



**SHIGA**  
INTERNATIONAL  
PATENT  
OFFICE  
JAPAN

# SHIGA IP NEWS

Volume 50 October 2017

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## Average FA Term is 9.5 Months and Patent Grant Rate is 75.8%

According to the Annual Report (2017) published by the Japanese Patent Office (JPO), the average term from request for examination of a patent application until the issuance of a notice of a first action (FA) was 9.5 months in 2016. Regarding trademark applications, the average term from filing an application until the issuance of a notice of a first action (FA) was 4.0 months in 2015 and 4.8 months in 2016, which is 0.8 months longer than the previous year.

	2014	2015	2016
Patents	9.6	9.5	9.5
Designs	6.2	6.1	6.2
Trademarks	4.3	4.0	4.8

(units: months)

Fig. 1: FA period at the Examination Stage

In view of the results of patent examinations in 2016, the number of primary examinations was 246,879, the number of granted patents was 191,032, the number of decisions of rejection was 58,638, and the number of registered patents was 203,087. The patent grant rate has been increasing year by year and was 75.8% in 2016. The JPO analyzed the data and commented that the increase in the patent grant rate was caused by a temporary reduction in the number of decisions of rejection without a response to an office action (OA). This is deemed to be due to procedural changes regarding extension of the response period to OAs associated with accession to the Patent Law Treaty (PLT).

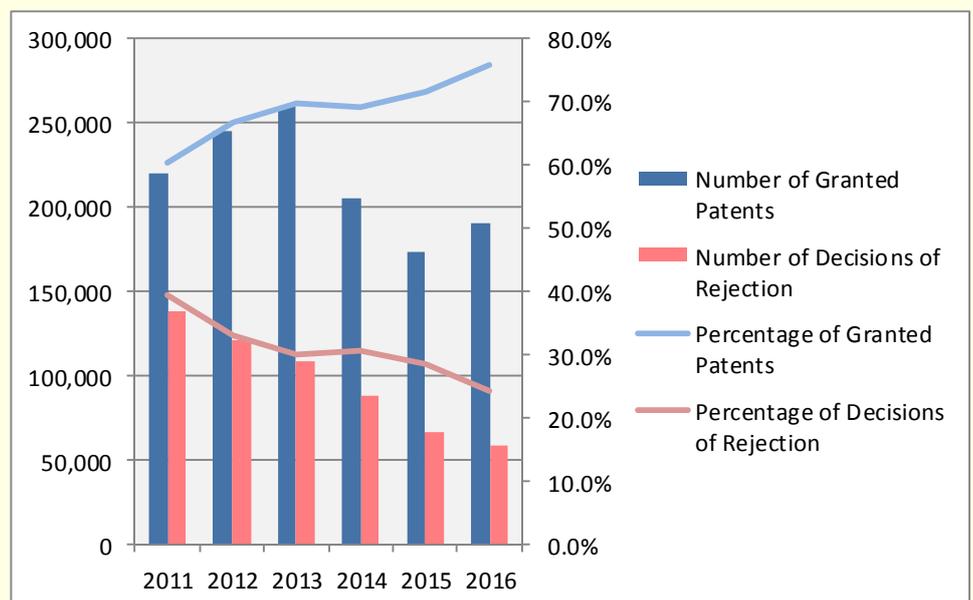


Fig.2: The Results of Final Decisions

# Recent IP High Court Case: Appeal against JPO Trial Decision regarding Support Requirements

The IP High Court (IPHC) dismissed a JPO Trial Decision for a tomato beverage patent on the grounds that the patented invention in question does not satisfy the support requirements. This case will be sent back to the JPO for reconsideration. However, it is very likely that the JPO will issue a Trial Decision to invalidate the patent due to failure to satisfy the support requirements. Japanese Patent Law, Article 36, Paragraph 6, Number 1 stipulates with regard to support requirements that a claimed invention should be thoroughly described in the Detailed Description of the Invention (also referred to below as “Detailed Description”) in the specification such that a person skilled in the art could recognize that the problems to be solved by the invention can indeed be solved by the invention for the entire scope of the claims.

