

# WINDS FROM JAPAN

The Licensing Executives Society Japan

## Recent Status and Problems of Patent Appeals and Trials: Effects of Recent Reforms in the JPO Appeal System and of Recent Judiciary Reforms (2003-2007), Including the Establishment of an IP High Court

By Shinjiro ONO\*



The proposal to establish a high court specializing in intellectual property, made in the 2003 document “Strategic Program for the Creation, Protection and Exploitation of Intellectual Property,” was aimed at reinforcing dispute resolution and at strengthening the protection of intellectual property rights.

Following the Supreme Court’s *Kilby* decision of April 11, 2000, discussion commenced on reforming the JPO’s appeal system. The result was the amended Patent Law of 2003 and 2004, which, like the establishment of the IP High Court in April 2005, aimed primarily at reinforcing dispute resolution and at strengthening the protection of patent rights in proceedings at the JPO.

By the 2003 amendment of the Patent Law, the opposition system was abandoned and a new unified invalidation trial system was introduced to establish a system that meets the fundamental need for prompt examination and settlement of patent validity disputes by a single, unified procedure. One important

feature of the new invalidation trials is that any third party is entitled to dispute validity of a patent right at any time.

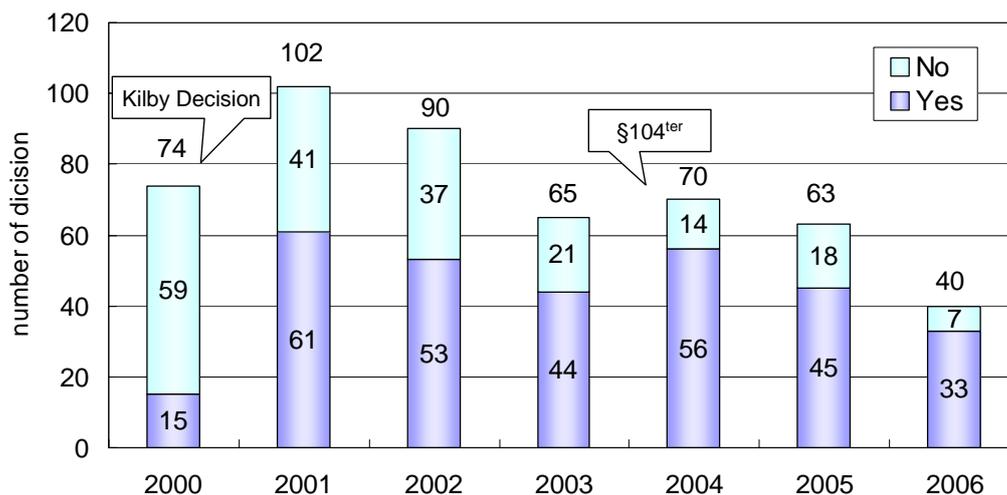
Following the Supreme Court’s *Kilby* decision, it has been practically recognized that the courts are substantially entitled to determine invalidity of a patent right if it is clear that the patent involves a reason for invalidation.

By the 2004 amendment of the Patent Law, an Article 104<sup>ter</sup>(1) relating to limitation on exercising a patent right, if courts find that the asserted patents are likely to be found invalid by a patent invalidation trial at the JPO, was introduced with a view to expressly reinforcing the foregoing practice. When a court makes a patent invalidation judgment in a patent infringement action, the decision is binding only on both parties of the action, and not on any third party. In other words, only the Japan Patent Office is entitled to invalidate the patent right. There has been no change in this point.

Now, two procedures are available when claiming patent invalidation in Japan, namely asserting invalidity of a patent in infringement litigation and filing an invalidation trial at the Japan patent Office.

After 2001, in about 70-80% of cases, alleged infringers (defendants) have been asserting invalidity of patent in infringement litigation. (Fig. 1)

**Fig. 1 Refutation of invalidity of patent in infringement litigation**



Since 2001, courts have ruled invalidation of patent in more than 40% of all infringement cases. In 2006, courts rendered decision to invalidate 70% (23 cases) of 33 cases in which defendants asserted invalidity of patent.

Please note that the number of decisions rendered by courts was only 40 in 2006, which accounted for a decrease 36% from 2005 (63 cases) and recently about half of patent litigation cases have ended in settlement.

This court situation, together with following trends of the results of invalidation trials at the Japan patent Office, is a hot issue in Japan.<sup>1</sup>

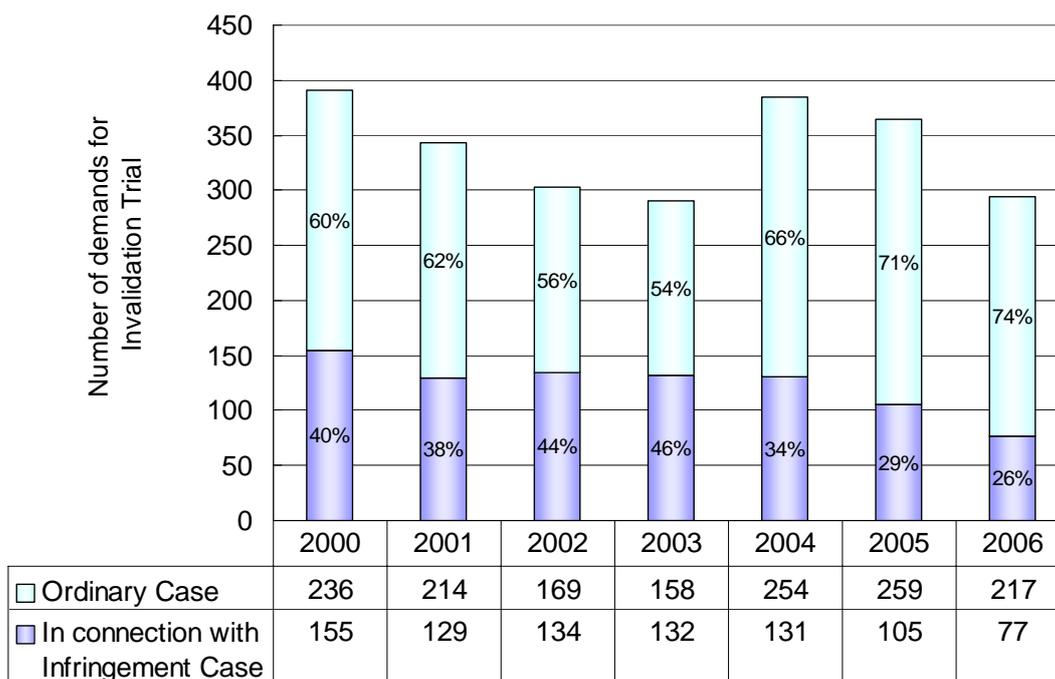
In this article I focus on the results of recent changes in the appeal system, with reference to relevant statistics and charts drawn from “Status and Problems of the Appeal System in Japan in 2006 and 2007,” Appeals Department, JPO, May 2006 and 2007 respectively.

