

**ENGLISH SEMINAR OF INTELLECTUAL PROPERTY
BY IP GRADUATE SCHOOL UNION**

Patent Law

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Graduate School of Intellectual Property

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Contents

1. Introduction
2. Patentable Subject Matter
3. Patent Right and Infringement

1. Introduction

History

1854: Opening a country

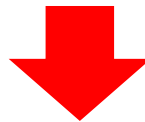
1884: Trademark Law (enacted)

1885: Patent Law (enacted)

1888: Design Law (enacted)

1899: Paris Convention (joined)

National Treatment



Foreign people started to apply for patents in Japan.

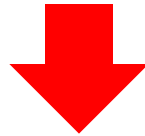
Purpose

- “The purpose of Patent Law is to encourage inventions through promoting the protection and the utilization of inventions, and thereby to contribute to **the development of industry.**” (Article 1 of the Patent Law)
- According to court decisions, the purpose of the patent law often forms a major part of the grounds for decisions.

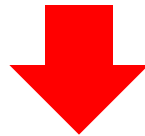
Japan Patent Law clearly stipulates “the development of industry” as the purpose of this law, which is not common among major countries.

Purpose

(1) The protection and the utilization



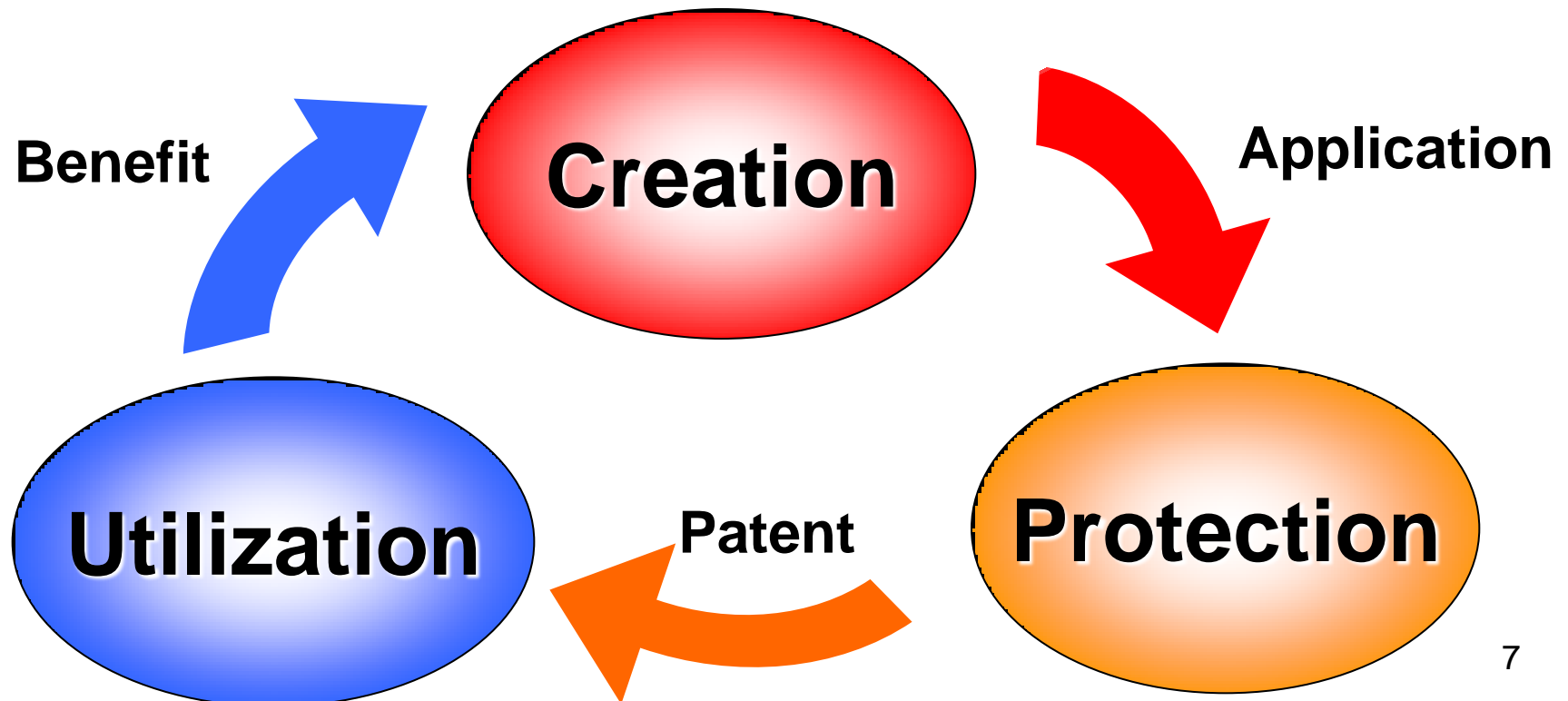
(2) To encourage inventions



(3) The development of industry

IP Cycle

Creating a high technology **[creation]**, protecting as intellectual property **[protection]**, manufacturing the products from intellectual property **[utilization]**, again creating a high technology, and realizing the sustainable innovation.