## Overview of the Case

Case Number: H28(Gyo-Ke)10147

Judgement Date: June 8, 2017

Japanese Patent Number: 5189667

Title of Invention: A manufacturing method of a tomato-containing beverage and a method of controlling the acidic taste of a tomato beverage

Plaintiff: Kagome Co., Ltd.

Defendant (Patentee): Ito En, Ltd.

## Case History

Kagome filed a Request for Invalidation Trial against the aforementioned patent owned by Ito En at the JPO on May 19, 2016. The JPO issued a decision stating that the patent should be maintained (Invalidation Trial No. 2015-800008). Kagome dissatisfied with the decision, filed a lawsuit at the IPHC to appeal against the Trial Decision. However, the IPHC revoked the JPO Trial Decision since the aforementioned patented invention does not fulfill the support requirements. It is highly probable that the JPO will issue a new Trial Decision to invalidate Ito En’s patent after reexamining the invalidation trial based on the IPHC’s judgement.

## Claim 1

*A tomato-containing beverage, in which a sugar content is from 9.4 to 10.0, a sugar/acid ratio\* is from 19.0 to 30.0, and a total amount of glutamic acid and aspartic acid is from 0.36 to 0.42% by weight.*

\*Note: The ratio of sugar/acid is calculated by dividing the content of sugar by the content of acid in the beverage.

## Detailed Description of the Invention

[Effect of the Invention]

[0034]

*Even if either juice of vegetables other than tomatoes, the main ingredient, or fruit juice is blended therein, the new tomato-containing beverage of the invention will provide a rich and sweet taste like a sweet tomato, the acidic taste due to tomatoes can be reduced, and a manufacturing method for the same can be realized by the present invention.*

The present invention teaches that a new tomato-containing beverage with a sweet, rich, and non-acidic taste can be produced if the following three values: 1) sugar content, 2) sugar/acid ratio, and 3) sum of the amounts of glutamic acid and aspartic acid contained in the beverage, are controlled such that they are within the numerical ranges recited in the claims. In summary, the problem to be solved by the present invention is to provide “a novel tomato-containing beverage which provides a rich and sweet taste like a sweet tomato, wherein the acidic taste due to tomatoes has been reduced even though neither the juice of vegetables other than tomatoes nor fruit juice is blended therein”.

Furthermore, the aforementioned problem can be solved by controlling the following three values: sugar content, sugar/acid ratio, and sum of the amounts of glutamic acid and aspartic acid contained in the beverage such that these values are within the following numerical ranges recited in claims 1, 8 and 11: “from 9.4 to 10.0” for the sugar content; “from 19.0 to 30.0” for the sugar/acid ratio; and “from 0.36 to 0.42” for the sum of the amounts of glutamic acid and aspartic acid. The IPHC concluded that the present patented inventions 1 to 11 do not satisfy the support requirements.

## Grounds for Judgement

### ●Criteria for parameter invention (Support Requirements)

This judgement referred to the IPHC judicial criteria on support requirements for a parameter invention, which were indicated in the Polarizing Film case in which the IPHC handed down a decision on November 11, 2007. The criteria are as follows:

*Thus, the present invention is a so-called parameter invention. Claim recitations of such inventions shall meet the support requirements if (i) the Detailed Description in the specification discloses the technical meaning of the relationship between the range denoted by a mathematical formulation and its effects, or performance, at least in such a way that the skilled person is able to understand it; or (ii) [the Detailed Description] includes disclosures of examples in a manner that the skilled person can recognize, by referring to the common technical knowledge at the time of filing, that the intended effects, or performance, would have been realized when [X and Y for the claimed invention fall within] the range denoted by the mathematical formulation even if particular examples are not included in the specification. [Extracted from the case summary published by the IPHC]*

●Whether the description of a flavor evaluation test supports the numerical values specified in the claims (whether a person skilled in the art could recognize that the problem to be solved by the invention can actually be solved by the invention)

