



SHIGA
INTERNATIONAL
PATENT
OFFICE
JAPAN

SHIGA IP NEWS

Volume 52 June 2018

IN THIS ISSUE

- ◆ JPO Releases List of Prospective Times to Begin Examination of Unexamined Patent Applications
- ◆ Nintendo Files Lawsuit at the Tokyo District Court against COLOPL regarding Popular Smartphone Game
- ◆ JPO Appeal Decision on Distinctiveness of a Foreign Word Mark
- ◆ Recent IP High Court Case: Suit against JPO Trial Decision regarding Inventive Step (Remarkable Effect)

JPO Releases List of Prospective Times to Begin Examination of Unexamined Patent Applications

The Japanese Patent Office (JPO) released a list indicating the expected times to commence examination of backlogged applications. This list is a service for confirming the expected examination times of published applications and allows an applicant to check when examination of an application is likely to begin. This service began operating in January 2018. In the past, the JPO provided a similar service that allowed applicants to inquire about prospective examination start times of backlogged applications and to download such information. A password was necessary to download the data under the previous service. However, starting in January 2018, the revised service allows an applicant to download data (in Excel file format) of all cases for which examination will begin within six months. The JPO will review the prospective time schedule on a quarterly basis.

If an applicant would like to have the application examined earlier than the prospective time, the applicant may take advantage of the accelerated examination system if certain conditions are met. In the case of an application for which the acquisition of rights has become unnecessary, 50% of the paid examination request fee is refundable under the refund system. Furthermore, since an applicant is also able to learn when examination of a competitor's backlogged application, which may threaten the applicant's products, will begin, the applicant may also be able to prevent the competitor from acquiring patent rights by providing information to the JPO at an appropriate time (i.e., by submitting a "Third Party Observation" to provide information regarding publications related to the patent application in question in order to show that the invention is not patentable).

Nintendo Files Lawsuit at the Tokyo District Court against COLOPL regarding Popular Smartphone Game

Nintendo Co., Ltd., a major toy manufacturer and video game publisher, filed a patent infringement litigation case at the Tokyo District Court alleging that a smartphone game, "Colopl RUNE STORY" developed by COLOPL, Inc., infringes Nintendo's patent rights. Nintendo requested an injunction on distribution of the game and approximately 4.4 billion JPY (40 million USD) in compensation from COLOPL. Nintendo claimed that COLOPL infringes the rights of five of Nintendo's patents related to touch panel operation procedures for moving characters in "Colopl RUNE STORY". Nintendo calculated profits earned by this game to be a minimum of 40 billion JPY and sought compensation of 4.4 billion JPY from COLOPL.

In response, COLOPL demanded the dismissal of all claims lodged against them and expressed the intent to fight against Nintendo's demands. Nintendo brought the action to the Tokyo District Court on December 22, 2017. According to COLOPL, Nintendo gave notice in September 2016 that COLOPL was infringing Nintendo's patent rights. Although Nintendo and COLOPL held discussions for over a year, they failed to reach an understanding.

"Colopl Rune Story" is a popular role playing game (RPG) that COLOPL published in 2014, amassing over one hundred million downloads (cumulative total). We will continue to monitor this case and provide updates as developments arise.

JPO Appeal Decision on Distinctiveness of a Foreign Word Mark

Trademarks using foreign words are common in Japan. Like other trademarks, the Japanese Patent Office (JPO) also examines such trademarks as to whether there is distinctiveness in connection with the goods and services it represents. In such cases, the distinctiveness of a trademark is judged based on common recognition among Japanese consumers. We would like to introduce an exemplary appeal case against a JPO Examiner's decision.

Trademark: **bon goût**

Filing Date: December 14, 2015

Application Number: 2015-122732

Appeal Number: 2017-7985 (Appeal against the JPO Examiner's Decision of Rejection)

Date of Appeal Decision: December 20, 2017 (Appeal Decision Publication Number: 218)

Designated Goods and Services:

- Class 30: Tea, coffee, cocoa, ice, confectionery, and other goods in this class
- Class 43: Providing foods and beverages and other services in this class

Subject Trademark Application

An application for a trademark consisting of "bon goût" was filed at the JPO on December 14, 2015, designating goods and services in classes 30, 32, 35, and 43. Thereafter, the designation of this application was amended to goods in class 30 including tea, coffee, cocoa, ice, and confectionery, and to services in class 43 including providing foods and beverages.