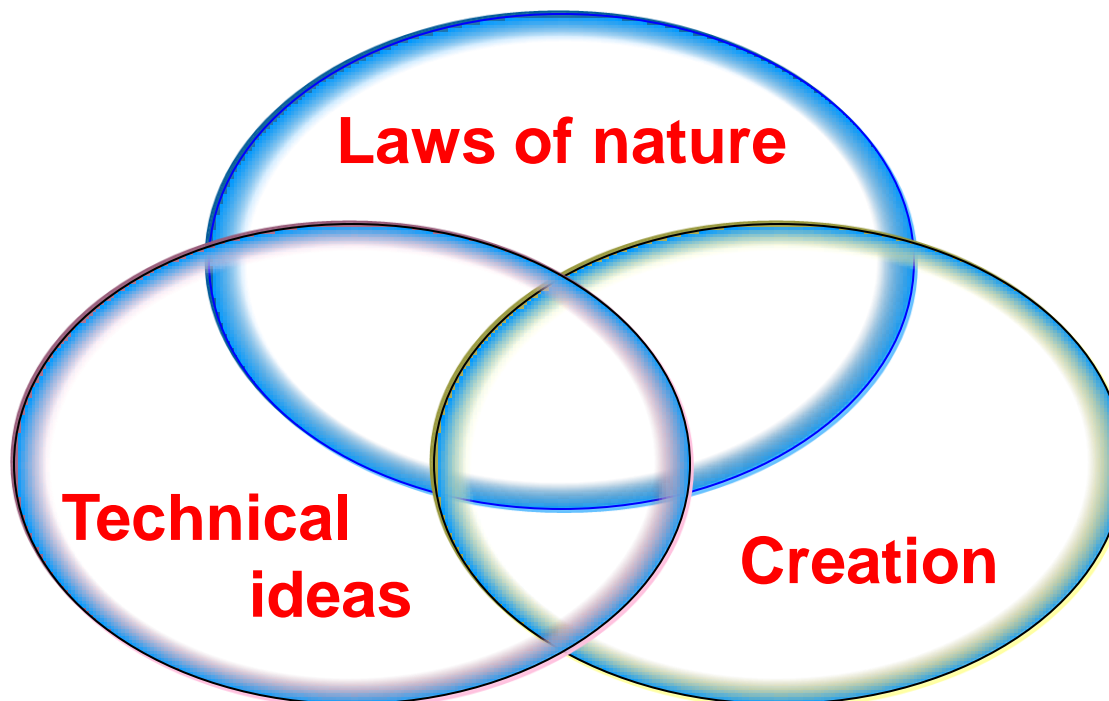
2. Patentable Subject Matter

Invention

Article 2 (Definitions)

Patent Law

(1) "Invention" in this Act means the highly advanced **creation of technical ideas** utilizing the **laws of nature**.



Invention

(1) Laws of nature

If claimed inventions are ---

- economic laws
- rules for playing a game as such
- mathematical methods or mental activities
- methods for doing business as such,

these inventions are not considered to be statutory because they do not utilize a law of nature.

Invention

(1) Laws of nature

<Note> (Software related invention)

Where information processing by software is concretely realized by using hardware resources (e.g. an arithmetic unit such as a CPU, a storage means such as memory) in the claimed invention, the claimed invention contains "a law of nature".

Invention

(2) Technical Idea

Personal skill (which is acquired through personal experience and cannot be shared with others as a knowledge due to lack of objectivity)

Example: A method of throwing a split-fingered fast ball characterized in the way of holding the ball in fingers and throwing the same.

Invention

(3) Creation

One of the requirements for a statutory invention is to be a "creation", and thus, mere discoveries, such as discoveries of natural things like an ore or natural phenomena, for which an inventor does not consciously create any technical idea, are not considered to be a statutory invention.

Invention

(3) Creation

<Note>

However, if things in nature such as chemical substances or microorganisms have been isolated artificially from their surroundings, then those are creations and considered to be a statutory invention.

Industrial Applicability

Patent Law

Article 29(Conditions for Patentability)

(1) An inventor of an invention that is **industrially applicable** may be entitled to obtain a patent for the said invention, except for the following:---

Industrially Applicable

Article 29(Conditions for Patentability)

Patent Law

(1) An inventor of an invention that is **industrially applicable** may be entitled to obtain a patent for the said invention,

Industrial Applicability	Example
Medical Activity	Surgical operation method
Invention which cannot be used as work	Method for smoking tobacco
Invention which cannot be carried out clearly	Bridge which connects the moon to the earth

Industrially Applicable

(1) Medical Activity

Methods of surgery, therapy or diagnosis of humans have been termed "medical activity" and are normally practiced by medical doctors (including those who are directed by medical doctors, hereinafter referred to as “medical doctors”).

