

Judgments of Intellectual Property High Court (Grand Panel)

Date of the Judgment: 2005.11.11

Case Number: 2005 (Gyo-Ke) 10042

Title (Case):

Judgment upholding a Decision of Revocation in an opposition procedure by the Patent Office, in which the recitations of a claimed invention do not comply with statutory requirement (support requirement) in Article 36, Paragraph 1, Item 5 of Patent Law that was effective before the revision by Law No. 116 of 1994, with regard to a particular mathematical formulation that includes two technical variables, or “parameters”, each of which denotes a characteristic of an element of the claim, which is used in the claimed invention.

Related Statutory Provision(s):

Article 36[(5) (i)] of the Patent Law, before the revision by Law No. 116 of 1994 (corresponding to Article 36 (6) (i) of the Patent Law, after the revision)

Summary of the Judgment:

I Outline of the Case

1 Brief Summary of Facts

In the present case, a plaintiff who was a patentee of a patent titled “Manufacturing Methods of Polarizing Film” (hereinafter “the Patent”) alleged that the Decision of Revocation in the opposition procedure was erroneous and thus sought reversal of the Decision based on Law No. 47 of 2003, Appendix Article 2(9). The Decision of Revocation that had been issued by the Patent Office was based on failure to meet the description requirements in the specification accompanied with the patent application in the opposition procedure that had been filed before the date of enforcement of Law No. 47 of 2003, or January 1, 2004. (In this summary, “specification” includes “claims” according to the statutory definition before the revision of Law No. 24 of 2002.)

The claimed invention of the Patent includes an element that is defined with a range limited by a particular mathematical formulation. This mathematical formulation is expressed using two technical parameters, each of which denotes a characteristic of the element of the claimed invention. Thus the present invention is a so-called parameter invention. In the present judicial review, what is at issue is the permissibility of the specification disclosure, that is, whether the specification

discloses the invention sufficiently, as set forth in Article 36 of the Patent Law, so that the invention is awarded monopolization and exclusivity.

2 Issues

(1) With respect to Reason for Revocation 1

A. (Fulfillment of support requirements)

Regarding the invention claimed in the specification accompanied with the patent application, which is a so-called “parameter invention”, do claim recitations of the application comply with statutory requirements of the Patent Law, Article 36(5) (i) ? The requirement (hereinafter, “support requirement”) was revised by Law No. 116 of 1994 (“patent revision of 1994”) to become Article 36(6) (i) of the Patent Law.

B. (Legitimacy of addition to specification by submitting experiment data after filing)

When the above-specified issue A is negated, can a patentee-plaintiff assert legitimacy as to the support requirement on claims by submitting additional experimental data in the course of an opposition procedure for amending the detailed description of the specification to include data that is not found in the original specification?

C. (Legitimacy of *ex post fact* application of the Guidelines)

In the case that the “Guidelines” (the Examination Guidelines for Patent and Utility Model in Japan) regarding the examination of the description requirements are revised after the filing date of the invention, is it permissible for the Patent Office to apply the Guidelines to the invention?

(2) With respect to Reason for Revocation 2

Does the detailed description in the specification comply with the statutory requirements of the Patent Law, Article 36(4) before the patent revision of 1994?

II Outline of the Judgment

The Court concluded that the plaintiff’s assertion presented in the Reason for Revocation is not persuasive, because, with respect to issue (1), the recitations of a claim of the present specification do not comply with the support requirements, and thus issue (2) is not necessary to discuss. Regarding issue (1), the Court held as follows:

1 With respect to A (Fulfillment of the support requirements of the specification)

(1) Whether the claim recitations fulfill the support requirements or not should be determined by the following scheme: claim recitations are first compared with the detailed description of the specification; then the fulfillment is determined according to whether the claimed invention was described in the detailed description of the invention, whether the claimed invention can be regarded as though the skilled person in the art could have figured out the invention based on its recitations, or whether the claimed invention can be regarded as though the skilled person could have figured it out based on common technical knowledge at the filing date given that the recitations were not included nor suggested [in the detailed description of the specification]. It is the patentee to whom the burden of proof as to the support requirements is given to.