It can be said that “sweet”, “acidic”, and “rich” tastes of a tomato-containing beverage are not affected only by the “sugar content”, “sugar/acid ratio”, and “the content of glutamic acid and aspartic acid” of the beverage recited in claim 1, and that various elements such as salty, bitter, *umami*, spicy, and full-bodied taste, as well as aroma, etc. are relevant to the aforementioned tastes. Also, it can be said that the physical feeling caused by a difference in viscosity can also affect the taste of a beverage. In addition, it is common technical knowledge that a tomato-containing beverage contains various ingredients. Therefore, it had been taken for granted that a person skilled in the art would come to recognize that ingredients other than the above-mentioned ingredients recited in claim 1 which are described as being measured in the examples and physical properties such as viscosity of beverage may also affect the taste of the tomato-containing beverage. Therefore, in order to evaluate the “sweet”, “acidic”, and “rich” tastes of a beverage, if a relationship between these tastes and the sugar content, sugar/acid ratio, and total amount of glutamic acid and aspartic acid of the beverage is determined by changing the sugar content, sugar/acid ratio, and total amount of glutamic acid and aspartic acid, either one of the following two procedures should be chosen:

1. In the case in which only these three elements, i.e., sugar content, sugar/acid ratio, and total amount of glutamic acid and aspartic acid, significantly affect the “sweet”, “acidic”, and “rich” tastes of the beverage or in the case in which other ingredients and/or elements might affect the taste of the beverage but it is not necessary to make them the same for all experiments, these points should be explained technically and then flavor evaluation tests should be conducted by changing the three elements recited in claim 1; or
2. In the case in which there is one or more elements that significantly affect the “sweet”, “acidic”, and “rich” tastes of a beverage in addition to the three technical elements recited in claim 1 and it cannot be said that it is not necessary to make the former the same for all experiments, flavor evaluation tests should be conducted by making the elements other than the three technical elements recited in claim 1 the same for all experiments and by changing the content of sugar, the ratio of sugar/acid and the total amount of glutamic acid and aspartic acid.

Furthermore, it is not clearly described in detail in the specification why the acidic taste of tomatoes can be reduced while maintaining rich and sweet tastes like those of sweet tomatoes by controlling the content of sugar and the sugar/acid ratio to fall within the numerical ranges recited in claim 1. In addition, the specification of the patent describes that the acidic taste of tomato can be reduced and the original sweet taste of tomatoes can be enhanced by controlling the amount of glutamic acid and aspartic acid to fall within the numerical range recited in claim 1 without decreasing the good taste (*umami*) of the tomato-containing beverage. However, the specification does not describe that only the content of sugar, sugar/acid ratio, and total amount of glutamic acid and aspartic acid will affect “sweet”, “acidic” and “rich” tastes of a tomato-containing beverage.

Therefore, it cannot be said that a person skilled in the art could immediately understand, from the flavor evaluation test results disclosed in the specification, the technical relationship between the numerical ranges for “sugar content”, “sugar/acid ratio” and “total amount of glutamic acid and aspartic acid” which are recited in claim 1 and the desired flavor of the tomato-containing beverage which is rich and sweet like a sweet tomato and in which the acidic taste of tomatoes is reduced.

### ●Regarding Method of Evaluation Tests

The specification of the patent discloses the results of flavor evaluation tests of tomato-containing beverages conducted by panelists. However, the IPHC concluded that the evaluation test method is not appropriate and stated as follows: It is undeniable that there are some panelists who add or deduct relatively large points for a small change of flavor and that there are some panelists who add or deduct relatively small points for a large change of flavor. Therefore, it is difficult to recognize that the flavor of each of the beverages is accurately evaluated based on an average value by all panelists for flavor of each of the beverages.

Therefore, it cannot be said that a person skilled in the art could understand from the results of evaluation tests of flavor that the tomato-containing beverages of working examples 1 to 3 actually exhibited a rich and sweet taste like sweet tomatoes and that the acidic taste of tomatoes was reduced.