Original Decision of Rejection in the Examination Stage

The original Decision of Rejection was based on the following.

It is not difficult to perceive the meaning of "delicious taste" or "good sense" from the entire trademark "bon goût". It has been recognized in the industry of the designated goods and services that the term "bon goût" is widely used to indicate "delicious (taste)" or "good sense". In consideration of this fact, when the subject trademark is used for the designated goods and services, it helps consumers understand and recognize that the trademark simply describes the "delicious" or "good" quality of the products or services. Therefore, this trademark should be rejected based on lack of distinctiveness.

Appeal Decision

In the subject trademark, the word "bon" represents the meaning of "good, delicious", and "goût" represents the meaning of "taste, sense". However, since the combined word "bon goût" is not familiar or known to the Japanese public, it should be recognized as a kind of coined word with no specific meaning. Furthermore, since a descriptive use of "bon goût" has not been found in the industry of the amended designated goods or services, it cannot be said that consumers would recognize the subject trademark as a mark describing the quality of the goods or services. Under these circumstances, it is obvious that the subject trademark functions as a distinctive mark to identify the source of the goods. Therefore, the original Decision of Rejection should be withdrawn.

Shiga's Comments

The meanings of French terms are also extensively examined at the JPO. Even if the distinctiveness of a trademark is denied in the examination stage, the Appeal Board may have a different opinion as can be seen in the above case. Thus, it may still be worthwhile to take cases to the appeal stage.

Recent IP High Court Case: Suit against JPO Trial Decision regarding Inventive Step (Remarkable Effect)

Case No.: 2018(Gyo-Ke)10063

Date of Judgement: February 20, 2018

Title of Invention: Solder Paste Composition and Reflow Soldering Method

Japanese Patent Registration No.: 4447798

Plaintiff: Senju Metal Industry Co., Ltd.

Defendant (Patentee): TAMURA Corporation

Case History

- The plaintiff filed a Request for Invalidation Trial (Invalidation Trial No.: 2015-800058) against the aforementioned patent at the Japanese Patent Office (JPO) on March 10, 2015.
- The defendant filed a Request for Correction at the JPO on May 26, 2015.
- The JPO accepted the corrections filed by the defendant and rejected the plaintiff's request for the patent invalidation trial on January 20, 2017 (hereinafter, referred to as "Trial Decision").
- The plaintiff filed a Request for Appeal against the JPO Trial Decision on March 10, 2017, at the Intellectual Property High Court (IPHC).
- The IPHC accepted the plaintiff's claim and on February 20, 2018, rescinded the JPO Trial Decision due to an incorrect judgement on inventive step.

Overview of the Case

Below is a comparison between Claim 1 of the claimed patent and that of the primary citation.

[Claim 1] Claimed Invention

A solder paste composition comprising a lead-free solder powder, a rosin-type resin, an active agent, and a flux, wherein the solder paste composition comprises an antioxidant which consists of a hindered phenolic compound having a molecular weight of at least 500.

[Claim 1] Cited Invention*

A flux for soldering characterized by containing one or more types of antioxidant that contains one or more phenol skeletons that have an attached tertiary butyl group, the antioxidant being contained in an amount of 1 to 30% by weight.

* Japanese Unexamined Patent Application, First Publication No. 1993-185283

[Difference 1]

"Solder paste" is described as "lead-free" in the claimed invention, whereas the metallic composition of the "solder paste" is not specified in the primary citation, and it is not clear whether the "solder paste" described in the primary citation is "lead-free".

Grounds for the JPO Judgement

Japanese Patent Law stipulates that "*where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph*". (Article 29, Paragraph 2)

Although the JPO recognized that a person skilled in the art might easily conceive of the matters specifying the claimed invention based on the matters disclosed in the cited invention, the JPO accepted the inventive step of the claimed invention because the claimed invention achieves a remarkable effect which a person skilled in the art would not expect. Therefore, the JPO deemed that a person skilled in the art could not easily invent the claimed invention and found that the claimed invention does not lack inventive step.

