Date	April 13, 2018	Court	Intellectual Property High Court, Special Division
Case Number	2016 (Gyo-Ke) 10182, 10184		

- Under the Patent Act prior to amendment by Act No.36 of 2014, the legal interest for litigation against JPO decision that dismissed a request for an invalidation trial would not be lost even after the expiration of patent right unless there is a special circumstance regarded as the complete extinguishment of possibility that any person can be subjected to a claim of the compensation for damage and the return for unjust enrichment or be imposed criminal penalties for conduct by the person within the lifetime of patent right.
- If an invention as allegedly claimed to be a cited invention is an "invention described in a publication" (Article 29, paragraph (1), item (iii) of the Patent Act) and a compound is described in the form of general formula in the publication and the general formula has an enormous number of alternatives, it is impossible to extract a specific technical concept according to a specific alternative and find it as a cited invention unless there is a circumstance where the technical concept according to the specific alternative should be positively or preferentially selected.

References: Article 9, paragraph (1) of the Administrative Case Litigation Act, Article 123, paragraph (2) and Article 29, paragraph (2) of the Patent Act

Number of related rights, etc.: Invalidation Trial No. 2015-800095, Patent No. 2648897

Summary of the Judgment

1 The case is a suit against JPO decision that dismissed a request for the invalidation trial of a patent according to an invention titled "pyrimidine derivatives." The issues are: [i] legal interest for litigation; and [ii] whether or not to involve inventive step.

2 Generally, the judgment, while accepting the interest for litigation, affirmed the conformance of the Patent to the requirement of inventive step, and dismissed the Plaintiffs demand as set forth below.

(1) Legal interest for litigation

A The request for trial was made on March 31, 2015, and thus the Patent Act as of the date (the Patent Act prior to amendment by Act No.36 of 2014) shall be applied to the request for trial.

Under the Patent Act prior to amendment by Act No.36 of 2014, the legal interest for litigation against JPO decision that dismissed a request for an invalidation trial would not be lost even after the expiration of patent right unless there is a special circumstance regarded as the complete extinguishment of possibility that any person can be subjected to a claim of the compensation for damage and the return for unjust enrichment or be imposed criminal penalties for conduct by the person within the

lifetime of patent right.

In this case, the lifetime of the patent right expired 25 years after the filing date, May 28, 1992, but there are no special circumstances as described above. Therefore, the legal interest for litigation has not yet been lost.

B In addition, the amendment by Act No.36 of 2014 has limited a person who is entitled to make a request for an invalidation trial to only a person who has a private proprietary interest with regard to invalidating the patent.

As long as there is the slightest possibility that a patent infringement issue may be raised, a person who might possibly get involved with such a problem obviously has a private proprietary interest to invalidate the patent as well as an interest to make a request for an invalidation trial (therefore, a legal interest for litigation against trial decision by the JPO that dismissed the request for an invalidation trial). Therefore, in order to establish the fact that a legal interest for litigation has diminished, it is required that the patent right expired and that there is a special circumstance regarded as the complete extinguishment of possibility that the plaintiff can be subjected to a claim of the compensation for damage and the return for unjust enrichment or be imposed criminal penalties for conduct by the plaintiff within the lifetime of patent right.

(2) As for inventive step

A The inventive step requirement is established by finding an invention according to patent application (the present invention) on the basis of the scope of claims, comparing the invention with a certain invention provided in each item of Article 29, paragraph (1) of the Patent Act, finding a common feature and a difference, and if there is a difference, determining whether a person ordinarily skilled in the art could easily conceive of the present invention corresponding to the difference, on the basis of the state of the art as of the filing date (or priority date; the same shall apply hereinafter.).

In the determination of such inventive step, a certain invention provided in each item of Article 29, paragraph (1) of the Patent Act to be compared with the present invention (the main cited invention) is usually selected from the inventions that are relevant to the present invention in their technical field and falling within a range targeted for comparison by a person ordinarily skilled in the art in the technical field. In particular, "an invention described in a Publication" of Article 29, paragraph (1), item (iii), should be a basis for the determination of whether a person ordinarily skilled in the art could easily conceive of the present invention on the basis of the state of the art as of the filing. Therefore, it must be a specific technical concept to be extracted

from the description of the Publication.

If an invention as allegedly claimed to be a cited invention is the "invention described in a publication" and a compound is described in the form of general formula in the publication and the general formula has an enormous number of alternatives, it is impossible to extract a specific technical concept according to a specific alternative and find it as a cited invention unless there is a circumstance where the technical concept according to the specific alternative should be positively or preferentially selected.

B In this case, the difference between the Invention and the main cited invention lies in that a part corresponding to alkylsulfonyl group in the compound of the Invention is a methyl group in the compound of the main cited invention. In a publication that allegedly describes a sub cited invention, there is described a compound where the part is an alkylsulfonyl group; however, it is one of 20,000,000 or more alternatives. Therefore, it is difficult for a person ordinarily skilled in the art to find any circumstances where the alternative should be selected. Thus it cannot be seen from the publication that the technical concept corresponding to the difference can be extracted.

Therefore, it cannot be said that the publication describes the configuration according to the above difference. The combination of the main cited invention with the sub cited invention does not result in the configuration according to the difference of the Invention. Therefore, it cannot be said that the Invention was easily conceivable on the basis of the cited invention.