INTRODUCTION

On April 1st last year, “2012 yearbook of IP-related court cases in the fields of chemistry and biotechnology”, which lists the court cases presented within the year 2012 (posted on the HP of the court), was published as a year book for IP practitioners in the fields of chemistry and biotechnology. This book is a 2013 version of it and published about half a year later than the 2012 version. One reason for this delay in publishing is that the number of IP-related court cases in these fields increased from “119” in 2012 to “135” in 2013. Another reason is that considerable changes such as layout change were made considering ease of use. I am relieved to have managed to publish this book although I was about to give up keeping writing many times before completion.

In the 2012 version, the court cases were listed in the order of date of decision. When searching court cases for reference in practice, however, particularly important information will be about whether there are court cases in the same technical fields, whether there are court cases having the same disputed points (articles), etc. When trying to use the 2012 version for expert opinions and lectures which I have many opportunities to prepare, I strongly felt inconvenience about its construction that the court cases were not listed on the basis of their technical fields and disputed points (articles). In view of this, the 2013 version has been compiled to list the court cases on the basis of main four technical fields of “chemistry”, “pharmaceuticals”, “biotechnology” and “food”, in each of which the court cases are arranged on the basis of their disputed points (articles). Note that, “pharmaceuticals” include not only pharmaceutical drugs but also quasi-drugs, various pharmacological agents, agrichemicals, and cosmetics. “Chemistry” includes not only materials but also structures having chemical features in devices and the like. Meanwhile, although many of the cases each have more than one disputed point, this book selects only one disputed point in each of the cases especially from the viewpoint of making the most of court cases in practice. Moreover, considering its portability etc., the 2013 version has been made compact to be A5 size from the large 2012 version which was an A4-size book.

This book is greatly different from many other similar books in that it specializes in the fields of chemistry and biotechnology and is written from the viewpoint of making the most of court cases in practice. As a result of research, the author found that “570” IP-related decisions were posted on the HP of the court in 2013. This book selects “135” decisions that are considered relating to the fields of chemistry and biotechnology (some decisions were deleted after posted on the HP of the court, but this book includes
such decisions whose data I already obtained). This number of decisions accounts for “about 23.7%” of the total number of IP-related decisions in 2013.

IP practitioners in the fields of chemistry and biotechnology have to take charge of even inventions of apparatus, etc. if the inventions have their features that lie in materials of the apparatus, etc. Hence, this book selects as many court cases as possible so long as, even if inventions themselves relate to apparatus, etc., their features or disputed points relate to chemistry or biotechnology. This book also selects as many court cases as possible so long as, even if their disputed points relate to irregularities by the Japanese Patent Office or mistakes in the procedure by the applicants, the title of invention, etc. relate to chemistry or biotechnology.

The recent IP practice has been becoming more and more difficult to properly handle without knowledge of the latest court cases. It has been important to know the latest court cases as soon as possible and make the most of knowledge from them in practice. This book not only shows overviews of individual decisions but also presents data analyses and classification lists of decisions in the chemical and biotech fields. With the help of the lists, graphs, etc., readers can easily see the number and types of cases where novelty, inventive step, support requirements, clarity requirements, and amendments were accepted, and conclusions of disputed points. Besides, each of the decisions is introduced so that readers can catch at a glance such information as date of decision, case number, court, judge, parties, title of invention, etc., disputed point, relevant article, and field. “Overview of Case” focuses on important matters and disputed points that IP practitioners want to know, briefly describing them. Also, “Judgment (Summary)” states the conclusion as briefly as possible and “Grounds (Summary)” summarizes minimum necessary grounds for decision in relation to the conclusion. “Notes for Interpretation” gives useful information for interpretation of the articles shown in the decision rather than from a practical point of view. “Practical Personal Opinion” states the author’s personal impressions and views. If there is a need to go over the court case, please refer to its decision.

“Overview of Case” also shows as detailed information as possible such as application numbers or patent numbers, trial numbers, and publication numbers of cited references, so that readers can make the most of such information for case study. It is recommended to actually do case study on a case to discuss.

The below-listed graphs and lists show that the classified data of the total “135” IP-related court cases in 2013 in the fields of chemistry and biotechnology give quite
interesting results.

