

# **“Judicial Symposium on Intellectual Property/TOKYO 2018” - Global Collaboration for IP Dispute Resolution - Outline of the Results (Second Day)**

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## **1. Introduction**

The Japan Patent Office hosted the second day of the “Judicial Symposium on Intellectual Property / TOKYO 2018” held in fall 2018. Administrative judges of intellectual property offices from Japan, Europe, and the United States gave speeches. Themes for the symposium were “the Latest Situation of Trials and Appeals of Each Office” and “Introduction of Trial and Appeal System for Patent Invalidation of Each Office.” Panel discussions were also held on “Trial and Appeal Procedures for Patent Invalidation” and “Whether or Not Claims Can Be Corrected/Amended in a Trial for Invalidation/IPR/Opposition.”

This article makes a report of the content of each program on the second day.

## **2. Keynote Speech**

At the beginning, Deputy Commissioner Kunihiro Shimano of the Japan Patent Office (JPO) gave a keynote speech. He stated that the JPO has recently been strengthening relationships with the United States Patent and Trademark Office (USPTO), the European Patent Office (EPO), and the intellectual property offices of ASEAN countries as international efforts of the JPO’s trial and appeal sector, in addition to Joint Experts Group for Trial and Appeal meetings among Japan, China, and South Korea which have been held in the past. In addition, he also stated that it is very important to carry forward exchange of information through international cooperation not only for increasing predictability in users’ utilizing trial and appeal systems overseas but also for each office’s pursuing best practice. Then, he explained the outline of the second day

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and expressed his expectation that users will develop knowledge on trial and appeal proceedings not only in Japan but also in the United States and Europe and increase predictability in utilizing each office's trial and appeal system, which will help prompt resolution of intellectual property disputes.

### **3. Speeches (The Latest Situation of Trials and Appeals of Each Office)**

The offices gave speeches on the latest situation of trials and appeals in Japan, Europe, and the United States, respectively.

The outline of each office's speech is reported below.

#### **3-1. JPO Trial and Appeal Department (TAD)**

Director-General Reeko Imamura from the TAD gave a speech on the "latest trends and efforts in trials and appeals."

In this speech, she explained the actual conditions of trials and appeals and efforts for timely and reliable trial and appeal decisions, as well as determinations concerning standard essential patents and provision of information about proceedings by J-PlatPat as the latest topics.

In the speech, she introduced the following fact: in September 2018 when three years passed since the launch of the system of opposition to grant of patent, the Manual for Trial and Appeal Proceedings was revised in order to solve problems because there have been cases where the pendency period is prolonged due to multiple times of intermediate procedures before a decision and because

users expressed opinions, including a request for provision of an opportunity for a person filing an opposition to express opinions even where the patentee does not file a request for correction. The major revisions are the following four points: (i) enrichment of the content of a notice of reasons for revocation, (ii) reduction of the number of intermediate procedures (in principle, the second notice of reasons for revocation shall be an advance notice of a decision), (iii) expansion of the opportunity for hearing the opinions of the opponent (even if a request for correction is not filed, hearing is conducted with the opponent), and (iv) appropriate scope of ex officio proceedings (a publication submitted after the period for filing an opposition may be adopted as evidence if it obviously constitutes an appropriate reason for revocation).

#### **3-2. EPO Boards of Appeal (BoA)**

From the BoA, President Carl Josefsson gave a speech on the "implementation of organizational restructuring."

In this speech, he explained about the independence and organizational restructuring of the BoA, authority of the President of the BoA, performance evaluation of the qualified members and the chairmen, revision of the Rules of Procedure of the Boards of Appeal, current statistics and efforts for efficiency, and relocation to Haar in the suburbs of Munich, Germany.

Out of these topics, regarding the independence of the BoA, he introduced the fact that the BoA has become an organization independent of the EPO. He explained as follows: The post of the President of the BoA was newly estab-

lished, and the duties and authority of the President of the EPO relating to the BoA were transferred to the President of the BoA; The Boards of Appeal Committee consisting of judges of related countries was newly established, and it has advisory and supervisory functions concerning independence and efficiency.