**A. Inter-Partes Trials**

**1. The New Invalidation Trial (Patent) in Effect from January 1, 2004.**

(1) Increase in demands for invalidation trials after the reform (Fig. 2)

**Fig. 2 Number of demands for Invalidation Trial (Patent)**



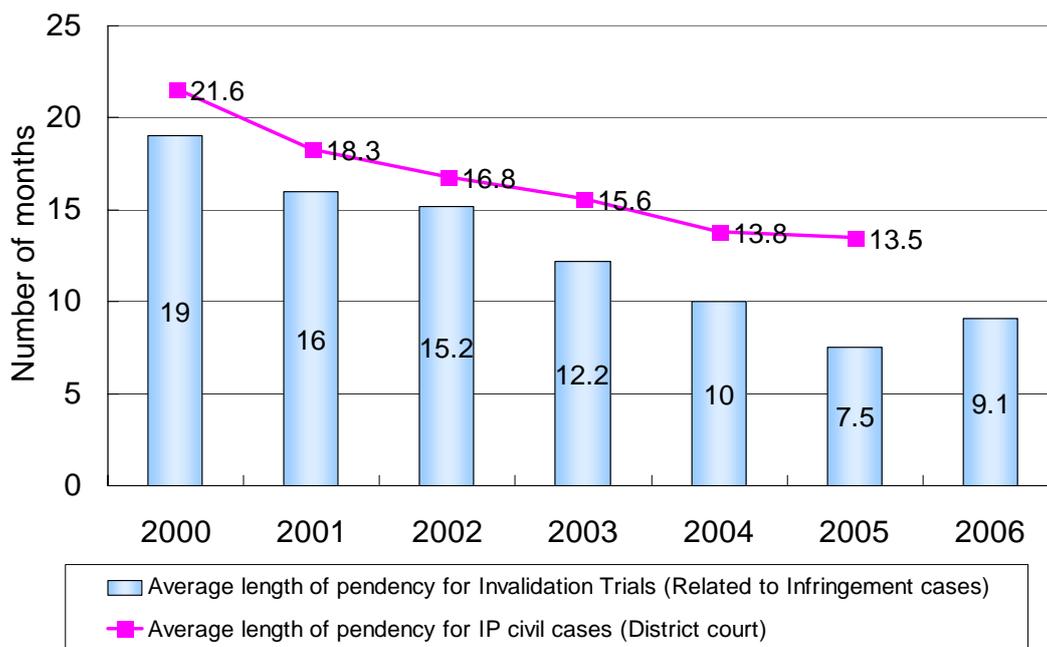
The integration and unification of the opposition system and invalidation trials caused demands for new invalidation trials in 2004 to increase by more than 30% compared to 2003. The increase is seen as stemming from the abolition of the opposition system.

However, this increase (around 100) in the number of new invalidation trials is still a considerable decrease from the number of oppositions in 2003, which stood at around 3,900. In 2006, the number

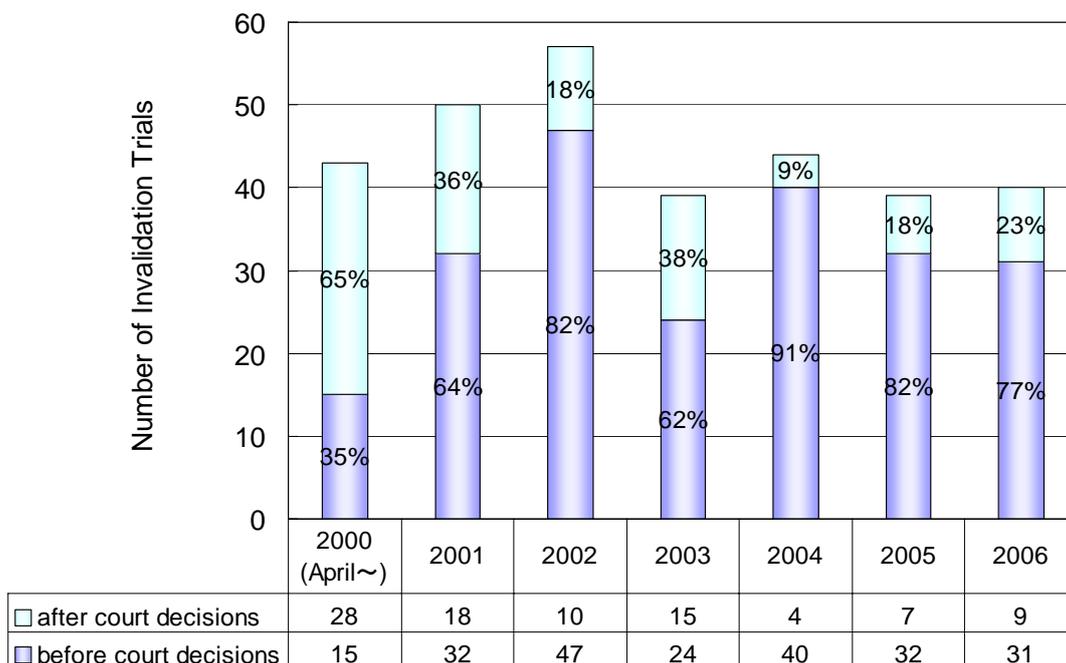
of new invalidation trials decreased to 294, which was similar to the figure in 2003. Especially, the number of demands for invalidation trial in connection with infringement cases has continued to decrease since 2003.

