Date	May 24, 2018	Court	Intellectual Property High Court, Third Division
Case Number	2017 (Gyo-Ke) 10129		
- A case in which a court has rescinded a JPO decision to revoke a granted patent on the grounds of nonconformance to the supporting requirement for the reason that the finding of the problem to be solved by the invention is erroneous.			

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

Number of related rights, etc.: Opposition No. 2016-700420, Patent No. 5813262

Summary of the Judgment

This is a case in which, with regard to the Plaintiff's patent titled "FOOD PRODUCT CONTAINING RICE SACCHARIFIED MATERIAL AND RICE OIL AND/OR INOSITOL," an opposition to a granted patent was filed with the JPO, and the patent was revoked on the grounds of violation of Article 36, paragraph (6), item (i) of the Patent Act, and the Plaintiff instituted an action accordingly to seek for rescinding the revocation decision.

In the lawsuit of the case, the issue in dispute was a method of the determination in the JPO decision that redefined a problem to be solved by the invention described in the specification by taking into consideration the state of art as of time of the filing.

The court decision has ruled in summary as follows and rescinded the decision:

The appropriateness of the description requirements is an issue on the description of the scope of the claims and the Detailed Description of the Invention. Thus the determination should be made primarily on the basis of these descriptions. The finding and the extraction of a problem to be solved by the invention should be made similarly on the basis of the descriptions (unless there is any exceptional circumstance such as that where the Detailed Description of the Invention contains no description on the problem). Therefore, the state of art as of time of the filing is only a matter to be considered auxiliary in order to understand the description, and in principle, should not be treated as a matter to extract a problem to be solved by the invention. (In other words, as long as a problem to be solved by the invention may be read from the Detailed Description of the Invention, it is sufficient to rely on the described problem in determining the appropriateness of the supporting requirement. It is neither necessary nor reasonable to daringly incorporate well-known technique and publicly-known technique in terms of considering the state of art as of time of the filing and find a problem different from that described in the Detailed Description of the Invention. The comparison with the state of art as of time of the filing should be made, if necessary, as a matter of inventive step.).

When it comes to the Invention, as the decision once found the problem to be solved by the invention as "to provide a rice saccharified material-containing food having richness, sweetness, and deliciousness," the problem can be definitely understood from the Detailed Description of the Invention. Thus it is not at all necessary to daringly redefine (further confine) the problem on the basis of "the state of the art as of time of the filing." Therefore, it is not reasonable that JPO made a decision to redefine the problem as "to provide a rice milk having a significant difference in richness (milky flavor), sweetness, and deliciousness compared to the rice milk of Example 1-1," since this means redefining the problem apart from the description of the Detailed Description of the Invention (by raising the level of the problem to be solved) regardless of the fact that the problem to be solved by the invention can be definitely read from the description.

As seen above, the JPO decision made an error in finding a problem that should be a premise for the determination of the supporting requirement, and as a result, misled to a determination to revoke a patent on the grounds of the violation of the supporting requirement, and thus such decision should be rescinded.

Judgment rendered on May 24, 2018
2017 (Gyo-Ke) 10129 The case of seeking rescission of JPO decision to revoke a patent
Date of conclusion of oral argument: March 22, 2018

Judgment

Plaintiff: TSUNO CO., LTD.
Defendant: Commissioner of the Japan Patent Office

Main text

1. A decision of revocation in connection with Opposition No. 2016-700420 that the Japan Patent Office made on May 8, 2017 shall be rescinded.
2. The court costs shall be borne by Defendant.

Facts and reasons

No. 1 Claim

The same as the main text of this judgment.

No. 2 Outline of the case

1 History of the procedures etc. in the Japan Patent Office

(1) Plaintiff filed a patent application (Japanese Patent Application No. 2015-43376, hereinafter referred to as "the application") for an invention titled "FOOD PRODUCT CONTAINING RICE SACCHARIFIED MATERIAL AND RICE OIL AND/OR INOSITOL" on March 5, 2015 (priority date: February 4, 2015) and received a notice of allowance, and a patent right was registered on October 2, 2015 as Patent No. 5813262 (hereinafter referred to as "the Patent").

(2) An opposition to the grant of the Patent was filed on May 13, 2016 and the Japan Patent Office examined this opposition as the case of Opposition No. 2016-700420.

In the proceedings, a reason for revocation was notified on July 12, 2016, and a written opinion and a demand for correction were submitted on September 13, 2016, a written statement was submitted on September 30, 2016, a written opinion was submitted by the Opponent on November 14, 2016, and thereafter a reason for revocation (preliminary notice of decision) was notified on January 19, 2017, and a written opinion and a demand for correction were submitted on March 27, 2017 (hereinafter the final demand for correction is referred to as "the demand for correction of the case").

Further, the demand for correction on September 13, 2016 was deemed to be withdrawn under the provision of Article 120-5, paragraph (7) of the Patent Act due to the subsequent demand for correction on March 27, 2017 (the demand for correction of the case).

(3) On May 8, 2017, the Japan Patent Office affirmed the demand for correction of the case and made a decision to the effect that "the patents according to Claims 1 to 4 of Patent No. 5813262 shall be revoked." and its certified copies were served to Plaintiff on May 19, 2017 (hereinafter the decision is referred to as "the ruling of the Opposition").

(4) Plaintiff filed a suit for the case seeking for the rescission of the ruling of the Opposition on June 14, 2017.

2 Statement of the Claims

The statement of the Claims after the correction is set forth as below (hereinafter referred to as "the Invention," and when individually identified, identified as "Invention 1" etc. in accordance with a number of a claim. Further, the specification and the drawings according to the Invention are collectively referred to as "the specification").

