Decided on	August 26, 2008	Court	Intellectual Property High Court, Third Division
Case number	2008 (Gyo-Ke) 10001		
- A case in which, in respect to the invention of a method of searching for English words from a dictionary only by pronunciation without knowledge of their spelling, a trial decision against granting a patent based on the reasoning that the invention neither represented the creation of a technical idea utilizing the laws of nature nor could be categorized as invention defined in Article 2, paragraph (1) of the Patent Act, and in accordance with the introductory clause for Article 29, paragraph (1) of the Patent Act, was cancelled			

Reference: Article 2, paragraph (1) and Article 29, paragraph (1) of the Patent Act

In a trial against an examiner's decision of refusal for a patent application for the invention of a method of searching English words in a dictionary by pronunciation without the knowledge of their spelling, a request for the reversal of the decision was denied on the grounds that the invention (hereinafter “the Invention”) neither represented a technical idea utilizing the laws of nature nor could be categorized as invention defined in Article 2, paragraph (1) of the Patent Act and that a patent could not therefore be granted to the Invention in accordance with the introductory clause for Article 29, paragraph (1) of the Patent Act. The court cancelled the trial decision based on the judgment that the Invention could be deemed as utilizing the laws of nature.

Concerning the criteria for judging whether the Invention could be categorized as invention defined in Article 2, paragraph (1) of the Patent Act, the court expressed the following views:

“Even if the process of creating a technical idea aimed at solving a specific problem contained mental activities, decision making or behavior of human beings or was closely related to the mental activities of human beings etc., this alone should not be grounds for denying the categorization of the relevant invention as an “invention” defined in Article 2, paragraph (1) of the Patent Act. If a discussion of the overall description of the scope of the patent application and consideration of the descriptions in patent specifications etc. suggest that the creation of a technical idea utilizing the laws of nature could be considered a means necessary to solve a specific problem, it should be categorized as an ‘invention’ defined in the aforementioned paragraph.”

Concerning the judgment that the Invention could be categorized as an invention defined in Article 2, paragraph (1) of the Patent Act, the court expressed its reasoning as follows:

“By focusing on the fact that human beings (including those who are assumed to use the dictionary concerning the Invention) excel in sound recognition, especially distinction of consonants, more than in many other abilities they inherently possess, the Invention is designed to use the inherent ability of distinguishing consonants to offer a method of repeatedly and continuously achieving certain effects in finding the meaning of English words in a dictionary even without an accurate knowledge of their spelling. This can be deemed as an example where the creation of a technical idea utilizing the laws of nature serves as a major means of solving a specific problem. Therefore, it is concluded that the Invention can be categorized as an ‘invention’ defined in Article 2, paragraph (1) of the Patent Act.”