Actions 1 and 2 and that this action did not go so far as to rehash arguments rejected in those actions. However, there are not a few

examples in patent infringement litigation in which amounts equivalent to consumption tax are claimed and awarded as part of damage or loss, and that fact is apparent to this court. Accordingly, it cannot be said that the plaintiff could not have recognized such practical circumstances. Moreover, the amount equivalent to consumption tax could readily be calculated merely by multiplying the amount equivalent to royalties by the then-current consumption tax rate (already 10% at the close of oral argument in Prior Actions 1 and 2, on December 19, 2022), and it cannot be said that it was difficult to assert the amount equivalent to consumption tax as a loss together with the amount equivalent to royalties in Prior Actions 1 and 2. Furthermore, the plaintiff had not expressly stated in the prior actions that it claimed only the damage or loss equivalent to royalties, nor indicated an intention to exclude the consumption tax portion from the subject of examination.
⇒The court assessed that, although the plaintiff could have made the entire loss, including the consumption tax amount, the subject of the court's examination in Prior Actions 1 and 2, or conversely excluded only the consumption tax portion, it deliberately did neither and made partial claims, losing as to part of them; it concluded that the claim for the remainder in this case contravened the defendant's reasonable expectation that the dispute concerning the entire claim had been resolved by the final and binding judgments in Prior Actions 1 and 2, and imposed the burden of defending twice.
Consequently, finding no special circumstances, the court held that bringing this action violated the procedural principle of good faith and was impermissible, and dismissed the action itself as inadmissible without reaching the merits of the claim for restitution of unjust enrichment.

(Excerpt from the Holding)
... A judgment rejecting all or part of a quantitatively partial claim is based on the results of the examination thus conducted with respect to the entire claim and indicates a determination that the claim does not exist at all or exists only in an amount less than that claimed as a part; in other words, it is nothing other than a determination that there is no portion that can subsequently be claimed as the remainder.

Accordingly, the plaintiff's bringing an action for the remainder after the above judgment becomes final and binding substantively rehashes claims and arguments not accepted in the prior action, contravenes the defendant's reasonable expectation that the dispute concerning the entire claim has been resolved by the final and binding judgment in the prior action, and imposes on the defendant the burden of defending twice.

In light of the foregoing, it is appropriate to interpret that, absent special circumstances, a plaintiff who lost an action on a quantitatively partial monetary claim is not permitted, as contrary to the principle of good faith, to bring an action for the remainder. (See Supreme Court, 1997 (O) No. 849, judgment of the Second Petty Bench of June 12, 1998, Minshu Vol. 52, No. 4, p. 1147 (the 1998 Supreme Court Judgment).)

...

There are not a few cases in patent infringement litigation in which claims for damages or restitution of unjust enrichment equivalent to consumption tax are made, and it is apparent to this court that amounts equivalent to consumption tax have been awarded as part of damage or loss; moreover, even in light of all the evidence in this case, no circumstances can be found such as the plaintiff's inability to recognize such actual conditions.

Furthermore, because the loss equivalent to consumption tax can readily be calculated by multiplying the loss equivalent to royalties by the prescribed consumption tax rate, it cannot be said that the entirety of the loss, including the consumption tax amount, had not been fixed at the close of oral argument in the fact-finding proceedings of Prior Actions 1 and 2; nor can any circumstances be discerned that made it difficult for the plaintiff, with respect to its unjust enrichment claims in Prior Actions 1 and 2, to assert, in addition to the loss equivalent to royalties, the amount obtained by multiplying that amount by the prescribed consumption tax rate as a loss equivalent to consumption tax, or any reasonable ground for not making that assertion.

Thus, it must be said that, although the plaintiff could have added the loss equivalent to consumption tax to the subject of examination and determination in

Prior Actions 1 and 2, or expressly stated that it would not be included in their subject matter, the plaintiff did not do so.
... This action is an action for the remainder brought by a plaintiff who lost actions on quantitatively partial monetary claims, and bringing this action is impermissible as contrary to the principle of good faith.

https://www.courts.go.jp/assets/hanrei/hanrei-pdf-94162.pdf