Patent Right	Date	October 5, 2023	Court	Intellectual Property High Court, Second Division
	Case number	2022 (Gyo-Ke) 10125		
- A case in which a JPO decision was rescinded on the grounds that the decision erred in the determination on whether or not a correction is compliant.				

Case type: Rescission of Trial Decision of Invalidation

Result: Granted

References: Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act

Related rights, etc.: Patent No. 6585232

Decision of JPO: Invalidation Trial No. 2020-800082

Summary of the Judgment

1. The present case is a suit against a trial decision that held a request for correction by the Plaintiff, who is a patentee, to be non-compliant and that invalidated a patent with regard to an invention titled "COMPOSITIONS COMPRISING 2,3-DICHLORO-1,1,1-TRIFLUOROPROPANE, 2-CHLORO-1,1,1-TRIFLUOROPROPENE, 2-CHLORO-1,1,1,2-TETRAFLUOROPROPANE, OR 2,3,3,3-TETRAFLUOROPROPENE" (Number of claims: 7). The issue of this case is the presence or absence of a violation of the correction requirement.

2. The present judgment recognized the Plaintiff's claim to be well founded, and rescinded the present trial decision. The reasons are outlined as follows.

(1) A correction of the scope of claims, etc. must be made "within the scope of the matters disclosed in the description, claims, or drawings attached to a written application" (Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act). This can be interpreted as requiring that the invention be fully disclosed from the time of filing the original application to thereby ensure prompt granting of rights and to prevent unforeseen disadvantages to third parties who acted on the premise of the scope of the invention disclosed at the time of filing the application. It is reasonable to interpret that the phrase "matters disclosed in the description, claims, or drawings attached to a written application" means technical matters that can be derived by a person ordinarily skilled in the art after taking the entire disclosure of the description, claims, or drawings into overall consideration (hereinafter merely referred to as "the original technical matters"). In a case where a correction does not introduce a new technical matter in relation to the original technical matters, it can be deemed that the correction is made "within the scope of the matters disclosed in the description, claims, or drawings."

(2) It can be found that the content of the original technical matters in the present case is the following: in preparing HFO-1234yf, by-products and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) can be present in small amounts as additional compounds; and with regard to Present Invention 1 (A composition comprising HFO-1234yf, HFC-254eb, and HFC-245cb), at least HFC-254eb and HFC-245cb are included as the additional compounds.

On the other hand, the present description, etc. state compositions comprising HFC-254eb and HFC-245cb as well as other compounds in the process of preparing HFO-1234yf. However, the present description, etc. do not state anything about HCFC-225cb. In addition, from the statement of the present description, etc., it cannot be recognized to be obvious to a person ordinarily skilled in the art that the composition comprises HCFC-225cb due to HCFC-225cb being generated as a by-product in the process of preparing HFO-1234yf or HCFC-225cb being contained as an impurity in HFO-1234yf or its raw materials. Thus, even taking into overall consideration the entire statement of the present description, etc., a person ordinarily skilled in the art cannot derive the technical matter of including HCFC-225cb in Present Invention 1.

Further, Present Correction Invention 1 is "A composition comprising HFO-1234yf, HFC-254eb, and HFC-245cb (except for a composition comprising 1% by weight or more of HCFC-225cb)." (the underlined portion has been added by the correction). By the present correction, a composition comprising 1% by weight or more of HCFC-225cb has been excluded from Present Invention 1. However, the present correction cannot be deemed to cause any change in the technical matters concerning Present Invention 1 stated in the present description, etc. Thus, the present correction has not added a new technical matter to the technical matters disclosed in the present description, etc.

(3) The Defendant asserts that the present correction cannot be deemed to be a correction excluding a portion identical to the Exhibit Ko 4 invention and cannot be allowed, because the disclaimer does not fall under "a correction excluding a portion identical to an invention of the prior application from an invention claimed in a patent application." However, in the Patent Act, it is not required to exclude only a portion identical to the invention of the prior application, nor to exclude only a portion identical to the prior art that was known prior to the filing of the patent application. In addition, when a correction does not introduce a new technical matter in relation to the original technical matters, it is difficult to consider that the correction will cause unforeseen damage to third parties. Thus, as an interpretation of the correction

requirement, it should be deemed to be unreasonable to add the requirements as asserted by the Defendant.