"[Claim 1]

A rice milk comprising a rice saccharified material and a rice oil comprising 1 to 5 mass% of γ-orizanol, wherein said rice milk comprises 0.5 to 5 mass% of said rice oil.

[Claim 2]

The rice milk of Claim 1, further comprising inositol.

[Claim 3]

The rice milk of Claim 2, further comprising 0.01 to 0.5 mass% of inositol.

[Claim 4]

A food comprising the rice milk according to any one of Claims 1 to 3."

3 Summary of Reason for the decision of the Opposition

The reason for the ruling of the Opposition is as per the attached copy of the written decision. In summary, the Invention is not described in the Detailed Description of the Invention; i.e.,

(1) It cannot be recognized from the description of the specification that the problem to be solved by Invention 1 may be solved across the whole range of the content of 0.5 to 5 mass% in rice milk for all rice oils comprising 1 to 5 mass% of γ-orizanol; and (2) The same can also apply to Inventions 2 to 4, which include all the matters for

specifying Invention 1 and do not add further limitation to rice oil. Therefore, the Invention does not satisfy the requirement of Article 36, paragraph (6), item (i) of the Patent Act (supporting requirement), and the patent according to the Invention should be revoked under the provision of Article 113, item (iv) of the Patent Act.

(omitted)

No. 5 Court decision

1 The Invention

(1) Description of Detailed Description of the Invention

The Detailed Description of the Invention of the specification has the following descriptions (see Tables and Drawings of the specification in the Attachment for Table 1, Figure 1, Figure 2, and Figure 4).

A Technical Field

[0001]

The present invention relates to foods comprising a rice saccharified material and a rice oil and/or inositol.

B Background Art

[0002]

Rice milk is a rice saccharified material-containing food, which is a milk-like beverage whose taste is adjusted by, e.g., adding vegetable oil and salt, etc. to one where rice is saccharified with an enzyme and koji, etc. For example, brown rice is ground and dispersed into water, to which protease, cellulase, pectinase and amylase are added and reacted to produce a rice milk (see Patent Document 1). This method adds enzymes such as protease, cellulase, and pectinase without control. Thus protease produces amino acids and oligopeptides, which is a cause of zatsumi similar to flavor-enhancing additives and its narrowly limited use.

[0003]

Accordingly, a rice saccharified solution is developed with a certain range of amino acid level as a rice saccharified solution with smooth texture and a clear taste without zatsumi (see Patent Document 2). The flavor of sweetness and richness (milky flavor) is not sufficiently improved, and thus the solution is not always satisfactory. Furthermore, granola and hot cake are becoming fashionable, whereas the population of those suffering milk allergy and soybean allergy is growing. Thus there is a need for a substitute of milk and soy milk with improved flavors. Accordingly, various research and development efforts have been made to enrich

dietary lives of people suffering milk allergy or soybean allergy. Another objective is to provide a food that enables us to produce many foods that have been conventionally produced or cooked by use of milk or soybeans without using milk or soy milk.

C Problem to be solved by the invention

[0006]

The present invention has been found as a result of intensive investigation to solve the problem to provide a rice saccharified material-containing food with improved richness, sweetness, deliciousness, etc. Specifically, the present invention has an objective to provide a rice saccharified material-containing food with richness, sweetness deliciousness, etc. Another objective is to provide a food that enables us to produce many foods that have been conventionally produced or cooked by use of milk or beans.

D Means for solving the problem

[0007]

The present invention encompasses the following inventions to solve the above problem:

[1] A food comprising a rice saccharified material and a rice oil and/or inositol.

[2] The food of the aforesaid item [1], wherein the rice oil comprises 0.1 to 40 mass% of γ-orizanol. ...

[5] The food of any one of the aforesaid items [1] to [4], wherein the food comprises 0.1 to 10 mass% of rice oil. ...

E Effects of the Invention

[0009]

The present invention can provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc....

F Embodiments for carrying out the invention

[0011]

The present invention includes foods comprising a rice saccharified material and a rice oil and/or inositol (hereinafter referred to as foods of the present invention). The food of the present invention may be a food containing a rice saccharified material, a rice oil and the other components, or may be a food containing a rice saccharified material, inositol, and the other components, or may be a food containing a rice saccharified material, a rice oil, and inositol and the other components, or may be a food consisting only of a rice saccharified material and a rice oil, or may be a food consisting only of a rice saccharified material and inositol, or may be a food consisting only of a rice saccharified material, inositol and a rice oil.

[0012]

[Rice saccharified material]

Rice saccharified material of the present invention may comprise a hydrolyzed product of glycosidic bond of starch molecule of rice. The rice saccharified material may comprise 0.01 to 99.99 mass% of the hydrolyzed product, or may comprise 15 to 35 mass%. ...

[0013]

[Rice oil]

The rice oil of the present invention is not particularly limited, but may include, for example, a rice crude oil of rice bran as a raw material, a rice oil in the way of purification, purified rice oil as a final product, etc. ... The rice oil of the present invention may comprise, for example, 0.1 to 70 mass% of γ-orizanol, ... may comprise 1 to 5 mass%, ... may comprise 1.4 to 1.6 mass%. The rice oil of the present invention may preferably comprise 1 mass% or more of γ-orizanol. Rice oil containing 1 mass% or more of γ-orizanol may be produced without the exogenous addition of γ-orizanol to rice oil, or may exogenously add γ-orizanol, but is preferably produced without the exogenous addition of γ-orizanol to rice oil. A large amount of γ-orizanol (e.g. 1 mass% or more) in a rice oil of the present invention allows a food of the present invention to show blood circulation promoting effects, sebum secretion promoting effects, blood cholesterols reducing effects, human skin microcirculation hyperfunction effects, capillary permeability suppressing effects, peripheral cutaneous temperature elevating effects, stress improving effects, and alleviation effects of symptoms associated with climacteric disorder.