In addition, he also introduced efforts for the revision of the Rules of Procedure of the Boards of Appeal for the purpose of increasing efficiency, predictability, and harmony. He also stated that the revised draft of the Rules of Procedure of the Boards of Appeal is placed<sup>1</sup> on the website and it is expected to be adopted in 2019 after being discussed at the user consultation conference<sup>2</sup> in December. Furthermore, as efforts for efficiency, he explained the five-year goal (disposing of 90% cases within 30 months and reducing the number of pending cases to 7,000 or less by 2023), improvement of the internal workflow, increase in the flexibility of allocation of operations between sectors, and renovation of the system of fees for filing an appeal.

### **3-3. USPTO Patent Trial and Appeal Board (PTAB)**

From the PTAB, Vice Chief Patent Judge Scott Weidenfeller gave a speech on the “statistics of the Patent Trial and Appeal Board.”

In this speech, he explained statistics on ex parte appeals and the America Invents Act (AIA) trial proceedings.

Regarding ex parte appeals, he stated that the number of pending cases rapidly increased in 2012 when the AIA was enacted but that it has recently been decreasing. He also stated that the pendency period in fiscal 2018 was shortened compared to fiscal 2017 in all technical

fields. In addition, he explained that the goal for the pendency period is one year and that the pendency period is balanced among technical fields by having administrative patent judges in other technical fields take charge of the cases in technical fields for which the pendency period is long. Furthermore, regarding the results of proceedings, he reported that, in fiscal 2018, the decision was maintained in about 60% cases, the decision was partially maintained in about 10% cases, and the decision was rescinded in about 30% cases.

Regarding the AIA trial proceedings, he stated as follows: The ratio of institution of trials has recently been decreasing, and it was 60% in fiscal 2018; for the entire period after the start of the system, 9,006 petitions were filed, trials were instituted on 4,650 cases, and 2,308 cases reached a PTAB decision. In addition, for the breakdown of the PTAB decisions, he explained that those decisions that all the claims are valid accounted for 19%, those decisions that part of the claims are invalid accounted for 16%, and those decisions that all the claims are invalid accounted for 64%.

## **4. Speeches (Introduction of Trial and Appeal System for Patent Invalidation of Each Office)**

Each office gave a speech on the trial and appeal system for patent invalidation of Japan, Europe, and the United States, respectively.

The outline of each office’s speech is reported below.

### **4-1. TAD**

From the TAD, Executive Chief

Administrative Judge Toshihide Abe gave a speech on “invalidation trial at the Japan Patent Office.”

In this speech, he explained the system for invalidation trial, including an advance notice of a trial decision, which was introduced through the legal amendment of 2011 and the outline of its operation, requirements for filing a request for correction (the content and time requirements), and specific case examples for a request for correction.

An advance notice of a trial decision is a notice to the parties that describes the same matters as those described in the trial decision when the panel received an impression that the patent is invalid. Thereby, the patentee is given an opportunity to file a request for correction.

Looking at the results of a survey on the influence of an advance notice of a trial decision and a request for correction with regard to trial decisions in three years from 2015 to 2017, an advance notice of a trial decision was given for 39% of the cases where a trial decision was rendered. A request for correction was not filed for 25% of the cases where an advance notice of a trial decision was given, and all of these cases led to a trial decision that the patent is invalid. On the other hand, the remaining 75% cases where a request for correction was filed after an advance notice of a trial decision are equally divided into the cases in which the patent was determined to be valid and those in which the patent was determined to be invalid.

For the content requirements of a request for correction, correction is limited to those for the purpose of restriction of the claims, correction of errors or incorrect translations, clarification of an ambiguous description, or correction of a

statement of claims which cites another statement of claims to a statement which does not cite that other statement of claims, and it must not be one that introduces a new matter or substantially enlarges or alters the claims.

#### **4-2. BoA**

From the BoA, President Carl Josefsson gave a speech on “proceedings at the Boards of Appeal.”