(4) The present trial decision did not allow the present correction on the grounds that the correction introduces a new technical matter, and invalidated the present patent for the present invention. However, the present correction cannot be deemed to introduce a new technical matter, as mentioned above. Therefore, it is inescapable to rescind the present trial decision on the grounds that the trial decision erred in the interpretation of the correction requirement stipulated in Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act.

Judgment rendered on October 5, 2023
2022 (Gyo-Ke) 10125 Case of seeking rescission of the trial decision
Date of conclusion of oral argument: August 1, 2023

Judgment

Plaintiff: The Chemours Company FC, Limited Liability Company

Defendant: AGC Inc.

Main text

1. The court shall rescind the decision made by the Japan Patent Office (JPO) on August 16, 2022 with regard to the case of Invalidation Trial No. 2020-800082.
2. The court costs shall be borne by the Defendant.

Facts and reasons

No. 1 Judicial decision sought by the Plaintiff

The same gist as the main text.

No. 2 Outline of the case

The present case is a suit against a trial decision that invalidated a patent with regard to inventions according to Claims 1 to 7 of Patent No. 6585232, in which the issue is the presence or absence of a violation of the correction requirement stipulated in Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2 of the same Act.

1. History of procedures at the JPO (Entire import of the oral argument)

(1) The Plaintiff is a patentee of the patent for the invention titled "COMPOSITIONS COMPRISING 2,3-DICHLORO-1,1,1-TRIFLUOROPROPANE, 2-CHLORO-1,1,1-TRIFLUOROPROPENE, 2-CHLORO-1,1,1,2-TETRAFLUOROPROPANE, OR 2,3,3,3-TETRAFLUOROPROPENE" (Patent No. 6585232, hereinafter referred to as "the present patent"). For the present patent, a divisional application was filed on May 28, 2018 (Original filing date: May 7, 2009; Priority claim under the Paris Convention: May 7, 2008, United States of America), and establishment of a patent right was registered on September 13, 2019 (Exhibit Ko 55).

(2) The Defendant filed a request for a trial for invalidation of the present patent (Number of claims: 7) on September 18, 2020. The Japan Patent Office

examined this request as the case of Invalidation Trial No. 2020-800082. Then, the Japan Patent Office gave an advance notice of a trial decision on October 13, 2021 (Exhibit Ko 50). The Plaintiff filed a written request for correction (Exhibit Ko 52; hereinafter, correction made by this written request for correction will be referred to as "the present correction") on January 17, 2022, requesting that the scope of claims of the present patent be corrected. However, the Japan Patent Office held that the present correction shall not be allowed, and rendered a trial decision that "the patent for the inventions according to Claims 1 to 7 of Patent No. 6585232 shall be invalidated" (hereinafter referred to as "the present trial decision"; for the overseas resident, 90 days were added to a statute of limitations for filing an action) on August 16 of the same year. A certified copy of the present trial decision was served on the Plaintiff on the 26th of the same month.

The Plaintiff filed the present suit on December 15 of the same year.

2. Summary of the invention

(1) The statement of Claims 1 to 7 in the scope of claims of the present patent before the present correction is as follows (hereinafter, the term "claim" will refer to a claim in the scope of claims of the present patent unless otherwise specified).

[Claim 1]

A composition comprising

HFO-1234yf, HFC-254eb, and HFC-245cb.

[Claim 2]

Use of the composition according to Claim 1 as a refrigerant.

[Claim 3]

Use of the composition according to Claim 1 as a refrigerant in air conditioners, freezers, refrigerators, heat pumps, water chillers, flooded evaporator chillers, direct expansion chillers, centrifugal chillers, walk-in coolers, mobile refrigerators, mobile air-conditioning units, and combinations thereof.

[Claim 4]

Use of the composition according to Claim 1 as an aerosol propellant.

[Claim 5]

Use of the composition according to Claim 1 as a foaming agent.

[Claim 6]

A method of using the composition according to Claim 1, wherein the composition comprises a composition that transfers heat from a heat source to a heat sink.

[Claim 7]

A method of using the composition according to Claim 1 as a refrigerant in a cycle comprising a composition that undergoes a phase transition from a liquid to a gas and returns.

