



IP Issues in Japan 2006

TANI & ABE

No. 6-20, Akasaka 2-chome

Minato-Ku, Tokyo 107-0052

TEL: +81-3-3589-1201/FAX: +81-3-3589-1206

E-mail: y_tani@taniabe.co.jp

<http://www.taniabe.co.jp>

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1. An outlines of proposed bill of intellectual property laws

(The bill is scheduled to submit to the ordinary session of the Diet of this year)

1-1. Protection of designs (Design Law)

1-2. Protection of inventions

— Proposed Revision of Patent Law —

a) Reinforcement of a divisional application system

b) Abuse prevention of a divisional application system

1) Current law

2) An amendment restriction of divisional application

c) Change of an amendment system

*Example

1. The outline of proposal amendment bill of intellectual property laws

1-1. Protection of designs (Design Law)

The target for protection of the design is expanded to operation screens of an information appliance.

Example

operation screen of a video equipment
setting screen of a digital camera

*Note that a computer screen is outside the target for protection.

1. The outline of proposal amendment bill of intellectual property laws

1-2. Protection of inventions

— Proposed Revision of Patent Law —

a) Reinforcement of a divisional application system

When two or more inventions are included in patent application, new opportunity to separate invention(s) as new application(s) (divisional application(s)) is added.

Divisional application is allowed to be filed until less than 30 after examination termination, i.e. decision of final rejection, decision of registration.

1. The outline of proposal amendment bill of intellectual property laws

1-2. Protection of inventions

— Proposed Revision of Patent Law —

b) Abuse prevention of a divisional application system

1) Current law

In current divisional application system, it is possible to file a divisional application of the invention in parent application to which the reason for refusal is already notified again by contents as it is.

It is not the structure which urges an applicant to fully review the reason for refusal notified in parent application. Moreover, if it is within the period which can amend the parent application, it is possible to divide application, even if many years have passed since the filing date of the parent application.

1. The outline of proposal amendment bill of intellectual property laws

1-2. Protection of inventions

— Proposed Revision of Patent Law —

b) Abuse prevention of a divisional application system

2) An amendment restriction of divisional application

In divisional application, when the notice of reasons for rejection notified in examination of parent application is not withdrawn, the same amendment restriction as the final notice of reasons for rejection back is imposed if the same invention as invention which was decided to be obvious in examination of parent application is included in divisional application.



1. An outlines of proposed bill of intellectual property laws

1-2. Protection of inventions

— Proposed Revision of Patent Law —

c) Change of an amendment system

After receiving the examination result (even if it is the non-final notice of reasons for rejection), it is restricted to change the subject of examination into another invention from which a technical feature differs.

1. An outlines of proposed bill of intellectual property laws

1-2. Protection of inventions

— Proposed Revision of Patent Law —

Case 1

-Claim-

A: The high sensitivity antenna for cellular phones

-Detailed description of the preferred embodiments-

A: The high sensitivity antenna for cellular phones

B: The folding mechanism of cellular phones

* A and B are inventions which do not satisfy the requirements for unity.

Case 2

-Claim-

B: The folding mechanism of cellular phones

-Detailed description of the preferred embodiments-

A: The high sensitivity antenna for cellular phones

B: The folding mechanism of cellular phones

An amendment from Case1 to Case2 is restricted to be filed after the non-final notice of reasons for rejection issues.

2.

An Outlines of the New Route Proposal for Applications Abroad

(The Trilateral Offices meeting of November 14-18, 2005 in Munich)

2-1. Background

2-2. Outline of the New Route Basic concept of the New Route

***New Route Proposal**

***Comparison of characteristics among 3 routes**

2. An Outlines of the New Route Proposal for Applications Abroad

-A patent examination highway-

The patent examination highway is the proposal of JPO aiming at the following matters;

Improving the quality of examination

Promoting mutual use of search/examination result between the Trilateral Offices

* Note that the New Route Proposal has not yet taken between the Trilateral Offices. It is now under examination whether this proposal is adopted.