In this speech, he explained about the organization of the EPO, proceedings of an appeal, correction of a patent in the inter partes procedures,<sup>3</sup> and the relationships between the BoA, each country’s court, and the Unified Patent Court.

In addition, he explained as follows regarding the BoA.

The EPO has unified the procedures for granting a patent and grants a European patent which constitutes a bundle of patents of up to 38 countries. In the case of being dissatisfied with a decision at the EPO, it is possible to file an appeal only with the BoA of the EPO. In principle, the panel’s decision is final and binding, but there are cases where the panel’s decision ceases to be final and binding due to a review of a fundamental procedural defect by the Enlarged Board of Appeal (EBoA) or a determination on the validity of a European patent at each country’s court. Then, the Technical Boards of Appeal examine appeals against the decisions of the examining divisions and opposition divisions, and a panel is usually composed of two technically qualified members and one legally qualified member. In addition, the EBoA is established to show important legal points of view. Meanwhile, the EBoA is composed of five legally qualified members and two technically qualified mem-

bers.

Moreover, he gave the following explanation regarding appeal proceedings.

For *ex parte* appeals, the BoA has the authority to examine whether an appeal fulfills the requirements under the European Patent Convention - the Convention on the Grant of European Patents (EPC) and can also examine a new issue. Regarding *inter partes* appeals, a new ground for opposition can be added only where the patentee gives consent thereto. Exchanges with the parties are conducted in writing many times as needed, and oral proceedings are concentrated on essential matters. Oral proceedings are conducted upon request of the party or the BoA, and are usually conducted in public for up to half a day.

Furthermore, he gave the following explanation about the correction procedure in an *inter partes* appeal.

Article 123 of the EPC provides for correction as follows, and both requirements (2) and (3) must be fulfilled for permission of correction of a patent: (1) The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given at least one opportunity to amend the application of his own volition; (2) The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed; (3) The European patent may not be amended in such a way as to extend the protection it confers. In addition, Article 100 of the EPC provides that opposition may be filed on the grounds that “the subject-matter of the European patent extends beyond the

content of the application as filed.” Meanwhile, there is no strict restriction on the number of requests for correction, but in terms of appeal practice, the number of auxiliary requests may be restricted. A request for correction can be submitted at any stage in the procedure, and in the appeal procedure, (1) correction requested together with the statement of grounds of appeal or reply, (2) correction requested after submission of the statement of grounds of appeal or reply, and (3) amendment requested after the establishment of the date of oral proceedings are possible. However, according to the Rules of Procedure of the Boards of Appeal, correction must be submitted as early as possible (ideally, together with the statement of grounds of appeal or reply). Whether to permit a correction submitted in a delayed fashion is left to the panel’s discretion. The later a correction is submitted, the less likely it is to be permitted.

At last, for a decision on an appeal, the conclusion is orally rendered at the end of oral proceedings, and grounds thereof are sent later in writing. It is exceptional that proceedings continue in writing after oral proceedings.

#### **4-3. PTAB**

From the PTAB, Vice Chief Patent Judge Scott Weidenfeller gave a speech on the “outline of the AIA trial proceedings.”

In this speech, he explained about the AIA trial proceedings and a request for correction (AIA trial proceedings include *inter partes* review (IPR), post-grant review (PGR), covered business method review (CBM), etc.).

The standard for proof in the AIA trial proceedings is “preponderance of

evidence,” and such evidence is considered to be less than “clear and convincing evidence” that is necessary for winning a lawsuit at a district court. Therefore, the AIA trial proceedings are more advantageous to petitioners. In addition, the proceedings are completed within 12 months from the institution of a trial, and the proceedings can be extended for six months only in the case where there are “reasonable grounds” but are basically not extended. In general, the entire pendency period from filing of a petition to completion or final decision is within 18 months.

Regarding the types of patents subject to proceedings and the timing of proceedings, patents before the First Inventor to File (FITF) are subject to IPR after their granting, and patents after the FITF are subject to IPR after the date nine months after their granting or the date on which the PGR procedure is completed (whichever comes later). CBM covers patents for which an infringement lawsuit was filed or for which an offence of infringement was fixed. PGR covers patents after the FITF for which nine months or less have passed since their granting.