(2) Efforts to achieve timely trial examination (Figs. 3 and 4)

**Fig. 3 Average length of pendency for Invalidation Trials in connection with Infringement**



**Fig. 4 Timing of Board Decision for Invalidation Trial in connection with Infringement**



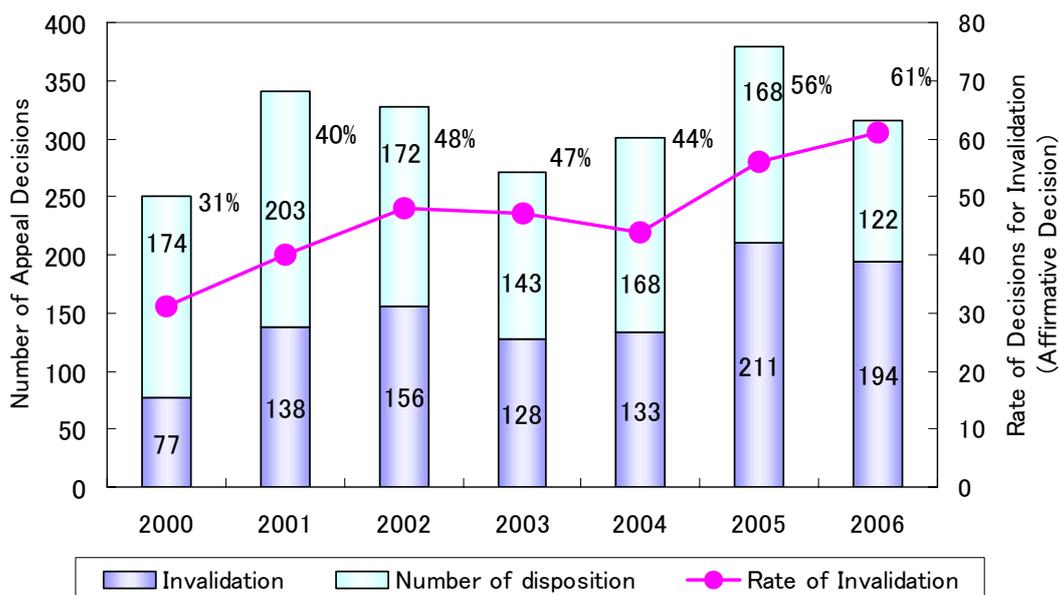
To facilitate early settlement of disputes over rights, the Appeals Department is now placing a high priority on cases of invalidation trial and trial for correction

In 2005, the average pendency (from commencement to disposition) of invalidation trials was 10 months, while for cases in connection with infringement lawsuits it was 7.5 months. Compared to cases in connection with infringement lawsuits in 2002, where pendency was about 15.2 months, average pendency was shortened to almost half of this within a period of just three years. Average

pendency in trials for correction was about 3.7 months in 2005. Consequently, in cases involving the coexistence of infringement lawsuits and invalidation trials, more than 80% of board decisions were issued before district court decisions. In 2005, oral proceedings were actively used in invalidation trials (187 cases) to improve the quality of trial examinations.

(3) Rate of issuance of decisions for invalidation (Fig. 5)

**Fig. 5 Rate of Decisions for Invalidation**



Due to implementation of strict trial procedures and revised examination standards, the percentage of decisions for invalidation has increased dramatically, from 31% in 2000 to 61% in 2006 (Fig. 5).

(4) Rate of decisions reversing invalidation trial decisions (rate of decisions of reversal) by the IP High Court and/or the Tokyo High Court (Fig. 6)

**Fig. 6 The Rate of Reversal of Invalidation Trial decisions**

Fiscal year	2002	2003	2004	2005	*2006	**2007
Overall	39.0% (41/105)	22.6% (28/124)	23.9% (27/113)	22.0% (18/82)	18.3% (19/104)	29.4% (20/68)
JPO's Decision Invalidating patents	20.0% (11/55)	12.2% (10/82)	1.5% (1/65)	8.3% (4/48)	11.5% (9/78)	10.4% (5/48)
JPO's Decision Affirming the validity of patents	60.0% (30/50)	42.9% (18/42)	54.2% (26/48)	41.2% (14/34)	38.5% (10/26)	75.0% (15/20)

( ): number of cases;

\*2006: Rate of Decisions for invalidation by the JPO is 61%

\*\*2007: April-November (8 months), 2007

The rate of reversal of JPO decisions of invalidation of patents and utility models has been decreasing since 2000. Specifically, the rate of reversal of decisions of invalidation fell in 2004 to below 10% and has continued to be about 10%.

On the other hand, the rate of reversal of decisions affirming the validity of patent rights remained in excess of 40% in 2005. In 2007, from April to November, it exceeded 60%.

Before 2000, the rate of reversal of invalidation trial decisions was in excess of 60%, and the JPO was consequently criticized for applying overly lenient criteria in determining inventive step and description requirements.

According to the JPO, the recent decrease in court decisions reversing JPO invalidation trial decisions is a result of the implementation of strict appeal and trial procedures in compliance with the principles of the revised Examination Guidelines issued in 2000. A brief discussion of the background follows.