FIG. 1, a percent circle graph by technical fields, shows “59% (80 cases)” for chemistry, “24% (33 cases)” for pharmaceuticals, “7% (9 cases)” for biotechnology, and “10% (13 cases)” for food. Although applications for pharmaceuticals are not very many, litigious cases at court are more than those in the other fields, and there is a tendency that litigation is highly likely to occur.

FIG. 2, a percent circle graph by type of cases, shows “86% (116 cases)” for request for rescission of the trial decision, and “14% (19 cases)” for the other requests. The litigation for request for rescission of the trial decision accounts for high percentage.

FIG. 3, a percent circle graph by courts, shows “90% (121 cases)” for Intellectual Property High Court, “0% (0 cases)” for Intellectual Property High Court Grand Panel (en banc), “7% (10 cases)” for Tokyo District Court, and “3% (4 cases)” for Osaka District Court. The shown data reflect the fact that there are many cases of the litigation for request for rescission of the trial decision.

FIG. 4, a percent circle graph by divisions of Intellectual Property High Court, shows that a total of 121 cases are classified into “19% (23 cases)” for First Division, “29% (34 cases)” for Second Division, “26% (32 cases)” for Third Division, “26% (32 cases)” for Fourth Division, and “0% (0 cases)” for Special Division (Grand Panel (en banc)). The shown data indicate that the decisions by First Division are small.

FIG. 5, a percent circle graph by divisions of district courts, shows, though the total number of cases is not many, “30% (4 cases)” for Tokyo District Court Civil Division 29, “21% (3 cases)” Tokyo District Court Civil Division 46, “21% (3 cases)” for Tokyo District Court Civil Division 47, “14% (2 cases)” for Osaka District Court Civil Division 21, and “14% (2 cases)” for Osaka District Court Civil Division 26.

FIG. 6, a percent circle graph by conclusions of requests, shows that the percentage of cases that dismissed the requests is “69% (93 cases)” and the percentage of cases that approved the requests is “31% (42 cases)”. The shown data indicate that the dismissed cases are about twice as many as the approved cases.

FIG. 7, a percent circle graph by conclusions of requests for rescission of the trial decision, shows that the percentage of cases that dismissed the requests is “68% (79 cases)” and the percentage of cases that approved the requests is “32% (37 cases)”. The shown data indicate that the dismissed cases are almost twice as many as the approved cases.
FIG. 8, a percent circle graph by conclusions of the other requests, shows that the percentage of cases that dismissed the requests is “74% (14 cases)” and the percentage of cases that approved the requests is “26% (5 cases)”. The shown data indicate that the dismissed cases are more than three times as many as the approved cases.

FIG. 9, a percent circle graph by conclusions of judgment of novelty, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “67% (8 cases)”, the percentage of cases that overruled the trial decision or the judgment by the lower court is “16% (2 cases)”, and the percentage of cases directly judged at court is “17% (2 cases)”. The shown data indicate that more cases affirmed the trial decision or the judgment by the lower court. The cases that affirmed the trial decision or the judgment by the lower court consist of “59% (7 cases)” where the judgment that novelty had been absent was affirmed and “8% (1 case)” where the judgment that novelty had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “8% (1 case)” where the judgment that novelty had been absent was affirmed and “8% (1 case)” where the judgment that novelty had been present was affirmed.

FIG. 10, a percent circle graph by conclusions of judgment of inventive step, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “65% (50 cases)”, the percentage of cases that overruled the trial decision or the judgment by the lower court is “31% (24 cases)”, and the percentage of cases directly judged at court is “4% (3 cases)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “48% (37 cases)” where the judgment that inventive step had been absent was affirmed and “17% (13 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “8% (6 cases)” where the judgment that inventive step had been present was overruled and “23% (18 cases)” where the judgment that inventive step had been absent was overruled.

FIG. 11, a percent circle graph by conclusions of judgment of inventive step in chemistry, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “53% (25 cases)”, the percentage of cases that overruled the trial decision or the judgment by the lower court is “43% (20 cases)”, and the percentage of cases directly judged at court is “4% (2 cases)”. The shown data indicate that the cases that affirmed the trial decision or the judgment by the lower court were
somewhat more than those that overruled the trial decision or the judgment by the lower court. The cases that affirmed the trial decision or the judgment by the lower court consist of “40% (19 cases)” where the judgment that inventive step had been absent was affirmed and “13% (6 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “11% (5 cases)” where the judgment that inventive step had been present was overruled and “32% (15 cases)” where the judgment that inventive step had been absent was overruled.

