

Case number	2006 (Gyo-Ke) 10563
Parties	[Plaintiff] Tamura Kaken Corporation [Defendant] Taiyo Ink MFG. Co., Ltd
Decided on	May 30, 2008
Division	Grand Panel

Holdings:

- Where a correction does not add any new technical matters to the technical matters that a person skilled in the art can understand, taking into account all statements in the description or drawings, such correction can be deemed to be made within the “scope of the matters stated in the description or drawings.”
- A correction to revise the initial claim into an “excluding claim” can be deemed to be made within the “scope of the matters stated in the description or drawings.”
- A registered trademark mentioned in a correction can be deemed to cover all products that could be identified by the registered trademark at the time of filing of the prior application, and therefore, the products identified by the registered trademark cannot be regarded as being technically unclear.
- It cannot be deemed to be in violation of the Ordinance for Enforcement of the Patent Act, when making a correction to revise the initial claim into an “excluding claim,” to indicate the parts to be excluded by using a registered trademark.
- The invention claimed in the patent application in question would not have been easily inferred by a person skilled in the art based on the invention disclosed in the cited prior application.

References:

Proviso to Article 134(2) of the Patent Act prior to revision by Act No. 116 of 1994 (corresponding to Article 134-2(1)(iii) and (5) and Article 126(3) of the existing Patent Act), Article 24 of the Ordinance for Enforcement of the Patent Act prior to revision by Ordinance of the Ministry of International Trade and Industry No. 41 of 1990 (Form 16), Article 29(2) of the Patent Act prior to revision by Act No. 41 of 1999 (corresponding to Article 29(2) of the existing

Patent Act)

I. Outline of the Case

The plaintiff filed a request to the Japan Patent Office (JPO) for a trial for invalidation of Patent No. 2133267 entitled “Photosensitive thermosetting resin composition and method of forming solder resist pattern by use thereof” (hereinafter referred to as the “Patent”) that the defendant holds. The inventions subject to the trial were those defined by Claim 1 and Claim 22 included in the description attached to the application of the Patent (hereinafter referred to as the “Description”; these inventions shall hereinafter be referred to as the “Initial Inventions”). The JPO made a decision to the effect that the Patent should be invalidated (hereinafter referred to as the “Preceding JPO Decision”).

The defendant filed an action to seek cancellation of the Preceding JPO Decision (hereinafter referred to as the “Preceding Suit”). Subsequently, the defendant filed a request for a trial for correction, and the Intellectual Property High Court (hereinafter referred to as the “Court”) made an order to cancel the Preceding JPO Decision.

In this case, the plaintiff seeks cancellation of another JPO decision that approved the correction of the Description (hereinafter referred to as the “Correction”) and dismissed the request for a trial for invalidation.

II. Gist of the JPO Decision

The JPO decision, while finding the Initial Inventions to be identical to the invention disclosed in the description attached to the prior application (hereinafter referred to as the “Cited Invention”), determined that the Correction was made within the scope of the matters stated in the description and for the purpose of restricting the scope of claims or clarifying an ambiguous statement, and that the Correction did not substantially enlarge or alter the scope of claims. In conclusion, the trial decision approved the Correction.

The JPO decision also determined that the Patent should not be invalidated because: the inventions after the Correction (hereinafter referred to as the “Present Inventions”) would not have been easily inferred based on the invention disclosed in the cited prior application (hereinafter referred to as the “Invention Based on Exhibit Ko No. 3”); according to the statements in the Description, the Present Inventions were not incomplete and the statements in the Description were not insufficient.

III. Major Issues

1. Legality of the Correction

(1) “Excluding claim”

The Correction revised the initial claims into “excluding claims” [a claim containing a negative expression, such as “excluding...”]. Can it be deemed to have been made “within the scope of the matters stated in the description or drawings”?

