



**Issue #3 April 18, 2016**

## IP PROSECUTION AND PROCEDURES

### **Revised JPO Examination Guidelines for Patents and Utility Models**

The JPO revised [the Examination Guidelines for Patents and Utility Models](#), effective April 1, 2016. Major changes are summarized below. Details [here](#).

#### **(A) Use Inventions for Food Products**

Recitations that specify a product by defining the manner of the use of the product (limitations of use) can now be recognized as technical features in food product inventions (but not for inventions relating to animals and plants).

#### **(B) Extension of Patent Terms**

[Whether a disposition by Cabinet Order was necessary to practice a patented invention when both a present disposition and a prior disposition have been made]

When manufacturing and distributing drug products or manufacturing and importing agricultural chemicals subject to both a present disposition and a prior disposition correspond to practicing a patented invention pertaining to an application for patent term extension, such actions are considered as follows: It is not recognized that the present disposition was needed to practice the patented invention pertaining to the application for patent term extension when the manufacturing and sale of the drug products or agricultural chemicals subject to the prior disposition are found to include the manufacturing or sale of the drug products or agricultural chemicals subject to the present disposition as a result of comparing the two dispositions with respect to the examination matters related directly to substantial sameness as drug products or agricultural chemicals in the light of the type and subject of the patented invention pertaining to the application for patent term extension.

*[[Original Announcement](#): JPO Website, Mar. 23, 2016]*

## Decision in Trial for Correction for Product-by-Process Claims

The JPO announced that it has for the first time issued a decision approving a categorical change of a Product-by-Process (PBP) claim from a product invention to a manufacturing method invention for a trial for correction ([Trial for Correction No. 2016-390005](#), in Japanese). This decision opens the way to overcoming grounds for invalidity (failure to satisfy the clarity requirement) in PBP claims that have already been granted. However, the JPO added that this decision does not apply to all such cases and that such corrections may be allowed depending on the case.

*[[Original Announcement](#) (in Japanese): JPO Website, Mar. 28, 2016]*

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## Examination Handbook for Patents and Utility Models Revisions for Product-by-Process Claims

The JPO revised [the Examination Handbook for Patents and Utility Models](#) regarding the clarity requirement for Product-by-Process (PBP) claims, effective April 1, 2016. The Pravastatin Sodium Case decisions (Cases Nos. 2012 (*Ju*) 1204 and 2012 (*Ju*) 2658) have been added to the “Basic Idea” of “Determination on Whether or Not ‘When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product’ is Relevant.” See details [here](#).

*[[Original Announcement](#): JPO Website, Mar. 30, 2016]*

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## Revised Examination Guidelines for Trademarks

The JPO revised the Examination Guidelines for Trademarks, effective April 1, 2016. Until now in Japan, mottos (for example, catch phrases) could not normally be registered, but they can now be registered under the following conditions:

If a trademark in an application is only recognized as a mark indicating, in a common manner, [\(1\) an advertisement for goods or services](#) or [\(2\) a corporate identity or business policy](#), the application will not be considered to satisfy the requirements for registration (as in the past). However, if it can be recognized that the trademark is not limited to (1) or (2) above, but is also as a coined term or the like, the application will be considered to satisfy the requirements for registration.

Whether a filed trademark is only recognized as (1) or (2) is determined based on the concept derived from the entirety of the trademark, the actual state of transaction, and the form or overall composition of the mark.

For more details, see the revised Examination Guidelines [here](#) (to follow).

*[[Original Announcement](#): METI Website, Mar. 22, 2016]*

## LITIGATION

## Chugai Also Wins Second Instance against Generic Drug Companies - Grand Panel of IP High Court Finds Patent Infringement of Process Patent

Chugai Pharmaceutical has won a patent infringement lawsuit against four generic drug companies in a second instance at the Japanese IP High Court ([Case No. 2015 \(Ne\) 10014](#), English to follow). The grand panel judgement made by the Special Division of the IP High Court rejected the appeal by the generic companies, fully recognizing Chugai's arguments. The drug in question is OXAROL Ointment, an agent for the treatment of keratosis. With this decision, the generic companies must now stop manufacturing and marketing their generic drugs, which were determined as infringing Chugai's manufacturing process patent.