2. An Outlines of the New Route Proposal for Applications Abroad

2-1. Background

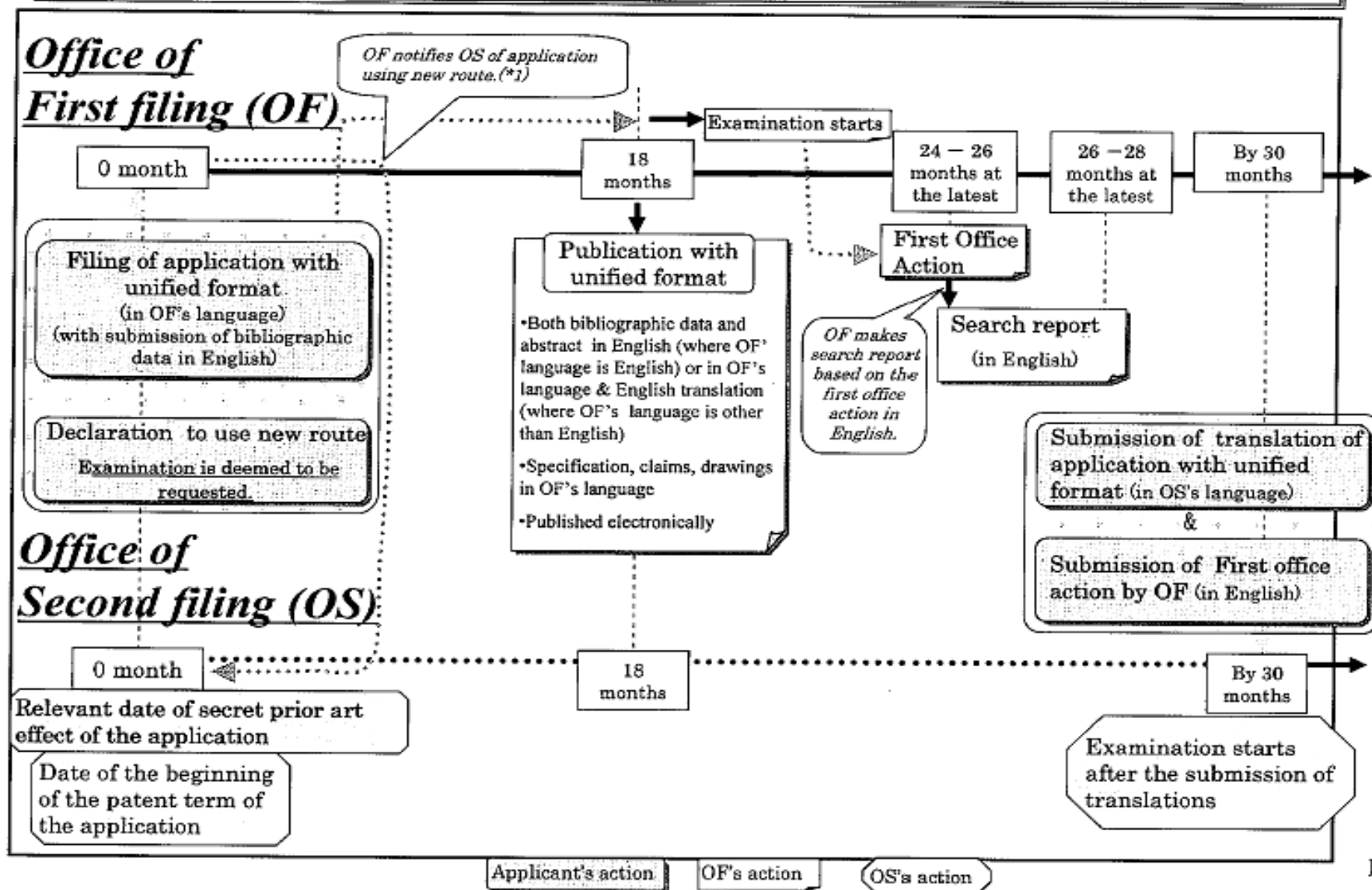
In an increasingly globalized economy, it is strongly expected that internationally active companies will obtain inexpensively similar examination results in a foreign country (the Office of Second Filing (OSF)) as in their own country (the Office of First Filing(OFF)). By closely cooperating with each other and resolving common problems, the Trilateral Offices play an important role in supporting the global patent activities of users.

2. Outline of the New Route Proposal for Applications Abroad

2-2. Outline of the New Route Basic concept of the New Route

An application filed with the OFF through the New Route is deemed to have been filed with the OSF on the filing date in the OFF. The time limit for an applicant to submit a translation is 30 months from the filing date (priority date). This time limit is granted under the condition that the OFF provides the search and examination result expeditiously to the OSF and that the OSF can exploit the result in an examination of the corresponding application.

New Route Proposal



Comparison of characteristics among 3 route

	Use		Advantages	Disadvantages
Paris Route	-For filing in few countries	Applicant	<ul style="list-style-type: none"> ▪ The cost is lower than PCT route when an applicant obtains patents in few countries. 	<ul style="list-style-type: none"> ▪ An applicant needs to make translations in different formats within 12 months from the priority date.
		Patent Office		<ul style="list-style-type: none"> ▪ A search and examination result of the OF is often unavailable to the OS
PCT	-For filing in many countries	Applicant	<ul style="list-style-type: none"> ▪ An Applicant can use the expanded time limit (30 months from the priority date) and a search and examination result of the OF to determine whether to continue the application procedure and to submit a translation to the OS. 	<ul style="list-style-type: none"> ▪ It is rather expensive when an applicant obtains patents in few countries.
		Patent Office	<ul style="list-style-type: none"> ▪ A search and examination result of the OF is always available to the OS. It contributes to high quality and expedited examination. 	
New Route	-For filing in few countries	Applicant	<ul style="list-style-type: none"> ▪ The cost is lower than PCT route when an applicant files to limited number of countries which participate in the agreement. ▪ Procedure is simple ▪ An Applicant can use the expanded time limit (30 months from the priority date) and a search and examination result of the OF to determine whether to continue the application procedure and to submit a translation to the OS. 	<ul style="list-style-type: none"> ▪ An applicant can file only within the Offices of the limited number of countries which participate in the agreement.
		Patent Office	<ul style="list-style-type: none"> ▪ A search and examination result of the OF is always available to the OS. It contributes to high quality and expedited examination. 	