[0015]

The rice oil of the present invention may include, for example, rice oil (manufactured by TSUNO CO., LTD., 0.2 weight% of γ-orizanol), rice germ oil (rice germ oil PRO-15, manufactured by TSUNO CO., LTD., 1.5 weight% of γ-orizanol), etc.

The food of the present invention may comprise, for example, 0.1 to 10 mass% of the rice oil, may comprise 0.5 to 10 mass%, may comprise 0.5 to 5 mass%, or may comprise 0.5 to 3 mass%.

The food of the present invention containing a rice oil can provide a rice saccharified material-containing food with richness, sweetness, and deliciousness. The food of the present invention comprises a rice oil, thereby particularly imparting a milky flavor as compared to a food containing the other vegetable oils rather than a rice oil. The food of the present invention comprises a rice oil, thereby preventing

degradation in long-term preservation at a normal temperature as compared to a food containing the other vegetable oils, rather than a rice oil, and suppressing odor generation or the elevation of peroxide value (POV) and acid value (AV) (see Japanese Patent No. 5596846).

[0016]

[Inositol]

The food of the present invention may comprise, for example, 0.01 to 0.5 mass% of inositol, may comprise 0.05 to 0.5 mass%, may comprise 0.05 to 1 mass%. ... The food of the present invention comprises inositol, thereby particularly improving the taste of sweetness. The food of the present invention comprises inositol, thereby further exhibiting fat-burning effects, anti-fatty liver effects, etc.

[0023]

[Richness, Sweetness, and Deliciousness]

The food of the present invention is excellent in its richness, sweetness, and deliciousness. ... Regarding richness, sweetness, and deliciousness, a food of the present invention and a food containing, e.g., soybean oil, etc. without rice oil or inositol are subjected to taste test, and when there is any significant difference or significant trend, it is determined as being improved.

G Examples

[0031]

Hereinafter, the present invention will be further illustrated by raising the examples, but should not be construed as being limited to the following examples. Many variations can be made within a scope of the technical idea of the present invention by a person who has an ordinary knowledge in the field.

[0032]

[Production Example 1: Preparation of rice powder]

Non-glutinous rice (hereinafter simply referred to as "rice") was washed until washing water became clear, and immersed into water for one to three hours and left to stand until the water became white. Thereafter, the water was drained away in a colander. Rice was spread on the colander to dry until a part of rice was cracked when rice was pressed with a finger. Dried rice was ground for ten minutes by a mill in an amount of 100 g. Thereafter, rice was sifted by a tea strainer (mesh 160). The rice remaining in the tea strainer was ground with an earthenware mortar into powder. From one go rice, 150 g rice powder was produced.

[0033]

[Production Example 2: Preparation of rice saccharified material]

To 20 g of rice powder there were added 79.9 g of water and 0.1 g of α-amylase (Sumizyme A10, manufactured by Shinnihonseiyaku Co., Ltd.), and while stirring with a stirrer, the mixture was heated for one hour up to 90°C. Thereafter, the mixture was stirred for one hour to obtain a rice saccharified material.

[0034]

[Production Example 3: Preparation of rice saccharified material-containing food (rice milk)]

To a rice saccharified material there were added various oils, inositol (manufactured by TSUNO CO., LTD.), salt, and monoglycerides in various ratios, followed by the addition of water to adjust the concentration to become a composition of the following Table 1. The mixture was stirred for 30 seconds by a mixer, and then left to stand for 30 seconds, and again stirred and mixed for 30 seconds to obtain a rice milk. In addition, the oils used were a rice oil (Rice Oil, manufactured by TSUNO CO., LTD., 0.2 weight% of γ-orizanol), a rice germ oil (Rice Germ Oil PRO-15, manufactured by TSUNO CO., LTD., 1.5 weight% of γ-orizanol, a kind of rice oil), and a soybean oil (Showa Marugoto Soybean Oil, manufactured by Showa Sangyo Co., Ltd.)

[0035]

[Table 1]

[0036]

[Test example 1]

Tastes test was conducted for rice milks with different kinds of contained oils. The evaluation was made by 30 persons selected randomly. The evaluation items were "richness (milky flavor)," "sweetness," and "deliciousness." The evaluation was made with the criteria of "0" for equivalent to the standard rice milk 1, "1" for the case where it was superior to the standard rice milk 1, "2" for the case where it was quite superior to the standard rice milk 1, "-1" for the case where it was inferior to the standard rice milk 1, and "-2" for the case where it was quite inferior to the standard rice milk 1.

[0037]

The results are shown in Figure 1. As shown in Figure 1, the rice milk of the present invention having a kind of oil of rice oil and rice germ oil (Examples 1-1 and 1-2) showed significantly superior results for all the items of richness (milky flavor), sweetness, and deliciousness as compared to the standard rice milk 1. On the other hand, rice milk with a kind of oil of soybean oil (Comparative Example 1) showed significantly inferior results in the item of deliciousness as compared to the standard

rice milk 1. It was demonstrated from this that a rice saccharified material-containing food became a food excellent in richness (milky flavor), sweetness, and deliciousness if rice oil or rice germ oil was further contained.

[0038]

[Test example 2]

Tastes test was conducted for rice milks containing different contents of rice germ oils. The evaluation was made by 30 persons selected randomly. The evaluation items were "richness (milky flavor)," "sweetness," and "deliciousness." The evaluation was made with criteria of "0" for equivalent to the standard rice milk 2, "1" for the case where it was superior to the standard rice milk 2, "2" for the case where it was quite superior to the standard rice milk 2, "-1" for the case where it was inferior to the standard rice milk 2 and "-2" for the case where it was quite inferior to the standard rice milk 2.

