

Date	September 29, 2016	Court	Intellectual Property High Court, First Division
Case number	2015 (Gyo-Ke) 10184		
– A case in which the court examined a so-called product-by-process claim.			

References: Article 36, paragraph (6), item (ii) of the Patent Act

Numbers of related rights, etc.: Patent No. 4968605

Summary of the Judgment

In the judgment of the Second Petty Bench of the Supreme Court of June 5, 2015, (2012 (Ju) 1204; the "PBP Supreme Court Judgment"), the court held that, if a claim of a patent for an invention of a product states the manufacturing process of the product, the statement of the claim would be considered to satisfy the clarity requirement specified in Article 36, paragraph (6), item (ii) of the Patent Act only if there are reasons that make it impossible or impractical to directly identify the product based on its structure or property as of the time of the filing of the application (the "reasons that make direct identification of the product impossible or impractical").

In this way, it can be interpreted that, in PBP Supreme Court Judgment, the court found it necessary for the applicant to provide an allegation about and proof for the existence of the reasons that make direct identification of the product impossible or impractical by holding that, in the case of an invention of a product, if a claim states the manufacturing process of the product, it would be unclear what structure or property of the product the statement of the manufacturing process describes and that, due to such lack of clarity, the readers of the claims, etc. would be unable to clearly understand the details of the invention.

Therefore, even when the manufacturing process of a product is stated in a claim, if the statement of the manufacturing process clearly describes the structure or property of the product, the readers of the claims would be able to clearly understand the details of the invention. Under such special circumstances, it is reasonable to interpret that no allegation about or proof for the existence of the reasons that make direct identification of the product impossible or impractical would be necessary.

Judgment rendered on September 29, 2016

2015 (Gyo-Ke) 10184, Case of Seeking Rescission of JPO Decision

Date of conclusion of oral argument: July 28, 2016

Judgment

Plaintiff: X₁

Plaintiff: X₂

Defendant: Pegasus Candle Co., Ltd.

Main text

1. The plaintiffs' claims shall be dismissed.
2. The plaintiffs shall bear the court costs.

Facts and reasons

No. 1 Claims

1. The JPO decision rendered with respect to Case of Invalidation Trial No. 2012-800197 on August 6, 2015, shall be rescinded.
2. The court costs shall be borne by the defendant.

No. 2 Outline of the case (Facts not accompanied by the basis for findings are facts for which the parties have no dispute or facts that can easily be found from the entire import of the oral argument.)

1. Developments in procedures at the JPO (Facts found by the court are accompanied by the indications of evidence.)

On June 7, 2006, the defendant filed a patent application for an invention titled "candle" (hereinafter referred to as the "Application"), and by means of an amendment dated May 13, 2011 (Exhibit Ko 15), amended the scope of claims and the description attached to the Application. On October 21, 2011, the defendant made another amendment to the scope of claims and the description. On April 13, 2012, the defendant had the establishment of a patent right registered (Patent No. 4968605; number of claims: 2) (Exhibit Ko 10; hereinafter referred to as the "Patent").

On November 29, 2012, the plaintiffs filed a request for an invalidation trial (Invalidation Trial No. 2012-800197) with the JPO to seek the invalidation of the Patent (Exhibit Ko 25). On September 20, 2013, the defendant filed a request for correction of the scope of claims and the description (Exhibit Ko 14). On May 9, 2014, the JPO rendered a decision to accept the correction as requested and dismiss the request for the trial (Exhibit Ko 26). On June 12, 2014, the plaintiffs filed an action with the Intellectual Property High Court (IP High Court) to seek

rescission of this JPO decision (2014 (Gyo-Ke) 10145). On March 25, 2015, the IP High Court rendered a judgment to rescind the JPO decision (Exhibit Ko 27), which became final and binding on a later date.

Based on this judgment by the IP High Court, on May 19, 2015, the defendant filed a request for correction with the JPO regarding the scope of claims and the description (hereinafter this request for correction and the corrected matters are collectively referred to as the "Correction") (Exhibit Ko 28). On August 6, 2015, the JPO rendered a decision to accept the Correction as requested and dismiss the request for the trial (hereinafter referred to as the "JPO Decision"). On September 12, 2015, the plaintiffs filed this action with the IP High Court to seek rescission of the JPO Decision.

2. Statement of the scope of claims (Exhibit Ko 28)

The scope of claims regarding Claims 1 and 2 after the Correction of the Patent (hereinafter referred to as the "Scope of Claims") is described as follows.

Claim 2 was corrected only for the part citing the correction of Claim 1. Hereinafter the inventions described in Claims 1 and 2 after the Correction are referred to as "Invention 1" and "Invention 2," respectively, and are collectively referred to as the "Invention"; and the description and drawings after the Correction are collectively referred to as the "Corrected Description." Claim 1 is paraphrased and marked with alphabetic letters by the court, and the corrected parts are underlined.

"[Claim 1]

A: A candle with a burning wick projecting from the center of the candle body, with a structure wherein:

B: the burning wick is coated with wax;

C: the wax applied for coating the tip portion of the burning wick of at least 3 mm from the tip is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to 19% to 33% of the amount of wax coating on the other portion of the burning wick, and thereby;

D: making the burning wick exposed; and

E: the tip portion of the burning wick is ignited within three seconds;

F: the candle characterized by the features A to E.

[Claim 2]

A candle described in Claim 1 wherein the tip portion of the burning wick is unwound."

3. Reasons for the JPO Decision

The reasons of the JPO Decision, which are as stated in the attached written decision (copy), can be summarized as follows: [i] there are no defects in the statements of the Scope of Claims or the Corrected Description, and the Patent cannot be deemed to have been granted based on a

patent application that fails to meet the enablement requirement under Article 36, paragraph (4), item (i) of the Patent Act, the support requirement under paragraph (6), item (i) of the same Article, or the clarity requirement under item (ii) of the same paragraph; and [ii] it cannot be said that Inventions 1 and 2 could have been easily made by a person ordinarily skilled in the art in reference to the inventions shown in the pictures or photographs contained in the catalogue titled "'95 WINTER-'96 SPRING CAKE ORNAMENT" prepared in 1995 (Exhibit Ko 1-1; hereinafter referred to as "Exhibit Ko 1-1 Publication"), the catalogue titled "CAKE ORNAMENT '91" prepared in 1991 (Exhibit Ko 1-2; hereinafter referred to as "Exhibit Ko 1-2 Publication"), the catalogue prepared in May 1999 (Exhibit Ko 1-3; hereinafter referred to as "Exhibit Ko 1-3 Publication"), the catalogue prepared in May 1999 (Exhibit Ko 1-4; hereinafter referred to as "Exhibit Ko 1-4 Publication"), and the DVD titled "Herrhammer" prepared in 2005 (Exhibit Ko 1-5; hereinafter referred to as "Exhibit Ko 1-5 Publication") (hereinafter these inventions are respectively referred to as "Exhibit Ko 1-1 Invention" to "Exhibit Ko 1-5 Invention"), and by applying the matters disclosed in Publication of Examined Patent Application No. 1965-17272 (Exhibit Ko 2; hereinafter referred to as "Exhibit Ko 2 Publication"), Publication of Examined Utility Model Application No. 1992-41160 (Exhibit Ko 3), Publication of Examined Utility Model Application No. 1928-9318 (Exhibit Ko 4), Publication of Unexamined Patent Application No. 1982-124618 (Exhibit Ko 5), Utility Model Registration No. 3088330 (Exhibit Ko 6), and Publication of Unexamined Patent Application No. 1984-46422 (Exhibit Ko 7; hereinafter referred to as "Exhibit Ko 7 Publication"), or well-known art, to Exhibit Ko 1-1 to Ko 1-5 Inventions, while taking into account the experiments to measure the residual rate of wax coating (Exhibit Ko 8), and thus the granting of the Patent for Inventions 1 and 2 was not in violation of the provisions of Article 29, paragraph (2) of the Patent Act and therefore the Patent for these inventions should not be invalidated.

(omitted)

No. 5 Court decision

The court determines that both of the grounds for rescission alleged by the plaintiff lack legal basis and therefore that the JPO Decision does not contain such illegality that requires its rescission. The reasons for this determination are as follows.

1. Ground for Rescission 1 (errors in the determination of defective descriptions)

(1) It is found that the Corrected Description states as follows (Exhibits Ko 10 and Ko 28).

"[Detailed explanation of the invention]

[Background art] [0002] The burning wick of a candle is coated with wax so that after the burning wick is ignited, the flame moves to the candle body smoothly. A candle with a burning

wick coated with wax is made by, for example, soaking the burning wick into the melted wax and then inserting the burning wick thus coated with wax into the candle body, or inserting a burning wick not coated with wax into the candle body and then soaking the portion of the burning wick that projects from the candle body into the melted wax to coat that portion with wax.

[0003] A small candle generally referred to as a "warmer candle" (a candle used with a device called a candle warmer) needs to be low-priced due to the amount and purpose of use, and it is produced in large volume to meet the demand. In most cases, it is shaped using the fully automatic production system in which the candle body is shaped by the shaping machine, with a hole formed at the center for the insertion of a burning wick, and then a burning wick coated with wax is inserted into the hole by the burning wick inserting machine. In order to make the burning wick resilient so that it can be perfectly inserted into the hole prepared on the candle body, more wax is applied to coat the burning wick than is used for burning wicks of ordinary types of candle. In addition, in order to shorten the time required to light a candle, the idea of applying an ignition agent or the like to the tip portion of the burning wick has recently been proposed.

[Disclosure of the invention]

[Problem to be solved by the invention] [0004] A candle with a burning wick coated with wax is lighted by first placing the burning flame of a lighted match or the like close to the tip of the burning wick to heat and melt the wax applied for coating the burning wick, and then heating and gasifying the melted wax to generate flammable gas, and through this process, the burning wick is ignited when the flammable gas catches fire. Thus, in order to light a candle, it is necessary to take steps to heat, melt, and gasify the wax, and therefore it inevitably takes about three to five seconds to ignite the burning wick. In the case of a candle with a burning wick that is inserted into the hole prepared on the candle body, such as a "warmer candle," a relatively large amount of wax is applied for coating the burning wick so that the burning wick can be easily inserted into the hole, and the burning wick is made stiff. This kind of candle takes a longer time to light because it takes more time to melt the wax applied for coating the burning wick. The method of applying an ignition agent to the tip portion of the burning wick in order to shorten the time to ignite the burning wick requires caution in handling the ignition agent and inevitably increases the production cost. Accordingly, the Invention is made for the purpose of providing a candle which needs a shorter time to ignite the burning wick but ensures ignition. Another purpose of the Invention is to provide a low-priced and safe candle made without applying an ignition agent to the tip of the burning wick.

[Means to solve the problem] [0005] The Invention relates to a candle with a burning wick projecting from the center of the candle body, with a structure wherein: the burning wick is

coated with wax; the wax applied for coating the tip portion of the burning wick of at least 3 mm from the tip is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to 33% or less of the amount of wax coating on the other portion of the burning wick, and thereby; making the burning wick exposed; and the tip portion of the burning wick is ignited within three seconds. In addition, the Invention relates to such candle wherein the tip portion of the burning wick is unwound. If the length of the tip portion of the burning wick where the amount of wax coating is adjusted is less than 3 mm, the flame that arises upon ignition would be so small that it might be extinguished by wind. Although there is no upper limit to the length of the tip portion, 3 mm would be sufficient to ensure that the wax applied for coating the other portion of the burning wick, where the amount of wax coating is larger than that of the tip portion, will be melted and gasified faster and burnt stably. Normally, the preferable length of the tip portion is about 5 mm. The wax applied for coating the tip portion of the burning wick is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion comes to 19% to 33% of the amount of wax coating on the other portion of the burning wick. If the residual rate of wax exceeds 33%, it takes a longer time to melt and gasify the coating wax, requiring a longer time to ignite the burning wick.

[Effect of the invention] [0006] The candle of the Invention can greatly shorten the ignition time by removing the wax applied for coating the tip portion of the burning wick and making the burning wick exposed, which is a simple and low-cost method. In addition, unwinding the tip portion of the burning wick makes it further easier to ignite the burning wick and makes it possible to shorten the time required to light the candle.

[0007] Furthermore, such a candle that is easier to light can prevent the dangers such as, for example, when elderly people light a candle with a match to perform a daily service, they might have trouble lighting the candle and get their fingers burnt by the fire on the match splint or drop the flame from the head of the match.

[0008] In addition, the reduction of the time required to light many candles displayed at places such as banquet halls and restaurants can bring about benefits such as facilitating the work and saving labor because workers can light candles without fail more quickly.

[0009] Moreover, in the situation where a large number of candles are displayed, such as when hundreds or thousands of candles are displayed at outdoor events, the reduction of the time between the start and end of the lighting of candles would be greatly beneficial for staging the events and increasing work efficiency.

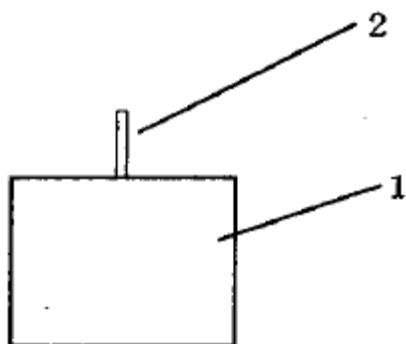
[Best mode for carrying out the invention] [0010] The candle of the Invention can be made by using a burning wick with the wax coating on its tip portion removed in the process of shaping a candle, or inserting such burning wick in the candle body that is already shaped.

[0011] Furthermore, the candle of the Invention can also be made by removing the wax applied for coating the tip portion of the burning wick to make it exposed after shaping the candle.

[0012] There is no limitation to the method for making the burning wick exposed; this can be done by heating and melting the wax to remove it, or by scraping off the wax by machine. There is also no limitation to the method of unwinding the exposed burning wick; it can be done by scratching the wick or by cutting the wick so that it would be finely split. The removal of the wax and the unwinding of the exposed wick can be performed simultaneously by putting the wick between toothed wheels."

"[Comparative Example 1] [0014] As shown in Figure 1, a candle body 1, which is 36 mm in diameter, 20 mm in height, and 17 g in weight, and has a hole of 2.2 mm in diameter at its center, and a burning wick 2, which is coated with wax by soaking it three times, while cooling it, into the wax for wick soaking made by mixing 30% of micro crystalline wax with commercially available 135 paraffin wax and melting the mixture at 80°C, were prepared."

"[Figure 1]



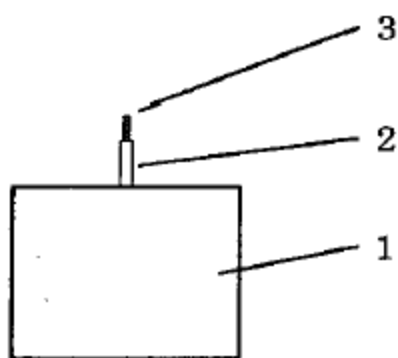
"Next, a candle was made by inserting burning wick 2, which is coated with wax and cut to 30 mm, into the hole on candle body 1. The candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth. Two sets of glass containers containing the candles, each set consisting of 12 such containers arranged without a gap and horizontally in a line, were prepared as Comparative Example 1.

[Comparative Example 2] [0015] Comparative Example 2 was prepared by arranging the same sets of glass containers containing the candles as those of Comparative Example 1, with the only difference being that the burning wick was soaked into wax two times instead of three times.

[Embodiment Example 1] [0016] A burning wick coated with wax was prepared by soaking the burning wick one time, while cooling it, into the same wax for wick soaking as that of Comparative Example 1, and its weight was measured. As calculated based on the difference in

terms of the weight of the burning wick of Comparative Example 1, the amount of wax coating applied for coating the burning wick was 33% of that of Comparative Example 1. A candle shown in Figure 2 was made by inserting the burning wick into the hole prepared on the candle body, as in the case of Comparative Example 1. The candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth. Two sets of glass containers containing the candles, each set consisting of 12 such containers arranged without a gap and horizontally in a line, were prepared as Embodiment Example 1. Since the time to ignite the burning wick depends on the amount of wax coating on the wick, Embodiment Example 1 used a simple method, that is, used a burning wick the whole portion of which is coated with wax evenly (the wax applied for coating the tip portion of the wick is not scraped off)."

"[Figure 2]



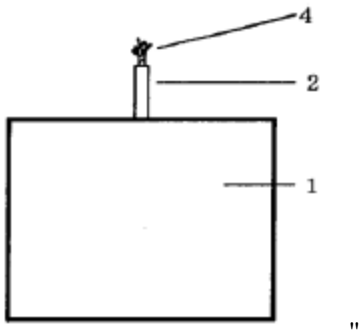
"[Embodiment Example 2] The weight of burning wick 2 of Comparative Example 1 was measured after scraping off the wax applied for coating it with a pick-like steel tool. As calculated based on the difference in terms of the weight of the burning wick of Comparative Example 1, the residual rate of wax applied for coating the burning wick was 24%. A candle shown in Figure 2 was made by inserting the burning wick into the hole prepared on the candle body, as in the case of Embodiment Example 1. The candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth. Two sets of glass containers containing the candles, each set consisting of 12 such containers arranged without a gap and horizontally in a line, were prepared as Embodiment Example 2.

[Embodiment Example 3] [0018] Burning wick 2 used in Comparative Example 1 was soaked into melted paraffin wax at 100°C to melt the coating wax, and its weight was measured. As calculated based on the difference in terms of the weight of the burning wick of Comparative

Example 1, the residual rate of wax was 19%. A candle shown in Figure 2 was made by inserting the burning wick into the hole prepared on the candle body, as in the case of Embodiment Example 1. The candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth. Two sets of glass containers containing the candles, each set consisting of 12 such containers arranged without a gap and horizontally in a line, were prepared as Embodiment Example 3.

[Embodiment Example 4] [0019] A candle shown in Figure 3 was made by inserting burning wick 2 of Embodiment Example 2 into the hole prepared on candle body 1, after unwinding the tip portion thereof. The part numbered 4 in Figure 3 is the unwound part of the tip portion of the burning wick. The candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth. Two sets of glass containers containing the candles, each set consisting of 12 such containers arranged without a gap and horizontally in a line, were prepared as Embodiment Example 4."

"[Figure 3]



"[0020] First, Tester A lighted, intentionally quickly, all the 12 candles of one of the two sets of candles in Comparative Example 1 using a lighter, and measured the time consumed for ignition. Then, Tester B lighted all the 12 candles of the other set of candles in the same manner, and measured the time consumed for ignition.

[0021] Next, the same process was performed for Comparative Example 2 and Embodiment Examples 1 to 4 and the time consumed for ignition was measured respectively. The measurement results are shown in Table 1.

[Table 1]

Time consumed for ignition	Comparative Example 1	Comparative Example 2	Embodiment Example 1	Embodiment Example 2	Embodiment Example 3	Embodiment Example 4
Residual rate of wax coating	100%	60%	33%	24%	19%	24%
Tester A	45.4 sec.	44.3 sec.	36.4 sec.	33.2 sec.	25.9 sec.	15.8 sec.
Tester B	46.0 sec	38.1 sec.	35.6 sec.	34.3 sec.	28.5 sec.	15.2 sec.
Average time	45.7 sec.	41.2 sec.	36.0 sec.	33.8 sec.	27.2 sec.	15.5 sec.
Average time per candle	3.8 sec.	3.4 sec.	3.0 sec.	2.8 sec.	2.3 sec.	1.3 sec.
Assessment	×	×	△	○	○	◎

Embodiment Example 4 used the burning wick of Embodiment Example 2 after unwinding its tip portion.

[0022] In Comparative Example 1, it took a long time to melt the wax applied for coating the burning wick, and the average ignition time per candle was 3.8 seconds. In Comparative Example 2 in which the amount of wax coating on the burning wick was 60% of that in Comparative Example 1, the time to melt the wax was shorter than that in Comparative Example 1, but the average ignition time per candle was 3.4 seconds, only slightly shorter than that in Comparative Example 1.

[0023] In Embodiment Example 1, the amount of wax coating on the burning wick was 33% of that in Comparative Example 1, and the average ignition time per candle was 3.0 seconds, thus demonstrating an effect in reducing the ignition time. In Embodiment Example 2 and Embodiment Example 3, the amount of wax coating on the burning wick was 24% and 19% of that in Comparative Example 1, respectively, and the average ignition time per candle was 2.8 seconds and 2.3 seconds, respectively, showing that it was easier to light candles and the time consumed for ignition was greatly reduced.

[0024] In Embodiment Example 4, which used the burning wick of Embodiment Example 2 after unwinding its tip portion, it was easy to ignite the unwound wick thread when lighting the candle and the average ignition time per candle was 1.3 seconds, showing the greater easiness in lighting candles.

[0025] Two sets of burning wicks of Comparative Example 1, each consisting of 12 wicks, were prepared by scraping off the wax applied for coating the tip portion thereof for 1 mm, 3 mm, and 5 mm from the tip, respectively, by the same method as that of Embodiment Example 2, using a pick-like steel tool (a total of 72 burning wicks in six sets). When calculating the amount of wax coating that remained on the tip portion based on the weight of the burning wick after scraping off the wax on the tip portion, the amount of wax coating on the tip portion of each of all 72 burning wicks was 24% of the amount of wax coating applied for coating the other portion of the burning wick. Two sets of candles shown in Figure 2, each consisting of 12 candles, were prepared by preparing two sets of burning wicks with the wax applied for coating the tip portion thereof being scraped off for 1 mm, 3 mm, and 5 mm from the tip, respectively (a total of 72 burning wicks in six sets), and inserting each such burning wicks into the hole prepared on candle body 1 (a total of 72 candles in six sets). Each candle thus made was put into a polycarbonate container of 38 mm in inside diameter and 24 mm in depth (not indicated in the figure), and then put into a glass container of 53 mm in diameter at the opening and 55 mm in depth (not indicated in the figure).

The burning wick of each candle was ignited and the ignition time was measured. The measurement results are shown in Table 2. While Table 2 does not show any significant difference in terms of the ignition time among the three types of burning wicks with a different length of the tip portion, the burning wick with the tip portion of 1 mm is unsuitable to be used outdoors because the flame that arises upon ignition would be so small that it might be extinguished by wind.

[Table 2]

Length of the area where wax was removed	5 mm	3 mm	1 mm
Tester A	25.8 sec.	27.1 sec.	27.1 sec.
Tester B	27.6 sec	26.8 sec.	24.8 sec.
Average time	2.2 sec.	2.3 sec.	2.2 sec.
Ignition in wind	Good	More or less good	Easy to be extinguished
Assessment	○	△	×

[0026] These measurement results show that the ignition time of the burning wick of a candle depends on the amount of wax coating on the very tip of the burning wick and to what degree the tip portion of the burning wick was unwound. However, in the case of the burning wick with the wax coating on the tip portion being scraped off for only 1 mm from the tip, the flame at the

time of ignition was as small as a grain of sesame and easily extinguished even by moderate wind, and therefore preferably, the wax coating should be removed for at least 3 to 5 mm from the tip.

[Industrial applicability] [0027] By providing a candle with high ignition performance and capability to reduce the ignition time significantly, the Invention would make it possible to light many candles displayed at places such as banquet halls and restaurants more quickly and reduce labor and trouble in lighting candles. Furthermore, it would also make it possible to light thousands of candles displayed at outdoor events efficiently and quickly, which is beneficial for not only saving labor but also bringing about staging effects such as enabling staging expressions using fire quickly and giving event participants a deeper impression and satisfaction. In addition, it would bring about significant benefits such as reducing the working hours, number of workers, and labor costs."

(2) Technical features of the Invention

According to (1) above, in order to light a candle with a burning wick coated with wax, it is necessary to take steps to heat, melt, and gasify the wax, and therefore it inevitably takes about three to five seconds to ignite the burning wick. For this reason, a candle with a burning wick coated with a relatively large amount of wax, such as a warmer candle, posed problems such as a longer time for initiation (Corrected Description [0004]). The Invention was made to solve this problem ([0004]), by means of a structure wherein a certain percentage of the wax applied for coating the tip portion of a burning wick that projects from the candle body is scraped off or removed by melting, and thereby making the burning wick exposed, and the tip portion of the burning wick is ignited within three seconds ([0005]). With such structure, the candle of the Invention brings about the effect of greatly reducing the ignition time by removing the wax applied for coating the tip portion of the burning wick and making the burning wick exposed, which is a simple and low-cost method ([0006]).

(3) Whether the Invention meets the enablement requirement under Article 36, paragraph (4), item (i) of the Patent Act, the support requirement under paragraph (6), item (i) of the same Article, or the clarity requirement under item (ii) of the same paragraph

A. "Residual rate of wax" (Constituent Feature C)

According to the statement of the Scope of Claims, the "tip portion of the burning wick" of the Invention refers to the portion of the burning wick projecting from the candle body, which is exposed by removing the coating wax, whereas the "other portion of the burning wick" refers to the portion of the projecting burning wick which is still coated with wax. Since the length of the "tip portion" of the burning wick is specified by means of variable value, "at least 3 mm," the length of the "other portion of the burning wick" would be shorter as the "tip portion" of the burning wick is made longer, and the total amount of wax coating on the other portion would be

gradually reduced. Also according to the statement of the Scope of Claims, the Invention reduces the ignition time of the tip portion of the burning wick to three seconds or less, by scraping off or removing by melting the wax applied for coating the tip portion of the burning wick for 3 mm or more from the tip, so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to a certain percentage of the amount of the wax applied for coating the other portion of the burning wick. In light of such structure of the Invention, a person ordinarily skilled in the art could naturally understand that the recitation of "the wax applied for coating the tip portion of the burning wick...is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to 19% to 33%" in Constituent Feature C does not refer to the ratio of the total amount of wax coating on the tip portion of the burning wick to the total amount of wax coating on the other portion of the burning wick, which depends on the length of the tip portion of the burning wick or the length of the other portion of the burning wick, but it refers to the ratio of the total amount of wax coating per unit length of the tip portion of the burning wick to the total amount of wax coating per unit length of the other portion of the burning wick. This can be expressed by the following formula: [amount of wax coating per unit length of the tip portion of the burning wick after the wax removal was performed] / [amount of wax coating per unit length of the other portion of the burning wick after the wax removal was performed]. Consequently, the recitation of "the residual rate of the wax...comes to 19% to 33%" cannot be found to be unclear. Taking into consideration the Corrected Description, according to the recitation in the Corrected Description ([Table 2] [0025]), the "residual rate of wax" for all the 72 burning wicks in Embodiment Example 2, with a different length of the tip portion, namely, 1 mm, 3 mm, and 5 mm, was calculated as 24%, irrespective of the length of the other portion of the burning wick. This also supports the abovementioned findings. Furthermore, based on those findings, the "residual rate of wax" is obtained by scraping off or removing by melting the wax on the tip portion of the burning wick, and it would be specified as a single value by the abovementioned formula. Hence, a person ordinarily skilled in the art could understand that the "tip portion" and the "other portion" of the burning wick are respectively coated with wax evenly.

Consequently, since the meaning of the term "residual rate of wax" in Constituent Feature C is clear and no particular difficulties can be found in calculating it, there are no errors in the determination of the JPO to the effect that the statement in the detailed explanation of the Invention and the statement in the Scope of Claims do not violate any of the enablement requirement under Article 36, paragraph (4), item (i) of the Patent Act or the clarity requirement under paragraph (6), item (ii) of the same Article.

B. "Ignited within three seconds" (Constituent Feature E)

According to (1) and (2) above, the technical features of the Invention are found in that the

Invention presents the means to reduce the ignition time of a candle with a burning wick coated with wax. The structure wherein the tip portion of the burning wick is "ignited within three seconds" is a requirement that constitutes the Invention, and hence it is clear that a candle that cannot be "ignited within three seconds" is excluded from the scope of the Invention.

Consequently, since the meaning of the recitation of "ignited within three seconds" in Constituent Feature E is clear and it is also clear that a candle that takes more than three seconds to be ignited is excluded from the scope of the Invention, there are no errors in the conclusion of the JPO to the effect that the statement in the detailed explanation of the Invention and the statement in the Scope of Claims do not violate any of the enablement requirement under Article 36, paragraph (4), item (i) of the Patent Act or the support requirement under paragraph (6), item (i) of the same Article.

C. Summary

According to the above, there are no errors in the determination of the JPO to the effect that the statement in the detailed explanation of the Invention and the statement in the Scope of Claims do not violate any of the enablement requirement under Article 36, paragraph (4), item (i) of the Patent Act, the support requirement under paragraph (6), item (i) of the same Article, or the clarity requirement under item (ii) of the same paragraph.

(4) Determination by the court on the allegations of the plaintiffs

A. The plaintiffs allege that the "residual rate of wax" should be interpreted as referring to the rate calculated by the formula, "amount of wax coating on the tip portion of the burning wick after the wax removal was performed" / "amount of wax coating on the other portion of the burning wick after the wax removal was performed," and that this interpretation does not contradict the statement in the Corrected Description. However, according to the interpretation alleged by the plaintiffs, the value of the "residual rate of wax" would vary depending on the length of the tip portion or the other portion, and such value would have no technical meaning in relation to the ignition time. What is more, this allegation clearly contradicts the statement in paragraph [0025] of the Corrected Description in which the residual rate of wax in Embodiment Example 2 is calculated as 24%, irrespective of the length of the other portion of the burning wick. In this respect, it is obviously inappropriate to interpret the value of the "residual rate of wax" as "around 24%" as alleged by the plaintiffs, despite the fact that the Corrected Description expressly specifies that rate as "24%." Thus, the appellants misinterpret the technical meaning of the Invention stated in the Scope of Claims, and therefore their allegation cannot be accepted.

B. The plaintiffs allege that although the "residual rate of wax" would vary depending on the thickness or weight of the burning wick of a candle, neither the Scope of Claims nor the Corrected Description specifies the thickness or weight of the burning wick, and this would

force a person ordinarily skilled in the art to do an excessive amount of trial and error in order to adjust the "residual rate of wax" to be "19% to 33%," and hence the Scope of Claims and the Corrected Description fail to meet the enablement requirement and the support requirement. However, as mentioned in (3) above, the "residual rate of wax" in the Invention is calculated by the formula, [amount of wax coating per unit length of the tip portion of the burning wick after the wax removal was performed] / [amount of wax coating per unit length of the other portion of the burning wick after the wax removal was performed]; the Corrected Description discloses a candle for which the "residual rate of wax" is "19% to 33%" and which is "ignited within three seconds"; and the candle of the Invention has a structure wherein both the tip portion and the other portion of the burning wick are respectively coated with wax evenly. Therefore, even though the thickness or other factors of the burning wick are not stated in the Scope of Claims or the Corrected Description, it cannot be said that there are circumstances that make it difficult to measure the "residual rate of wax" on the basis of the amount of wax coating per unit length, and it is too much to say that a person ordinarily skilled in the art would be forced to do an excessive amount of trial and error.

Thus, by making the allegation mentioned above, the plaintiffs, after all, do nothing more than allege the violation of the enablement requirement or the support requirement based on their understanding of the formula for calculating the "residual rate of wax" that is inconsistent with what is explained above, and therefore their allegation cannot be accepted.

C. The plaintiffs allege that while the Scope of Claims specifically states that the tip portion of the burning wick is "ignited within three seconds," the Corrected Description only discloses the average value of the ignition time, and therefore that a candle that cannot be "ignited within three seconds," which is a specific value, would be included in the scope of the candles of the Invention. They also allege that a person ordinarily skilled in the art could not understand from the statement in the Scope of Claims that the ignition time expressed by a specific value, "within three seconds," is the average value of the ignition time. However, as mentioned in (3) B. above, the technical features of the Invention are found in that the Invention presents the means to reduce the ignition time of a candle with a burning wick coated with wax, and the structure wherein the tip portion of the burning wick is "ignited within three seconds" is a requirement that constitutes the Invention, and hence it is clear that a candle that cannot be "ignited within three seconds" is excluded from the scope of the Invention. Thus, the plaintiffs made the allegation mentioned above, while misinterpreting the technical meaning of the Invention and assuming that a candle that cannot be "ignited within three seconds" is included in the scope of the Invention, and therefore their allegation cannot be accepted.

D. The plaintiffs allege that while the method for making a candle that is disclosed in the Corrected Description is limited to the method of scraping off wax from the tip portion of the

burning wick and then inserting it into the hole prepared on the candle body that is already shaped, the Scope of Claims does not limit the method for making a candle to that method, and therefore that the statement in the Scope of Claims fails to meet the support requirement under Article 36, paragraph (6), item (i) of the Patent Act. However, the Corrected Description states the basic structure of a candle as follows: "A candle with a burning wick coated with wax is made by, for example, soaking the burning wick into the melted wax and then inserting the burning wick thus coated with wax into the candle body, or inserting a burning wick not coated with wax into the candle body and then soaking the portion of the burning wick that projects from the candle body into the melted wax to coat that portion with wax." ([0002]); "The candle of the Invention can be made by using a burning wick with the wax coating on its tip portion removed in the process of shaping a candle, or inserting such burning wick in the candle body that is already shaped. Furthermore, the candle of the Invention can also be made by removing the wax applied for coating the tip portion of the burning wick to make it exposed after shaping the candle." ([0010][0011]). Thus, it is clear that a candle that a person ordinarily skilled in the art could, by referring to the Corrected Description, recognize as a candle that is capable of solving the problem targeted by the Invention is not limited to the one in the Embodiment Example that is achieved by inserting the burning wick with the wax coating on its tip portion removed into the hole prepared on the candle body ([0025]). Consequently, the plaintiffs' allegation lacks its premise and cannot be accepted.

E. The plaintiffs allege that the recitation regarding the Invention, "scraped off or removed by melting," indicates that Claim 1 is a product-by-process claim which defines a product in terms of a process to manufacture that product, and therefore the Invention fails to meet the clarity requirement.

However, based on the relevant evidence (Exhibit Ko 25) and the entire import of the oral argument, it is found that the abovementioned allegation of the plaintiffs had not been made as grounds for invalidation during the trial proceedings for invalidation of the Patent and had not been the subject of examination and determination by the JPO in the trial proceedings, and hence, this allegation, from the beginning, is not the subject of examination and determination by the court in this action (1967 (Gyo-Tsu) 28, judgment of the Grand Bench of the Supreme Court, March 10, 1976, Minshu Vol. 30, No. 2, at 79), and thus unreasonable.

We make additional remarks on this point. The Supreme Court judgment on the product-by-process claim states that when a claim of a patent for an invention of a product recites the manufacturing process of the product, the recitation of the claim should be held to meet the clarity requirement prescribed in Article 36, paragraph (6), item (ii) of the Patent Act, only if there are circumstances where it was impossible or utterly impractical to directly define the product subject to the invention by means of its structure or characteristics at the time of the

filing of the application (hereinafter such circumstances are referred to as "impossible or impractical circumstances"). Thus, the reason why the Supreme Court judgment on the product-by-process claim requires the applicant to allege and prove these circumstances can be interpreted as that, according to the holding of the Supreme Court, when a claim of a patent for an invention of a product recites the manufacturing process of the product, it is unclear what structure or characteristics of the product are represented by the recitation of the manufacturing process, and this would prevent those who read the recitation of the claim, etc. from clearly understanding the content of the invention. Based on this interpretation, even when a claim recites the manufacturing process of the product, if the recitation of the manufacturing process clearly represents the structure or characteristics of the product, it would be possible to clearly understand the content of the invention. It is appropriate to construe that in that situation, the applicant is not required to allege or prove impossible or impractical circumstances.

This reasoning can be applied in this case as follows. The recitation regarding the Invention, "candle..., with a structure wherein: the burning wick is coated with wax; the wax applied for coating the tip portion of the burning wick...is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to 19% to 33% of the amount of the wax applied for coating the other portion of the burning wick, and thereby: making the burning wick exposed," can be read as specifying temporal elements in terms of the manufacturing of the product, but it only indicates the structure of the tip portion of the burning wick of the candle by reciting the condition of the candle in which the residual rate of wax is 19% to 33% after the wax is scraped off or removed by melting. Even if this recitation is interpreted as reciting the manufacturing process of the product, it can be understood as clearly indicating the structure or characteristics of the candle of the Invention, and hence, when such special circumstances exist, the applicant is not required to allege or prove the impossible or impractical circumstances mentioned in the Supreme Court judgment on the product-by-process claim.

Thus, the plaintiffs' allegation is based on their misinterpretation of the Supreme Court judgment on the product-by-process claim and therefore it cannot be accepted.

(5) Summary

Even by fully examining other allegations made by the plaintiffs before this court, their allegations, after all, only criticize the JPO decision based on their dogmatic view regarding the "residual rate of wax" while misinterpreting the technical meaning of the Invention, and these allegations do not affect the determination of this court mentioned above.

According to the above, there are no errors in the determination of the JPO to the effect that the statement in the detailed explanation of the Invention and the statement in the Scope of Claims are not defective, and hence Ground for Rescission 1 lacks legal basis.

2. Ground for Rescission 2 (errors in the determination of an inventive step)

(1) Summary of the invention

According to the Corrected Description, the content of Invention 1 is as follows.

A. Conventionally, in order to light a candle with a burning wick coated with wax, it is necessary to take steps to heat, melt, and gasify the wax, and therefore it inevitably takes about three to five seconds to ignite the burning wick. For this reason, a candle with a burning wick coated with a relatively large amount of wax, such as a warmer candle, posed problems such as a longer time for initiation (Corrected Description [0004]). The Invention was made to solve this problem ([0004]) and to provide a candle with a structure wherein the wax applied for coating the tip portion of the burning wick of at least 3 mm from the tip is scraped off or removed by melting so that the residual rate of wax (meaning the rate calculated by the formula: [amount of wax coating per unit length of the tip portion of the burning wick after the wax removal was performed] / [amount of wax coating per unit length of the other portion of the burning wick after the wax removal was performed]) comes to 19% to 33%, and thereby making the burning wick exposed, and also the tip portion of the burning wick is ignited within three seconds ([0005]).

B. With this structure, the cradle of the Invention brings about the effect of greatly reducing the ignition time by removing the wax applied for coating the tip portion of the burning wick and making the burning wick exposed, which is a simple and low-cost method ([0006]).

(2) Summaries of Exhibit Ko 1-1 to Ko 1-5 Inventions (there are no disputes between the parties.)

It is found that Exhibit Ko 1-1 to Ko 1-5 Publications respectively disclose the following inventions.

A. Exhibit Ko 1-1 Invention

"A candle with a burning wick projecting from the candle body shaped as a Santa Claus or Snowman, with the lower part of the projecting portion of the burning wick being coated with the wax of the candle body and the tip part being white"

B. Exhibit Ko 1-2 Invention

"A candle with a thin candle projecting from the candle body shaped as a Snowman, with the burning wick of the thin candle projecting for about 4.4 mm"

C. Exhibit Ko 1-3 Invention

"A candle with a burning wick projecting from the candle body, with the projecting portion of the burning wick being coated with the wax that forms the candle body"

D. Exhibit Ko 1-4 Invention

"A candle with a burning wick projecting from the candle body, with the projecting portion of the burning wick being coated with the wax that forms the candle body"

E. Exhibit Ko 1-5 Invention

"A candle with a burning wick projecting from the candle body, with the projecting portion of the burning wick being made by removing by melting the wax that forms the candle body and is applied for coating the tip portion of the wick"

(3) Common features and differences between the Invention and Exhibit Ko 1-1 Invention

A. Common features (there are no disputes between the parties.)

"A candle with a burning wick projecting from the candle body, with the burning wick being coated with wax and the tip portion of the burning wick being exposed"

B. Differences

(A) Difference (a) 1

The "burning wick" of Invention 1 is made in a manner that "the burning wick is coated with wax; the wax applied for coating the tip portion of the burning wick of at least 3 mm from the tip is scraped off or removed by melting so that the residual rate of the wax applied for coating the tip portion of the burning wick comes to 19% to 33% of the amount of the wax applied for coating the other portion of the burning wick, and thereby; making the burning wick exposed," whereas the burning wick of Exhibit Ko 1-1 Invention is not specified as such.

(B) Difference (a) 2

The candle of Invention 1 has a "structure...wherein the tip portion of the burning wick is ignited within three seconds," whereas the burning wick of Exhibit Ko 1-1 Invention is not specified as such.

(4) Whether a person ordinarily skilled in the art could have easily conceived of the differences concerning Exhibit Ko 1-1 Invention

None of Exhibit Ko 2 to Ko 7 Publications and other evidence describes a candle for which the "residual rate of wax" in the meaning mentioned in (1) above comes to 19% to 33%. Furthermore, none of them contains a statement that is sufficient to find that a candle made with such structure was well known at the time of the filing of the Application. Thus, it cannot be found that a person ordinarily skilled in the art could have easily adopted the structure involving Difference (a) 1.

Consequently, it cannot be said that a person ordinarily skilled in the art could have easily conceived of Invention 1 from Exhibit Ko 1-1 Invention, any matters disclosed in other evidence, or well-known art.

(5) Whether a person ordinarily skilled in the art could have easily conceived of the differences concerning Exhibit Ko 1-2 to Ko 1-5 Inventions

Compared with Invention 1, Exhibit Ko 1-2 to Ko 1-5 Inventions are found to have the same differences as Difference (a) 1 mentioned in (3) B (A). It cannot be said that a person ordinarily skilled in the art could have easily conceived of the structure of Invention 1 involving that

difference as mentioned in (4) above.

Consequently, it cannot be said that a person ordinarily skilled in the art could have easily conceived of Invention 1 from Exhibit Ko 1-2 to Ko 1-5 Inventions, any matters disclosed in other evidence, or well-known art.

(6) Whether a person ordinarily skilled in the art could have easily conceived of Invention 2

Invention 2 is described by limiting Invention 1 to one wherein "the tip portion of the burning wick is unwound." Consequently, it cannot be said, either, that a person ordinarily skilled in the art could have easily conceived of Invention 2 from Exhibit Ko 1-1 to Ko 1-5 Inventions, any matters disclosed in other evidence, or well-known art.

(7) Determination by the court on the allegations of the plaintiffs

The plaintiffs allege as follows. The scope of the Invention includes conventional candles that are generally used. A candle for which the "residual rate of wax" is 16% is disclosed in the publication submitted as Exhibit Ko 35. What is more, in the first place, the ignition time of the Invention does not depend on the "residual rate of wax," but the candle is ignited "within three seconds" only if the tip portion of the burning wick is exposed. Hence, adjusting the "residual rate of wax" to come to "19% to 33%" is nothing more than a design factor that has no technical meaning or meaning in terms of limitation. Thus, a person ordinarily skilled in the art could have easily made the Invention based on well-known art.

However, the formula for calculating the "residual rate of wax" applied by the plaintiffs to the abovementioned candle is different from the formula indicated for the Invention. Moreover, in the case of the abovementioned candle, the "tip portion" and the "other portion" of the burning wick are not evenly coated with wax. Thus, the plaintiffs' allegations mentioned above address a candle that is different from the candle of the Invention and these allegations lack their premise. Even taking into account other evidence submitted by the plaintiffs, none of such evidence discloses a candle for which the "residual rate of wax" is "19% to 33%," and there is no evidence that is sufficient to find that said candle was well known at the time of the filing of the Application.

Thus, by making the allegations mentioned above, the plaintiffs only assert their dogmatic view while misinterpreting the technical features of the Invention, and their allegations cannot be accepted.

(8) Summary

Even by fully examining other allegations made by the plaintiffs before this court, their allegations, after all, only criticize the JPO decision based on their dogmatic view regarding the "residual rate of wax" while misinterpreting the technical meaning of the Invention, and these allegations do not affect the determination of this court mentioned above.

According to the above, there are no errors in the determination of the JPO to the effect that

the Invention involves an inventive step, and hence Ground for Rescission 2 lacks legal basis.

No. 6 Conclusion

As shown above, both of the grounds for rescission alleged by the plaintiffs lack legal basis, and the plaintiffs' claims shall be dismissed for lacking grounds, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, First Division

Presiding judge: SHITARA Ryuichi

Judge: NAKASHIMA Motoyuki

Judge: OKADA Shingo