

Date	January 15, 2018	Court	Intellectual Property High Court, Fourth Division
Case number	2016 (Gyo-Ke) 10278		
– A case in which the court held that, with respect to an invention titled "novel crystalline form of pitavastatin calcium," it cannot be said that the invention concerning the application in question after the division (the "Application") does not fall within the scope of the matters initially stated in the description, etc. of the original patent application and thus the Application is not deemed as the one filed at the time of the filing of the original patent application.			

Reference: Article 44 of the Patent Act

Number of related rights, etc.: Patent No. 5702494, Opposition No. 2015-700094

### Summary of the Judgment

An opposition to a granted patent was filed in relation to the plaintiff's patent (the "Patent") concerning the invention titled "novel crystalline form of pitavastatin calcium."

On the premise that the application for the patent in question (the "Application") was not a lawful divided application and that the Application is not deemed as the one filed at the time of the filing of the original patent application, the JPO rescinded part of the Patent excluding Claim 8 by determining that the invention concerning some of the claims of the Patent (Claims 1, 3, 5, 7, and 10 to 13) lacks an inventive step and the Patent concerning the rest of the claims (Claims 2, 4, 6, and 9) violates the requirements for correction, support requirements, and enablement requirement.

As stated below, the court found that it cannot be said that the invention concerning the Application falls within the scope of the matters initially stated in the description, etc. of the original patent application and thus the Application is not deemed as the one filed at the time of the filing of the original patent application. Then, the court held that the invention concerning some of the claims of the Patent (Claims 1, 3, 5, 7, and 10 to 13) lacks an inventive step based on the invention stated in a publication distributed after the time of the filing of the original patent application and before the day of the filing of the Application. Meanwhile, the court found that the Patent concerning the rest of the claims (Claims 2, 4, 6, and 9) does not violate the requirements for correction, support requirements, and enablement requirement. Based on these findings, the court rescinded part of the JPO decision on the rescission of the Patent concerning these claims.

(1) The substantive requirements for a lawful divided application are as follows: [i] more than two inventions were included in the description, statement of the scope of

claims, or drawings of the original application; [ii] the invention pertaining to the new application is a part of the inventions stated in the description, statement of the scope of claims, or drawings of the original application; and [iii] the invention pertaining to the new application falls within the scope of the matters initially stated in the description, etc. of the original patent application. In order for the Application to be deemed as having been filed at the time of the filing of the first application, the Application, the third application, and the second application must respectively fulfill the abovementioned requirements for division [i] to [iii] in relation to the original application.

(2) Invention 1 is a polymorphic form of pitavastatin calcium that is specified by an X-ray powder diffraction pattern having characteristic peaks expressed as  $2\theta$  at  $5.0 \pm 0.2^\circ$ ,  $6.8 \pm 0.2^\circ$ ,  $9.1 \pm 0.2^\circ$ ,  $13.7 \pm 0.2^\circ$ ,  $20.8 \pm 0.2^\circ$ , and  $24.2 \pm 0.2^\circ$  and not having a characteristic peak at  $20.2 \pm 0.2^\circ$ . However, the initial description, etc. attached to the third application does not state such a polymorphic form as Polymorphic Form A, neither can it be said that such a polymorphic form is stated as a polymorphic form other than Polymorphic Form A.

Therefore, it cannot be said that Invention 1 falls within the scope of the matters stated in the initial description, etc. attached to the third application. Invention 1 does not fulfill the aforementioned requirement for division [iii].