[0039]

The results are shown in Figure 2. As shown in Figure 2, rice milks of the present invention having a kind of oil of rice germ oil and the content of 0.5 to 5 mass% (Examples 2-1 to 2-4) showed significantly superior results for all the items of richness (milky flavor), sweetness, and deliciousness as compared to the standard rice milk 2. Further, rice milk of the present invention having a kind of oil of rice germ oil and the content of 10 mass% (Example 2-5) showed significantly superior results for the items of richness (milky flavor) and sweetness as compared to the standard rice milk 2. It was demonstrated from this that a rice saccharified material-containing food is preferable if 0.5 to 10 mass% of rice oil or rice germ oil is contained.

[0040]

[Test example 3]

Tastes test was conducted with rice milks having different contents of inositol. The evaluation was made by 30 persons selected randomly. The evaluation items were "richness (milky flavor)," "sweetness," and "deliciousness." The evaluation was made with the criteria of "0" for equivalent to the standard rice milk 3, "1" for the case where it was superior to the standard rice milk 3, "2" for the case where it was quite superior to the standard rice milk 3, "-1" for the case where it was inferior to the standard rice milk 3 and "-2" for the case where it was quite inferior to the standard rice milk 3.

[0041]

The results are shown in Figure 3. As shown in Figure 3, rice milks of the present invention having different contents of inositol of 0.01 to 0.1 mass% (Examples

3-2 to 3-4) showed significantly superior results for all the items of richness (milky flavor), sweetness, and deliciousness as compared to the standard rice milk 3. Further, rice milks of the present invention having a content of inositol of 0.5 mass% (Examples to 3-1) showed significantly superior results for the items of sweetness and deliciousness compared to the standard rice milk 3. It was demonstrated from this that a rice saccharified material-containing food is preferable if 0.01 to 0.5 mass% of rice oil or rice germ oil is contained.

[0042]

[Test example 4]

Taste tests were conducted to investigate the change of "richness (milky flavor)," "sweetness," and "deliciousness" of rice milk containing a rice germ oil and inositol. The evaluation was made by 30 persons selected randomly. The evaluation items were "richness (milky flavor)," "sweetness," and "deliciousness." The evaluation was made with criteria of "0" for equivalent to the standard rice milk 4, "1" for the case where it was superior to the standard rice milk 4, "2" for the case where it was quite superior to the standard rice milk 4, "-1" for the case where it was inferior to the standard rice milk 4, and "-2" for the case where it was quite inferior to the standard rice milk 4.

[0043]

The results are shown in Table 4. As shown in Figure 4, the inclusion of rice germ oil and inositol exhibited synergistic effects for all the items of "richness (milky flavor)," "sweetness," and "deliciousness" (Examples 4-2 to 4-5). It was demonstrated from this that a rice saccharified material-containing food becomes a food having further excellent richness (milky flavor), sweetness, and deliciousness if rice germ oil and inositol are contained. In addition, the sugar content of the rice milk of Example 4-4 is 17.4 mass% if measured with Hand-held Refractometer PAL-1 (manufactured by ATAGO CO.,LTD).

H Industrial Applicability

[0051]

The present invention can provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc. and is thus industrially applicable.

(2) Comprehensively taking the above description into account, the following matters are recognized with regard to the Invention:

A If various enzymes are added without control in producing a rice saccharified material-containing food of a rice milk, amino acids and oligopeptides are produced by protease, which is a cause of zatsumi of flavor enhancing additives and its limited use

([0002]).

A rice saccharified solution is developed with a certain range of amino acid level as a rice saccharified solution with smooth texture and a clear taste without zatsumi. The flavor of sweetness and richness (milky flavor) is not sufficiently improved, and thus the solution is not always satisfactory. Further, granola and hot cake are becoming fashionable, whereas the population of those suffering milk allergy and soybean allergy is growing. Thus there is a need for a substitute of milk and soy milk with improved flavors ([0003]).

Accordingly, the present invention has an objective to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc. Another objective is to provide a food that enables us to produce many foods that have been conventionally produced or cooked by use of milk or beans ([0006]).

B The present invention includes foods comprising a rice saccharified material and a rice oil and/or inositol ([0011]). The rice oil of the present invention may comprise 1 to 5 mass% of γ-orizanol. Rice oil containing 1 mass% or more of γ-orizanol may be produced without the exogenous addition of γ-orizanol to rice oil, or may exogenously add γ-orizanol ([0013]).

C The present invention can provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc. and is thus industrially applicable ([0051]).

2 Ground 1 for rescission (Error in the determination method)

Article 36, paragraph (6), item (i) of the Patent Act specifies that the statement of the claims should comply with the requirement that "an invention for which a patent is sought should be described in the Detailed Description of the Invention" (supporting requirement). The spirit is to prevent the grant of an exclusive right for an undisclosed invention by reciting an undescribed invention in the Detailed Description of the Invention because it is against the spirit of the patent system, and thus prohibits such a statement of the claims.

Consequently, the determination of whether or not the statement of the Claims might comply with the support requirement should follow the steps of: comparing the statement of the Claims with the descriptions of the Detailed Description of the invention; and considering whether or not the invention recited in the Claims might fall within the scope in which a person ordinarily skilled in the art could recognize that a problem to be solved by the invention might be solved by the description or suggestion of the Detailed Description of the Invention, or considering whether or not the invention recited in the Claims might fall within the scope in which

a person ordinarily skilled in the art could recognize without such description or suggestion in view of common technical knowledge as of the filing that the problem to be solved by the invention might be solved.

