

# ESAKI & ASSOCIATES

## TOKYO

MARK LIGHT TORANOMON,  
3-1, NISHISHIMBASHI 2-CHOME,  
MINATO-KU, TOKYO 105-0003, JAPAN  
TEL: +81-3-3502-1476  
FAX: +81-3-3503-9577  
+81-3-3503-0238  
E-MAIL: reception@esakipat.co.jp

K. Esaki (Patent Attorney)  
Y. Sakuma (Patent Attorney)  
Y. Kaminishi (Patent Attorney)  
E. Tazaki (Patent Attorney)  
T. Suzuki (Patent Attorney)  
H. Kazama (Patent Attorney)

M. Kajisawa (Patent Attorney)  
J. Shinohara (Patent Attorney)  
I. Torayama (Patent Attorney, Ph. D)  
S. Nakamura (Patent Attorney, Ph. D)  
M. Takahashi (Patent Attorney)  
Y. Koizumi (Patent Attorney)

## Newsletter

This Newsletter covers the following:

- Revisions in the Design System
- Introduction of the Fast Track Examination System for Trademarks
- Revision of Examination Guidelines for Trademarks
- Points to note due to revisions in the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol Relating to that Agreement
- Revisions to the Patent Law
- Official Announcement regarding the Guide to Licensing Negotiations Involving Standard Essential Patents
- Opposition Statistics
- Revision to the Infringement Suit System
- Grand Panel Decisions by the Intellectual Property High Court

May 2019

Newsletter No. E-199

### 1 Revisions in the Design System

Currently, discussions to revise the Japanese Design System on a wide scale are in progress. Below is an overview of these revisions along with a summary of revisions now in effect. Furthermore, as the Examination Guidelines as well as the revisions to Design Law are still under consideration, please be aware that both are subject to change in the near future.

#### 1. Term Extensions Relating to Exceptions to Lack of Novelty of Designs (Grace Period)

According to the 2018 revision to the Design Law, the grace period available has been extended to one year.

This revision applies to applications filed on or after 9 June 2018. This grace period cannot be applied to designs that have been laid open on or prior to 8 December 2017, even if the application is filed on or after 9 June 2018.

#### 2. Revision of the Examination Guidelines for Designs (Revised January 2019)

The Revised Examination Guidelines for Design applies to applications for design registrations to be examined on or after 10 January 2019. Outlined below are the main points of change. All points reflect a change in criteria leaning towards a more lenient examination process.

##### 1. Clarification on how to determine whether objects constitute a single article

The following, regarding articles comprised of multiple constituent objects, was revised for clarification.

- (1) If all of the constituent objects indicated are essential for performing a single usage and function, they are determined to constitute a single article.
- (2) If it cannot be determined that all of the constituent objects are essential for performing a single usage and function, whether or not they constitute a single article is determined by: ① Whether all of the constituent objects physically constitute a single bundle, ② Whether all of the constituent objects are worked in an integrated manner from a common sense perspective.

**1. Examples of constituent objects that are determined to constitute a single article.**

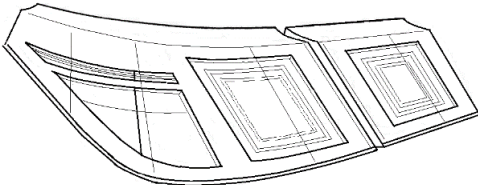
[Case Example 1] Jelly with a container



(This picture was cited from the Examination Guidelines for Design)

[Case Example 2] Tail lamp of a passenger vehicle

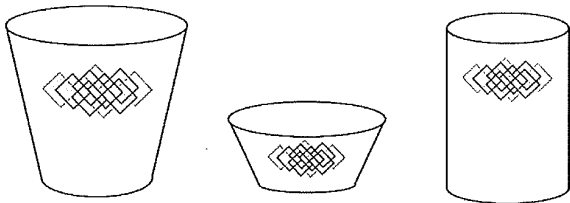
(Note: This tail lamp is physically separated into a component to be attached to the trunk and a component to be attached to the vehicle body)



(This picture was cited from the Examination Guidelines for Design)