He gave the following explanation about the correction procedure.

In an IPR, a patentee may file a motion to correct a patent once by suggesting a reasonable number of substitute claims for the disputed claims, etc. Here, the reasonable number is usually one, but multiple substitute claims can be suggested through proof of their necessity. A correction can neither enlarge the scope of claims of the patent nor introduce new subject matter. Then, a request for correction is denied where the correction does not respond to a ground of invalidation involved in the proceedings or where the

correction enlarges the scope of claims of the patent or introduces new subject matter. In addition, a request for correction must include a claim listing, show the changes clearly, and set forth the support in the original disclosure of the patent for each claim that is added or corrected and the support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.

Next, he introduced “intervening rights.” Intervening rights are based on Section 252 of the patent law. For example, where a person makes an investment in the manufacturing or preparation of a product without infringing a patent right pertaining to the original claims, even if the product infringes the patent right pertaining to the claims after correction, the court permits him/her to continue the manufacturing or preparation of the product that infringes the patent right pertaining to the claims after correction in order to have him/her recover the investment.

In addition, he explained as follows about the amendment to the Rules of Practice<sup>4</sup> for which public comment procedure was started.

This amendment is to ensure that a patentee files a request for correction after the PTAB shows its preliminary determination on patentability and that if the patent is determined to be invalid again, the patentee can file a request for correction again. The period for filing a request for correction is shortened to six weeks, and the schedule becomes tighter.

At last, regarding the burden of proof of patentability of the claims for which a request for correction was filed, the PTAB presented guidance after the Aqua case in which it was ruled that not the patentee but the person who files a

motion assumes the burden.<sup>5</sup> He indicated that although only a few requests for correction had been filed in the past, the Aqua case changed the situation and the number of requests for correction filed in the first half of fiscal 2018 exceeds the annual number of requests for correction filed in the previous fiscal year.

Meanwhile, participants in the symposium addressed questions regarding intervening rights. In particular, the following questions were addressed: If a correction can neither enlarge the scope of claims nor introduce new subject matter, if a product infringes the claims after the correction, has the product also infringed the claims before the correction? Thinking so, what is the case where the product does not infringe the claims before the correction? In response to these questions, he answered as follows: The U.S. court introduces the idea of intervening rights based on the idea that if the claims before a correction is determined to be invalid (even if a product infringes the claims before the correction), the product does not constitute infringement of the claims before the correction; the idea of intervening rights is based on Section 252 that provides for reissued patents, but it is also applicable in all procedures in the AIA trial proceedings; therefore, patentees do not like to make a correction much in the correction procedure in an IPR.

## **5. Panel Discussion (Case Study on Trial and Appeal Procedures for Patent Invalidation)**

The trial and appeal procedures for patent invalidation were taken up as the theme of the panel discussion, and discussions were held by using a hypo-

thetical case.

Mr. Shoichi Okuyama, a patent attorney at Okuyama & Sasajima, served as the moderator, and Director-General Reeko Imamura of the TAD, Chairman Ingo Beckedorf of the Technical Board of Appeal of the EPO, and Vice Chief Patent Judge Scott Weidenfeller of the PTAB took the rostrum as panelists.

See the following ([https://www.jpo.go.jp/torikumi/kokusai/kokusai2/pdf/chiz\\_aishihou-2018/06.pdf](https://www.jpo.go.jp/torikumi/kokusai/kokusai2/pdf/chiz_aishihou-2018/06.pdf)) with regard to the comparative table concerning correction in a trial for patent invalidation, etc. among the offices and the assumed case taken up in the panel discussion.

In this panel discussion, the moderator asked each office questions about the trial and appeal procedures for patent invalidation. Some of the questions and each office's answers thereto are introduced below.

### **5-1. After this, through what procedure is the trial/appeal case carried forward at each office?**

The TAD's answer was as follows.