**a. Decisions Rendered by Tokyo High Court Concerning Inventive Step**

In 1998, the Appeals Department began analyzing court decisions rendered by the Tokyo High Court concerning inventive step. Out of the 56 court decisions issued, a majority consisted of decisions reversing the decision below, and holding that the patent in question was invalid. (Cases reversed by Tokyo High Court). The JPO compiled a brochure in November 1999 showing the results of the analysis, and distributed it to all examiners and appeal examiners for use as an internal reference source. In February 2000, through the Japan Institute of Invention and Innovation (JIII), the brochure was published under the title "Some Points related to Inventive Step which Examiners/Appeal Examiners Should Take into Consideration."

**b. Revision of Examination Guidelines in December 2000**

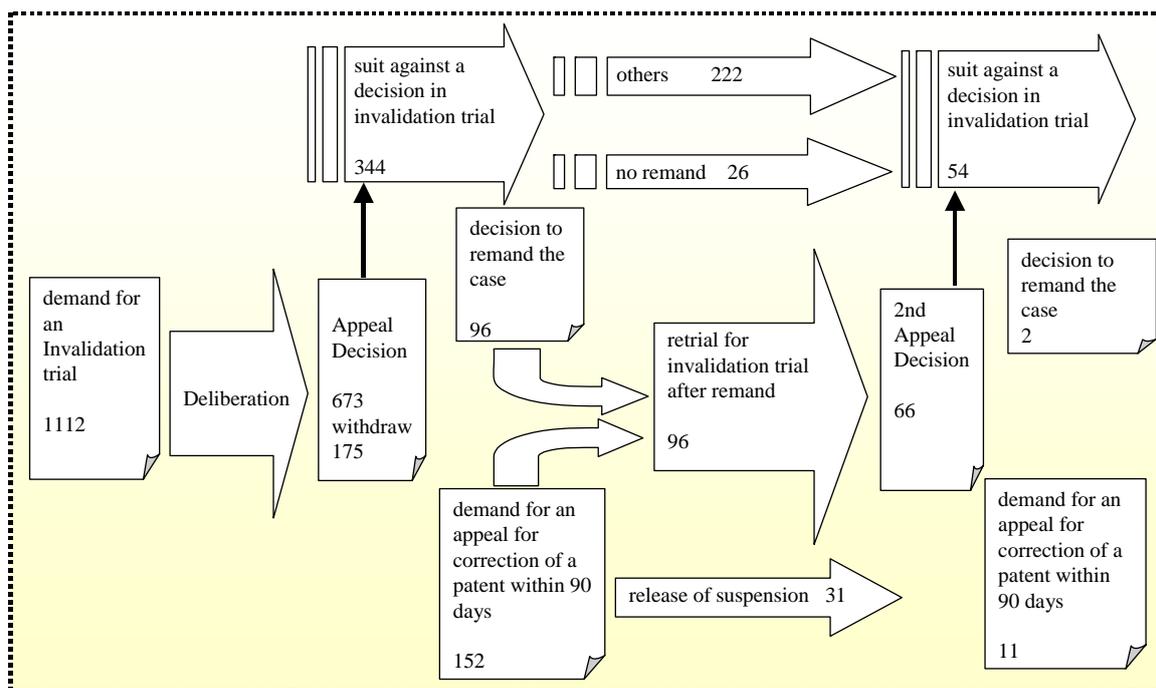
In June 1998, the JPO started to revise the Examination Guidelines in response to users'

criticism, mainly of the application of relatively lenient criteria in determining inventive step and description requirements. During the revision process, the Examination Department and the Appeals Department cooperated closely in exchanging opinions and ideas, and the new Guidelines were issued in December 2000. These new Guidelines introduced the results of the Appeals Department's analysis of court decisions. Application of the principles of the new Guidelines has led to the recent increase in the number and percentage of decisions of rejections by examiners and also to an increase in the rate of decisions for invalidation in invalidation trials. With the year 2000 as the threshold, the standard for judging inventive step seems have become stricter, and decisions rendered by the court and the appeal board of the JPO have become more consistent, with fewer variations or inconsistencies.

Furthermore, the JPO considers valuable the revision of Article 168(3)-(6) under the 2004 amendment of the Patent Law, allowing the Commissioner of the Patent Office to request a court handling infringement litigation to provide him with relevant materials submitted to the court (those related to invalidation defense pursuant to Article 104-3). By gathering evidence under these provisions, as well as instructing parties to complete arguments and cases through oral proceedings, Collegial Bodies have been able to make more precise and well-reasoned decisions, such that they are affirmed by the IP High Court in suits filed against invalidation trials.

**2. The status of invalidation trials and trials for correction between January 1, 2004 and March 30, 2007 (Remand order under Article 181(2) of the Patent Law)**

**Fig. 7 The Status of Invalidation Trials and Trials for Correction between January 2004 and March 2007**



The remand provision under Article 181(2) was established to address the “playing catch phenomenon,” the time consuming and wasteful practice of passing back and forth between the Patent Office and the IP High Court (or previously, the Tokyo High Court) a patent dispute involving the same patent.

During the relevant period, 31 of 152 cases were not remanded, meaning that the court did not automatically allow a request for a remand order. That is, the court considered that correction was not likely to be permitted by the Collegial Bodies. According to the practice of the IP High Court, when a party requests a remand order, the court is required to hear the opinion of the other party. Therefore, the parties’ viewpoints will be factors to be considered.

On June 15, 2006, the JPO announced a change in practice. When an appeal for correction is filed within 90 days from the issuance of a second appeal decision after remand, the Collegial Bodies will not suspend deliberation of the appeal for correction, and will issue a decision as soon as possible. The

change in policy, implemented as of July 6, 2006, is to avoid both lengthy argument of cases in which exhaustive arguments are pursued and the “playing catch phenomenon.”