(2) Content of the present correction

The statement "A composition comprising ..." in Claim 1 is corrected to recite "A composition comprising ... (except for a composition comprising 1% by weight or more of HCFC-225cb)" (the same correction applies to Claims 2 to 7 that depend from Claim 1).

3. Summary of reasons of the present trial decision

(1) Whether the present correction complies with the correction requirement

A. Correction Matter 1 pertaining to the present correction is as mentioned in 2(2) above.

B. In the description, claims, or drawings attached to the written application for the present patent (hereinafter referred to as "the present description, etc."), as a statement on a composition comprising all of "HFO-1234yf," "HFC-254eb," and "HFC-245cb", the contained amount (mole percent) of these components is shown in each of the row "500" for temperature (°C) in Table 5 ([Table 6]) and the row "3" for time in Table 6 ([Table 7]).

These were obtained by analyzing components of outflow from a reactor using on-line GCMS. Table 5 ([Table 6]) shows the outflow components when the reactor temperature was changed, and Table 6 ([Table 7]) shows the outflow components collected periodically at reactor temperatures of 575°C and 400°C. Other than these two, none of the outflows from the reactor is not shown to comprise all of "HFO-1234yf," "HFC-254eb," and "HFC-245cb" simultaneously.

Hence, the present description, etc. merely state a composition comprising all of "HFO-1234yf," "HFC-254eb," and "HFC-245cb" in an integrated manner without specifically distinguishing the composition from many other compositions.

In addition, it cannot be found that the present description, etc. substantially state the composition comprising "HFO-1234yf," "HFC-254eb," and "HFC-245cb" simultaneously with supporting evidence.

In order to assert that the correction of a so-called "disclaimer" with a numerical range limitation as in the present correction does not add a new matter, it can be interpreted to require that an "excluded" subject matter can be deemed to exist; i.e., it can be interpreted to require that the invention according to Claim 1 before the correction (hereinafter referred to as "Present Invention 1"; hereinafter, each of the inventions according to Claims 1 to 7 will be referred to as "Present Invention 1,"

"Present Invention 2," and the like according to each claim number; Present Inventions 1 to 7 will collectively be referred to as "the present invention") can be deemed to include "a composition comprising 1% by weight or more of HCFC-225cb", or that even if an "excluded subject matter" does not exist, Present Invention 1 can be deemed to include "a composition comprising less than 1% by weight of HCFC-225cb" because it will be explicitly indicated that the invention according to Claim 1 after the correction (hereinafter referred to as "Present Correction Invention 1") includes "a composition comprising less than 1% by weight of HCFC-225cb."

However, Claim 1 before the correction does not include a definition for HCFC-225cb, and Claims 2 to 7, which depend from Claim 1, also do not include a definition for HCFC-225cb. In addition, no statement on HCFC-225cb can be found in the present description, etc. as well. Hence, it is not clear whether "HCFC-225cb" is included in Present Invention 1. Further, there is no common general technical knowledge that HCFC-225cb is contained in any of the reaction products stated in the present description, etc.

Furthermore, since there is no statement on HCFC-225cb in the present description, etc., there is no other choice but to deem that the contained amount of HCFC-225cb is unknown. That is, it should be deemed that Present Invention 1 is not supposed to include "HCFC-225cb."

Thus, it cannot be deemed that Present Invention 1 includes "a composition comprising 1% by weight or more of HCFC-225cb", nor can it be deemed that Present Invention 1 includes "a composition comprising less than 1% by weight of HCFC-225cb."

C. As mentioned in the foregoing, Correction Matter 1 introduces a new technical matter in relation to the matters disclosed in the description, claims, or drawings attached to the written application, and falls under the addition of a new matter, thus violating the provision of Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act.

Therefore, the present correction cannot be allowed.

(2) Validity of the Present Invention

A. Exhibit Ko 4 (International Publication No. WO2007/086972) discloses "a volatile material containing $CF_3CF=CH_2$ (HFC-1234yf) (10%), $CF_3CF_2CH_3$ (20%), CF_3CFHCH_3 (48%), and HCFC-225cb (20%)" (hereinafter referred to as "Exhibit Ko 4 invention"). Thus, Present Invention 1 is the Exhibit Ko 4 invention. In addition, Present Inventions 2 to 7 are the Exhibit Ko 4 invention, or could easily have been made by a person ordinarily skilled in the art on the basis of the Exhibit Ko 4

invention. Therefore, the present invention may not be granted a patent under the provision of Article 29, paragraph (1), item (iii) of the Patent Act or the provision of Article 29, paragraph (2) of the same Act, and Reason 3 for Invalidation (novelty and an inventive step) is well founded.