## Analysis

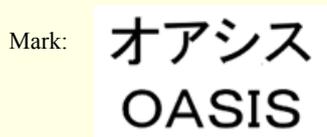
There are cases in which a food product or beverage is claimed by specifying a numerical range of an amount of an ingredient contained in it, and the applicant describes in the specification that the desired effects or properties are achieved when such a numerical range is satisfied, by indicating results of a sensory test conducted by panelists. The IPHC judged the support requirements (Japanese Patent Law, Article 36, Paragraph 6, Number 1) in the present case.

When drafting a specification for an invention relating to a food product or beverage, if there are some ingredients which have an influence on the effects or functions of the claimed invention but the ingredients and the amounts thereof are not recited in the claims, it would be necessary to sufficiently explain in the specification why it is not necessary to recite the ingredients and the amounts thereof as essential elements in the claims or why the problem to be solved by the claimed invention can actually be solved only by the technical elements recited in the claims. Furthermore, if the ingredients contained in a product other than the ingredients recited in a claim do not affect the functions or effects of the claimed invention, it would be better to describe this point in the specification and also the reason why only the ingredients recited in the claim are essential to achieve the effects of the claimed invention, in other words, to solve the problem.

## JPO Appeal Decision on Similarity of Services

Under Japanese practice, the similarity of goods or services is predetermined and the similarity is rarely reversed. However, in the following appeal against the decision in the first instance, the JPO's Appeal Examiners accepted the applicant's assertions of dissimilarity of services against the decision in the first instance.

### 1. Applied for mark



### 2. Cited mark



(“オアシス” is a transliteration of “OASIS”)

Conflicting services: Teaching of software in Class 41      Conflicting services: Teaching of health management; teaching of sports in Class 41

### 3. Summary of Appeal Decision

The part “oasis” of the cited mark provides a strong and prominent impression and would be divided from the other elements. Therefore, the present mark should be similar to the cited mark in terms of the commonness of their pronunciations and concepts. The service “teaching of software” of the present application clearly differs in content of knowledge from the services “teaching of health management; teaching of sports” of the cited registration, and these services are provided by their respective specialists. Therefore, as there are differences in features, providers and consumers between these services, these services are not related to each other. Therefore, it cannot be said that the service “teaching of software” is similar to the services “teaching of health management; teaching of sports”.

### 4. Shiga's comments

Under Japanese practice, the similarity of goods or services is predetermined by using similarity codes, which are assigned to each of the goods or services. In the present case, as the same similarity code “41A01” is assigned to the designated services of both marks, these services were deemed to be similar to each other at the examination stage. However, in the appeal, the JPO judged these services to be dissimilar by examining the differences more precisely than in the examination stage. As is the case with this decision, even if the goods or services designated by your application and the cited registrations share common similarity codes, there would still exist a possibility of reversing the predetermined similarity at the Appeal stage.

## JPO Considering Protection of Brand Designs with a View to Design Law Revision

The JPO established the Study Group of Industrial Competitiveness and Design and recently held the first meeting. Under the current climate of rapid progress in homogenization (commoditization) of products, we are in an age when it is difficult to effect differentiation to attain superiority over competitors' products by relying solely on function and quality. In actuality, even though Japanese companies release functionally superior products, businesses in emerging countries immediately follow suit, leading to a reduction in selling prices. As a result, Japanese enterprises face the reality that it is difficult to maintain a competitive advantage. On the other hand, western companies including Apple (U.S.) and Dyson (U.K.) express their own strengths, technology, and image backed by a clear corporate philosophy as a brand identity by means of designs, thereby enhancing the value of their products, resulting in global market expansion. Therefore, the Study Group will compile tasks to aid in enhancing Japanese corporate competitiveness through design and will consider countermeasures with a view to future Design Law revisions. They will also prepare a report including concrete measures by March 2018, and aim for law revisions in 2019.