Industrially Applicable

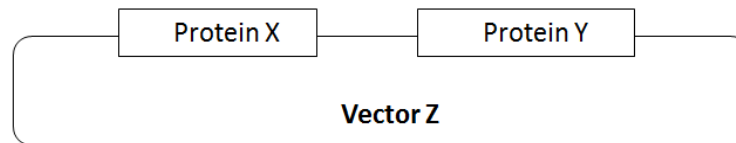
(1) Medical Activity

Even if methods of surgery, therapy or diagnosis are practiced on animal bodies in general, unless it is clear that the methods practiced on a human body are explicitly excluded, the methods are deemed as being “methods of surgery, therapy or diagnosis of humans.”

Industrial Applicability

[Claim]

A method of reducing a cancer by administering the vector Z including both the DNA encoding protein X and the DNA encoding protein Y into a human body.

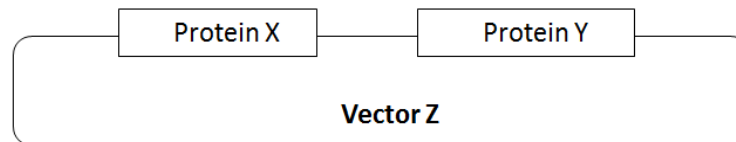


JPO Examination Guideline

Industrial Applicability

[Claim]

A method for manufacturing cell formulation for cancer therapy by introducing genes with vector Z including both the DNA encoding protein X and the DNA encoding protein Y into a cell W extracted from a human body.



JPO Examination Guideline

Judicial Case

- Case Name: Surgical Operation Case (IP High Court)
- Date: April 11, 2002
- Decision: **SURGICAL OPERATIONS** do not have
“Industrial Applicability”.(Article 29-1)

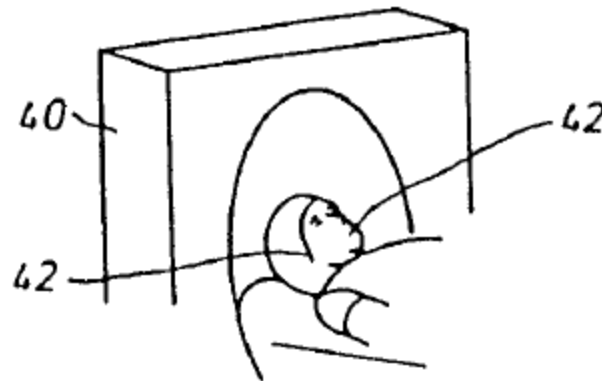


Fig.1

Novelty

Patent Law

Article 29(Conditions for Patentability)

- (1) Inventions which are not novel are as the following;
- (i) inventions that were **publicly known in Japan or a foreign country**, prior to the filing of the patent application;
 - (ii) inventions that were **publicly worked in Japan or a foreign country**, prior to the filing of the patent application;

Novelty

Patent Law

Article 29(Conditions for Patentability)

Inventions which are not novel are as the following;

...

- (iii) inventions that were **described in a distributed publication**, or inventions that were made publicly available through **an electric telecommunication line in Japan or a foreign country**, prior to the filing of the patent application.

Novelty

Novelty	Example
publicly known	broadcasted on TV
publicly worked	for sale on the store
described in a distributed publication	described in research journals
an electric telecommunication line	open on website

Case Studies (1)

1. He explained his invention to many of his co-workers in his company in detail. In this case, his invention lost novelty?

All the employees have “Duty of Secrecy” in their company.

Case Studies (2)

2. He lectured his invention in his seminar, but there was only one participant in this seminar. In this case, his invention lost novelty?

The number of the participants does NOT matter.

Case Studies (3)

3. His invention was uploaded on his Website, and it could be retrieved by search engine, but there was no access from others. In this case, his invention lost novelty?

The possibility (not the fact) to be known is the point.

Case Studies (4)

4. X watched Y's invention on TV in the morning, and X applied for patent of Y's invention in the afternoon of the same day. X's application is rejected by lack of novelty?

The time (not the day) of application is the point.

Case Studies (5)

5. X applied for a patent of his invention in the morning, and Y applied for the patent of the same invention in the afternoon of the same day. Who can obtain the patent?

X and Y should discuss which can obtain the patent.

Product-by-Process Claims

- Product X manufactured by Process Y



Novel or Not?

- Product X manufactured by Process Z

* Product X is the same, but Process Y is different from Process Z.