A trial for invalidation is carried forward in Japan based on the structure of conflict between the parties. In receiving a request for a trial for invalidation, a panel of administrative judges gives an invitation to reply to the patentee. In response to this, the patentee submits a written answer and may also file a request for correction as needed. Under the Patent Act, a trial for invalidation shall be conducted by oral proceedings. Oral proceedings are conducted after giving a notice of proceeding matters to both parties. Where the panel reached a determination that the patent is to be invalid, it gives an advance notice of a trial decision and thereby gives the patentee an oppor-

tunity to make a correction. Where the determination that the patent is to be invalid is not reversed as a result of further proceedings, the panel renders a trial decision to invalidate the patent. On the other hand, where the panel reached a determination that the patent is to be maintained after oral proceedings, it renders a trial decision to the effect that the patent is valid without giving an advance notice of a trial decision.

The BoA's answer was as follows.

Where the appellant submits new evidence and the evidence was not submitted to the opposition division, the BoA determines whether to take the new evidence into consideration. In addition, the patentee can file a request for correction as the main and auxiliary requests in a written answer. The rapporteur of the panel prepares a written opinion on the case, and the panel takes counsel together and considers whether to take the new evidence into consideration and also discusses the patentability of the main and auxiliary requests. Then, the panel composed of two technically qualified members and one legally qualified member issues a preliminary opinion. In order to fairly carry forward the procedure, where the new evidence is taken into consideration, the patentee can make a correction through the main and auxiliary requests. In this case, the appellant can make a counterargument and can also make a new assertion.

The PTAB's answer was as follows.

Where the petitioner submits new evidence, he/she explains the reason why this new evidence denies patentability. The petitioner submits a petition to the PTAB by means of the USPTO's "PTAB End-to-End" system that is for submission of electronic documents and also

pays fees for filing the petition. The patentee is granted a three-month period for preparing a preliminary response to the petition. The PTAB must decide whether to conduct an IPR after the patentee submits a preliminary response. In deciding whether to conduct an IPR, the PTAB must determine whether the petitioner has proven the "existence of the reasonable possibility that at least one of the claims subject to the petition will be invalidated." Even if such possibility has been proven, the PTAB has discretion to refuse to conduct an IPR. In addition, the PTAB can also refuse to conduct an IPR where "a petition has been filed for the same or substantially same prior art or discussion in the past."

A three-month discovery period is available after the institution of a trial, and after that, the patentee is granted an opportunity to correct, and oral hearing is conducted. Then, a decision is rendered within 12 months from the date of institution of a trial.

**5-2. [Question] Although Company A is not completely confident in the validity of the right, it wonders if it is possible to deal with the case without making any correction/amendment or by making only slight correction/amendment. What are the possible options that Company A can choose?**

The TAD's answer was as follows.

Two opportunities for correction are available for the respondent (Company A), specifically, (i) the period for submitting a written answer and (ii) the period for giving a response to an advance notice of a trial decision (which is given in the case that is expected to lead to a trial decision to invalidate the patent).

Therefore, Company A can file no request for correction or make slight correction when submitting a written answer and file a request for correction after receiving an advance notice of a trial decision that is given in the case where the panel determines that the patent is invalid. However, proceedings are prolonged if Company A makes a correction after receiving an advance notice of a trial decision.

The BoA's answer was as follows.

There is no restriction on the number of corrections, but there are procedural constraints. The patentee should file multiple requests for correction as auxiliary requests based on the main request and thereby ensure that the right can be protected whichever direction proceedings proceed. As a correction by an auxiliary request at a late phase is hard to be permitted, a patentee should strategically file a request for correction at an early stage. Then, an auxiliary request can be considered as an effective means.

The PTAB's answer was as follows.

In the new correction process (which is now under the public comment procedure), it is possible to avoid application of intervening rights by making a slight correction. It is possible to confirm the panel's response concerning whether the content of the correction is sufficient and file the second request for correction if the content is not sufficient. The PTAB is trying to make a repetitive process within the time limit of one year. Company A can take action to maintain the patent by making as slight correction as possible.

The moderator asked the PTAB whether correction will be more easily permitted in the AIA trial proceedings in the future. The PTAB answered that it is just the purpose of this change of the cor-

rection process to make it easier for patentees to make corrections.