(2) Use of the registered trademark

As a result of the Correction, the registered trademark, “TEPIC,” is additionally stated in the claims. Can the products be deemed to be clearly identified by means of the registered trademark? (Can the Correction be deemed to be intended to “restrict the scope of claims”?)

2. Inventive step in the Present Inventions

IV. Gist of the Holdings of the Court

1. Legality of the Correction

(1) “Excluding claims”

Before determining whether or not it is allowable to correct an initial claim by revising it into an “excluding claim,” the Court indicated the following general test for determining the satisfaction of the requirement for correction prescribed in the Patent Act, i.e. a correction shall be made “within the scope of matters stated in the description or drawings.”

The “matters stated in the description or drawings” are disclosed to third parties by the applicant as a prerequisite for gaining a monopoly based on a patent right for an invention, the highly advanced creation of technical ideas, and such “matters” must be technical matters concerning the invention disclosed in the description or drawings. And the “matters stated in the description or drawings” mean technical matters that a person skilled in the art can understand, taking into account all statements in the description or drawings. Where an amendment does not add any new technical matters to the technical matters that can be understood in this manner, the amendment can be deemed to be made within the “scope of the matters stated in the description or drawings.”

Based on this reasoning, the Court clearly stated that this general test also applies where the patentee files a request for correction to exclude the relevant part of the invention claimed in the patent application that is identical to the invention claimed in a prior application, which had not yet been laid open at the time of filing of the present application, by revising the initial claim into an “excluding claim.”

Since the patentee, at the time of filing of the application, is not aware of the existence of the invention claimed in a prior application, the description or drawings attached to his/her patent application usually do not contain any specific statements on such prior invention. The provision of the proviso to Article 134(2) of the Patent Act prior to the revision in 1994 shall also apply to a correction to be made to correct the matters that are not specifically stated in the description or drawings. As long as such correction can be found not to be adding any new technical matters to the technical matters disclosed in the statements in the description or drawings, it should be deemed to be made within the “scope of the matters stated in the description or drawings.”

Based on the legal construction mentioned above, the Court found that the Correction conformed to the Patent Act.

On this issue, the Court also addressed the JPO’s Examination Guidelines, which provide that a correction revising an initial claim into an “excluding claim” shall be treated “exceptionally” as being made within the scope of the matters stated in the description or drawings. The Court concluded that this treatment is “inappropriate,” holding as follows.

Even in the case of an amendment in which the matters to be amended are stated with negative expressions, if the matters to be amended are stated in the description or drawings, such amendment can be deemed not to be introducing any new technical matters as in the case of an amendment in which the matters to be amended are stated with positive expressions, unless there are special circumstances. And an amendment in which the matters to be amended are not stated in the description or drawings should not always be deemed to be introducing a new technical matter.

(2) Use of the registered trademark

As a result of the Correction, the registered trademark, “TEPIC,” is additionally stated in the claims. There is more than one product that can be identified by means of the trademark “TEPIC.”

On this issue, the Court held as follows: [1] Since the Correction is intended to exclude the relevant part of the invention that is identical to the invention claimed in the prior application so as to avoid invalidation of the Patent by reason of such identity, the term “TEPIC” mentioned in the Correction can be regarded as referring to “TEPIC” stated in the description attached to the prior application; [2] The registered trademark “TEPIC” mentioned in the Correction can be deemed to cover all products that could be identified by the registered trademark at the time of filing of the prior application, and therefore, to that extent, the products identified by the registered trademark “TEPIC” cannot be regarded as being technically unclear.

In relation to this issue, the Court commented on the conventional practice at the JPO.

