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## Contents & Abstracts

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### ■ Can AI be an Inventor? Issues over Statutory Interpretation and Legislation ..... 6

*NAKAYAMA Ichiro*

As Artificial Intelligence (below referred to as “AI”) continues to advance at a rapid pace, it is becoming increasingly possible to generate products that are indistinguishable from those created by natural persons, in large quantities and with minimal effort. Accordingly, the premise of the patent law that only natural persons can create inventions is gradually being challenged. Actually, patent applications have been filed in Japan and other countries, naming AI as the “inventor”. These applications have been rejected in numerous countries, with judicial decisions having been handed down in some, including Japan, the United Kingdom, the United States, and Australia. As a matter of interpretation of patent law, the judicial decisions in these countries are similar: only natural persons, not AI, can be inventors. The Tokyo District Court Judgment (Gyo-u) No. 5001 of May 16, 2024, is no exception, and this paper will analyze judicial decisions in Japan and various other countries.

On the other hand, the abovementioned Tokyo District Court Judgment sets forth expectations for legislation from the perspective of industrial policy. To this end, this paper also discusses the appropriateness of an industrial policy to protect allegedly “autonomous” AI products. The role of industrial policy is to deal with market failure, and as regards patent law, patent protection is necessary to prevent an underproduction of inventions (market failure). Here, the concern of underproduction of inventions is based on the premise that they are scarce goods. However, allegedly “autonomous” AI products can hardly be considered scarce. If there is no concern about underproduction (market failure) of such AI products, there is little need for patent protection. That being said, this does not necessarily mean that incentives for AI-related inventions are not needed at all, or that there are no issues to be resolved under current law.

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## ■ Support Requirements and Enablement Requirements

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*BEKKI Kazuo*

The support requirements described in the Scope of Claims of the Invention and the enablement requirement for the Detailed Description of the Invention in the Descriptions are both established to prevent patent rights being granted to inventions that have not been fully disclosed, and in both cases, they require that the invention described in the Scope of Claims be substantially disclosed in the Detailed Description of the Invention. Therefore, in terms of eliminating Claims that are overly broad, these two requirements are effectively just two sides of the same coin, but they still exist as different description requirements, and the distinction between the two should be interrogated.

Since Grand Panel judgement of the Intellectual Property High Court in the “Parameter Case,” the support requirement is focused on the “Problems” in the Scope of Claims of the Invention, while the enablement requirement is focused on the “Works” defined within the text, requiring substantiality of the disclosure.

In this paper, I will explore the significance of the support requirement “Problems” and the enablement requirement “Works,” while considering the relation with the “Problems” loosely required for disclosure by the Ministerial Ordinance on the detailed description of inventions. Based on this, I will clarify the distinction between these two requirements, where, with regard to the “Works,” or particularly “Uses” in the enablement requirements, it is sufficient that the “Uses” solve some technical “Problem,” and does not necessarily solve the “Problems” in the support requirements.

Further, if there is an “Effect” stated in the Claims, which could be considered the opposite of the “Problems,” the invention in the Scope of Claims of the Invention will always be interpreted as being limited to solving the “Problems,” and as a result there is a concern that neither the support requirement nor the enablement requirement will serve to play their role in excluding overly broad claims. Therefore, based on recent court decisions, I will focus on the relationship between the “Effect” in Claims and other components of the Claims, and, based on the above analysis, will present a proposal for a descriptive requirement for adding “Effect” as a result to be achieved to a Claim.

## ■ A Study on the Relationship between Industrial Property Law and Administrative Law ..... 59

*TANAKA Yoshihiro*

Industrial property law grants rights to creators and business operators to implement and use inventions, ideas, designs, and trademarks, and has provisions related to civil claims for injunctions or damages. Therefore, industrial property law is, in its nature, very much like civil law (property law). On the other hand, these legal mechanisms were established as a legal approach to achieve the policy objective of industrial development, and, in this sense, industrial property law also has the nature of administrative laws and regulations in that it defines formal state activities conducted for the aim of realizing national objectives. The legal mechanisms of administrative laws and regulations have been built under the influence of other administrative laws and regulations of the same legal domain, and, through an accumulation of academic theories and precedents, legal interpretative theories specific to this legal domain have been formed. Legal domains with such characteristics are useful in examining the arguing points of the general theory of administrative law. Further, special

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relationships may arise between administrative laws and regulations of different legal domains, and, recently, a need for an analysis of administrative laws and regulations focusing on such relationships has been pointed out.