## B. Ex-parte Appeals

### 1. Appeals against Examiner’s Final Decision of Rejection

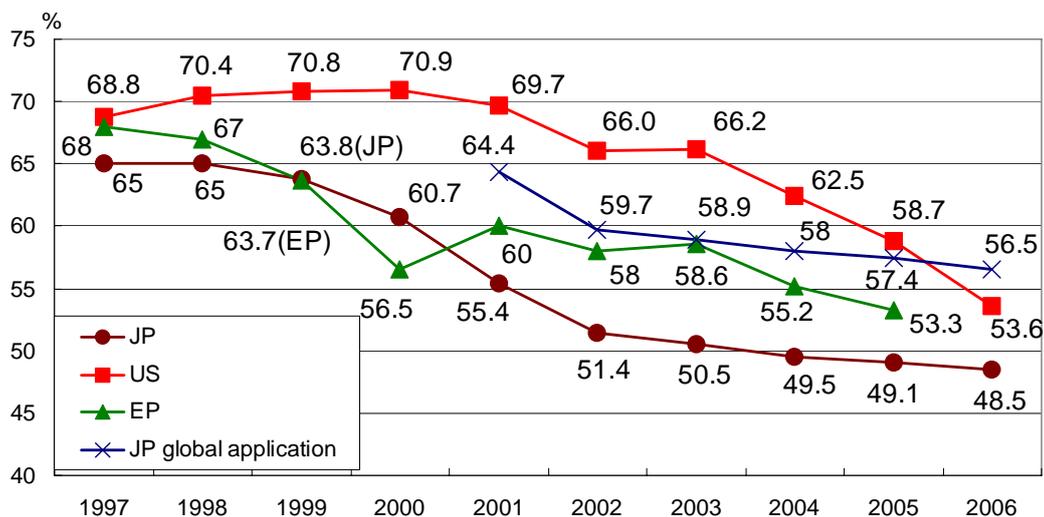
#### (1) Trend in Appeal Denial Rate in Appeals against Examiner’s Final Decision of Rejection

The rate of decisions denying an appeal (appeal denial rate) has increased dramatically—from about 21% in 1997 to about 57% in 2006.

In other words, the success rate of an appeal was 43% in 2006.

In contrast, the rate of patent grant (allowance rate) in examination has decreased from about 65% in 1998 to about 49% in 2006. (Fig. 8)

**Fig. 8 Grant (allowance) Rate**



JPO Annual Report 2007 p96

We can see similar trends in the European Patent Office and the USPTO. The difference between allowance rates among Trilateral Offices has become smaller.

With respect to Japanese global applications (The priority applications, based on which global applications were filed), the allowance rate has been always about 9% higher than that of other applications of the same global applicants. The JPO believes this is because Japanese global applicants conduct thorough searching before filing global applications, taking later high costs such as translation fees and foreign patent attorneys' fees into consideration. In other words, the JPO considers that the magnitude of allowance rate is related mainly to the quality of patent applications to be examined; however, the foregoing trends reflect stricter application of revised rigorous examination standards in 2000.

In this regard, the Trilateral Offices are conducting comparative study of examination practices regarding the description requirements and inventive step /Non-obviousness requirement and will disseminate the study results to applicants and attorneys.<sup>2</sup>

According to the JPO, measures have now been taken to ensure that stricter and more adequate appeal examination and trials take place, based on court

decisions on patentability, such as level of inventive step in decisions of suits against appeal or trial decisions—in other words, in compliance with the principles of the new Guidelines of 2000. (See A 1 (4) above)

Among the different technical fields, the ratio of affirmative decisions issued in the chemical fields is higher than that in others due to the unpredictable effects of a combination of factors. (Fig. 9)

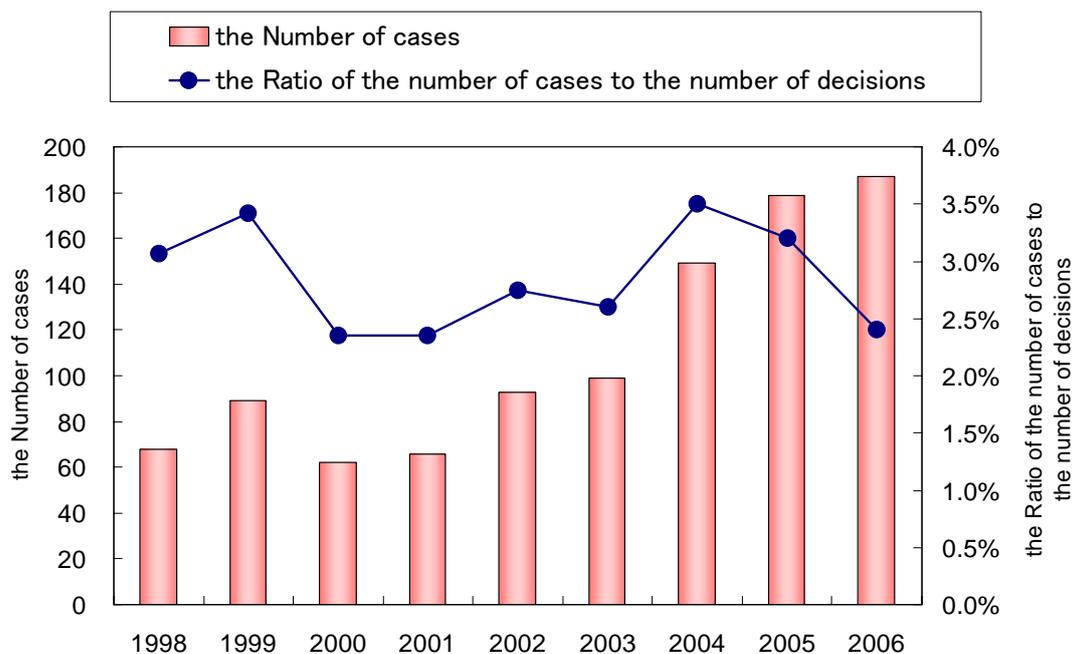
**Fig. 9 Ratio of Affirmative Decisions in Technical Fields (Patent) in 2006**

Technical fields	Ratio of Affirmative Decisions
Physical fields	39.3%
Mechanical fields	44.0%
Chemical fields	51.3%
Electrical fields	39.2%
Mean	43.3%

(exclusion of abandonment)