B. Additionally, it is not possible to accept all of reasons for invalidation asserted by the Defendant; i.e., Reason 1 for Invalidation (violation of the clarity requirement), Reason 2 for Invalidation (violation of the support requirement), Reason 4 for Invalidation (lack of novelty and an inventive step based on Exhibit Ko 14 (International Publication No. WO2008/079265) on the premise of violation of the division requirement), and Reason 5 for Invalidation (lack of novelty and an inventive step based on Exhibit Ko 16 (National Publication of International Patent Application No. 2011-520017) on the premise of violation of the division requirement).

(omitted)

No. 5 Judgment of this court

1. Present invention

(1) The present description, etc. state as shown in Attachment "Patent Gazette" (Exhibit Ko 55).

(2) Summary of the present invention

According to the statement in (1) above, the present invention relates to the field of compositions useful as heat transfer compositions, aerosol propellants, foaming agents, blowing agents, solvents, cleaning agents, carrier fluids, displacement drying agents, buffing abrasion agents, polymerization media, expansion agents for polyolefins and polyurethanes, gaseous dielectrics, fire extinguishers, and fire extinguishers in the form of liquid or gas, and new environmental regulations have led to the need for new compositions for use in refrigeration, air conditioning, and heat pump apparatus, and against this background, compounds with low global warming potential are of particular interest, and under these circumstances, the present applicants have found that in preparing such new compounds with low global warming potential, such as 1234yf, certain additional compounds are present in small amounts ([0001] to [0003]).

2. Exhibit Ko 4

Exhibit Ko 4 (International Publication No. WO2007/086972), which was internationally published on August 2, 2007, discloses as follows (its Japanese translation is based on Exhibit Ko 6 (National Publication of International Patent

Application No. 2009-514951) that is the corresponding national publication gazette).

[0002]

Background of the Invention

Many halocarbons, in particular lower halocarbons, are used in a variety of applications, such as refrigerants, propellant gases, fire extinguishers, and foaming agents, in foam and in many other forms. The term "halocarbon" as used herein means a compound containing carbon, one or more halogens, and hydrogen as an optional element. Halocarbons of particular interest in the present invention are "C3 halocarbons," which are halocarbons having three carbon atoms in their chain, including C3 hydrochlorofluorocarbons, C3 hydrofluorocarbons, and C3 hydrofluoroolefins. Examples of such compounds include $CF_3CF_2CHCl_2$ (HCFC-225ca), $CClF_2CF_2CHClF$ (HCFC-225cb), $CF_3CF_2CH_2Cl$ (HCFC-235ca), $CF_3CF_2CH_3$ (HFC-245cb), CF_3CFHCH_3 (HFC-254eb), and $CF_3CF=CH_2$ (HFO-1234yf).

[0009]

Summary of the Invention

... The present U.S. applicants have found an advantageous method and/or means of converting a halocarbon blend such as HCFC-225ca, in particular an isomeric blend of HCFC-225ca and HCFC-225cb, into a composition comprising HCFC-225cb but comprising little or no HCFC-225ca....

[0010]

... In certain preferred embodiments, the conversion step, which preferably comprises reduction, produces C3 hydrofluorocarbons including pentafluorinated C3 hydrofluorocarbons, such as $CF_3CF_2CH_3$ (HFC-245cb), and tetrafluorinated C3 hydrofluorocarbons, such as $HCF_2CF_2CH_3$. In certain preferred embodiments, the preferred conversion step produces C3 hydrofluoroolefins such as trifluorinated C3 hydrofluoroolefins, tetrafluorinated C3 hydrofluoroolefins, and pentafluorinated C3 hydrofluoroolefins, for example the trifluorinated olefin $CF_3CH=CH_2$, the tetrafluorinated olefin $CF_3CF=CH_2$ (HFC-1234yf), and the pentafluorinated olefin $CF_3CF=CFH$ (HFC 1225ye) ....

