

Sample Answer to Problem 1

5 (2) Lawfulness of the procedure

As shown in (1)(iii) above, the examiner's decision of refusal dated July 8, 2011 in the present application indicates that the inventions according to claims 1-18, 21-26 and 29-33 are not patentable. A reason for refusal is not given for the invention according to claim 19.

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As shown in (1)(iv), the amendment according to the written amendment dated November 14, 2011, hereinafter "the present amendment", was made to overcome the reasons of refusal in the above decision of refusal. The examiner determined that, as claimed in the written request for trial by the plaintiff, claim 1 after the present amendment, hereinafter "new claim 1", is the one rewritten as an independent claim based on claim 19 before the present amendment, hereinafter "old claim 19", by specifically describing the parts recited in old claim 19. The examiner also determined that in the present application, old claim 1 has been deleted and new claim 1 was created from old claim 19. Therefore, as seen from the view point of the amendment to old claim 1, the amendment has a purpose of deletion of old claim 1 which is not aimed to restriction of the scope of patent claim. Dismissal of the present amendment is not permissible for the reason of violation of requirement of independent patentability, as mentioned above.

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Furthermore, since the contents of old claim 19 are the same as those of new claim 1, as seen from the view point of the amendment to old claim 19, the present amendment did not restrict the scope of the claim. The trial court decided that, in substance, new claim 1 is refused by dismissing the amendment because of violation of the requirement of independent patentability. In this aspect, the trial court erred.

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Although the point of the above argument of the defendant is not fully clear to us, if the point is that, when promptness in examination or trial procedure is required, even a process lacking procedural appropriateness

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may be tolerated, such an argument may not be acceptable at all from the view point of security of due process in an administrative decision. Furthermore, in the present trial case, as explained in (2) above, dismissal of the amendment in the present case apparently lacks appropriateness of procedure and the defendant's argument is not acceptable.

Sample Answer to Problem 2

(2) According to Article 35 (4) of the Japanese Patent Act, employers or the like are allowed to determine a value for assignment of a right to obtain patent or the like regarding an employee's invention from an employee or the like based on applicable office regulations. Under the same article, if the determination is not unreasonable, payment of the value determined by the employer or the like is sufficient for the assignment of the right. In this context, whether or not the determination is unreasonable must be determined by considering

- (a) circumstances around discussion made between employees or the like and the employers or the like on establishing standards for determining the value,
- (b) circumstances around disclosure of the standards,
- (c) circumstances around hearing of opinions of employees or the like on calculation of amount of the value,
- (d) the other conditions.

In view of this, if the steps (a)-(c) above do not exist, payment of the value according to the office regulations or the like should be determined to lack reasonableness, as long as any special condition does not exist such as preparation of steps for protecting the interest of employees or the like. In that case, the amount of the value calculated according to the determination can compensate for a defect in the steps or the like.