
INTRODUCTION OF ARTICLES

Thoughts on Effectiveness of Method Inventions in the Biotechnology and Medical Fields

The Third Subcommittee,
The Second Patent Committee

With regard to the granting of patent rights and the scope of enforcement for method (process) inventions in the biomedical field, which typically are related to genetic information and screening methods, there presently are some ambiguities in its practical operation and interpretation. These ambiguities are the result of the change in the circumstantial reality that, while current inventions are technologies that deal with tangible things, the above inventions include, not only those dealing with tangible things, but also those dealing with information. The author believes that this change must be adequately recognized in the future.

Accordingly, the granting of rights and the scope of enforcement for method inventions in the biomedical field are discussed from the point of view what criteria may be used in assessing information, and whether it is reasonable to provide protection for it in actual society. More specifically, inventions comprising new uses of chemical substances, medical treatment/diagnosis method inventions and screening method inventions are discussed in comparison with inventions of manufacturing methods of tangible things.

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Study of Court Decisions Regarding Prior User's Right — From the Walking Beam Furnace Case to recent decisions —

The First Subcommittee,
The Second Patent Committee

Prior user's right is an important statutory non-exclusive license as a means to defend a user from being accused of infringement by a patent right holder, but the statutory interpretation thereof is not yet summarized for those decisions made after the Walking Beam Furnace Case which is a landmark decision relevant to the prior user's right, thus the current direction of such decisions has not been well understood.

In this paper, recent major decisions are discussed in terms of “completion of an invention”, “commercial working of the invention or the preparation therefor”, “modification of working mode/scope”, and “succession of the prior user's right” as the requirements of the prior user's right, and the paper also summarizes the current statutory interpretation of the right.

As a result of the study, it has become evident that, as the current trend, the prior user's rights are found in a good percentage of the recent trials, and determination on "commercial preparation" is flexibly made, and with regard to the "modification of working mode/scope", the prior user's right was found to be granted for a working mode modified within "an extent in which the identity is kept", "an extent of the same technical idea", and "an extent in which the identity with more specific concept is kept".

This paper also considers judgments made by courts on evidence for proof of the prior user's rights referred in these decisions, and points out the importance of providing three types of materials that are "drawings", "slips or checks etc." and "an actual article" as the evidence for proof of the prior user's right, and discusses the manner of preparation and preservation of relevant documents and other materials necessary for claiming the prior user's right, which is the matter patent practitioners now have to keep in mind.

Furthermore, the paper also includes the result of a survey conducted over a number of enterprises in effort to see whether they would claim their prior user's right in their negotiations or lawsuits, how they would prepare and preserve their evidence and so forth, and summarizes matters to be noted in preserving the evidence under the potential intention to use the evidence in an argument based on the prior user's right or a claim therefor.

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Exploiting Intellectual Property Through Company Management — New method of managing IP by stressing knowledge management —

The First Subcommittee,
Intellectual Property Management Committee

With the advancement from an information-oriented society to a knowledge society, the environment for business operations is drastically changing. In recent years, various new business methods have been proposed and employed to adapt to the knowledge society, and they have demonstrated their effectiveness. But what allows businesses to continue to exist and develop is, ultimately, the exploitation of knowledge. From this viewpoint, any business method may be seen as a tool for exploiting this knowledge. Since intellectual properties comprise one part of the important knowledge that companies possess, the way of thinking of these new business methods should of course be applied also to the exploitation of those intellectual properties.

Among a wide variety of business methods, this article selects for discussion "knowledge management" as a process method for exploiting intellectual properties in businesses and "EVA, MVA" as a means for assessing the degree of contribution of intellectual properties in businesses. It first summarizes what they are, and then explains the visions of companies and the position their intellectual property strategies occupy in relation to these visions. It presents four representative examples of intellectual property strategies, and for each of the examples, discusses specific cases of intellectual property management that implement the knowledge management method, and methods for assessing degree of contribution that uses EVA and MVA. In conclusion, the article proposes the following three suggestions: (1) provide an explicit vision of a company with regard to the exploitation of its knowledge, and develop an intellectual property strategy based on that vision; (2) introduce the knowledge management method in implementing the intellectual property strategy and so reorganize the company's intellectual property