**5-3. [Question] At what phase in proceedings is the substantial result of determination (valid or invalid) indicated? (for example, by participating in oral proceedings/hearing, can Company A obtain the result of determination that the patent is valid as the result of permission of the correction or invalid, etc.?)**

The TAD's answer was as follows.

The final result of determination that the patent is valid or invalid is indicated in a written trial decision after a notice of conclusion of proceedings is given. Where the panel reached a determination to invalidate the patent, it does not immediately render a trial decision to invalidate but gives an advance notice of a trial decision in writing to give the patentee an opportunity to make a correction. Then it concludes proceedings after further proceedings, and renders a trial decision that the patent is valid or invalid. A provisional opinion concerning the finding of the patented invention, cited invention, identical features and different features between them, etc. is sometimes indicated in a written notice of matters subject to proceedings before oral proceedings, but the panel never indicates a determination that the patent is valid or invalid in oral proceedings. The TAD makes it an internal goal to give the next office action within three months after oral proceedings in a trial for invalidation.

The BoA's answer was as follows.

The BoA indicates the final conclusion that the patent is valid or invalid at the time of completion of oral proceedings. Before then, there is also an oppor-

tunity for the panel to communicate a preliminary opinion concerning whether the content of an opposition concerning novelty and an inventive step was valid. In addition, even after the commencement of oral proceedings, the chairman expresses the panel's preliminary opinion as of the previous day of oral proceedings at the beginning of oral proceedings as the summary of the procedure taken prior to oral proceedings. After that, in light of oral proceedings, the panel communicates the conclusion, including new requests and new evidence. Finally, the details are understood in a decision notified about one month after oral proceedings.

The PTAB's answer was as follows.

The only decision concerning patentability is made by a final document of the PTAB at the time of completion of an IPR. The parties can understand the possibility of existence of any reason for invalidation at the time of institution of a trial.

**5-4. [Question] The reason for invalidation/revocation alleged by Company B was dissolved by Company A's correction/amendment. In such situation, Company A came to feel certain that Product  $\alpha$  which Company B manufactures falls within the scope of the patent right after the correction/amendment. In such case, can Company A file a claim for damages in the past with regard to Product  $\alpha$  of Company B?**

The TAD's answer was as follows.

In Japan, where a correction is permitted, it is deemed that the establishment of a patent right was registered based on the description, claims, drawings, etc. after the correction. Therefore, Company A can file a claim for damages

in the past with the court.

The BoA's answer was as follows.

Where a patent is lawfully corrected, the correction has retroactive effect. Therefore, the patentee can file a lawsuit with each country's infringement court. Needless to say, Company A can retroactively file a claim for damages in the past.

The PTAB's answer was as follows.

As already explained, there are intervening rights. Therefore, the court considers the case within the scope of equity between the parties. In doing so, the court also considers whether the patent right before the correction is infringed. Therefore, in this regard, the United States cannot give a clear answer.

**5-5. If a patentee requests permission of the content of a correction/amendment on the grounds that the correction was permitted at another office and the patent right was also determined to be valid, can your office deal with the case?**

The TAD's answer was as follows.

A patentee can allege the fact that a correction was permitted at another office and the patent right was determined to be valid, but whether the correction is permitted and whether the patent is valid are to be determined based on the Patent Act in Japan.

The BoA's answer was as follows.

The parties or their representatives can request the panel to consider a correction as information related to the opposition if the correction has been permitted at another office. However, in doing so, it is necessary to state the reason for requesting permission of the content of the correction, the reason for doing so now, and whether all grounds

for opposition can be avoided by the correction. There is no established rule.

The PTAB's answer was as follows.

A patentee can file a motion to amend the patent with the PTAB by the same method as the method for another office and communicate said other office's decision. The PTAB carefully considers the other office's decision but assumes the obligation to determine patentability under the law of the United States of America.

Last, the moderator asked the question of whether the USPTO or the EPO has something to tell users in Japan given the change of Under Secretary of Commerce for Intellectual Property and Director of the USPTO and the President of the EPO.

The PTAB's answer was as follows.