(2) Trends of lawsuits against appeal decisions (Fig. 10)

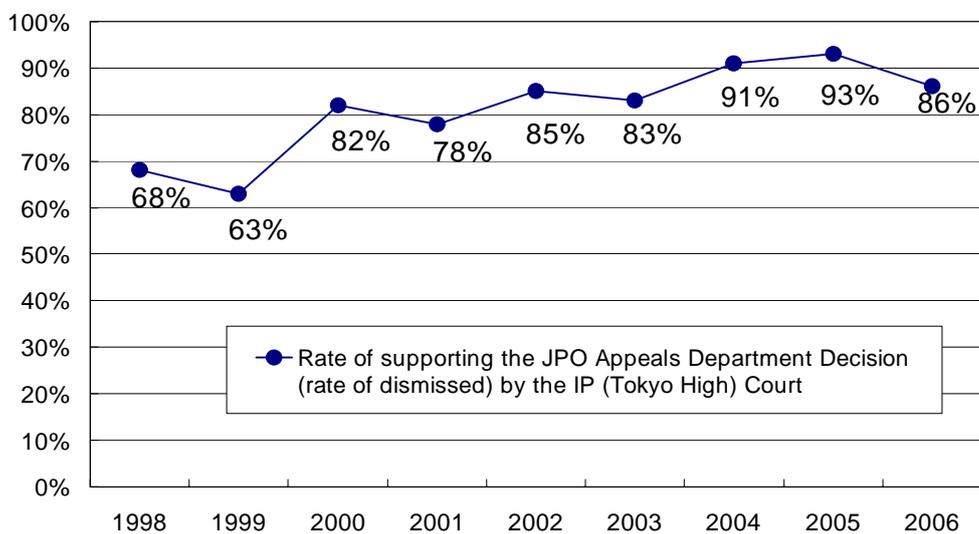
**Fig. 10 Trend of Lawsuits against Appeal Decisions (Ex-parte)**



Although the number of cases brought to the IP High Court (or Tokyo High Court) has been increasing, the percentage of suits filed against appeal decisions has remained relatively stable (2.5-3.5%).

(3) Rate of affirmance of decisions of the JPO Appeals Department by the IP High Court (or Tokyo High Court) (Fig. 11)

**Fig. 11 Court Decisions of Lawsuits against Appeal Decisions (Ex-parte)**

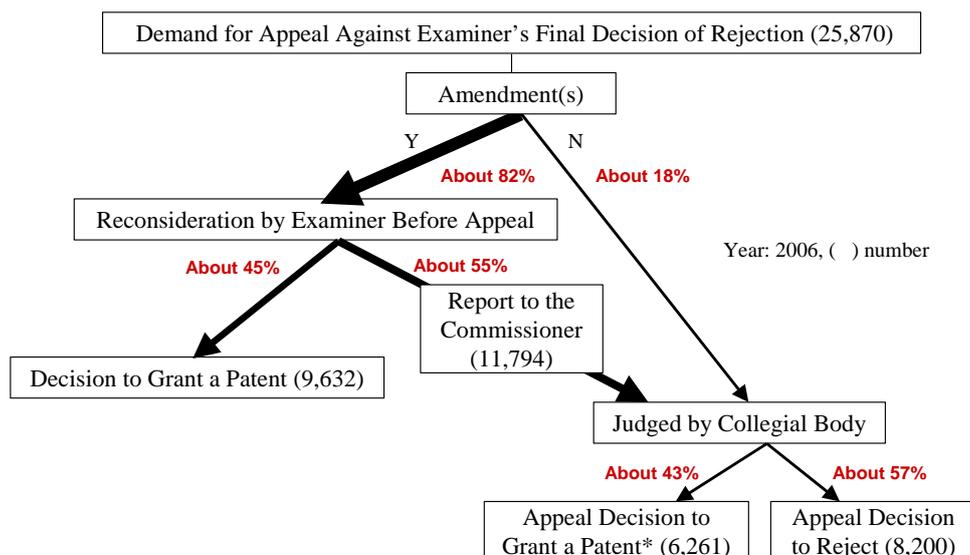


The rate of affirmance of decisions of the JPO Appeals Department has increased from about 63% in 1999 to about 86% in 2006; in other words, the rate of reversal of decisions did not exceed 14% in 2006. Accordingly, the rate of success at the IP High Court

in challenging decisions issued by the JPO Appeals Department is quite low.

(4) Reconsideration by an Examiner before Appeal (Article 162 of the Patent Law) (Fig. 12)

**Fig. 12 Reconsideration by Examiner before Appeal  
(Article 162 of Patent Law)**



\*63%: Collegial body issued a reason for rejection

The JPO announced a policy in 2005 that opportunities would no longer be readily granted to amend claims, a specification or drawings during an appeal against an examiner's final decision of rejection.

According to the announcement, the purpose of the restriction of opportunity for amendment at appeal is to reduce the number of cases that proceed to examination at the Appeals Department.

It cannot be expected that the Appeals Department will issue a notice of a new ground for rejection at the appeal stage; therefore, amendments that can be filed within 30 days from the date of filing a demand for appeal are substantially a last opportunity for amending claims, specification and /or drawings.

On the other hand, the JPO requires an examiner, at the reconsideration stage, where the examiner determines that an application can be placed in a patentable condition by minor amendments or the like, to communicate by telephone or facsimile and so on, with the applicant. According to the JPO, at the reconsideration stage, at least one supervisor or director of the division joins reexamination, in other words, two examiners conduct reexamination.

Looking at the results of reconsideration by an examiner before appeal in 2006, the number of applications for which the original decision was cancelled and a decision to grant a patent was rendered (the percentage of applications patented in reconsideration proceedings) has decreased (45%) as compared to the percentage of reconsideration reports made to the JPO Commissioner (55%).

Since 63% of applications were granted patents after issuance of a reason of rejection by Collegial Bodies in 2005, in order to reduce the burden on applicants and the JPO, the Appeals Department is

making efforts to promote obtaining patents at the stage of reconsideration by an examiner.