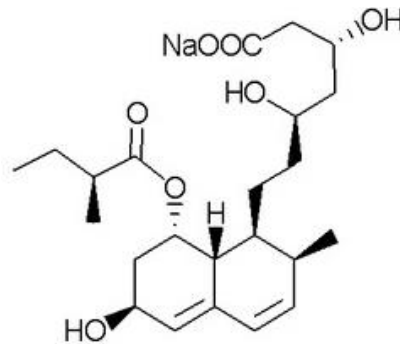
Product-by-Process Claims

[Product-by-Process Claims]

It is understood that claims defining products by the manufacturing processes means definitions that represent products per se gained **as final products**. Accordingly, the novelty of the claimed invention is denied when other manufacturing processes are able to produce an identical

Judicial Case

- Case Code: Supreme Court, H24 (Ju) No.1204
- Date: June. 5, 2015
- Decision: **Product-by-Process Claims was interpreted as the final product. (not considering the process)**



Pravastatin

(Medicine for hyper cholesterol)

Inventive Step

Article 29(Conditions for Patentability)

Patent Law

(2) Where, prior to the filing of the patent application, **a person ordinarily skilled in the art of the invention** would have been **able to easily make the invention** based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

Case Studies

Conversion of a medicine for animals to a medicine for human beings

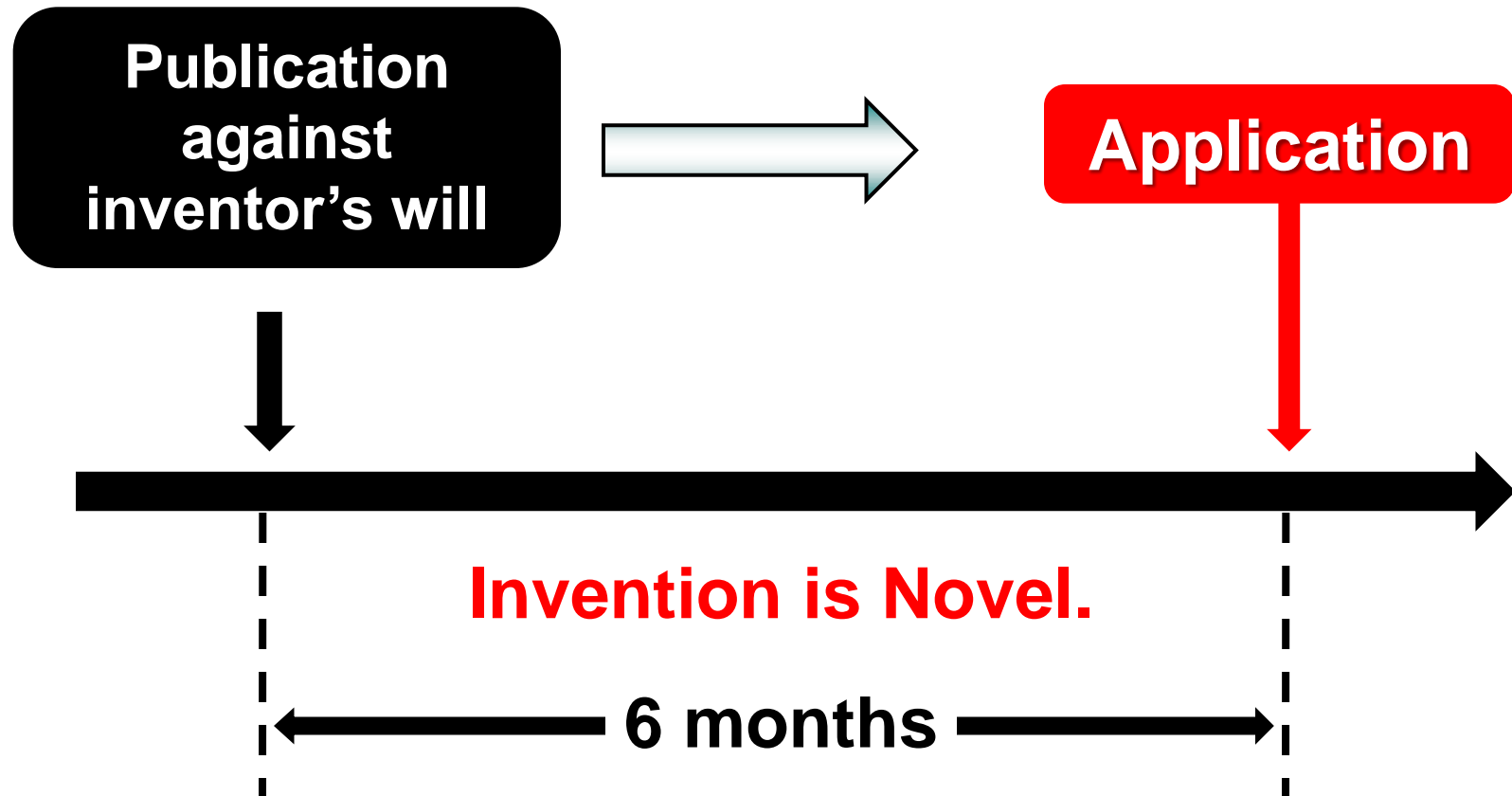
New medicine for human is invented. Prior document explained that the same active ingredient was used for the same efficacy for dogs.

