

Date	August 31, 2010	Court	Intellectual Property High Court, Third Division
Case number	2009 (Gyo-Ke) 10434		
A case in which the court ruled that in the process of construction of Article 36, paragraph (6), item (ii) of the Act [Patent Act in effect at the time of the filing of the application], it is impermissible to demand that the statement of the scope of claims represent any technical meaning in relation to the function, characteristics, problem to be solved, or intended effect of the invention			

References:

Article 36, paragraph (6), item (ii) of the Patent Act

The plaintiff filed a patent application, which was refused by an examiner of the Japan Patent Office (JPO), and then filed a request with the JPO trial board for a trial against the decision of refusal, but was given a decision to dismiss the request. Accordingly, the plaintiff filed a suit with the Intellectual Property High Court to seek rescission of the JPO decision.

The court rescinded the JPO decision, finding errors therein in terms of the construction and application of Article 36, paragraph (6), item (ii) of the Patent Act which had been in effect at the time of the filing of the application (hereinafter referred to as the “Act”).

As a requirement for the statement of the scope of claims, Article 36, paragraph (6), item (ii) of the Act provides that the invention for which a patent is sought should be clearly stated in the scope of claims. If the invention as stated in the scope of claims is not clear, the technical scope of the invention finally granted a patent would be unclear, which could cause an unexpected detriment to a third party. The abovementioned provision is intended to prevent such an unfavorable situation. In this context, it is needless to say that whether or not the invention for which a patent is sought is clear should be determined from the perspective of whether or not the statement of the scope of claims is unclear to the extent that it could cause an unexpected detriment to a third party, as may be found by taking into consideration not only the statement of the scope of claims but also the statements in the description and drawings attached to the application, as well as applying the technical knowledge shared among persons ordinarily skilled in the art at the time of the filing of the application as the basic standards.

Seeing the objectives, etc. of the Patent Act in whole, in the process of construction of Article 36, paragraph (6), item (ii) of the Act, it is impermissible to demand that the statement of the scope of claims represent any technical meaning in relation to the

function, characteristics, problem to be solved, or intended effect of the invention. If Article 36, paragraph (6), item (ii) of the Act is construed as requiring the statement of the scope of claims to represent any technical meaning in relation to the function, characteristics, problem to be solved, or intended effect of the invention, this would be equal to demanding that the requirement for compliance with Article 36, paragraph (4) of the Act also be met in order to comply with Article 36, paragraph (6), item (ii) of the Act, in which case a single matter would be used as the basis for finding noncompliance with more than one patentability requirement, bringing about an unfair and unjust consequence.