
INTRODUCTION OF ARTICLES

Thoughts on Effectiveness of Method Inventions in the Biotechnology and Medical Fields

The Third Subcommittee,
The Second Patent Committee

With regard to the granting of patent rights and the scope of enforcement for method (process) inventions in the biomedical field, which typically are related to genetic information and screening methods, there presently are some ambiguities in its practical operation and interpretation. These ambiguities are the result of the change in the circumstantial reality that, while current inventions are technologies that deal with tangible things, the above inventions include, not only those dealing with tangible things, but also those dealing with information. The author believes that this change must be adequately recognized in the future.

Accordingly, the granting of rights and the scope of enforcement for method inventions in the biomedical field are discussed from the point of view what criteria may be used in assessing information, and whether it is reasonable to provide protection for it in actual society. More specifically, inventions comprising new uses of chemical substances, medical treatment/diagnosis method inventions and screening method inventions are discussed in comparison with inventions of manufacturing methods of tangible things.

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Study of Court Decisions Regarding Prior User's Right — From the Walking Beam Furnace Case to recent decisions —

The First Subcommittee,
The Second Patent Committee

Prior user's right is an important statutory non-exclusive license as a means to defend a user from being accused of infringement by a patent right holder, but the statutory interpretation thereof is not yet summarized for those decisions made after the Walking Beam Furnace Case which is a landmark decision relevant to the prior user's right, thus the current direction of such decisions has not been well understood.

In this paper, recent major decisions are discussed in terms of “completion of an invention”, “commercial working of the invention or the preparation therefor”, “modification of working mode/scope”, and “succession of the prior user's right” as the requirements of the prior user's right, and the paper also summarizes the current statutory interpretation of the right.