Date	November 29, 2017	Court	Intellectual Property High Court, Third Division
Case number	2016 (Gyo-Ke) 10222		
– A case in which the court rescinded a JPO decision that invalidated a patent for an invention titled "magnesium oxide for separation agent for annealing, and grain-oriented electromagnetic steel sheet" based on the violation of the support requirements, by holding that there were errors in the findings of the JPO.			

Reference: Article 36, paragraph (6), item (i) and Article 123, paragraph (1), item (iv) of the Patent Act

Number of related rights, etc.: Invalidation Trial No. 2013-800094, Patent No. 3761867

Summary of the Judgment

The plaintiff is the patentee for the patent in question (Patent No. 3761867) (the "Patent") for an invention titled "magnesium oxide for separation agent for annealing, and grain-oriented electromagnetic steel sheet" (the "Invention"). The defendant filed a request for an invalidation trial (Invalidation Trial No. 2013-800094) and the JPO rendered a decision to invalidate the Patent.

The Invention aims to improve the performance of magnesium oxide for separation agent for annealing by controlling the content of trace components, etc. (the "Trace Component Content" and the "Molar Ratio") in order to improve the magnetic and insulative characteristics of grain-oriented electromagnetic steel sheets and the performance of the forsterite film that decides the product's market value, specifically, forsterite film formation rate, appearance and adhesion of the film, and acid removal property of magnesium unreacted oxide.

The JPO determined that the Invention violates the support requirements by finding as follows.

(1) The magnesium oxide referred to in the embodiments and comparative examples in the description in question (the "Description") satisfies the conditions of the Trace Component Content and the Molar Ratio. At the same time, CAA40% is arranged to fall under certain ranges (110 to 130 seconds and 120 to 140 seconds). Based on the test results, it is found that magnesium oxide with certain CAA is able to solve the problem in question when the conditions of the Trace Component Content and the Molar Ratio are met. On the other hand, it is well-known that there is a correlation between CAA and the performance of the forsterite film in relation to magnesium oxide for separation agent for annealing.

Then, it is not found that the problem is to be solved just by specifying the Trace

Component Content and the Molar Ratio in the case of magnesium oxide for which CAA is not specified.

(2) The detailed explanation of the Invention in the Description includes an embodiment using a reagent (pure substance) that uses magnesium oxide as a raw material and another embodiment using sea water, bittern, etc. as raw materials, but the influence of trace components, such as Cl and F, which affect the forsterite film, is not considered at all. In addition, regardless of whether trace components, such as Cl and F, are contained or not, the Description does not state whether the Invention, which only specifies the Trace Component Content and the Molar Ratio, solves the problem or not, nor is it found to be obvious.

The court rescinded the JPO decision by finding as follows and determining that there were errors in the JPO's findings concerning the support requirements ((1) and (2) above).

(1) The fact that the problem can be solved by controlling the content of trace components in magnesium oxide for separation agent for annealing within the range of the Trace Component Content and the Molar Ratio was supported by the embodiments and comparative examples. A person ordinarily skilled in the art could have recognized based on the statement of the detailed explanation of the invention in the Description that the problem can be solved by controlling the content of the trace components, etc. as stated in the claims. Since the Description states rationales for determining the Trace Component Content and the Molar Ratio as the most suitable range, it is found that the JPO decision erred in finding that the problem of the Invention is solved only when CAA is set within the certain range. Moreover, as of the time of the filing of the patent application in question, there were two approaches to the improvement of the performance of a forsterite film; one was to focus on the content of the trace components of magnesium oxide, and the other was to focus on CAA. It is considered that the plaintiff was free to choose one of those approaches or to adopt two of them together.

(2) In light of the statement concerning the trace components and embodiments stated in the Description, it can be construed based on the statement of the detailed explanation of the invention in the Description that the problem is solved in the same way even if any impurities, such as CL and F, were not contained. Therefore, it cannot be said that the influence of trace components was not considered at all.