Case Studies

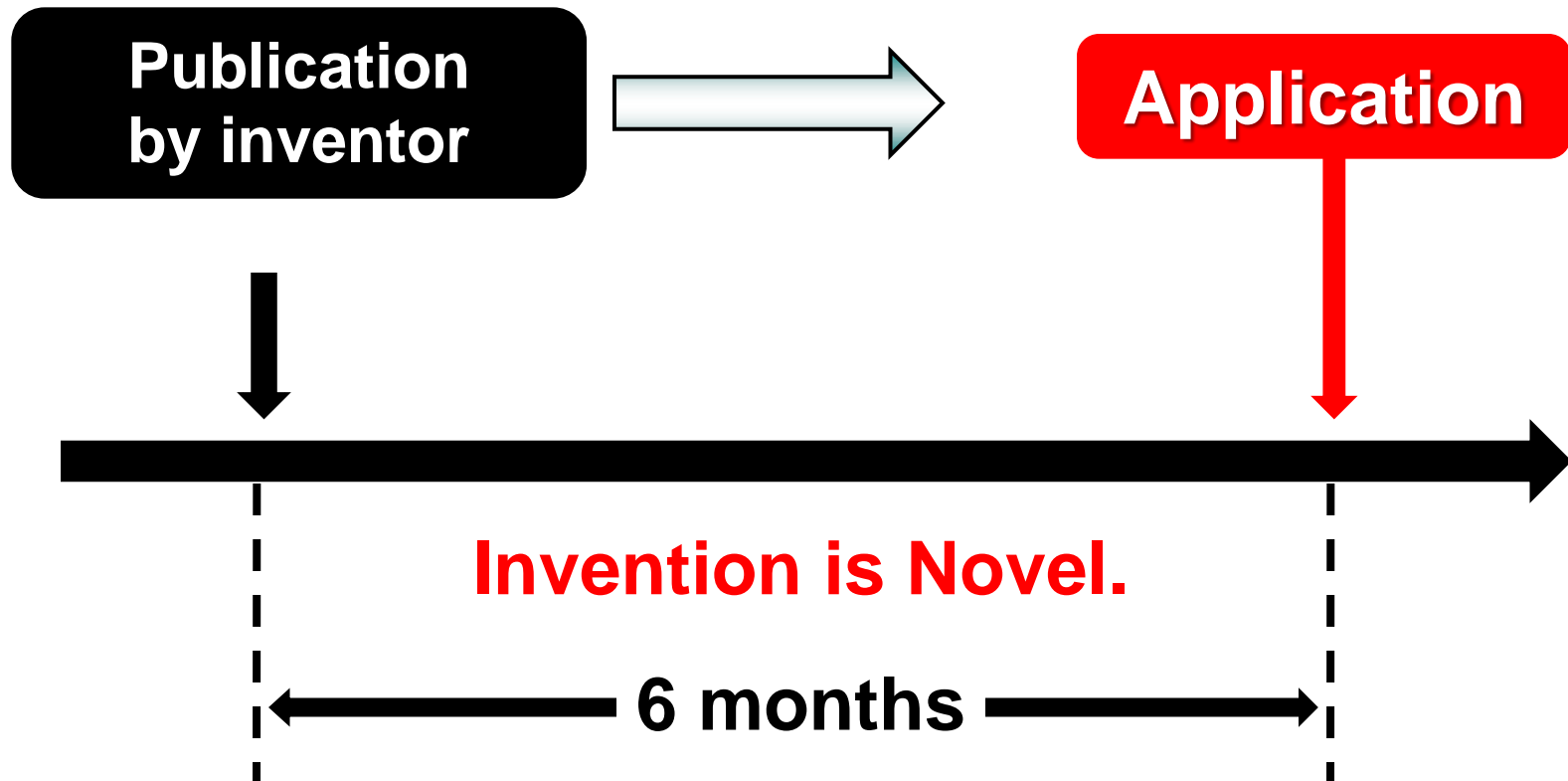
Conversion of DNA from animals to DNA from human beings

New polynucleotide is purified from human cell. Prior document explained polynucleotide from rat cell which has 80% homology to that from human cell.