[0012]

Thus, one aspect of the present invention relates to an advantageous method of preparing a hydrofluorocarbon directly from a halocarbon blend comprising HCFC-225cb, and more preferably from a blend comprising HCFC-225cb and HCFC-225ca. Preferably, this method is carried out without converting a substantial amount of the HCFC-225cb to other compounds. In particular embodiments, this method comprises the steps of: (a) providing a halocarbon blend comprising 1,3-dichloro-

1,1,2,2,3-pentafluoropropane (HCFC-225cb) and at least one other halocarbon that is not a hydrofluorocarbon; and (b) contacting the blend with a reducing agent under conditions effective to convert at least a substantial portion of the at least one other halocarbon into at least one hydrofluorocarbon. In certain preferred embodiments, the other halocarbon is a C3 HCFC, preferably HCFC-225cb, and the one hydrofluorocarbon preferably comprises at least one C3 hydrofluoroolefin, preferably at least one tetrafluoropropene, and even more preferably $CF_3CF=CH_2$ (HFO-1234yf).

[0013]

Another aspect of the present invention relates to a method of selectively reducing one or more compounds in a halocarbon blend comprising HCFC-225cb .... In particular embodiments, this method preferably comprises the steps of: (a) providing a halocarbon blend comprising HCFC-225cb and at least one other halocarbon that is not a hydrofluorocarbon; and (b) contacting the blend with a reducing agent to reduce at least a portion of the other halocarbon without reducing a majority of the HCFC-225cb, preferably without reducing more than about 90 percent by weight of the HCFC-225cb.

[0015]

Preferred blends according to the present invention are those comprising the compound HCFC-225cb .... In still other preferred embodiments, the blend consists essentially of from about 1 to about 99 percent by weight of HCFC-225cb (more preferably from about 40 to about 55 percent by weight of HCFC-225cb) and from about 1 to about 99 percent by weight of HCFC-225ca (more preferably from about 45 to about 60 percent by weight of HCFC-225ca).

[0027]

Working Example 2:

This working example describes the reduction of a blend of HCFC-225ca/cb with excess hydrogen at 120°C.

[0028]

The reaction of Working Example 1 was repeated, except that the reaction was conducted at 120°C. The volatile materials (44 g) collected in a cold trap were analyzed by GC. As a result, the GC confirmed the production of $CF_3CF=CH_2$ (HFC-1234yf) (10%), $CF_3CF_2CH_3$ (20%), CF_3CFHCH_3 (48%), and HCFC-225cb (20%). GC of the pot residue mainly confirmed the solvent ethanol and unreacted 225cb.

3. Whether or not the present correction is compliant

(1) The present correction is that the statement "A composition comprising

HFO-1234yf, HFC-254eb, and HFC-245cb." of Claim 1 in the scope of claims of the present patent is corrected to recite "A composition comprising HFO-1234yf, HFC-254eb, and HFC-245cb (except for a composition comprising 1% by weight or more of HCFC-225cb)." (the portion to be corrected by the present correction is underlined). By the present correction, Claims 2 to 7, which depend from the statement of Claim 1, are also corrected.

(2) The present correction was requested by the Plaintiff, who is the respondent of the trial for patent invalidation with regard to the present patent, in response to an advance notice of a trial decision (Exhibit Ko 50; Article 164-2, paragraph (1) of the Patent Act) to the effect that a reason for invalidation is found on the grounds of lack of novelty and an inventive step over Exhibit Ko 4 invention (Exhibit Ko 52; Article 134-2, paragraph (1), the main clause of the same Act).

(3) A correction of the scope of claims etc. must be made "within the scope of the matters disclosed in the description, claims, or drawings attached to a written application" (Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act). This can be interpreted as requiring that the invention be fully disclosed from the time of filing the original application to thereby ensure prompt grant of rights and to prevent unforeseen disadvantages to third parties who acted on the premise of the scope of the invention disclosed at the time of filing the application. It is reasonable to interpret that the phrase "matters disclosed in the description, claims, or drawings attached to a written application" means technical matters that can be derived by a person ordinarily skilled in the art after taking the entire disclosure of the description, claims, or drawings into overall consideration (hereinafter merely referred to as "the original technical matters"). In a case where a correction does not introduce a new technical matter in relation to the original technical matters, it can be deemed that the correction is made "within the scope of the matters disclosed in the description, claims, or drawings."