In this regard, on November 16, 2006, the JPO announced that as of December 1, 2006 it would indicate claims for which an Examiner does not find reason for rejection in a final decision of rejection. In 2006, the number of demands for an appeal was 25,870.

To reduce the number of demands for an appeal, the JPO is currently considering submitting a draft bill to amend the Patent Law in 2008, in which a term for filing a demand for an appeal is extended from 30 days to 3 months and a deadline for filing an amendment is the same date as that for filing a demand for an appeal. (final decision on whether providing foreign residents with an additional period (one month) is scheduled in later this year)

The purpose of this amendment is to allow enough time for an applicant to consider duly the necessity of filing a demand for an appeal.

*Reference*

1. "Avoid invalidity risks in court", *Managing Intellectual Property*, September 2007, P101-106 <http://www.managingip.com/Article.aspx?ArticleID=1408982>
2. [http://www.trilateral.net/conf\\_sum/](http://www.trilateral.net/conf_sum/)

~~~~~

\*Former Deputy Commissioner of the Japan Patent Office

Patent Attorney, Head of Patent Division, Partner with YUASA and HARA

# Hindsight or Inventiveness? – A Japanese Perspective

By **Jinzo FUJINO\***

Given the fragility of the teaching, suggestion or motivation (TSM) test under the Supreme Court's decision in *KSR Int'l v. Teleflex, Inc.*, there remains much speculation about how the courts and the US PTO will determine obviousness in US. Comparatively, in Japan, a determination of inventive step, a counterpart to non-obviousness requirement in US, has so far been stable. Uncertainties, if any, have been regarded as being less here than in US.

However, such recognition does not necessarily mean that examiners at the Japanese Patent Office are free from the adverse influence of hindsight in determining inventive step. Here is a good example which illustrates the difficulty of distinguishing inventive step from hindsight. In *XEOX S.P.A. v. Commissioner of the Japanese Patent Office*, the Intellectual Property High Court highlighted this issue. In this case, rejection of a patent application was heard before the Appeals Department which upheld the initial decision made by the original examiner. The case was appealed to the IP High Court which vacated the decision of the Appeals Department and remanded the case for re-examination.

## Shoe Sole Structures in Prior Art

The patent application in question (GEOX application) was filed on March 5, 1994 claiming a priority in Italy a year earlier. The GEOX application concerns a shoe sole structure comprising three layers which have waterproofing and permeable characteristics and configurations. The examiner cited four laid-open utility model applications.

Citation #1 discloses a shoe sole structure in which a part of the upper surface of a base layer is provided with a waterproofed cloth. It describes in its embodiment that moisture penetration through the shoe sole makes the inside of the shoe wet and stuffy causing discomfort to the shoe-wearer. Most of such discomfort arises at the points of the sole surface where the foot sole directly fits. Accordingly, a provision of the waterproofed cloth to such fitting points suffices because permeability is assured in areas other than the fitting points.

Citation #2 discloses another shoe sole structure in which a two-layered shoe sole is shown. A rubber-like soft material is attached to a leather-like hard material to form an integrated shoe sole. The area under the big toe is, however, made of a single-layer of soft material, thereby to assure comfortable movement of the big toe. This reference, however, does not provide any description about waterproofing and/or permeable functions. Citation #3 discloses

another type of shoe sole structures in which a sheet of leather is impregnated with acrylic ester monomer. A transparent urethane resin is integrally adhered to the upper surface of the leather to form a thin base layer. Then, a fiber-reinforced thermoplastic sheet is partially and adhesively provided to parts of the upper surface of the base layer. This structure assures flexibility, durability, waterproof and endurance of the shoe sole. According to this structure, waterproofing is assured while keeping permeability due to inclusion of leather in the base layer. Citation #4 discloses a simple shoe sole structure in which leather and a synthetic resin are polymerized for use as a sole material. No description is made with regard to waterproof and permeability.

The Examiner rejected the GEOX application over Citation #1 in view of Citations #2, #3 and #4.

## View of IP High Court

The IP High Court first analyzed the disclosure of the Citations #2 through #4 first. Citation #2 discloses, accordingly to the court, a general combination of plane rubber material and a leather material. No description is made to teach or suggest the provision of the shoe sole with waterproofing and permeable characteristics. It does not contain an idea of providing a porous layer with a base layer for permeability.

Citation #3, the court agreed, describes a waterproofing effect in an improved fashion. Such improvement is due to the lamination of a transparent urethane resin to the surface of the base layer. However, no reference is made to loss of permeability which is caused by the laminated urethane resin. Again, as the court stated, there is no description made with regard to an idea of providing a waterproofed cloth having porosities to maintain permeability. Likewise, Citation #4 makes no reference to a waterproofed layer having porosities to maintain permeability.

The court put more weight on Citation #1. This prior art includes a description regarding the solution of discomfort caused by stuffy air inside shoes, which was one of the objects of the GEOX application. While acknowledging the specific structures and layers therein, the court clarified that this prior art neither "describes nor suggests" any idea to coat the waterproofed cloth with an over-layer with porosities for the purpose of removing discomfort of stuffy air in the shoe.

The defendant (JPO) argued that the idea of maintain a waterproofing effect by coating with the waterproof cloth is apparent from the cited reference and that it would be a common sense for those who

skilled in the art to conceive that coating the non-waterproofed surface of the base layer with a synthetic resin would improve a waterproofing effect. In the GEOX application, the non-waterproofed surface is around the base layer, i.e., the peripheral portion of the base layer. Engineers with ordinary skill in the art could easily arrive at a solution by coating the peripheral portion with a synthetic resin.

This JPO's rationale was not persuasive. The court stated: "[T]here are no descriptions or suggestions in the Citations with respect to the provision of the waterproofed material to improve waterproof effects." Having thus stated, the court continued: "[Defendant's] arguments are groundless since their rationale on the distinctive parts of this application stands on hindsight." (underline added)

### IP Court Follows the TSM Test

It is not surprising that the IP High Court appears to follow an approach similar to that in the TSM test in determining inventive step. The court was established in 2005, modelling itself on the Court of Appeals for the Federal Circuit in US.

This decision is one of the many decisions on inventive step delivered by the IP High Court, and thus cannot be generalized as a precedent. However, the case is interesting when the arguments raised by the court are contrasted with the *KSR v. Teleflex* decision in US wherein the Supreme Court weighs common sense of the skilled partisan holding down the rigid application of the TSM test.