Exception



Exception



Written Requirements

Article 36 (Written Requirements)

Patent Law

- (4) The statement of the detailed explanation of the invention as provided in item (iii) of the preceding Paragraph shall comply with each of the following items:
- (i) in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall **be clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention;**

Written Requirements

Article 36 (Written Requirements)

Patent Law

- (6) The statement of the scope of claims as provided in paragraph (2) shall comply
- (i) the invention for which a patent is sought is **stated in the detailed explanation** of the invention;
 - (ii) the invention for which a patent is sought is **clear**;

Written Requirements

Written Requirements	Brief Explanation
Enablement requirements	Specification be clear and sufficient to work the claimed invention. (article 36 (4) -1)
Support requirements	Claimed invention should be stated in the specification . (article 36 (6) -1)
Clarity requirements	Claimed invention should be clear . (article 36 (6) -2)

Unpatentable invention

Patent Law

Article 32 (Unpatentable inventions)

Any invention that is liable to injure **public order, morality or public health** shall not be patented.

[Example]

“Illegal products”, “Child porno”, “Unhealthy foods” etc.

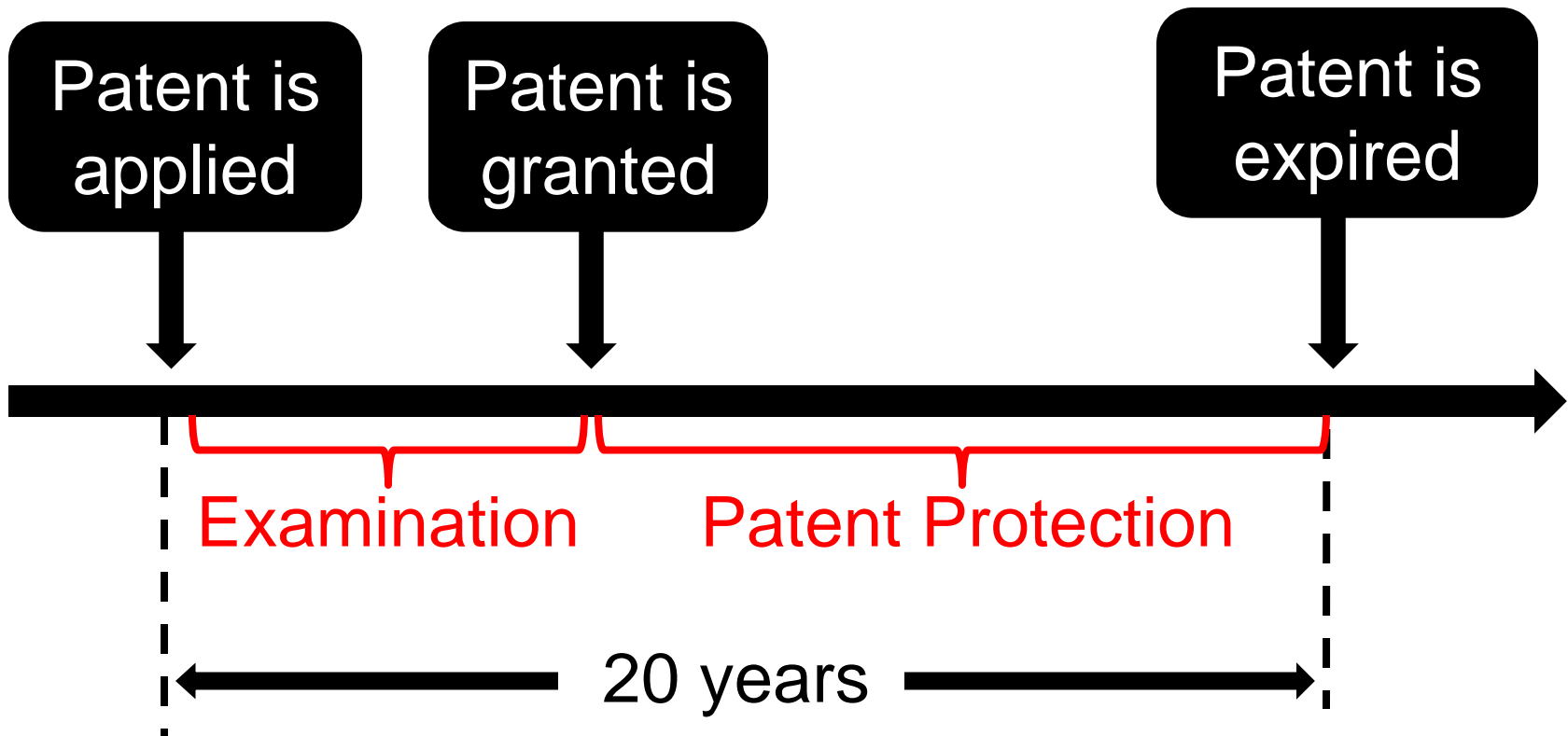
Judicial Case

- Case Name: Bingo Game Case (Tokyo High Court)
- Date: Dec. 15, 1956
- Decision: Article 32 (Patent Law) can not be applied to “Bingo Game”. (Article 32 should be applied restrictively.)