(4) In the present case, it can be recognized that the present correction was made "within the scope of the matters disclosed in the description, claims, or drawings" for the following reasons.

A. (A) The statement of the scope of claims for Present Invention 1 is "A composition comprising HFO-1234yf, HFC-254eb, and HFC-245cb." It is apparent that the composition literally comprises HFO-1234yf, HFC-254eb, and HFC-245cb. As far as the composition literally comprises these compounds, it can be interpreted that compositions comprising any materials other than these compounds may be included in the scope of claims.

(B) The present description, etc. state that "The applicants have found that in preparing new compounds with low global warming potential, such as 1234yf, certain additional compounds are present in small amounts." ([0003]), "According to the present invention, there is provided a composition comprising HFO-1234yf and at least one additional compound selected from the group consisting of HFO-1234ze, HFO-1243zf, HCFC-243db, HCFC-244db, HFC-245cb, HFC-245fa, HCFO-1233xf, HCFO-1233zd, HCFC-253fb, HCFC-234ab, HCFC-243fa, ethylene, HFC-23, CFC-13, HFC-143a, HFC-152a, HFO-1243zf, HFC-236fa, HCO-1130, HCO-1130a, HFO-1336, HCFC-133a, HCFC-254fb, HCFC-1131, HFC-1141, HCFO-1242zf, HCFO-1223xd, HCFC-233ab, HCFC-226ba, and HFC-227ca. The composition comprises less than about 1 percent by weight of the at least one additional compound." ([0004]), "In one embodiment, the total amount of the additional compounds in the composition comprising HFO-1234yf ranges from more than zero percent by weight to less than 1 percent by weight." ([0012]). In view of these statements, the present description, etc. can be deemed to state: [i] in preparing HFO-1234yf, certain additional compounds are present in small amounts; and [ii] the total amount of additional compounds in the composition comprising HFO-1234yf ranges from more than zero percent by weight to less than 1 percent by weight.

In addition, taking into the overall consideration the statements of [0013], [0016], [0019], [0022], [0030], and [Figure 1] in the present description, etc., the present description, etc. can be deemed to state that by-products generated in the process of preparing HFO-1234yf and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) fall under the additional compounds.

B. On the basis of each statement in A above, it can be found that the content of the original technical matters in the present case is the following: in preparing HFO-1234yf, by-products and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) can be present in small amounts as the additional compounds; and with regard to Present Invention 1, at least HFC-254eb and HFC-245cb are included as the additional compounds.

On the other hand, the present description, etc. state compositions comprising HFC-254eb and HFC-245cb as well as other compounds in the process of preparing HFO-1234yf ([Table 6] Table 5, [Table 7] Table 6). However, the present description, etc. do not state anything about HCFC-225cb. In addition, from the statement of the present description, etc., it cannot be recognized to be obvious to a person ordinarily skilled in the art that the composition comprises HCFC-225cb due

to HCFC-225cb being generated as a by-product in the process of preparing HFO-1234yf or HCFC-225cb being contained as an impurity in HFO-1234yf or its raw materials. Thus, even taking the entire statement of the present description, etc. into overall consideration, a person ordinarily skilled in the art cannot derive the technical matter of including HCFC-225cb in Present Invention 1.

C. Present Correction Invention 1 is "A composition comprising HFO-1234yf, HFC-254eb, and HFC-245cb (except for a composition comprising 1% by weight or more of HCFC-225cb)." By the present correction, a composition comprising 1% by weight or more of HCFC-225cb has been excluded from Present Invention 1. However, in light of B above, the present correction cannot be deemed to cause any change in the technical matters concerning Present Invention 1 stated in the present description, etc. Thus, the present correction has not added a new technical matter to the technical matters disclosed in the present description, etc.

D. The present trial decision interpreted that in order to recognize that the correction of a so-called "disclaimer" with a numerical range limitation does not add a new matter, it can be interpreted to require that an "excluded" subject matter can be deemed to exist; i.e., Present Invention 1 can be deemed to include "a composition comprising 1% by weight or more of HCFC-225cb", or that even if an "excluded" subject matter does not exist, Present Invention 1 can be deemed to include "a composition comprising less than 1% by weight of HCFC-225cb" because it will be explicitly indicated that Present Invention 1 includes "a composition comprising less than 1% by weight of HCFC-225cb." On this basis, the present trial decision determined that the present correction introduces a new technical matter on the grounds that in the present case, Present Invention 1 cannot be deemed to include "a composition comprising 1% by weight or more of HCFC-225cb", nor can Present Invention 1 be deemed to include "a composition comprising less than 1% by weight of HCFC-225cb."