Plaintiff argues that the above determination criteria may apply only to "special circumstances," and may not apply to this case (should not be considered); however, the determination criteria may not apply only to "special circumstances" as Plaintiff argues, but relate to general patent inventions, which is obvious from the above spirit of the law.

Therefore, the Plaintiff's argument is not acceptable.

It should be noted that the ruling of the Opposition is erroneous in that it considered the conformance to the supporting requirement with the Invention being construed as an invention of numerical limitation (parameter invention) having a technical feature in the content of γ-orizanol. This point is considered hereinafter in Reasons 2 and 3 for rescission.

3 Reason 2 for rescission (Error in the finding of problem) and Reason 3 for rescission (Error in the determination of a scope where a person ordinarily skilled in the art can recognize that a problem may be solved)

(1) Finding of Problem

A As seen above, the determination of whether or not the statement of the Claims might comply with the support requirement should follow the steps of: comparing the statement of the Claims with the descriptions of the Detailed Description of the invention; and considering whether or not the invention recited in the Claims might fall within the scope in which a person ordinarily skilled in the art could recognize that a problem to be solved by the invention might be solved by the description or suggestion of the Detailed Description of the Invention, or considering whether or not the invention recited in the Claims might fall within the scope in which a person ordinarily skilled in the art could recognize without such description or suggestion in view of common technical knowledge as of the filing that the problem to be solved by the invention might be solved.

Further, it is required to describe matters necessary for a person ordinarily skilled in the art to understand the significance of the invention, including "Problem to be solved by the invention and Means for solution," in the Detailed Description of the Invention (Article 24-2 of Regulations under the Patent Act).

Taking the above into consideration, it is reasonable to find a problem to be solved by the invention in principle, which is a prerequisite for the determination of the

conformance to the supporting requirement, on the basis of the description of the Detailed Description of the Invention in view of common technical knowledge.

When the Invention is considered from such viewpoint, the Detailed Description of the Invention of the specification discloses as background art that the addition of various enzymes without control in producing a rice saccharified material-containing food of a rice milk results in the production of amino acids and oligopeptides, which is a cause of zatsumi similar to flavor enhancing additives and its limited use ([0002]), and a rice saccharified solution is developed with a certain range of amino acid level as a rice saccharified solution with smooth texture and a clear taste without zatsumi, however, the flavor of sweetness and richness (milky flavor) is not sufficiently improved, and thus the solution is not always satisfactory, and furthermore, granola and hot cake are becoming fashionable, whereas the population of those suffering milk allergy and soybean allergy is growing, and thus there is a need for a substitute of milk and soy milk with improved flavors ([0003]). Furthermore, the Detailed Description of the Invention describes a problem to be solved by the invention, stating that "the present invention has been found as a result of intensive investigation to solve the problem to provide a rice saccharified material-containing food with improved richness, sweetness, deliciousness, etc. Specifically, the present invention has an objective to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc. Another objective is to provide a food that enables us to produce many foods that have been conventionally produced or cooked by use of milk or beans." ([0006]).

It can be definitely understood from these descriptions that the Invention has an objective "to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc." by itself.

B On the contrary, the ruling of the Opposition once finds an objective of Invention 1 in a similar manner to the above item A, stating that "It is recognized that the objective of Invention 1 is "to provide a rice saccharified material-containing food with richness, sweetness, and deliciousness" since the patent specification evaluates each evaluation item of 'richness,' 'sweetness,' and 'deliciousness' in the description of 'to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc.' ([0006]) and Examples ([0031] to [0043])", whereas when it comes to the conformance to the supporting requirement, it reformulates the problem, stating that "the objective of Invention 1 is to provide a rice milk with significant difference in richness (milky flavor), sweetness, and deliciousness from the rice milk of Example 1-1," and when it comes to the means for solution, it finds that "To recognize that the

Invention 1 can solve the problem, ... it is necessary to recognize that there is a significant difference in richness (milky flavor), sweetness, and deliciousness from the rice milk of Example 1-1." (Ruling of the Opposition, page 12, lines 16 to 25).

In this regard, the Defendant argues that a problem to be solved by the invention was an unsolved problem in view of the state of art as of the filing, and thus the objective of Invention 1 "to provide a rice saccharified material-containing food with richness, sweetness, and deliciousness" is meant to provide a rice saccharified material-containing food with richness, sweetness, and deliciousness as compared to rice saccharified material-containing foods that constitute the state of art as of the filing (specifically, a rice milk of Example 1-1), and this is why the ruling of the Opposition found an objective of the Invention 1 "to provide a rice milk having a significant difference in richness (milky flavor), sweetness, and deliciousness as compared to the rice milk of Example 1-1" (Therefore, the finding of a problem of the ruling of the Opposition is not erroneous).

Indeed, the problem to be solved by the invention was generally an unsolved problem in view of the state of art as of the filing. Thus it would not be totally prohibited to supplement the description by finding a problem from the state of art in the case of exceptional circumstances, e.g., where the Detailed Description of the Invention did not at all mention the problem.

However, the conformance to the description requirements is a matter of the descriptions of the scope of the claims and the Detailed Description of the Invention. Thus the determination should be made primarily on the basis of these descriptions. The finding and the extraction of a problem should be made similarly on the basis of the descriptions unless there are any exceptional circumstances as mentioned above.

Therefore, the state of art as of the filing is only a matter to be considered auxiliary in order to understand the description, and thus it should not be inherently treated as a matter to extract a problem. (In other words, as long as a problem to be solved by the invention may be read from the Detailed Description of the Invention, it is sufficient to determine the conformance to the supporting requirement on the basis of the problem. It is neither necessary nor reasonable to further incorporate well-known technique and publicly-known technique in the name of considering the state of art as of the filing and find a problem different from that described in the Detailed Description of the Invention. The comparison with the state of art as of the filing should be made, if necessary, as a matter of inventive step.).