Grounds for the IPHC Judgement

[Lack of Inventive Step]

The cited invention describes that an antioxidant that contains one or more phenol skeletons that have an attached tertiary butyl group hinders re-oxidation of solder powder. On the other hand, the claimed invention describes that an antioxidant consisting of a hindered phenolic compound is deemed to be an antioxidant that contains a tertiary butyl group attached to a phenol skeleton. Taking into account these descriptions, a person skilled in the art could easily conceive of enhancing solderability to hinder re-oxidation of solder powder as long as the antioxidant contains a tertiary butyl group attached to a phenol skeleton based on both the cited invention and common technical knowledge.

[Remarkable Effect]

In addition, the claimed invention specifies the antioxidant as having a molecular weight of at least 500. However, this is not sufficient to prove that the claimed invention achieves a remarkable effect for the following reasons. Therefore, the effect of the claimed invention is not deemed to be a particularly “remarkable effect” which a person skilled in the art could not have conceived of based on the common technical knowledge at the time of filing of the claimed invention and/or the cited invention.

The claimed specification describes three types of experiments which assess reflow. Example 1 which contains X as a hindered phenolic compound, Example 2 which contains X, and Comparative Example which does not contain an antioxidant. The specification describes that Example 1 and Example 2 show excellent solderability even at a preheat temperature of 150°C, and particularly excellent solderability at a preheat temperature of 200°C while maintaining excellent ability in other properties. As a result of Example 1 and Example 2, it can be said that solder paste that contains X as a hindered phenolic antioxidant has excellent solderability compared to solder paste that does not contain an antioxidant.

However, the claimed specification does not describe a comparative experiment comparing either the solder paste in the claimed invention or the solder paste composition containing an antioxidant which consists of a hindered phenolic compound having a molecular weight of less than 500. Therefore, it cannot be said from the disclosure of the claimed specification that, by containing an antioxidant which consists of a hindered phenolic compound having a molecular weight of less than 500, the claimed invention achieves a remarkable effect compared to the cited invention.

In addition, with regard to the hindered phenolic antioxidant having a molecular weight of at least 500 in the claimed invention, the claimed specification describes “the amount (molecular weight) of hindering phenolic compound is not limited, although, ... a molecular weight of 500 or more is most preferable due to excellent thermal stability” [paragraph [0010] of the Detailed Description of the Invention].

However, the claimed specification does not describe the effect achieved by obtaining a solder paste compound with excellent reflow soldering characteristics, compared to a hindered phenolic antioxidant having a molecular weight of at least 500, even though the claimed specification mentions excellent thermal stability. Accordingly, it cannot be asserted that the molecular weight of the antioxidant has critical significance.

The defendant conducted experiments to verify the dissolution state of the solder by using a reflow thermal resistance test with the following solder pastes: a) Fluxes D and E each containing an antioxidant having a molecular weight of 500 or more, and b) Fluxes B and C each containing an antioxidant having a molecular weight of less than 500. As a result, the defendant claims that Fluxes D and E containing an antioxidant having a molecular weight of 500 or more cause the solder paste to have a lower non-dissolution/melting rate.

However, it cannot be asserted based on the defendant’s experiments that flux containing an antioxidant having a molecular weight of 500 or more produces solder paste with a lower non-melting rate than a flux containing an antioxidant having a molecular weight of 500 or less.

Taking into account the above results of the experiments, it is hard to say that the results suggested by the defendant’s experiments are assessed based on clear, non-arbitrary assessment standards. Under such circumstances, the defendant’s experiments do not suggest an objective result where a solder paste produced with Fluxes D and E has improved reflow characteristics compared with Fluxes B and C.

Therefore, it cannot be said that the effect of the claimed invention, which contains an antioxidant consisting of a hindered phenolic compound having a molecular weight of at least 500, is a remarkable effect, and that a person in the skilled art could easily conceive of the claimed invention based on the cited invention and common technical knowledge.

Conclusion

The IPHC dismissed the JPO Trial Decision that stated that the claimed invention achieves a remarkable effect, and that a person skilled in the art could not easily conceive of the claimed invention.