~~~~~  
\*Editor, *WINDS from Japan*  
Professor, Tokyo University of Science, Graduate School of Intellectual Property Studies

---

## IP News from Japan

**By Shoichi Okuyama\***

### **Changes coming for patents and trademarks in Japan**

The Japanese cabinet approved a bill on February 1, 2008, and it is now before the Diet. The bill contains five major elements: (1) reform of the registration scheme for exclusive and non-exclusive patent licenses, (2) extension of the term for filing an appeal, after a negative examination decision is issued by a JPO examiner, from the current 30 days to 3 months, (3) *reduction* in official fees for patents and trademarks, (4) acceptance of priority documents issued by a country or international organization (e.g., WIPO) other than the country of first filing, and (5) payment of official fees directly from bank accounts.

(1) It will become possible to record exclusive licenses and non-exclusive licenses at the Japan Patent Office even before a patent application matures into a patent. Currently, it is only possible to register licenses after grant. Also, the public will have limited access to records at the JPO for registered non-exclusive licenses. Currently, all details, such as the identity of licensees, durations, and royalty rates provided at the time of registration are made public. This patent law amendment is coupled with the establishment this year of a new scheme for registering general non-exclusive licenses that do not specify patents by their numbers.

(2) The term for filing an appeal will be increased to 3 months to streamline the currently complicated

system in view of general changes that are being made to all administrative procedures.

(3) Reduction in fees will be particularly significant for trademark owners. The fee of ¥66,000 for one class required at the time of registration will be reduced to ¥37,600, and that of ¥151,000, payable at the time of renewal, will be reduced to less than one-third (¥48,500). Patent annuities and other fees will also be reduced by about 12% on average, because the JPO has been running in the black.

(4) and (5) These statutory and procedural changes do not affect foreign applicants directly. It should be noted that priority documents are already exchanged electronically among the EPO, USPTO and JPO, as well as with the Korean IP Office, without applicants taking any actions, but the automatic exchange of priority documents will be expanded in the near future to many other offices through the WIPO.

The bill is expected to pass Diet and become law before the end of the current session in June. The fee reduction is expected to take effect shortly after the passage of the bill.

### **Mr. Takagi runs for the head of WIPO**

On February 5, 2008, the Japan Patent Office announced that Mr. Yoshiyuki Takagi, who started his career as a Japanese patent examiner with an engineering degree, and who is a fifteen-year veteran at the World Intellectual Property Organization,

would run for the office of the Director General of WIPO in the election set for May 13 and 14, 2008. The current DG, Mr. Kamil Idris, is stepping down a year earlier than his full term due to criticisms relating to the misrepresentation of his age. It is expected that many candidates will stand for election.

### **Saga of employee inventors goes on**

On December 7, 2007, Toshiba was sued for an equivalent of US\$2.4 million by Prof. Shinya Amano, 59, who developed at Toshiba a basic AI technology for conversion of *kana* (Japanese phonetic characters) to *kanji* (Japanese characters based on Chinese) between 1974 and 1978. Prof. Amano is claiming compensation for his inventions as stipulated in Article 35 (employees' inventions) of the Japanese patent law. According to Prof. Amano, Toshiba, as well as other Japanese companies and Microsoft, was able to succeed in the Japanese word processor business thanks to his two inventions, which are still used in almost all Japanese word processing software. Prof. Amano calculates his claim for an award based on Toshiba's profits in 1996 and 1997, for which the statute of limitations does not apply. For these two years, he received a sum of about US\$2,100 from Toshiba. Also, he waited until 2007, after his

retirement from Toshiba in 2004, because of a three-year secrecy obligation with Toshiba.

The number of pending employee invention cases has declined considerably, and with guidelines that have emerged from case law, more cases have recently ended with settlements.

### **Patent Prosecution Highway is now established**

The Japan Patent Office announced in December 2007 that the Patent Prosecution Highway would complete its pilot project phase with the U.S. Patent and Trademark Office and go into full operation on January 4, 2008. Since July 2006, more than 370 cases have been prosecuted under this project. The JPO is currently running a pilot project with the Korean and UK IP Offices. The German Patent and Trademark Office will join the pilot project in March 2008. Reportedly, the USPTO and UKIPO are also considering starting a pilot project.

~~~~~

*\* Editor, WINDS from Japan  
Patent Attorney, Ph.D., Okuyama & Co.*

## **Editors' Note**

We trust that the articles included in this issue of Winds from Japan will prove useful in providing up-to-date information on the captioned matter. We recommend that you refer to the article "Recent Status and Problems of Patent Appeals and Trials" when determining your patent strategy in Japan. An analysis of an inventive step of an invention in view of the Supreme Court's decision in the KSR case will also be useful in understanding the difference between the Japanese and the U. S. patent practices. We are also including articles providing up-dates on IP activities in Japan.

If you are interested in reading back issues of our newsletter, please access the following web site;

<http://www.lesj.org>

(KO)

### **WINDS from Japan Editorial Board Members, 2008**

Editor in Chief:

**Kazuaki Okimoto**

Editors:

**Jinzo Fujino; Shoichi Okuyama;  
Yuzuru Hayashi; Toshihiko Kanayama;  
Akira Mifune; Junichi Yamazaki;  
Kei Konishi; Robert Hollingshead;  
Naoki Yoshida; Mitsuo Kariya**

Editorial Staff:

**Akira Fukuda**