When it comes to the Invention, as the ruling of the Opposition once found the problem as "to provide a rice saccharified material-containing food having richness,

sweetness and deliciousness", the problem can be definitely understood from the Detailed Description of the Invention. Thus it is unnecessary to reformulate (further confine) a problem on the basis of "the state of the art as of the filing." (Furthermore, Example 1-1 that the ruling of the Opposition regarded as the state of art is first of all not a publicly-known composition.).

Therefore, the fact that the Japan Patent Office made a decision to reformulate a problem as "to provide a rice milk having a significant difference in richness (milky flavor), sweetness, and deliciousness compared to the rice milk of Example 1-1" is not reasonable since it reformulates a problem apart from the description of the Detailed Description of the Invention (by raising the level of a problem to be solved) regardless of the fact that the problem to be solved by the invention may be definitely read from the description.

As seen above, the finding of a problem in the ruling of the Opposition cannot be said to be reasonable, and thus the Defendant's allegation is not acceptable.

(2) The scope where a person ordinarily skilled in the art can recognize that a problem may be solved

A As aforementioned, it is recognized that the problem of the Invention is to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc. Therefore, it is considered whether or not the Invention falls within a range where a person ordinarily skilled in the art could recognize from the description of the Detailed Description of the Invention that a problem "to provide a rice saccharified material-containing food with richness, sweetness, deliciousness, etc." might be solved.

B Descriptions of Detailed Description of the Invention

(A) Detailed Description of the Invention describes a food containing a rice saccharified material as well as a rice oil and/or inositol as the means for solving the problem, and that the food may contain 0.5 to 5 mass% rice oil, and that the content of γ-orizanol in a rice oil may be 1 to 5 weight% ([0007], [0013], and [0015]).

Further, "[Richness, Sweetness and Deliciousness] The food of the present invention is excellent in its richness, sweetness, and deliciousness. ... Regarding richness, sweetness, and deliciousness, a food of the present invention and a food containing, e.g., soybean oil, etc. without rice oil or inositol are subjected to taste test, and when there is any significant difference or significant trend, it is determined as being improved." ([0023]). In view of this, it can be seen that the Detailed Description of the Invention describes the addition of rice oil or inositol or both of them to rice milk as the means for solving the problem.

(B) Examples of the Detailed Description of the Invention describe production examples 1 to 3 in which rice milks containing a rice saccharified material were prepared from rice powder as well as test examples 1 to 4 in which taste test of rice milk was conducted ([0031] to [0043]).

Here, the content of γ-orizanol in a rice oil used for the preparation of rice milk is 0.2 weight% for rice oil and 1.5 weight% for rice germ oil ([0034]). Therefore, the rice milk of the embodiments encompassed into the scope of the Invention 1 is Example 1-2 used for test examples 1 and 4, Examples 2-1 to 2-4 for test example 2 and further Examples 4-2 to 4-5 for test example 4 ([0035] Table 1).

(C) Further, when it comes to the method of the above taste test, according to the description of [0036], [0038], and [0042], it can be seen that the evaluation was made by randomly-selected 30 persons by setting a standard rice milk for comparison for each test for the evaluation items of "richness (milky flavor)," "sweetness," and "deliciousness" in comparison to the standard rice milks, with criteria of "0" for equivalent to the standard rice milk, "1" for the case where it was superior to the standard rice milk, "2" for the case where it was quite superior to the standard rice milk, "-1" for the case where it was inferior to the standard rice milk, and "-2" for the case where it was quite inferior to the standard rice milk.

C Result of the above test using a rice milk within the scope of the Invention

(A) Regarding test example 1

According to Figure 1 showing a result of the test example 1, the rice milk of Example 1-2 containing 3 mass% rice germ oil in which 1.5 weight% γ-orizanol was contained scored 1.5 point or more for all items of richness (milky flavor), sweetness, and deliciousness as compared to the standard rice milk 1 free of oil, which shows the superiority to the standard rice milk 1.

Further, the bottom part of Figure 1 describes "*$p<0.05$, **$p<0.01$ (t-test)." The graph of Figure 1 indicates "**" for all of each evaluation item of richness (milky flavor), sweetness, and deliciousness with respect to Example 1-2. This indicates that the result of the comparison between the standard rice milk 1 and Example 1-2 in the test example 1 is statistically significant with a high precision of $p<0.01$ by t-test for all evaluation items.

Consequently, the result shown in Figure 1 for rice milk of Example 1-2 in test example 1 confirmed a significant difference by comparing with a standard rice milk and conducting a statistical evaluation by randomly-selected 30 persons in organoleptic examination on the taste of human sensor such as richness (milky flavor), sweetness, and deliciousness, and thus it was an objective result of evaluation that clarified the

evaluation criteria and excluded subjective view.

Further, the Detailed Description of the Invention describes a rice saccharified material-containing food containing a rice saccharified material as well as a rice oil and/or inositol as means for solving the problem in Invention 1. As is practically shown in the result of Figure 1, the rice milk of Example 1-2 corresponding to the rice milk of Invention 1 is superior to the standard rice milk 1 lacking the above means for solving the problem for all items of richness (milky flavor), sweetness, and deliciousness. It is thus supported that the above means for solving the problem may solve the problem with regard to at least the specific rice milk of Example 1-2.