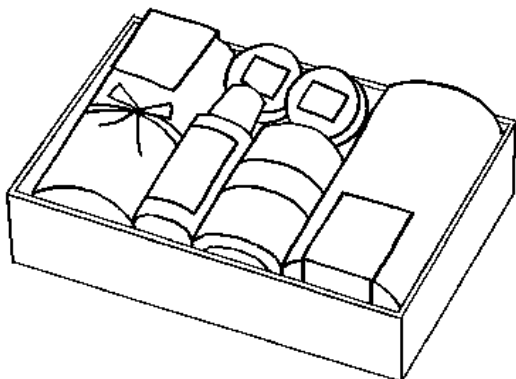
**2. Examples of constituent objects that are determined not to constitute a single article.**

[Case Example 1] Cup



(This picture was cited from the Examination Guidelines for Design)

[Case Example 2] Gift Set



(This picture was cited from the Examination Guidelines for Design)

## 2. Changes to the subject matter stated in the column of the “Article to the Design”

Even if, for example, a complementary statement made in the Article to the Design relates to the shape, pattern, color, or includes a statement with the name of the material used (Red-colored flower vase, Round-shaped table, etc.), if the subject matter and classifications stated in the Article to the Design are substantial, to the same extent as designated by an Ordinance of the Ministry of Economy, it will not be subject to a Notice of Reasons for Refusal.

## 3. Regarding the requirements for being found to be a design for a set of articles

In Japan, in order for an application for design registration to be registered as a design for a set of articles, it must comply with all of the following requirements:

- (1) The subject matter stated in the column of the “Article to the Design” of the application is designated by an Ordinance of the Ministry of Economy.
- (2) The constituent articles are appropriate.
- (3) The set of articles is coordinated as a whole.

Regarding the above mentioned (2) [The constituent articles are appropriate], in the past, at least each of the constituent articles in the “List of constituent articles” in the Examination Guidelines must have been included, however after this revision, the constituent list in question will be treated as an example for reference for applicants. In reference to the above-mentioned (1), there have been only 56 kinds of articles recognized as a design for a set of articles and there is no change to this point. For example [A golf club set] (in which more than one golf club make a set), [Set of office supplies] (scissors, letter openers, ruler), etc.

---

## 3. Revisions to the Examination Guidelines Regarding How to Determine Drawings and Partial Designs (Draft Planned for May 2019)

---

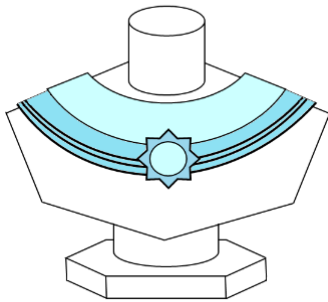
Under current Japanese practice, all design applications to be registered must either provide drawings, pictures, or CG images displaying the article in its entirety, or said application will be subject to receive a Notice of Reason for Refusal. Even in other countries where there were no issues with registration, there were many cases only in Japan where formal instructions or a Notice of Reasons for Refusal were given. In light of this, users have called for a more lenient approach in determining what constitutes an acceptable drawing. Outside of making direct changes to the Design Law itself, this situation is currently under review.

## 1. Regarding changes to design drawings

- Even if one of the six views, for example, the rear view of the design drawings, is omitted, and there is no explanation given for the omission of said view, if the scope of the design can be determined from the specifics of an article, it is determined to be concrete. In this case, the design will be treated as a partial design, the “parts to receive design registration” of which are other than the parts of the rear view.
- In case of a partial design application, if it can be determined from the specifics of an article, the position, size and scope, and the boundary between the parts to receive design registration and other parts, a design can be identified without indicating the design in its entirety. (For Example: The “Article to the Design” is “golf club,” and the drawing is such that the head of the golf club is drawn with a solid line, the shaft extending from the clubhead is drawn with a dashed line, and the grip of the golf club is not included.)
- Relaxation of requirements regarding the way to depict illustrations when omitting the middle section of a long object.
- Subject matter other than the design for which the design registration is requested can be included in the drawings if there is an explanation in the [Description of the Design] and/or the subject matter can be clearly recognized due to being drawn in a distinguishing manner in the drawings, etc.

