
INTRODUCTION OF ARTICLES

The Scope of “Information” as a New Subject Matter under Japanese Patent Law

The Second Subcommittee,
The First Patent Committee

“Law Amending Parts of Patent Law” submitted to the Diet on February 21, 2002, enacted in April and become effective in September of the same year, stipulates that “product” as set forth in Patent Law includes software programs. “Programs” as used here mean a software program and “other information used for process by computer and similar to programs.”

In fact, the current examination manual does not stipulate what “information” “similar to programs” is.

This article reviews how information is actually protected under Patent Law, and identifies and examines the gray-zone cases of “information having specific function” or “data having data structure.”

As a result of the examination, we found several problems including “obscure border between programs and information,” “unsatisfactory protection to data structure” and “imbalance in protection of object and information.”

This article further calls for revision of examination manual in respect of the following points as specific recommendations to enhance protection of “information:”

- 1) to allow applicant to claim “data structure” as “product”;
- 2) to clarify application of “definitions of programs”; and
- 3) to provide the same protection as given to “object” to three-dimensional protein structure to which unique information identified as technical concept is added.

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Relationship of Recycled Products and Patent Rights

The Fifth Subcommittee,
The Second Patent Committee

Recycling movement has actively been promoted in recent years under which reusable parts of disused article and wastes are processed for reuse in light of protection of environment. While it is widely known that anyone who bought patented products from patentee or any authorized party can freely use the products in principle because of exhaustion of the patent rights, it is not

known if bringing a recycled product using the reusable parts of once-exhausted patented products to the market again will be subject to any restriction from the patent rights.

This article reviews Japanese and U.S. court decisions relating to recycling system to examine the relationship of recycled products and patented rights where patented products are recycled. Each decisions are examined from two viewpoints: narrow construction of exhaustion doctrine focusing on the recycled products itself (examination based on subject matter); and construction reflecting proprietor's intention (examination based both on subject matter and subjective factor). Logical structure of grounds for finding or not finding infringement is also examined.

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"Completeness" of Gene-Related Inventions

The First Subcommittee,
Biotechnology Committee

Heretofore, it has been considered that in order to complete an invention on a chemical substance, the chemical substance has to be actually produced and that the utility has to be proved. In contrast, a gene-related substance have closer relationship between the structure and the function than a generally known low molecular weight substance. In addition, according to the recent development of biotechnology, the coding region of a protein can be predicted by the genome sequence. Accordingly, once that the genome sequence has been determined, one with ordinary skill in the art could identify the substance encoded by the gene sequence and anticipate the function and utility from the homology of known protein sequences without actually producing the substance, finding its functions and showing the utility based on the functions. Under these backgrounds, the First Subcommittee of Biotechnology Committee has studied the completeness of invention on the gene-related substance in the light of recently rendered two actions of annulment of the trial decision in Japan: "Brain Natriuretic Peptide case (BNP case)" and "T-cell Antigen Receptor Polypeptide- β case (TCR- β case)." In addition, we have tried to provide the criteria for how to decide if the gene-related invention is incomplete or lacking in a requirement of enablement.

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