(B) Regarding test example 2

According to Table 1 of [0035], test example 2 is a taste test that evaluates rice milk containing different amounts of rice germ oil, which is a rice oil containing 1.5 weight% γ-orizanol, in comparison to the standard rice milk 2 free of rice oil. It is recognized that test example 2 ensured objectivity in a similar way to test example 1 in view of the test method described in [0038] and the statistical evaluation described in Figure 2.

According to Figure 2, the rice milks of Examples 2-1 to 2-4 are superior to standard rice milk 2 for all evaluation items. The contents of rice germ oil are 1 weight% for Example 2-2, 3 weight% for Example 2-3, and 5 weight% for Example 2-4. It is thus supported that the content of rice oil as a solution for improved richness, sweetness, and deliciousness of rice saccharified material-containing food is in the range of 1 to 5 weight%.

(C) Regarding test example 4

Test example 4 relates to Examples corresponding to Inventions 2 and 3 further containing inositol in addition to rice oil where the taste test and statistical evaluation were conducted in a similar manner to test examples 1 and 2, and the scores of Examples 4-2 to 4-5 containing inositol and 3 mass% rice germ oil all exceed the standard rice milk 4 free of inositol and Example 2-3 that includes inositol but is free of rice oil ([0035] Table 1, [0042] and [0043] Figure 4).

Therefore, it can be said that Inventions 2 and 3 including inositol as well as rice oil also fall within a range where a problem may be solved.

(D) Further, comprehensively taking the results of the above test examples 1, 2, and 4, it can be said that Invention 4 also falls within a range where a problem may be solved.

D As seen above, all of the Inventions fall within a range where a person ordinarily skilled in the art could recognize from the description of the Detailed Description of the Invention that a problem "to provide a rice saccharified material-

containing food with richness, sweetness, deliciousness etc." might be solved.

(3) Defendant's allegation

In response to this, on the premise that the Invention is an invention with numerical limitation having a technical feature in the content of γ-orizanol and the objective is "to provide a rice milk having a significant difference in richness (milky flavor), sweetness, and deliciousness as compared to the rice milk of Example 1-1," the Defendant argues that Examples of the Detailed description of the invention confirmed the effects only for (rice milk of Example 1-2 = rice milk including 3 mass% of) rice germ oil with a content of γ-orizanol of 1.5 weight%, and it cannot be generalized to rice milks including 0.5 to 5 mass% rice oil with a content of γ-orizanol of 1 to 5 mass%, and thus the Invention does not conform to the supporting requirement.

As discussed in aforesaid item (1), however, the finding of the problem as Defendant argues is erroneous from the start, and thus the Defendant's argument is not acceptable.

(4) Summary

As seen above, the ruling of the Opposition made an error in the finding of a problem that premises the determination of the supporting requirement, which also leads to an erroneous determination as to whether or not a person ordinarily skilled in the art could recognize from the description of the Detailed Description of the Invention that a problem could be solved by the Invention, and leads to a conclusion of patent revocation on the grounds of the violation of the supporting requirement.

Therefore, Reason 2 and Reason 3 for rescission have a point.

4 Conclusion

As seen above, the ruling of the Opposition contains illegality to be rescinded, and thus shall be rescinded and the court judges as in the formal adjudication.

Intellectual Property High Court, Third Division

Presiding Judge TSURUOKA Toshihiko

Judge TERADA Toshihiko

Judge MAGIRA Hiromitsu

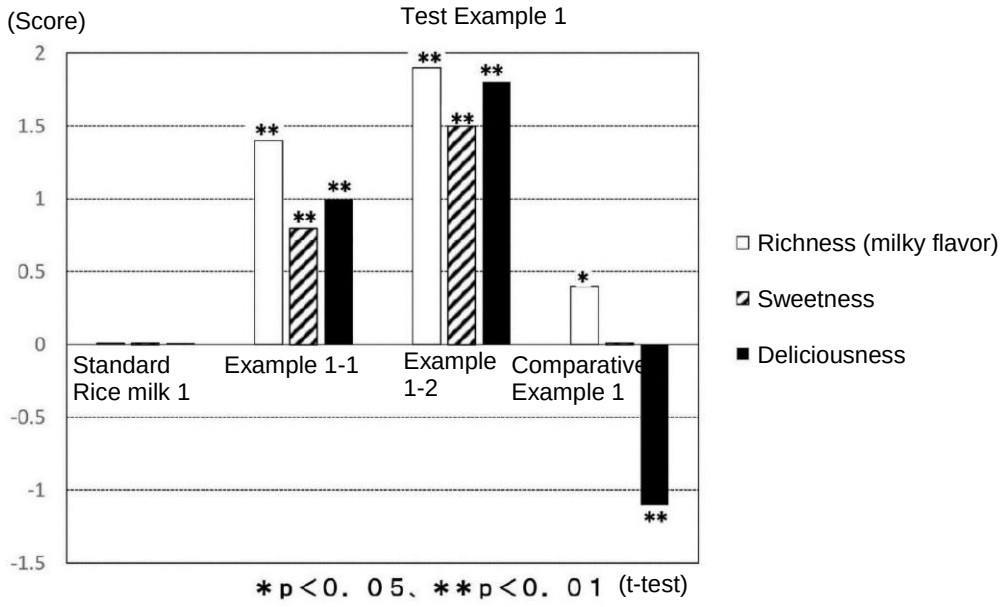
(Attachment) Tables and Drawings of the specification

[Table 1]