## Case Example [Article to the Design] Necklace

[Description of the Design] The torso represented in white is an article other than the design for which the design registration is requested.



(This image was cited from the Draft Revision of the Examination Guidelines for Design.)

## 2. Regarding changes in partial design

- Until the recent revisions, applicants were required to write “Partial Design” on design applications regarding a part of an article. Under the planned revisions, this column will be deleted from design applications; however, the concept of partial and entire design will remain in effect.
- Partial and entire design applications under the First-to-file rule that were not subject to similarity judgement, will now be subject to said judgement. Additionally, entire designs and partial designs can be related designs.

---

## 4. Direction of Design Law Revisions

---

Revision to Design Law is under review with the aim of reaching a decision by 2020. The main topics under review are outlined below:

1. **Protection of Graphic Image Designs**
2. **Protection of Spatial Designs**
3. **Expansion of the Related Design System**
4. **Extension of duration of Design Rights**
5. **Introduction of the multiple design filing system**

In addition to the topics outlined above, numerous revisions are currently under review. We will keep you informed regarding the details of those decisions.

---

## 2 Introduction of the Fast Track Examination for Trademarks

---

---

### 1. What is Fast Track Examination?

---

#### 1. Regarding which applications shall be subject to Fast Track Examination

The JPO has introduced a fast track examination system as a measure to quickly and accurately examine applications, even in a time when there is a rapid increase in the number of pending trademark applications. If an application is subject to a fast track examination, a first official action (either of refusal or grant) will be issued approximately two months earlier than an application under normal examination. (Currently, normal examinations average 8 months to resolve.) However, some applications may require more time depending on the case. This operation has been implemented as a trial. Its full-scale introduction will be examined after the state of operation is verified.

## 1. Regarding applications for trademark registration which shall be subject to Fast Track Examination.

Applications that satisfy **both** of the following requirements shall be subject to the fast track examination. Furthermore, applications filed on or after 1 October 2018 shall be subject to this examination.

- (1) An application for trademark registration in which **only** the goods or services published in the “Examination Guidelines for Similar Goods and Services,” “Regulation for Enforcement of the Trademark Act,” or “International Classification of Goods and Services (Nice Classification)” (hereinafter referred to as “the goods or services indicated in the guidelines, etc.”) are designated at the time of filing.
- (2) An application for trademark registration with respect to which no amendment of the designated goods or designated services has been made until the commencement of the examination.

## 2. Regarding applications for trademark registration which shall **not** be subject to Fast Track Examination.

- Applications for “sound trademarks,” “motion trademarks,” “hologram trademarks,” “position trademarks,” and “color trademarks (trademarks consisting solely of colors),” as well as International Registrations designating Japan, are not subject to fast track examination.
- If the “Goods and Services accepted at examination,” as published in the Japan Platform for Patent Information, or specific descriptions other than “the goods or services indicated in the guidelines, etc.” are included in the list of goods and services, the relevant application shall be ineligible. In order to ensure that fast track examinations are a viable and convenient method of accelerating the examination process, the JPO plans to review the “goods or services indicated in the guidelines, etc.,” to determine whether revisions are required.
- Even though the differences in indication between the designated goods or services and “the goods or services indicated in the guidelines, etc.” is slight, the relevant application shall be ineligible. Example: Using the indication, “arranging and conducting of seminars,” in Class 41, instead of “arranging, conducting, and organization of seminars,” according to the specification set forth in the “Examination Guidelines for Similar Goods and Services.”

## 2. Regarding the Procedures for the Fast Track Examination

### 1. Requesting a Fast Track Examination

A request for a fast track examination is not necessary. Even if an applicant does not wish for an application to undergo a fast track examination, an application for trademark application which satisfies the requirements above shall automatically be subject to fast track examination. Furthermore, applications that satisfy the fast track examination requirements are not made public by the JPO.

### 2. Fee

The JPO does not charge any fees for the fast track examination.

---

## 2. Difference Between Fast Track Examinations and Accelerated Examinations

---

### 1. What is an Accelerated Examination?

The accelerated examination system for trademarks is a system under which the JPO conducts examinations on trademark applications for applicants who have certain needs to require rights sooner than normal. Under this system, the average time from request of the accelerated examination to result of the examination is 1.8 months. Please note that applications for “sound trademarks,” “motion trademarks,” “hologram trademarks,” “position trademarks,” and “color trademarks (trademarks consisting solely of colors),” cannot apply for accelerated examinations at the JPO. Currently, International Registrations designating Japan cannot request an accelerated examination. Trademark applications must meet at least one of the following requirements in order to be eligible for an accelerated examination.

- (1) Applications in which the applicants (licensees) are already using, or have already prepared to a considerable extent to use, their filed trademarks for designated goods and/or services and who have an urgent need to acquire trademark rights. (For example: a third party is using the applicant's trademark without permission, the applicant received a warning from a third party regarding the use of a trademark, the applicant is seeking consent to use a trademark from a third party, etc.)
- (2) Applications designating only the goods and/or services on which the applicants (licensees) are already using their filed trademarks; or have prepared to a considerable extent to use their filed trademarks.
- (3) Applications in which applicants (licensees) are already using, or have prepared to a considerable extent to use, their filed trademarks for designated goods and/or services and all designated goods and/or services are listed in the "the goods or services indicated in the guidelines, etc."

When applicants request accelerated examinations on their trademarks, they need to submit documents in writing, explaining their reasons and needs for said examination. Applicants are required to submit these documents in Japanese. The JPO does not charge any fees for the request for an accelerated examination.

## 2. The Pros and Cons of the Fast Track and Accelerated Examination Systems

Under the fast track examination system, when applicants wish to register an application as soon as possible, they can automatically do so simply by only specifying goods and services indicated in the "goods or services indicated in the guidelines, etc." However, goods and services that did not exist in the past are often not listed in "goods or services indicated in the guidelines, etc." as goods and services that match completely. Depending on the intended goods and services to be covered, they may not be suited for a fast track examination. In that regard, there is no limit in specifying goods and services under the conditions of the accelerated examination requirements (1) & (2). However, as the requirements for accelerated examinations state that the applicants (licensees) must only specify goods and services that they are already using, or have already prepared to a considerable extent to use, applicants cannot include goods and services that they are planning to use in the future.

Even if the request for an accelerated examination is not accepted, an application can still undergo the fast track examination if all of the requirements are met.

## 3 Revision of Examination Guidelines for Trademarks

The JPO announced the revisions to the Examination Guidelines for Trademarks. The 2 main revisions put into effect are outlined below. The revised Examination Guidelines apply to applications examined on or after 30 January 2019.

### 1. Regarding "Applications for Trademark Registration in Bad Faith" Towards Pending Variety Registrations of Breed Names

#### 1. The Variety Registration process

The application process for variety registrations is similar to that of trademark applications. An application for variety registration is made by submitting an application to the Ministry of Agriculture, Forestry, and Fisheries. After a formal examination is conducted, the application is officially announced and proceeds to a substantive examination, after which it is registered. The average time from application to registration is 2-3 years. The breeder's right is granted by registration and lasts for either 25 or 30 years from the registration date (depending on the plant).

#### 2. Reason for the revisions of the Examination Guidelines

While there is temporary protection for variety registration applications from the time it is officially announced to its registration as well as breeder's rights after registration, once a variety registration is officially announced, information regarding the genus or species the variety belongs to, its name, etc., is made public. Additionally, since information regarding the application is made public as well, a third party could register a trademark bearing the variety name without permission. To prevent future occurrences of this, the Examination Guidelines for Trademarks was revised.

### 3. Handling of “Applications for Trademark Registration in Bad Faith”

In the case where a trademark application is filed for a mark which is the same as or similar to a breed name for a variety registration under the application process, and it designates the same or similar goods and services in connection to seeds and/or harvest as the pending variety registration application, if said trademark is considered as a trademark application in bad faith based on materials obtained through the presentation of information, etc., it will not be registered (Trademark Law, Article 4(1)(vii)).

## 2. Further Clarification Regarding the Distinctiveness of a Trademark (Regarding the Eligibility of Trademark Law, Article 3(1)(iii))

### 1. Trademark Law, Article 3(1)(iii)

Article 3(1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

- (i) abbr.
- (ii) abbr.
- (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;
- (iv) (omitted below)

(This is an excerpt from the Japanese Law Translation Database System, sponsored by the Ministry of Justice)

### 2. Regarding the Eligibility of Trademark Law, Article 3(1)(iii)

The following were added to the Examination Guidelines in the revision:

- Whether this applies to the trademark to be registered is determined based on the recognition of general consumers.
- In this regard, it does not matter whether the trademark is actually used to indicate the characteristics of the goods and services.

## 4 Points to Note Due to Revisions in the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

Amendments to the Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as the Common Regulations) are in force as of 1 February 2019. Although a summary of these amendments is outlined below, please be aware that the following amendments do **not** apply for International Registrations designating Japan.

### 1. Division of an International Registration (Rule 27<sup>bis</sup>)

New Rule 27<sup>bis</sup> of the Common Regulations now allows the division of an international registration. However, as Japanese national Trademark Law does not provide for the division of International Registrations, it is not applicable in Japan.

## 2. Merger of International Registrations (Rule 27<sup>ter</sup>)

New Rule 27<sup>ter</sup>3(2)(a), allows “requests for merger of international registrations resulting from the recording of division were made possible,” in addition to “requests for merger of international registrations resulting from the recording of a partial change in ownership.” (Rule 27<sup>ter</sup>(1)). However, as Japanese national Trademark Law does not provide for the merger of registrations of international registrations, mergers resulting from division are not applicable in Japan (Rule 27<sup>ter</sup>3(2)(b)).

## 5 Patents

### 1. Revisions to the Patent Law

#### 1. Term Extensions Related to Exceptions to Lack of Novelty of Invention (Grace Period)

According to the 2018 revision to the Patent Law, the grace period available has been extended to one year.

This revision applies to applications filed on or after 9 June 2018. This grace period cannot be applied to inventions that have been laid open on or prior to 8 December 2017, even if the application is filed on or after 9 June 2018.

Furthermore, the aforementioned one-year extension also applies to utility model applications.

#### 2. Reduction of Official Fees for Request for Examination, Patent Registration and Annual Fees

In accordance with the above revision, the JPO is revising their system of official fee reduction for Requests for Examination, patent registration and annual fees for businesses, individuals, universities, etc. that meet certain requirements. Said fees shall be reduced by at most two thirds of the full fee.

##### Before Revision

Prior to the aforementioned revision, it was necessary to file an application and documentation certifying that the above requirements were met in order for the reduction to apply.

##### After Revision

- 1) While it is no longer necessary to file such an application or certificate, the JPO may in future request that such a certificate be filed if, for example, there is any doubt regarding whether the above requirements are met.
- 2) Furthermore, the above requirements have been loosened, and the range of entities which are eligible for said reductions, especially small and medium business, has been broadened.

This revision will apply to applications which have had a Request for Examination filed on or after 1 April 2019, regardless of the application date.

If you would like any further details regarding the above, kindly contact us.

### 2. Official Announcement Regarding the Guide to Licensing Negotiations Involving Standard Essential Patents

In June 2018, the JPO released an official announcement regarding the Guide to Licensing Negotiations Involving Standard Essential Patents.



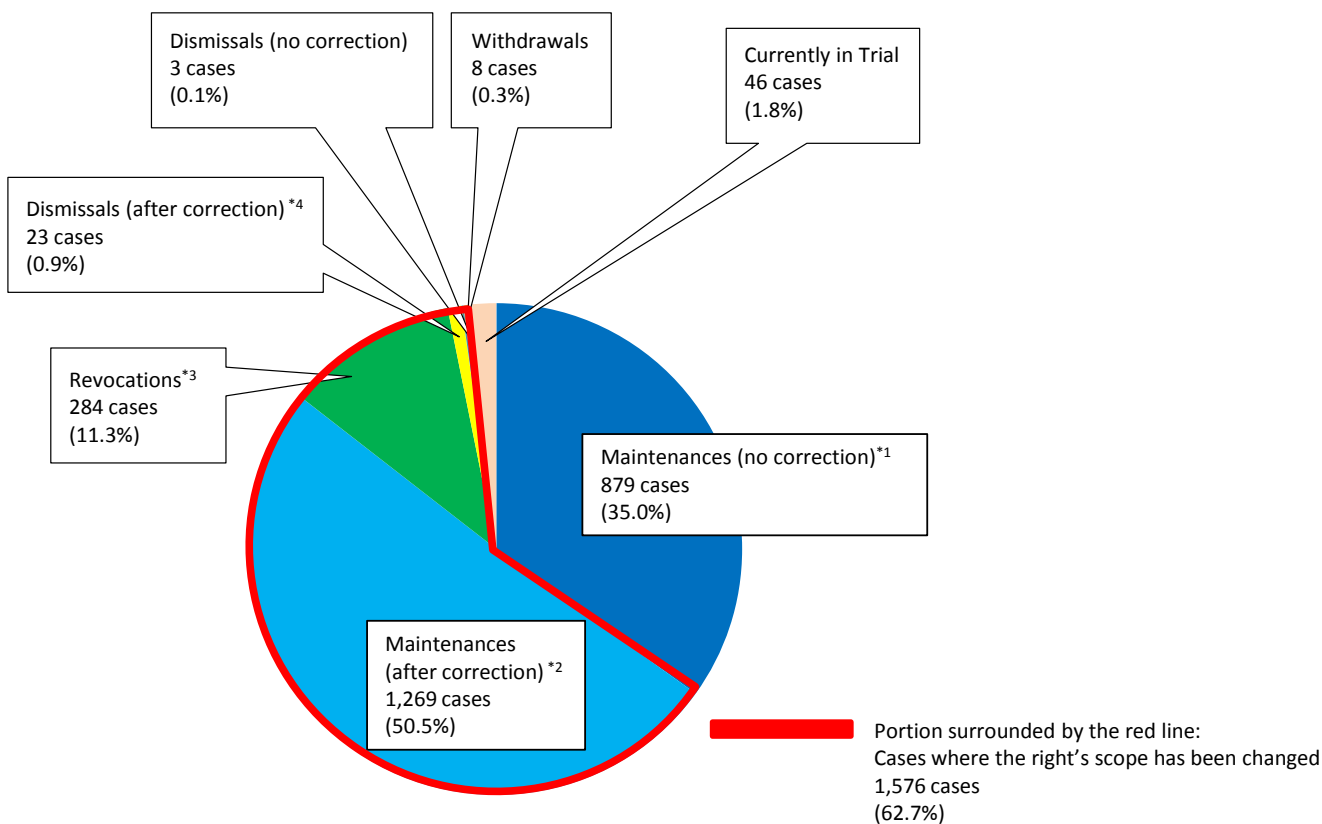
The JPO produced said Guide with the aim of clarifying licensing negotiations involving standard essential patents which need to be implemented in such fields as radio communications, as well as making them more predictable, making negotiations between patent right holders and licensees smoother, and preventing or quickly resolving disputes. The Guide mainly explains how license negotiations should progress and how the royalties should be calculated. Furthermore, please note that said Guide is not legally binding.

For further details, kindly refer to the English version of the guidelines available from the JPO website at the following internet address.

<https://www.jpo.go.jp/shiryoku/kijun/kijun2/files/seps-tebiki/guide-seps-en.pdf>

### 3. Opposition Statistics

Around four years have passed since the system for lodging oppositions to patents was introduced in April 2015, and the JPO has released statistical data showing the trial results of the 2512 cases lodged between the system's inception and September 2017.



\*1 Patent right maintained without correction.

\*2 Patent right maintained after partial or complete correction thereof.

\*3 Cases where all or some of the opposed claims were revoked.

\*4 Oppositions dismissed after recognizing corrections cancelling all opposed claims.

(This chart was taken from the JPO website and slightly modified.)