There are two matters to which the new Director of the USPTO gives priority. One is relating to Section 101 and another is relating to the PTAB. Therefore, as revisions to standard operating procedures,<sup>6</sup> the USPTO revised the standard procedures for designating panels<sup>7</sup> and the AIA Trial Practice Guide.<sup>8</sup> In addition, the USPTO also changed the claim construction standard. The USPTO wishes to make the system fair to peti-

tioners and has intensively taken actions during the past few months.

The BoA's answer was as follows.

The EPO recognizes that approach for correction at the EPO is very strict, and we also wish to improve the procedure in order to offer better services.

## 6. Panel Discussion (Case Study Related to Whether or Not Claims Can Be Corrected/Amended in a Trial for Invalidation/IPR/Opposition)

The issue of whether or not claims can be corrected/amended in a trial for invalidation/IPR/opposition was taken up as a theme of the panel discussion, and discussions were held by using a hypothetical case.

Ms. Shimako Kato, a patent attorney at Abe, Ikubo & Katayama, served as the moderator, and Executive Chief Administrative Judge Toshihide Abe of the TAD, Mr. Marco Alvazzi Delfrate, a member of the BoA, and Vice Chief Patent Judge Scott Weidenfeller of the PTAB took the rostrum as panelists.

See the following regarding the hypothetical case taken up in the panel discussion.



(<https://www.jpo.go.jp/torikumi/kokusai/kokusai2/pdf/chizaishihou-2018/06.pdf>)

Regarding this hypothetical case, discussions were held on each proposed correction (proposal) in descending order (from proposals 5 to 1). Each office gave the following answer.

#### **6-1. TAD**

Proposal 5 is expected to be permitted based on stated item of the description C.

Compared to proposal 5, proposal 4 is not restricted in relation to the point that a frame “extends from the one side to the other side of the conveyor belt above the conveyor belt” and the point that the side that holds the scanning device hanging from the frame is the “other side of the conveyor belt.” This restriction is the configuration of the scanning device in response to the case where there are “design constraints” in the description.

Proposal 4 is considered to be one that responds to the case where there are no such “design constraints.” However, according to stated item C in the description, it can be said that the statement is made on the premise of the case where there are no such design constraints. Therefore, proposal 4 is also considered as a correction that is within the scope of the matters indicated in the description in light of the decision of the Grand Panel of the Intellectual Property High Court in 2008 holding that “when a correction is one that does not introduce any new technical matter in relation to the technical matters which a person ordinarily skilled in the art can draw by putting all statements in the description or drawings together, the correction can be considered as one that is made ‘within the scope of

the matters indicated in the description or drawings.” In addition, the correction is recognized as one for the purpose of restriction of the claims as it restricts the configuration of the moving device. Therefore, proposal 4 is expected to be permitted.

As the term “holding” is used in proposal 3, other forms of attachment, such as “embedding” in a frame, are included, in addition to “hanging” as stated in the description. Therefore, it is questioned whether inclusion of such forms of attachment falls under an addition of a new matter in relation to the description.

This hypothetical case was prepared in reference to an actual case. Although it is nothing more than one case, venturing to generalize determinations on corrections based on this actual case, it is considered possible to extract the following points: (1) A generalized feature is not related to the essential feature of this invention from the perspective of technical meaning of this invention; (2) not only the means stated in this description, but also other means covered by the generalized feature had been known to the public before the filing date of the patent.

In light of the previously introduced decision of the Grand Panel and the determination in this actual case, proposal 3 seems to be determined not to be one that introduces a new technical matter even if the term “holding” includes other forms of attachment in addition to “hanging.” Therefore, proposal 3 is also expected to be permitted.

Proposals 2 and 1 do not include the restriction that the frame moves along the guide. Therefore, whether proposals 2 and 1 introduce a new technical matter depends on whether the form wherein a

guide is not included in the moving device can be assumed based on common general technical knowledge as of the filing.

### **6-2. BoA**

At the BoA, proposals 4 and 5 are permitted, but proposals 1 to 3 are not permitted.