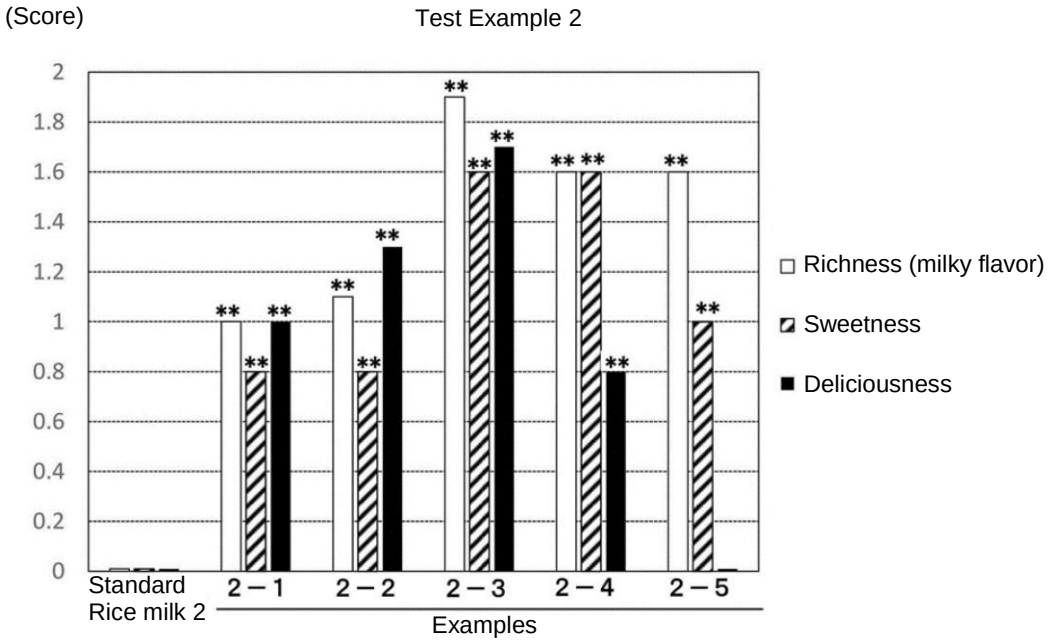
		Composition of Rice milk (In Table, % indicates mass percent.)						
		20 mass% rice saccharified solution	Oil	Kind of Oil	Inositol	Water	Salt	Monoglyceride
Test Example 1	Standard rice milk 1	16%	0%		0%	83.70 %	0.10 %	0.20%
	Example 1-1		3%	Rice oil		80.70 %		
	Example 1-2		3%	Rice germ oil		80.70 %		
	Comparative Example 1		3%	Soybean oil		80.70 %		
Test Example 2	Standard rice milk 2	16%	0%	Rice germ oil	0%	83.70 %	0.10 %	0.20%
	Example 2-1		0.50 %			83.20 %		
	Example 2-2		1%			82.70 %		
	Example 2-3		3%			80.70 %		
	Example 2-4		5%			78.70 %		
	Example 2-5		10%			73.70 %		
Test Example 3	Standard rice milk 3	16%	0%		0%	83.70 %	0.10 %	0.20%
	Example 3-1				0.01 %	83.69 %		
	Example 3-2				0.05 %	83.65 %		
	Example 3-3				0.1%	83.60 %		
	Example 3-4				0.5%	83.20 %		

Test Example 4	Standard rice milk 4 (Example 1-2)	16%	3%	Rice germ oil	0%	80.70 %	0.10 %	0.20%
	Example 2-3		0%		0.1%	83.60 %		
	Example 4-2		3%		0.01 %	83.70 %		
	Example 4-3		3%		0.05 %	80.65 %		
	Example 4-4		3%		0.1%	80.60 %		
	Example 4-5		3%		0.50 %	80.20 %		

[Figure 1]

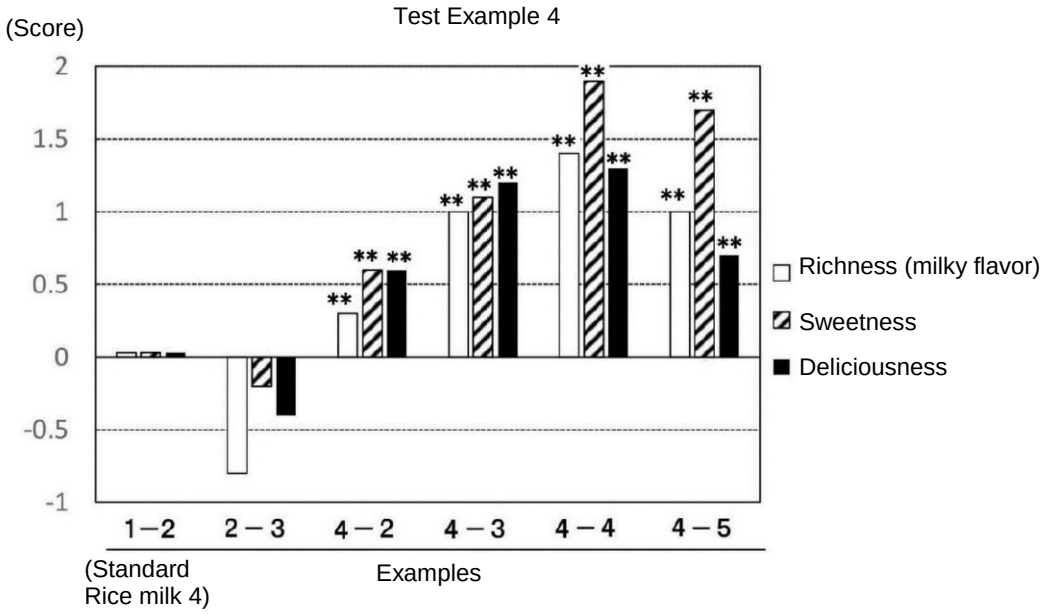


[Figure 2]



＊p＜0．05、＊＊p＜0．01 (t-test)

[Figure 4]



＊p＜0．05、＊＊p＜0．01 (t-test)