To demonstrate that the arguments in administrative jurisprudence relating to the above legal domains (the domains of various administrative law theories) are valid for industrial property law, this paper summarizes and analyzes the Patent Law, the Utility Model Law, the Design Law, and the Trademark Law, which constitute the industrial property law, from the perspective of administrative laws, while comparing them with the Copyright Law, which has a different legal purpose of cultural development but adopts the same legal mechanism of granting rights for creative works. In addition, as regards “ensuring the effectiveness of administration”, which is a major arguing point in the general theory of administrative law, this paper points out that, in order to solve the dysfunction of administrative penalties and to deter illegal acts by the intimidating power of penalties, it is necessary to consider the requirements for constituting a crime while focusing on the applicability of individual administrative penalty provisions based on criminal practice, not the legal domain to which the administrative law or regulation in question belongs.

## ■ IP Dispute Resolution in the Age of the Data Economy

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*HATANAKA Asako*

In Europe, legislator continues to grant more progressive role for mediation under EU law, including mandatory mediation for FRAND-related disputes. Although judgments and settlement agreements are per se only binding on the parties directly involved, the impact they give upon third parties both inside and outside of the jurisdiction is not insignificant due to the inherent non-territorial nature of intellectual property. In the age of data economy, a friction between legislative interpretation and private autonomy, as well as between the openness of judgements and the confidentiality of agreements in intellectual property disputes becomes apparent.

This paper examines the past proposals and case law related to mandatory mediation in the UK and EU, in order to examine the potential utility of mandatory mediation for intellectual property disputes. In the UK, explicit compulsory procedures for intellectual property disputes through arbitration and mediation have been repeatedly proposed by legislator, alongside with some specific areas of civil disputes. In parallel, the UK muddled through the turmoil of cases relevant to the judge’s implicit power to order ADR, until the government announced in 2022 that it would introduce mandatory mediation for small claims in civil litigation. In the EU, mandatory mediation is justified under positive law to the extent that it does not hinder the exercise of the right to access the judicial system, and the case law at the European Court of Human Rights and the Court of Justice of the European Union has settled the conditions upon which it can be undertaken. The former requires that the compulsory procedure is undertaken in the absence of constraints and examined the tension between judicial economy and the adverse effect of friendly settlement, while the latter has presented specific requirements for compulsory ADR in the context of consumer disputes. The four requirements set out in the Alassini case are of particular significance that the outcome of mandatory procedure is not binding, that the procedure does not substantially delay the action to court, that the period of prescription is suspended, and that the cost of mandatory mechanism is free of charge or insignificant. However, whether or not the above-mentioned norms apply to the mandatory mediation for intellectual property dispute resolution which is under discussion in the EU as sufficient justification and requirements needs a careful review.

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■ **Disposal of Inventory by a Trademark Licensee After License Termination and Trademark Function Theory** ..... 83

*SUZUKI Takafumi*

This paper examines a court case in which the issue was the “disposal of inventory after termination of a contract by a party having been granted a license to use a trademark”. In said court case, it was disputed whether the sale of goods in stock (legally manufactured by the party of the contract within the scope of the license) after the termination of the trademark license contract constitutes a trademark infringement or not. Regarding this point, the Intellectual Property High Court formally recognized the existence of a trademark infringement, based on (1) the fact that a trademark license contract loses its effect after the termination of the contract and (2) the fact that the case is distinguished from previous court cases on trademark function theory.

However, this decision is problematic with respect to the following. To begin with, (1) the fact per se that the trademark license contract lost its effect does not constitute a sufficient basis for the recognition of a trademark infringement. Next, (2) the differences between the previous court cases on parallel imports and this case (existence/non-existence of international element, existence/non-existence of involvement as a party of a contract) do not obstruct the application of the existing judgment framework related to trademark function theory. Accordingly, rather than formally recognizing the existence of the trademark infringement, the court should, for this decision, have substantially examined whether the function of the trademark is impaired or not, based on precedents and theoretic discussions developed so far.

Reevaluating this decision from such perspective, the following was found. To justify the conclusion of this decision, it is necessary to replace the first criterion of the Fred Perry case, which stated that it is sufficient that “the trademark was legally applied”, with “the goods bearing the trademark were legally placed in distribution”. Meanwhile, prior to this decision, there were no cases in which the conclusion was influenced by whether or not the goods were “legally placed in distribution”. Accordingly, this decision can be positioned as a case in which the trademark function theory was applied based on a new standard of judgment (although it is not clear from the judgment paper).

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