1	2	3	4	5
6	7	8	9	10
11	12	☆	14	15
16	17	18	19	20
21	22	23	24	25

3. Patent Right and Infringement

Duration of Patent Right



Examination = Novelty, Inventive step, etc.

Duration of Patent Right

Patent Law

Article 67 (Duration of patent rights)

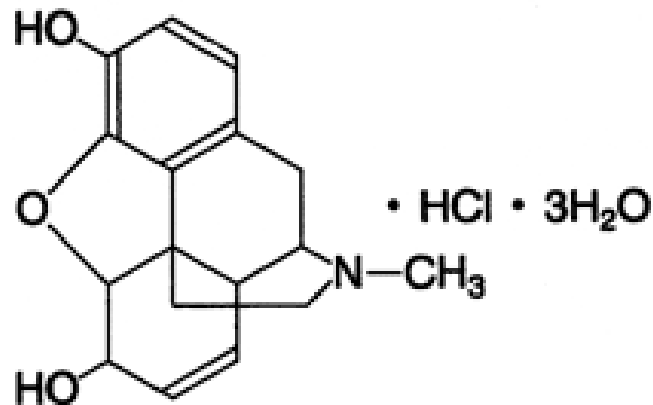
- (1) The duration of a patent right shall expire after a period of **20 years from the filing date** of the patent application.
- (2) Extension of patent term ...**within 5 years** ...

<Note>

Patent term can be extended within 5 years if some patent term is lost by the procedure for an approval of manufacturing patented medicines.

Judicial Case

- Case Code: Supreme Court, H21 (Gyo-Hi) No.326
- Date: April 28, 2011
- Point: Condition for the patent term extension became more flexible than before.



Morphine Hydrochloride (Pain-killer)

Effect of Patent Right

Patent Law

Article 68 (Effect of patent right)

A patentee shall have **the exclusive right** to work the patented invention **as a business**.

<Note>

“Personal work” and “family work” are NOT “as a business”.

Limitation of Patent Right

Patent Law

Article 69 (Limitations of patent right)

(1) A patent right shall not be effective against the working of the patented invention **for experimental or research purposes.**

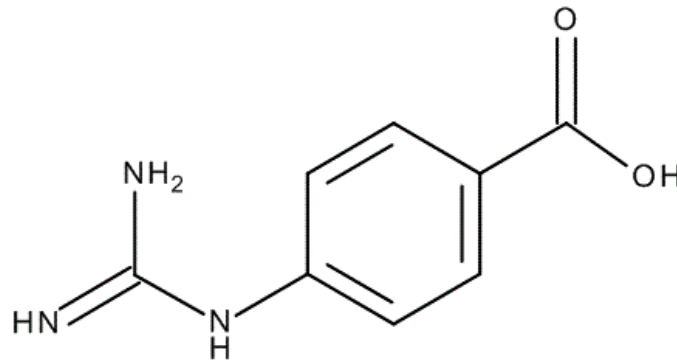
<Question>

Patent right can reach “Clinical test”?

Patent right can reach “University’s research”?

Judicial Case

- Case Code: Supreme Court, H10 (Ju) No.153
- Date: April 16, 1999
- Decision: Patent rights can NOT reach “Clinical test”.



Guanidino benzoic acid
(Medicine for Pancreas Disease)

Judicial Case

- Case Code: Tokyo District Court, H11 (Wa) No.15238
- Date: Dec. 20, 2001
- Decision: **There is no infringement because university's research is outside the scope of the claims.**

(There is no judicial decision whether patent right can reach "University's research".)

Scope of patented invention

Article 70 (Technical scope of patented invention)

- (1) The technical scope of a patented invention shall be determined based upon the statements in the **scope of claims** attached to the application.
- (2) In the case of the preceding paragraph, the meaning of each term used in the scope of claims shall be interpreted in consideration of the **statements in the description and drawings** attached to the application.

[Note]

Scope of patented invention basically means “Claim”.

Judicial Case

- Case Code: Supreme Court, H6 (O) No.1083
- Date: October 24, 1998
- Decision: Rule for Doctrine of equivalents (as below)
 - 1) Replacement of a non-essential part
 - 2) Possibility of replacement
 - 3) Easiness of replacement
 - 4) Failure in argument of publicly known technology and easily invented technology
 - 5) Taking account of prosecution history

Advisory opinion

Patent Law

Article 71 (advisory opinion)

(1) A request may be made to the Patent Office for its **advisory opinion** on the technical scope of a patented invention.