In general, the products identified by a registered trademark cannot always be regarded as being technically clear. We cannot clearly identify which product, among those generally called “TEPIC,” is designated by the term “TEPIC” mentioned in the Correction, only by reading the statements in the description of the inventions after the Correction. In order to enable third parties who have accessed the statements in the corrected description to understand the content of the inventions stated in the claims, it is basically desirable to clearly indicate in the description that “TEPIC” mentioned in the Correction refers to “TEPIC” stated in Working Example 2 disclosed in the description attached to the prior application. In order to provide such a clear indication, it is necessary to correct the detailed explanation of the invention included in the description, thereby clearly indicating that the statements in the claims have been corrected for the purpose of excluding the invention stated in Working Example 2 disclosed in the description attached to the prior application. Such correction can be deemed to be made for the purpose of clarifying an ambiguous statement in the detailed explanation of the invention upon correcting the statement in the claims. In light of our holdings shown above, the Correction can be deemed not to be introducing any new technical matter, nor can it be regarded as

substantially enlarging or altering the scope of claims. However, due to the fact that the JPO, according to the Examination Guidelines mentioned above, conventionally treated such correction as not being made “within the scope of the matters stated in the description or drawings,” the defendant did not choose to request such correction but rather to identify the relevant part of the invention to be excluded by only using the term “TEPIC” when correcting the claims.

The Court also commented on the relationships between the Correction and the form subject to the Ordinance for Enforcement of the Patent Act.

Article 24 of the Ordinance for Enforcement of the Patent Act prior to revision by Ordinance of the Ministry of International Trade and Industry No. 41 of 1990 provides that “the description to be attached to a patent application shall be prepared with Form No. 16.” As for Form No. 16, it is provided that “a registered trademark may be used only in cases where the product in question cannot be indicated or identified without using the registered trademark; in such cases, it shall be stated in the form that the term in question is a registered trademark.” Under the trademark registration system, the correspondence between a registered trademark and the properties and composition of the product identified by the registered trademark is not assured, and a registered trademark cannot always be regarded as being capable of identifying a product definitely or clearly. Therefore, in general, the use of a registered trademark in the statements in a patent description is considered to be allowable only in extremely exceptional cases. The Correction is intended to exclude the relevant parts of the Initial Inventions that are identical to the Cited invention, by explaining the contents of the Cited invention which are to be excluded, or listing the ingredients contained in Initial Inventions 1 and 2---Ingredients (A) to (D) and (A) to (E), each of which can be chosen from a variety of substances or products, and identifying the relevant ingredients with negative expressions (in the form of an “excluding claim”) while citing the statements on the specific substances or products used in Working Example 2 disclosed in the description attached to the prior application. This seems to be the only way to exclude the relevant parts identical to the Cited invention without excess or deficiency. Therefore, it cannot be

deemed to be in violation of Article 24 of said Ordinance, when making the Correction, to indicate the parts to be excluded by using the registered trademark “TEPIC,” the factor by which the Cited invention can be identified.

2. Inventive step in the Present Inventions

The Court affirmed the JPO decision, rejecting other grounds for cancellation of the JPO Decision alleged by the plaintiff. As for the question of whether or not the Present Inventions involve an inventive step compared to the Invention Based on Exhibit Ko No. 3, the Court held as follows:

The Invention Based on Exhibit Ko No. 3 differs from the Present Invention 1 in terms of the purpose of the invention, and what is more, we should determine that Exhibit Ko No. 3 does not provide any suggestion on the technical problem to be solved by the Present Invention 1 and the means for solving it. As alleged by the plaintiff, “N-glycidyl type epoxy resin” (Invention Based on Exhibit Ko No. 3) and “heterocyclic epoxy resin” (Present Invention 1) are names of ingredients that indicate the same chemical constitution from different viewpoints, and there is a publicly known compound that corresponds to both ingredients, triglycidyl isocyanurate. However, this fact cannot be the grounds for concluding that a person skilled in the art who has accessed the statements in Exhibit Ko No. 3 would have recognized the essence of the technical problem to be solved by the Present Invention 1 and easily inferred, as the means for solving the technical problem, the composition corresponding to the difference between the Present Invention 1 and the Invention Based on Exhibit Ko No.3 (the composition using a compound that is “in fine grains and hardly soluble in used diluents” as an epoxy compound of Ingredient (D)).