A patent right holder can correct, for example, the claims or Specification during opposition proceedings. As can be seen from the above chart, although the number of cases resulting in decisions of revocation tends to be low, cases where the scope of the claims has been changed (typically restricted) through a correction are included among the cases where the right has been maintained. Therefore, the overall number of cases where the scope of the patent right has changed has correspondingly proportionally grown (62.7%). Looking at this data, it could be thought that the opposition system is useful as a system for third parties to at least force a change in the scope of patent rights.

---

## 4. Revision to the Infringement Suit System

---

The Nihon Keizai Shimbun newspaper predicts that a proposal for the revision to the Patent Law in connection with the infringement suit system will be submitted to this year's ordinary Diet session.

According to said prediction, a system allowing a court-appointed technical specialist to collect evidence of business activities suspected of having infringed on a patent right will be introduced in infringement suits. In said system, when certain requirements are met, in accordance with the plaintiff's (i.e. the patent right holder's) allegation, such a technical specialist will be able to collect evidence of a patent right having been infringed.

Patent right infringements are unique in that they are easy to infringe, but difficult to prove and deter. The JPO committee charged with examining the patent system have been discussing revisions to the infringement suit system including, for example, improving the manner in which reparations are calculated, as well as strengthening the means for gathering the evidence described above, in order to adequately protect the rights of the patent owner even under such circumstances.

If any further details are released, we will inform you.

---

## 5. Grand Panel Decisions by the Intellectual Property High Court

---

The Intellectual Property High Court (IPHC) was established in 2005 to deal exclusively with intellectual property right infringements.

Although IPHC cases are normally handled by panels of three judges, in trials where advanced technical matters become problematic or which will have great influence on industry and the economy, a Grand Panel of five judges is convened to render a more deliberate verdict and establish consistency of legal understanding within the IPHC with regards to such cases which will result in such great influence on industry and the economy.

Since the IPHC's creation, twelve decisions have been made by such Grand Panels, two of which will be presented below. As English translations of both of said decisions are available on the IPHC website, please see the relevant web pages therein for further details.

### 1. 2016(Ne)10046 Appeal Case Seeking an Injunction Against Patent Infringement

#### Case Information

Appealed From	Tokyo District Court (Case Number: 2015(Wa)12414)
Parties	[Appellant (Plaintiff)] Debiopharm International S. A. [Appellee (Defendant)] TOWA PHARMACEUTICAL CO., LTD.
Patent	JP 3547755B (Title of the invention: Pharmaceutical stable oxaliplatinum preparation) [Claim 1] A pharmaceutically stable preparation of oxaliplatinum for the administration by the parenteral route, consisting of a solution of oxaliplatinum in water at a concentration of 1 to 5 mg/ml and having a pH of 4.5 to 6, the oxaliplatinum content in the preparation being at least 95% of the initial content and the solution remaining clear, colorless and free of precipitate after storage for a pharmaceutically acceptable duration of time.
Judgment	20 January 2017

In this case, the patentee of JP3547755B sought an injunction against the production of pharmaceutical products manufactured and sold by the defendant by claiming that said products fall under the technical scope of the invention in claim 1 of said patent, and that the validity of said patent right, the duration of which had been extended, reached said production. Furthermore, the registration of the extension of said patent's duration was received based on the manufacture and sale of the corresponding medicament (Elplat) being approved, said approval being itself based on the Pharmaceutical Affairs Law.

Although Elplat and the defendant's product have the same active ingredient and result as well as dosage/administration, they are different in that the former is an aqueous solution consisting of oxaliplatin and water only while, in the latter, oxaliplatin and an equal amount of glycerin are added to water.

Therefore, the Grand Panel's verdict dismissed the above request as the defendant's product did not reach the validity of the patent right of JP3547755B.

The main points of this verdict are outlined below.

### **(1) Validity of a patent right when the time period has been extended**

The prevailing view in the aforementioned verdict relating to the above validity is as follows.

The patented invention pertaining to a patent right, the duration of which was extended, is not only effective against the "product" (medicine) specified by the "ingredients, dosage, administration, efficacy and effects" prescribed at time of approval, but also against those which are substantially identical to said product as a medicine. Even if said characteristics contain partial differences from the target product (i.e. the defendant's product), if said differences are only slight or are as a whole only formal, the validity of said patented invention covers in its scope the target product, which is included in products which are substantially the same as the product which was approved as a medicine.