According to the BoA's case law, "a correction is permitted if it is within the scope which a person ordinarily skilled in the art can directly and unambiguously draw from application documents as a whole based on common general technical knowledge through objective and relative observation as of the filing date," and "where features in a specific combination do not have any clearly recognized functional or structural relationship or where extracted features are not related in an inseparable manner, intermediate generalization is admitted."

Proposal 5 is permitted based on stated item C in the description.

In addition, proposal 4 is also permitted because a ground for omitting to state that the side on which the scanning device is hung is the "other side" is recognized based on stated item C in the description, "If attempts are made to have the scanning device move during scanning, due to design constraints, a guide means for moving the scanning device cannot be placed on either side of the conveyor belt."

However, proposal 3 is not permitted for the following reasons. Considering intermediate generalization, the "frame" and "hanging" are recognized as having a structural and functional relationship, and it is not permitted not to stipulate "hanging" that has a structural relationship with the "frame." In addition, it is considered

that a person ordinarily skilled in the art cannot clearly find another method for realizing the invention based on a generalized form that does not stipulate "hanging."

Moreover, regarding proposal 2, the "frame" is stipulated but the "guide" is not stipulated, and it is difficult to realize the invention without the "guide." Therefore, proposal 2 is not permitted.

Then, proposal 1 is not permitted for the same reasons as those for proposals 2 and 3.

Incidentally, the BoA makes determinations on the permission of a correction and patentability at the same time, but in this case, the BoA gave the aforementioned answer on the premise that all proposals 1 to 5 are patentable based on the hypothesis that "no prior art document has been or will be found for the configuration in the corrected or amended portion."

### **6-3. PTAB**

At the PTAB, only proposal 5 is permitted.

As permission of a correction is not determined independently of a determination on patentability, a correction is not permitted without patentability. As proposals 1 to 4 are considered not to be patentable, the corrections are considered not to be permitted. On the other hand, proposal 5 is recognized as patentable as it is considered not to be obvious (involve an inventive step). Therefore, the correction is also considered to be permitted.

In considering whether the corrections add a new matter separate from a determination on patentability, all the proposals are permitted because it is permitted to add a term stated in the original description to the claims. A correction is



considered to be permitted because it does not fall under an addition of a new matter unless it enlarges the claims.

## 7. Closing Remarks

In closing the symposium, President Yutaro Kikuchi of the Japan Federation of Bar Association gave an address and mentioned the importance of collaboration with intellectual property judiciary-related persons not only in Japan but also abroad and efforts for international development of intellectual property judiciary in response to a growing need of international dispute resolution.

## 8. Conclusion

A total of about 900 persons participated in this symposium for two days, and the symposium provided an opportunity to recognize the high level of users' interest in intellectual property judiciary again.

The JPO wishes to carry forward sharing of information to users and support for the development of intellectual property systems in each country and region by deepening discussions on intel-

lectual property judiciary and trial and appeal systems in each country and region through continuous holding of international symposiums on resolution of intellectual property disputes in the future.

### (Notes)

<sup>1</sup> [http://documents.epo.org/projects/babylon/eponet.nsf/0/A6E82330B5DC1C8BC12583320044C6D4/\\$File/RPBA\\_for\\_user\\_conference\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/A6E82330B5DC1C8BC12583320044C6D4/$File/RPBA_for_user_conference_en.pdf)

<sup>2</sup> <https://www.epo.org/learning-events/events/conferences/rpba-conference.html>

<sup>3</sup> The term “amendment” is used in the Convention on the Grant of European Patents (EPC), but in this article, amendment after granting of a patent is sometimes called “correction.”

<sup>4</sup> <https://www.federalregister.gov/documents/2018/10/29/2018-23187/request-for-comments-on-motion-to-amend-practice-and-procedures-in-trial-proceedings-under-the>  
[https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf)

<sup>5</sup> [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf)

<sup>6</sup> <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/procedures/revisions-standard-operating>

<sup>7</sup> <https://www.uspto.gov/sites/default/files/documents/SOP%201%20R15%20FINAL.pdf>

<sup>8</sup> [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf)