

Date	April 14, 2010	Court	Intellectual Property High Court, Fourth Division
Case number	2009 (Gyo-Ke) 10065		
<p>– A case wherein, with regard to the invention titled "method of esterification by an enzyme" as claimed in the divisional application, the court ruled that the correction to the description was impermissible on the following grounds: the technical matters of said invention do not require that the enzyme reaction should take place in the system that is "dried as much as possible" but include the use of the substrate that is not dehydrated to the greatest extent possible, and therefore these matters cannot be found to have been included in the scope of matters stated in the description attached to the original application, which disclosed the method of discharging water from a system that is "dried as much as possible," wherein the enzyme reaction takes place in the system with the use of the substrate that is dehydrated to the greatest extent possible, and hence, said divisional application cannot be regarded as a legal divisional application; and on the premise that the filing date of said divisional application is the day on which said application, not the original application, was actually filed, the invention after the correction does not involve an inventive step and in this respect it fails to meet the requirement for independent patentability.</p>			

References:

Article 44, paragraph (1) and Article 126, paragraphs (1) and (3) of the Patent Act prior to the revision by Act No. 116 of 1994

In this case, the appellant, which holds a patent right for the invention titled "method of esterification by an enzyme" as claimed in the divisional application, sought rescission of the JPO decision that dismissed its request for a trial for correction with regard to the description attached to said divisional application, alleging that there was an error in the JPO's determination to the effect that the technical matters of the invention after the correction were not included in the scope of matters stated in the description attached to the original patent application.

The court held as follows. "The description attached to the application in question is understood as disclosing not only the method of discharging water from a system that is 'dried as much as possible,' wherein enzyme reaction takes place in the system, with the use of the substrate that is dehydrated to the greatest extent possible and the enzyme, but also the method of discharging water from a system and thereby drying the system wherein the reaction of the substrate to the enzyme takes place not in such a state that is 'dried as much as possible' but somewhere in the whole system in which esterification takes place, with the use of the substrate that is not dehydrated to the

greatest extent possible. However, the latter method was not disclosed in the description attached to the original application." The court further held as follows. "According to the results of the examination shown above, the technical matters prior to the correction do not require that the enzyme reaction should take place in the system that is 'dried as much as possible.' With respect to the substrate, such as glycerin, while the invention claimed in the original application was supposed to use the substrate that is dehydrated to the greatest extent possible, said technical matters include the use of the substrate that is not dehydrated to the greatest extent possible, and thus these matters cannot be found to have been included in the scope of matters stated in the original application and therefore the patent application in question cannot be regarded as a legal divisional application provided for in Article 44, paragraph (1) of the Patent Act prior to the revision." Accordingly, on the premise that the filing date of said divisional application is the day on which said application, not the original application, was actually filed, the court determined that the invention after the correction does not involve an inventive step and in this respect it fails to meet the requirement for independent patentability. In conclusion, the court ruled that the correction to the description was impermissible.