In the present case, as it could not be said that the differences between the two products were only slight or as a whole only formal, the defendant's product was not considered to be covered by the scope of the patent right's extended validity.

### **(2) Interpretation of the Japanese expression "karanaru" ("consisting of")**

This court decision is very interesting with regards to the interpretation of the Japanese term "karanaru", usually used to translate the English term "consisting of".

For example, if an English- or German-language PCT application which was applied for outside of Japan is transferred to Japan, a Japanese translation of the specification and claims must be filed with the JPO and, if said specification and claims include the term "consisting of", this is usually translated into Japanese as "karanaru". In this case, claim 1 of the aforementioned patent contained said term.

The Examination Guidelines do not specify whether said Japanese term should be regarded as close-ended or open-ended but, in this case, the Grand Panel Decision stated that this should be judged by considering the Specification and the history of the application.

Specifically, this case should be judged as follows.

- as the phrase "consisting of an aqueous solution of oxaliplatin" can be interpreted as meaning either that the solution consists solely of oxaliplatin and water, or that it consists of oxaliplatin and water and may contain other ingredients, such as additives, the totality of the claims can be considered, this matter was thus judged by referring to the Specification and history of the application.
- in this case, looking at the Specification and application history, the phrase "consisting of an aqueous solution of oxaliplatin" should be interpreted as meaning that the solution consists solely of oxaliplatin and water and no other ingredients such as additives.

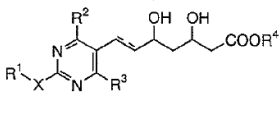
Although JPO examinations have until now tended to understand the meaning of "karanaru" as being close-ended, it is possible that this Grand Panel Decision will have an effect on JPO Examination practice.

The above Decision can be viewed in English on the IPHC website at the address below.

[http://www.ip.courts.go.jp/app/files/hanrei\\_en/136/002136.pdf](http://www.ip.courts.go.jp/app/files/hanrei_en/136/002136.pdf)

## 2. 2016(Gyo-Ke)10182 Case Seeking Rescission of the JPO Decision of Dismissal of Motion to Invalidate a Patent

### Case Information

Appealed From	Japan Patent Office (Case Number: Muko 2015-800095)
Parties	[Plaintiff] Nippon Chemiphar Co., Ltd. [Defendant (Patentee)] Shionogi & Co., Ltd.
Patent	JP 2648897B (Title of the invention: Pyrimidine derivative)  [Claim 1] A compound represented by the formula (I), or the corresponding ring-closed lactone.   <p style="text-align: center;">(I)</p> (definition of each substituent not included)
Judgment	13 April 2018

This case was a trial seeking the rescission of a JPO Decision rejecting a Request for an Invalidation Trial against JP2648897B.

The plaintiff asserted that the present patent should be invalidated because a) the potential benefits of any suits brought against the patent have not been lost, even after the time period of said patent has expired b) the patent does not have inventive step, and c) the patent does not meet the support requirement. However, the plaintiff's request was dismissed as the presence of said inventive step and support were both recognized, although the Panel agreed with the plaintiff's first assertion.

This case's Decision shows, for the first time as a Grand Panel Decision, the prevailing view in relation to how inventive step is judged. It was determined whether, if a compound is described in the form of a general formula in a publication and there is a huge number of choices for said general formula, such a publication is eligible for use as cited references to judge novelty and inventive step.

Said Decision specifically states that an invention asserted as a cited invention should be one that is "disclosed in a distributed publication" (Patent Law Article 29(1)(iii)) and, if a compound is described in the form of a general formula in a publication and the general formula has a huge number of alternatives, as long there is no information regarding the positive or preferential selection of the specific technical concept relating to the specific alternative and when said specific technical concept cannot be extracted, the invention involved cannot be used as a cited invention.

The above Decision can be viewed in English on the IPHC website at the following address:

[http://www.ip.courts.go.jp/eng/vcms\\_lf/2016gk10182\\_10184zenbun.pdf](http://www.ip.courts.go.jp/eng/vcms_lf/2016gk10182_10184zenbun.pdf)