



# Grand Panel Case

## “Pyrimidine Derivative” Case

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Judge, IP High Court  
April 18, 2018



# Overview

- ▶ 1. Outline of the Judgement of IP High Court on “Pyrimidine Derivative” Grand Panel Case
- ▶ 2. The Ruling concerning “Inventive Step”
- ▶ 3. The Ruling concerning “The standing of the plea”



# 1. Outline of the Judgement of IP High Court on “Pyrimidine Derivative” Grand Panel Case

- Docket No.;  
2018 (Gyo-Ke) 10182, etc., Judgement of IP High Court on April 13, 2018
- Suits against trial decision made by the Japan Patent Office related to a patent
- Special division of IP High Court  
Presiding Judge: Misao Shimizu  
Chief Judge of IP High Court
- 11<sup>th</sup> Grand Panel Judgement of IP High Court



# 1. Outline of the Judgement of IP High Court on “Pyrimidine Derivative” Grand Panel Case

Presiding Judge Shimizu delivered the unanimous opinion of the court with respect to;

## (1) Inventive Step

- The standard of finding the cited invention described in a distributed publication

## (2) The standing of the plea



## 2. The Ruling concerning “Inventive Step”- Code

- ▶ “Inventive Step” = “Non Obviousness”
- ▶ Patent Act of Japan Article 29, paragraph(2)

“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.”

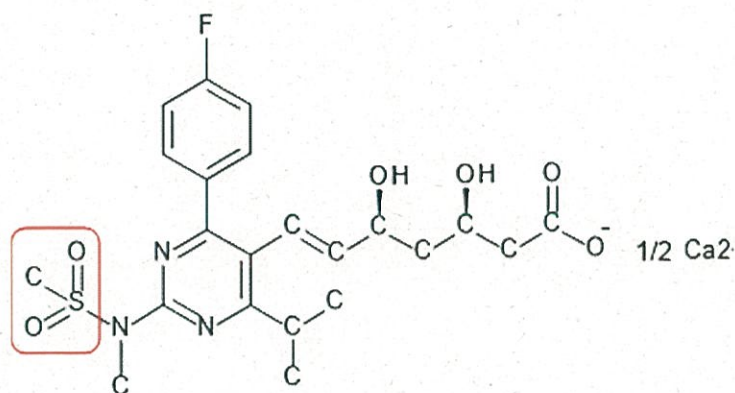
→ Patent Act of Japan Article 29, paragraph(1) item (3)

“**inventions that were described in a distributed publication** prior to the filing of the patent application”

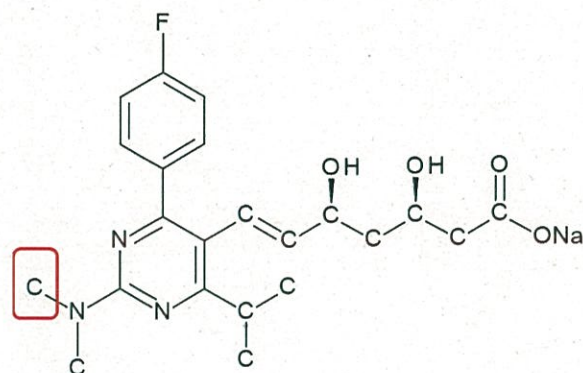


## 2. The Ruling concerning “Inventive Step” - Facts

The Invented Compound  
- Rosuvastatin



“The Cited Compound”- Main  
(alleged) - Compound A



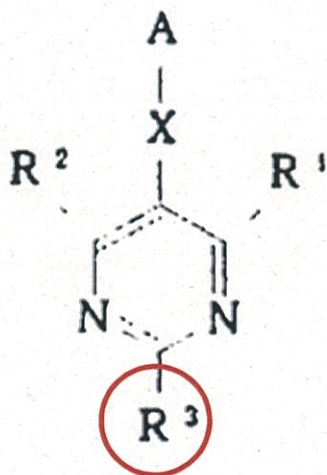
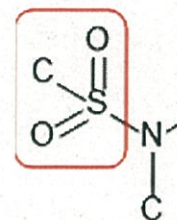
The difference is “Alkylsulfonyl or Methyl”



## Facts (Continued)

“The Cited Compound”- Sub (alleged)

- Compound B,  $R^3 =$



The general formula described is;

$R^3$  は水素を表わすか、シクロアルキルを表わすか、アルキルを表わし、該基はハロゲン、シアノ、アルコキシ、アルキルチオ、アルキルスルホニル、トリフルオロメチル、トリフルオロメトキシ、トリフルオロメチルチオ、トリフルオロメチルスルホニル、アルコキシカルボニルもしくはアシルで、或いは式  $-NR^4R^5$ 、但し、 $R^4$  及び  $R^5$  は上記の意味を有する、の基で、またはカルバモイル、ジアルキルカルバモイル、スルファモイル、ジアルキルスルファモイル、ヘテロアリール、アリール、アリールオキシ、アリールチオ、アリールスルホニル、アラールコキシ、アラールキルチオもしくはアラールキルスルホニルで置換されていてもよく、最後に述べた置換基のヘテロアリール及びアリール基はハロゲン、シアノ、トリフルオロメチル、トリフルオロメトキシ、アルキル、アルコキシ、アルキルチオまたはアルキルスルホニルからなる同一もしくは相異なる基で一置換、二置換または三置換されていてもよく、または  $R^3$  はヘテロアリールを表わし、該基はハロゲン、アルキル、アルコキシ、アルキルチオ、アルキルスルホニル、アリール、アリールオキシ、アリールチオ、アリールスルホニル、トリフルオロメチル、トリフルオロメトキシ、トリフルオロメチルチオもしくは（判決注：「もしくは」の誤記と認める。）アルコキシで、または式  $-NR^4R^5$ 、但し、 $R^4$  及び  $R^5$  は上記の意味を有する、の基からなる同一もしくは相異なる基で一置換、二置換または三置換されていてもよく、或いは  $R^3$  はアリールを表わし、該基はアルキル、アルコキシ、アルキルチオ、アルキルスルホニル、アリール、アリールオキシ、アリールチオ、アリールスルホニル、..... and so on

...more than 20,000,000 options



## 2. The Ruling concerning “Inventive Step” (1)

The invention which is alleged as “the cited invention” cannot be found in the case where;

- “the cited invention” is an “invention that was described in a distributed publication” (Patent Act Article 29, paragraph(1), item (3)),
- the compound is described in the form of a general formula in the distributed publication,
- the general formula has a huge number of options,

In addition,

(continued)



## 2. The Ruling concerning “Inventive Step” (2)

- the party alleges that a single compound which is one of the huge number of options of the general formula, constitutes “the cited invention”.

However, this excludes the case “a person who has common knowledge in the technical field to which the invention pertains” has enough reason to select the certain compound prior to the other options of the general formula.

This is because it is impossible to extract the specific technical idea of the certain compound from the distributed publication.



### 3. The Ruling concerning “The standing of the plea”

The standing of the plea in “the suit against the trial decision made by the Japan Patent Office” in which the request for patent invalidation trial was rejected shall not lapse even after the termination of the patent right under the Patent Act before the revision by Act No. 36, 2016, unless there shall be no possibility that;

- any compensation for damages, unjust enrichment or criminal punishments can be imposed on an individual, because of the act which existed during the duration of the patent right.



## References

English translation for the “Pyrimidine Derivative”  
Grand Panel Case will be available on IPHC’s website  
in the near future(estimated June - July 2018).

<http://www.ip.courts.go.jp>



Thank you !