The chief judge said that, when determining the first requirement/essential portion of a patent concerning the doctrine of equivalents, the essential portion of the patent should be determined on the basis of contribution over the prior art. At the Japanese IP High Court, the Grand Panel of five judges conducts proceedings in cases involving important issues. This is a landmark decision in that it has clarified the Grand Panel's standards for applying the "doctrine of equivalents" to determine infringement.

*[[Original Press Release](#): Chugai Website, Mar. 25, 2016]*

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### **Settlement of Court Case Involving Mouthwash Package with "Kaba-kun," a Character Originating with Meiji Pharmaceuticals**

Accompanying the sales transfer of the mouthwash "isodine," a court battle had been fought between the drug developer and former seller concerning the package design making use of a hippopotamus character that was well known for years in Japan, but a settlement has been reached between the two companies (see [the first issue of our News Bulletin](#)). Meiji, which has a registered trademark for the character and which has used it in sales in Japan for many years, will continue to use the character in the future.

Through this settlement, the former seller, Meiji, will begin selling a new mouthwash making use of the character "Kaba-kun (Mr. Hippo)". Meanwhile, Mundipharma, developer of isodine and engaging in sales of isodine, will continue to use an isodine package having a character resembling "Kaba-kun" until the end of August this year, after which, from September, a different character will be used.

*[[Original Press Release](#) (in Japanese): Mundipharma Website, Mar. 24, 2016]*

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### **Shimano Loses Patent Lawsuit to Apple**

A former supplier for Apple, Shimano Manufacturing, lost a patent infringement lawsuit ([Case No. 2014 \(Wa\) No. 20422](#)) it filed against Apple, seeking an injunction of sales and compensation for damages, but in a ruling issued by the Tokyo District Court, Shimano's demands were rejected. Shimano argued that pins (spring pins) used in the power connector of Apple's MacBook infringed its patent, in response to which, Apple argued that, though the probe was co-developed by both companies, Shimano filed for and received a patent independently.

While the details of the decision have yet to be made public, Shimano said "we will be in consultation with our legal team."

Concerning this product, Shimano, in addition to the patent infringement lawsuit, also filed a lawsuit alleging violation of the Anti-Monopoly Act, the latter of which was disputed as to the propriety of jurisdiction, and in a tentative decision from February of this year, it was determined this anti-monopoly case will continue in the Tokyo District Court (see [the first issue of our News](#)

[Bulletin](#)). A final decision has yet to be reached.

[[Original Press Release](#) (in Japanese): Shimano Website, Mar. 18, 2016]

## OTHER IP-RELATED NEWS

### **Reduction in burden of proof in IP litigation - INPIT plans a time stamp saving service**

The National Center for Industrial Property Information and Training (INPIT) plans to initiate a service saving time stamp tokens imprinted with a clear time for the purpose of proving the existence and identity of electronic documents from March 2017. By the public institution saving time stamp tokens, it will be possible to prove the time the documents existed for evidence in court disputes and to prove that said documents have not been tampered with, thus making it possible to reduce the burden of proof on litigants.

Specifically, INPIT will, free of charge, save time stamp tokens issued for electronic documents, the time stamp tokens issued by an authorized time verification agent. This service is thought to be useful in patent infringement lawsuits, in which a defendant accused of patent infringement must prove prior use, or in trade secret infringement lawsuits, in which a trade secret holder must prove leaked secrets were held and hidden prior to the leak of the trade secret.

[[Original Announcement](#) (in Japanese): INPIT Website, Mar. 25, 2016]

## NEWS ABOUT SONODA & KOBAYASHI

We will attend the

[Chinese Pharmaceutical Enterprises Overseas Patent Training Sessions](#)

April 25-27, 2016, Nanjing, China

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### **Our Firm**

SONODA & KOBAYASHI, an intellectual property law firm, offers dependable legal services for intellectual property in Japan. Our multinational team of 80 experts in technology, law, languages and international communication has served companies from around the world and has gained a reputation for thoroughness and reliability. Our high standards, expertise and team work have defined us since the founding of our firm in 1998.

### **Visit Us**

Sonoda & Kobayashi is located in Shinjuku, one of the main business districts in Tokyo. We welcome visitors and look forward to seeing you at [our office](#).



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