the patent opposition system and the patent invalidation trial system. After the passing of one year since the enforcement of the system, we conducted a survey on the actual utilization of the new invalidation trial system and the post-grant information submittal system, targeting member companies. The survey result shows that the status of the utilization of these systems by companies has not changed much since the introduction of the new invalidation trial system. Moreover, some requested the revival of the opposition system while others said that the abolishment of the opposition system has caused a proliferation of unstable patent rights.

In fact, the number of demands for invalidation trials has only slightly changed since the new system became effective. Under the old system, about 4,000 oppositions were filed, but they have been tucked away somewhere. Although the new invalidation trial system is supposed to subsume the opposition system, it is, in fact, not serving as an alternative to the opposition system.

This report examines how individuals and companies should utilize the new invalidation trial system as an alternative to the old opposition system, in line with the purport of the revision of the invalidation trial system, as well as examining positive methods for managing the system in order to make it a user-friendly system.

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Thoughts on Judgments Regarding Inventive Step Seen in Appeal Decision Cancellation Cases

The Fifth Subcommittee
The Second Patent Committee

An appeal decision in the patent proceedings is a final judgment made by a collegial body of appeal examiners at the Japan Patent Office (JPO), and any person who is dissatisfied with an appeal decision may file a suit against that appeal decision with the Intellectual Property High Court (or the Tokyo High Court until March 2005). Persons engaged in patent practice have an interest in how the court deals with appeal decisions in terms of "inventive step" (Section 29(2) of the Patent Law). We examined cases where the Tokyo High Court canceled appeal decisions based on inventive step, with the aim to consider this concept from the viewpoint of the difference in judgment between the JPO and the Tokyo High Court.

In the main text, we examined whether there is any difference in judgment method between the JPO and the Tokyo High Court for each type of appeal decision, and pointed out that the court is more likely to cancel JPO decisions that didn't allow appeals for patent invalidation. We can infer that this tendency may arise from the time lag that occurred because the court's judgments were issued ahead of the JPO's revised Examination Guidelines released from 2000, or the possibility that the court took into consideration the revision of the guidelines when making judgments. We then categorized suits challenging the appeal decisions into cases relating to (1) error in judgment on whether the invention could have easily been created based on prior arts (the cited invention), (2) error in findings on well-known art, and (3) error in judgment on the numerical limitation or operation- effect of the invention, and presented the details of the points in dispute and the grounds for judgment in the representative cases. We also conducted comparisons with foreign (European and US) standards for judgment.

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