3. *A patent about 2 screen-display of a cellular phone*

3. A patent about 2 screen-display of a cellular phone

ADC technology, which is venture company, got the patent(Patent No. 3408154) about the cellular phone which mounts a main liquid crystal display and a back liquid crystal display.

(Outline)

The 1st display turns on a light by opening the upper part.

The 2nd display turns on a light in the state where the upper part is folded up. At that moment the 1st display is turned off.

A standby screen and a power-supply screen are displayed on the two displays.

3. A patent about 2 screen-display of a cellular phone

The patent is related to a portable terminal which mounts two displays. The 1st display is an inside main display and the 2nd display is a back liquid crystal. ADC technology asserted that flip phones which mount two screens of main liquid crystal and sub liquid crystal infringe this patent.

ADC technology fought with NTT DoCoMo and NEC over the court. The argument of NTT DoCoMo and NEC were accepted on the grounds that the Patent Office determined cancellation of this patent. When the judgment was taken, the patent had been canceled by the patent opposition for the reason the patented invention would be obvious on the basis of prior arts. Tokyo District Court admitted that there was no claim for damages in ADC technology. NTT DoCoMo and NEC won the lawsuit.

4. Help icon patent litigation

-Matsushita Electric Industrial Co., Ltd. vs. Justsystem Corp

4. Help icon patent litigation

-Matsushita Electric Industrial Co., Ltd. vs. Justsystem Corp

The appeal court judgment of a lawsuit which Matsushita Electric Industrial was asking for selling prohibition of the word-processing software "Ichitaro" and graphics software "Hanako" of JUST System for the reason the function of the "help icon" which displays the balloon help embedded in both software infringes the patent was taken at the Intellectual Property High Court on September 30, 2005. The inversion judgment which accepted the arguments of JUST System was decided.

4. Help icon patent litigation

-Matsushita Electric Industrial Co., Ltd. vs. Justsystem Corp

In the lower court decision in Tokyo District Court in February, the court accepted the arguments of Matsushita Electric Industrial and ordered the stop of manufacturing and selling of "Ichitaro" and "Hanako", and cancellation of the products. In this trial in which JUST System filed an appeal considering this as dissatisfied, the lower court decision of Tokyo District Court was canceled, and each claim of Matsushita Electric Industrial became inversion judgment of rejecting. Matsushita Electric Industrial gave up an appeal to a final court.

You can read details of the litigation in the following web site:

<http://www.law.washington.edu/Casrip/Newsletter/Vol12/newsv12i2Japan2.html>



**5. *E-Ticket patent
litigation***

-JAL. VS ANA-

5. E-Ticket patent litigation -JAL. VS ANA-

In 2004, JAL (plaintiff) claimed the stop of operation of a system and claimed for damage, 15,600 million of yen to ANA (defendant) on the ground that ANA was infringing on JAL' s patent right involving the online service system for companies which can take the aircraft reserved without airline ticket.

ANA asserted an invalid about the patent right (appeal for invalidation).

The Patent Office issued the notice of invalidation.

JAL limited the scope of claims in filing an amendment and submits withdrawal of a petition for the reason that concern of conflict dissolved.

Tokyo District Court accepted claim abandonment and the lawsuit ended in 2005.



6. Inventive Step

(Non-obviousness of Combination invention)

6. *Inventive Step (Non-obviousness of Combination invention)*

A: Motivation Theory

It is the theory that the present invention is obvious only when there are suggestion and motivation of combination in cited arts.

B: Hindrance factor Theory

It is the theory that the present invention is non-obvious when there is a hindrance factor of combination, although it can be presumed to be obvious in principle.

Judgment of Tokyo High Court, including judgment about whether or not hindrance factor exists (2000~2005)

The number of cases in which the Court accepted the hindrance factor

14 cases (9.5%)

The number of cases in which the Court denied the hindrance factor

134 cases (90.5%)

6. *Inventive Step (Non-obviousness of Combination invention)*

The trend of inventive step judgment of the Japanese Patent Office according to statistics, the strike rate of appeal is dropping sharply,

Data in 1996 88.0% → Data in 2004 55%(electronic field 50.1%)

Judgment of the inventive step in the Patent Office has become severe.

Since there is a big difference in a strike rate of appeal by whether or not an amendment at the time of an appeal is filed, the amendment at the time of the appeal is effective in order to get patents in the appeal examination.



Thank you for your attention