FIG. 12, a percent circle graph by conclusions of judgment of inventive step in pharmaceuticals, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “72% (10 cases)”, the percentage of cases that overruled the trial decision or the judgment by the lower court is “21% (3 cases)”, and the percentage of cases directly judged at court is “7% (1 case)”. The shown data indicate that the cases that affirmed the trial decision or the judgment by the lower court were almost three times as many as those that overruled the trial decision or the judgment by the lower court. The cases that affirmed the trial decision or the judgment by the lower court consist of “58% (8 cases)” where the judgment that inventive step had been absent was affirmed and “14% (2 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “7% (1 case)” where the judgment that inventive step had been present was overruled and “14% (2 cases)” where the judgment that inventive step had been absent was overruled. One characteristic seen from the data in the field of pharmaceuticals is that the percentage of the cases finally judged that inventive step was absent; i.e., “65% (9 cases)” is much higher that that of the cases finally judged that inventive step was present; i.e., “35% (5 cases)”.  

FIG. 13, a percent circle graph by conclusions of judgment of inventive step in biotechnology, shows, though the total number of cases is not many, that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “100% (6 cases)”, the percentage of case that overruled the trial decision or the judgment by the lower court is “0% (0 cases)”, and the percentage of cases directly judged at court is “0% (0 cases)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “83% (5 cases)” where the judgment that inventive step had been absent was affirmed and “7% (1 case)” where the judgment that inventive step had been present was affirmed.

FIG. 14, a percent circle graph by conclusions of judgment of inventive step in food,
shows, though the total number of cases is not many, that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “91% (10 cases)” and the percentage of cases that overruled the trial decision or the judgment by the lower court is “9% (1 case)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “55% (6 cases)” where the judgment that inventive step had been absent was affirmed and “36% (4 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “0% (0 cases)” where the judgment that inventive step had been present was overruled and “9% (1 case)” where the judgment that inventive step had been absent was overruled.

FIG. 15, a percent circle graph by conclusions of judgment of support requirements, shows, though the total number of cases is not many, that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “60% (6 cases)”, the percentage of case that overruled the trial decision or the judgment by the lower court is “40% (4 cases)”, and the percentage of cases directly judged at court is “0% (0 cases)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “40% (4 cases)” where the judgment that violation of support requirements had been absent was affirmed and “20% (2 cases)” where the judgment that violation of support requirements had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “20% (2 cases)” where the judgment that violation of support requirements had been present was overruled and “20% (2 cases)” where the judgment that violation of support requirements had been absent was overruled. One characteristic seen from the data of FIG. 15 is that the cases judged as not violating support requirements account for “60% (6 cases)” in a total of 10 cases, meaning that there are more cases that were judged as not violating support requirements.

FIG. 16, a percent circle graph by conclusions of judgment of <Inventive Step> by First Division of Intellectual Property High Court, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “56% (9 cases)” and the percentage of cases that overruled the trial decision or the judgment by the lower court is “44% (7 cases)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “43% (7 cases)” where the judgment that inventive step had been absent was affirmed and “13% (2 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “25% (4 cases)” where the judgment that
inventive step had been absent was overruled and “19% (3 cases)” where the judgment that inventive step had been present was overruled. Though accuracy is not enough because of the total number of cases being not many, the First Division in 2013 gave the results that the cases finally judged as having inventive step accounted for “38% (6 cases)” and the cases finally judged not having inventive step accounted for “62% (10 cases)”.

FIG. 17, a percent circle graph by technical fields as well as conclusions of judgment of <Inventive Step> by First Division of Intellectual Property High Court, shows that the percentage of cases finally judged as having inventive step is “31% (5 cases)” for chemistry and “0% (0 cases)” for pharmaceuticals, and the percentage of cases finally judged as not having inventive step is “25% (4 cases)” for chemistry and “19% (3 cases)” for pharmaceuticals.