Then, the determination by the present trial decision will be discussed. As mentioned in B above, the present description, etc. do not state anything about HCFC-225cb. However, as mentioned in A(A) above, the statement of the scope of claims for Present Invention 1 can be interpreted to mean a composition that may comprise any materials other than HFO-1234yf, HFC-254eb, and HFC-245cb as far as the statement literally comprises HFO-1234yf, HFC-254eb, and HFC-245cb. Further, it can be deemed that the fact that the present correction has specified "except for a composition comprising 1% by weight or more of HCFC-225cb" explicitly indicates that Present Correction Invention 1 does not include a composition comprising 1% by

weight or more of HCFC-225cb, but it cannot be deemed that the same fact has explicitly indicated that Present Correction Invention 1 is a composition comprising less than 1% by weight of HCFC-225cb.

E. Therefore, it should be deemed that the present correction does not introduce a new technical matter in relation to the original technical matters.

(5) The Defendant asserts that the present correction cannot be deemed to be a correction excluding a portion identical to Exhibit Ko 4 invention and cannot be allowed, because the disclaimer does not fall under "a correction excluding a portion identical to an invention of the prior application from an invention claimed in a patent application."

However, it is provided that when a correction of the scope of claims is made in accordance with Article 134-2, paragraph (1) of the Patent Act, the correction must remain within the scope of the matters disclosed in the description, claims, or drawings attached to a written application and must not substantially enlarge or alter the claims (the same Article, paragraph (9) and Article 126, paragraphs (5) and (6) of the same Act), but it is not further required to exclude only a portion identical to the invention of the prior application nor to exclude only a portion identical to the prior art that was known prior to the filing of the patent application. In addition, when a correction is made "within the scope of the matters disclosed in the description, claims, or drawings"; that is, when a correction does not introduce a new technical matter in relation to the original technical matters, it is difficult to consider that the correction will cause unforeseen damage to third parties. Thus, as an interpretation of the correction requirement stipulated in the same paragraph, it should be deemed to be unreasonable to add the requirements as asserted by the Defendant.

Furthermore, the Defendant asserts that it cannot be allowed to freely define the content of the correction invention in the form of a disclaimer. In this regard, the present correction is a correction made in response to the advance notice of the trial decision to the effect that a reason for invalidation is found on the grounds of lack of novelty and an inventive step over Exhibit Ko 4, as mentioned in (2) above. However, as mentioned in 2 above, Exhibit Ko 4 discloses not only Exhibit Ko 4 invention but also discloses that the invention "relates to an advantageous method of preparing a hydrofluorocarbon directly from a halocarbon blend comprising HCFC-225cb. ... this method is carried out without converting a substantial amount of the HCFC-225cb into other compounds." ([0012]), and that "Preferred blends according to the present invention are those comprising the compound HCFC-225cb. In ... other preferred embodiments, the blend consists essentially of from about 1 to about

99 percent by weight of HCFC-225cb ..." ([0015]). Taking each disclosure of Exhibit Ko 4 into consideration, the present correction can be deemed to intend to exclude a portion that is probable to be regarded as substantially identical to the invention disclosed in Exhibit Ko 4. Thus, the present correction cannot be deemed to freely define the content of the correction invention independently of the invention disclosed in the prior art Exhibit Ko 4.

(6) The present trial decision did not allow the present correction on the grounds that the correction introduces a new technical matter, and invalidated the present patent for the present invention. However, the present correction cannot be deemed to introduce a new technical matter, as mentioned above. Therefore, it is inescapable to rescind the present trial decision, on the grounds that the present trial decision erred in the interpretation of the correction requirement stipulated in Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act.

No. 6 Conclusion

As mentioned in the foregoing, the Plaintiff's claim is well founded and thus shall be affirmed. Therefore, the judgment is rendered as mentioned in the main text.

Intellectual Property High Court, Second Division

Presiding Judge: SHIMIZU Hibiku

Judge: ASAI Ken

Judge: KATSUMATA Kumiko

Attachment "Patent Gazette" (omitted)