<Note>

Advisory opinion is drafted by the JPO.

<Question>

What is the legal effect of advisory opinion?

Judicial Case

- Case Code: Supreme Court, S42 (Gyo-Tu) No.47
- Date: April 18, 1968
- Decision: **There is no legal effect in advisory opinion.**

<Note>

Advisory opinion can be highly considered by courts because it is drafted by the JPO.

Expert opinion

Patent Law

Article 71 bis (expert opinion)

(1) Where the Commissioner of the Patent Office is commissioned by the court for the provision of an expert opinion on the technical scope of a patented invention, the Commissioner of the Patent Office shall appoint three trial examiners and direct them to provide an expert opinion on the requested matter.

Exclusive license

Patent Law

Article 77 (Exclusive license)

- (1) A patentee may grant an **exclusive license** on the patent right.
- (2) An exclusive licensee shall have an **exclusive right to work** the patented invention as a business to the extent permitted by the contract granting the license.



- Only Y can work the patented invention.
- Even X can NOT work the patented invention.

Non-exclusive license

Patent Law

Article 78 (Non-exclusive license)

- (1) A patentee may grant a **non-exclusive license** on the patent right to any third party.
- (2) A non-exclusive licensee shall have **a right to work** the patented invention as a business to the extent prescribed by this Act or permitted by the contract granting the license.



- Y can work the patented invention.
- X can also work the patented invention.

Right to seek injunction

Patent Law

Article 100 (Right to seek injunction)

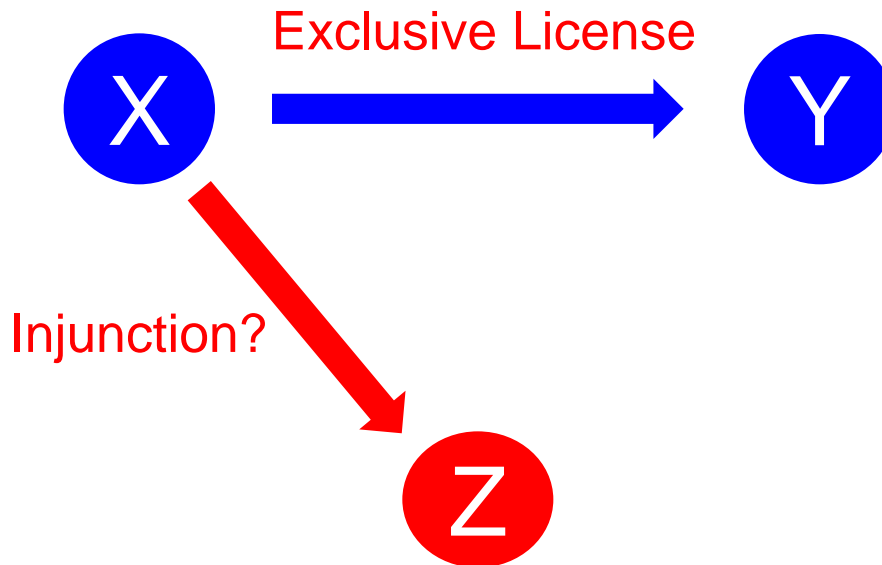
(1) A patentee or exclusive licensee may demand a person who infringes or is likely to infringe the patent right or exclusive license **to stop or prevent such infringement.**

[Question]

Patentee who provided exclusive license can still have a right to seek injunction?

Judicial Case

- Case Code: Supreme Court, H16 (Ju) No.997
- Date: June 17, 2005
- Decision: **Patentee who provided exclusive license can still have a right to seek injunction.**



Trial for invalidation

Patent Law

Article 123 (Trial for patent invalidation)

(1) Where a patent falls under any of the following, a request for **a trial for patent invalidation** may be filed.

[Question]

Non-exclusive licensee can appeal for a invalidation of the patent which is licensed to this licensee?

Judicial Case

- Case Code: Tokyo High Court, S59 (Gyo-Ke) No.7
- Date: July 30, 1985
- Decision: **Non-exclusive licensee can appeal for a invalidation of the patent which is licensed to this licensee.**



Penal regulations

Article 196 (Crime of infringement)

An infringer of a patent right shall be punished by imprisonment with work for a term not exceeding 10 years or a fine not exceeding 10,000,000 yen or combination thereof.

< Penal regulations >

- “imprisonment”
- “fine”
- “combination thereof”

Penal regulations

Article 201 (Dual liability)

(1) Where **employee of a juridical person** has committed in the course of performing his/her duties for the juridical person, in addition to the offender, **the juridical person shall be punished by a fine** as provided in the corresponding item:

(i) **Article 196, ---; a fine not exceeding 300 million yen;**

< Penal regulations >

- The juridical person could be punished by a fine.

Thank you

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