FIG. 18, a percent circle graph by conclusions of judgment of <Inventive Step> by Second Division of Intellectual Property High Court, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “84% (21 cases)” and the percentage of cases that overruled the trial decision or the judgment by the lower court is “16% (4 cases)” . The cases that affirmed the trial decision or the judgment by the lower court consist of “64% (16 cases)” where the judgment that inventive step had been absent was affirmed and “20% (5 cases)” where the judgment that inventive step had been present was affirmed . The cases that overruled the trial decision or the judgment by the lower court consist of “12% (3 cases)” where the judgment that inventive step had been absent was overruled and “4% (1 case)” where the judgment that inventive step had been present was overruled. Though accuracy is not enough because of the total number of cases being not many, the Second Division in 2013 gave the results that the cases finally judged as having inventive step accounted for “32% (8 cases)” and the cases finally judged not having inventive step accounted for “68% (17 cases)”.

FIG. 19, a percent circle graph by technical fields as well as conclusions of judgment of <Inventive Step> by Second Division of Intellectual Property High Court, shows that the percentage of cases finally judged as having inventive step is “20% (5 cases)” for chemistry, “0% (0 cases)” for pharmaceuticals, “4% (1 case)” for biotechnology and “8% (2 cases)” for food and the percentage of cases finally judged as not having inventive step is “44% (11 cases)” for chemistry, “8% (2 cases)” for pharmaceuticals, “4% (1 case)” for biotechnology and “12% (3 cases)” for food.
FIG. 20, a percent circle graph by conclusions of judgment of <Inventive Step> by Third Division of Intellectual Property High Court, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “60% (12 cases)” and the percentage of cases that overruled the trial decision or the judgment by the lower court is “40% (8 cases)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “45% (9 cases)” where the judgment that inventive step had been absent was affirmed and “15% (3 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “30% (6 cases)” where the judgment that inventive step had been absent was overruled and “10% (2 cases)” where the judgment that inventive step had been present was overruled. Though accuracy is not enough because of the total number of cases being not many, the Third Division in 2013 gave the results that the cases finally judged as having inventive step accounted for “45% (9 cases)” and the cases finally judged not having inventive step accounted for “55% (11 cases)”.

FIG. 21, a percent circle graph by technical fields as well as conclusions of judgment of <Inventive Step> by Third Division of Intellectual Property High Court, shows that the percentage of cases finally judged as having inventive step is “30% (6 cases)” for chemistry, “5% (1 case)” for pharmaceuticals, “0% (0 cases)” for biotechnology and “0% (0 cases)” for food and the percentage of cases finally judged as not having inventive step is “35% (7 cases)” for chemistry, “5% (1 case)” for pharmaceuticals, “10% (2 cases)” for biotechnology and “5% (1 case)” for food.

FIG. 22, a percent circle graph by conclusions of judgment of <Inventive Step> by Fourth Division of Intellectual Property High Court, shows that the percentage of cases that affirmed the trial decision or the judgment by the lower court is “57% (8 cases)”, the percentage of cases that overruled the trial decision or the judgment by the lower court is “36% (5 cases)”, and the percentage of cases directly judged at court is “7% (1 case)”. The cases that affirmed the trial decision or the judgment by the lower court consist of “43% (6 cases)” where the judgment that inventive step had been absent was affirmed and “14% (2 cases)” where the judgment that inventive step had been present was affirmed. The cases that overruled the trial decision or the judgment by the lower court consist of “36% (5 cases)” where the judgment that inventive step had been absent was overruled and “0% (0 cases)” where the judgment that inventive step had been present was overruled. Though accuracy is not enough because of the total number of cases being not many, the Fourth Division in 2013 gave the results that the cases finally
judged as having inventive step accounted for “57% (8 cases)” and the cases finally judged not having inventive step accounted for “43% (6 cases)”.

FIG. 23, a percent circle graph by technical fields as well as conclusions of judgment of <Inventive Step> by Fourth Division of Intellectual Property High Court, shows that the percentage of cases finally judged as having inventive step is “36% (5 cases)” for chemistry, “14% (2 cases)” for pharmaceuticals, “0% (0 cases)” for biotechnology and “7% (1 case)” for food, and the percentage of cases finally judged as not having inventive step is “14% (2 cases)” for chemistry, “22% (3 cases)” for pharmaceuticals, “0% (0 cases)” for biotechnology and “7% (1 case)” for food.

Please note that the above data are those limited within the year 2013.

I hope that this book could be helpful to IP practitioners in the fields of chemistry and biotechnology.

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Koichi Hirota
Patent Attorney