(2) An element of the present invention is a material that is limited in a range determined by a particular mathematical formulation. The mathematical formulation includes two technical variables, or parameters, each of which denotes a characteristic of the element. Specifically, the element is a poly-vinyl-alcohol based material film ("PVA film") whose complete salvation temperature, X, and balanced degree of swelling, Y, fall within a range that is denoted by a particular mathematical formulation [of X and Y] . Thus, the present invention is a so-called parameter invention. Claim recitations of such invention shall meet the support requirements if (i) the detailed description in the specification discloses a technical meaning in the relationship between the range denoted by the mathematical formulation and its effects, or performances, at least in such a way that the skilled person is able to understand it at the time of filing even if particular examples are not included in the specification; or (ii) [the detailed description] includes the disclosure of examples in a manner that the skilled person can recognize, by consulting the common technical knowledge at the time of filing, that the intended effects, or performances, would have been realized when [X and Y for the claimed invention fall within] the range denoted by the mathematical formulation.

(3) The detailed description of the present specification includes only two examples and two comparative examples for showing the effectiveness of the above structure. The examples merely show that polarizer films with considerable durability and tolerance for high stretch rate are realized by PVA films with specific sets of complete salvation temperature, X, and a balanced degree of swelling, Y; whereas, the comparative example merely show that polarizer films with poor durability and poor tolerance for high stretch rates are realized by PVA films with

other specific sets of complete salvation temperature, X, and a balanced degree of swelling, Y. Therefore, such description does not disclose examples in such a way that the skilled person can recognize, by consulting the common technical knowledge at the time of filing, that the intended effects, or performances, would have been realized when the [numerical values of the characteristics for the PVA films] fall within the range [denoted by the mathematical formulation in the claim recitations]. Therefore, the claim recitations do not meet the support requirements.

2 With respect to B (Legitimacy of addition to specification by submitting experiment data after filing)

(1) With respect to the so-called parameter invention, notably the present invention, if we take into consideration the fact that the detailed description, which neither discloses the examples so specifically that the skilled person can recognize the problem solved by the present invention, nor discloses [the invention] in such a manner that the [disclosure of] detailed description can be expanded or generalized into what is recited in the claims by consulting the technical knowledge on the filing date; then, under the objective of the patent system in which [sufficient] disclosure is assumed for any granted patent, it is not allowed that the [scope of the] detailed description is expanded or generalized to what is recited in the claims for the purpose of satisfying the support requirements by submitting experimental data after the filing date, wherein the data is new matter that not disclosed in the detailed description.

(2) The experimental data that has been filed by the plaintiff during the opposition procedure discloses (i) performance measurement results of polarizer film obtained from PVA films of a specific set of [values for] complete salvation temperature, X and a balanced degree of swelling, Y; and (ii) relationships between the polarizer film performance and the set of [values for] complete salvation temperature, X, and balanced degree of swelling, Y, for PVA films, wherein the relationships are determined based on the measurement results. Both of them have never been disclosed specifically in the detailed description, thus they are disclosed nothing but after the filing date. Therefore, in light of the above-mentioned (1), [such experimental data] are not allowed to be consulted [as grounds for the claimed invention] because they are introducing new matter into the detailed description.

3 With respect to C (Legitimacy of *ex post fact* application of the Guidelines)

(1) Whether the claim recitations meet the support requirements or not should be determined by the objective of pertinent provisions of the Patent Law. The Guideline is not a law, but merely an examination standard which has been made in the

Patent Office for the purpose of ensuring equality and rationality in patent examinations as to whether a patent application meets the patentability requirements under the Patent Law. Thus, the holding in 1(2) is not affected by whether or not the standards in the Guideline that is applicable to the present invention includes the interpretation of the above-mentioned provision of the Patent Law.

(2) Since the standards of the Guideline, which was revised in October 2002, conform with the objective of Article 36 Paragraph 5 Item 1 of Patent Act before the 2002 revision, which was revised in 1994, there is no violation of law even when the standards are retroactively applied in an *ex post fact* manner to a patent that was filed before a filing date on which the revised standard went into effect.

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2005 (Gyo-Ke) 10042, Case of seeking rescission of a decision to revoke a patent (Date of conclusion of oral argument: October 7, 2005)

Judgment

Plaintiff: Nippon Synthetic Chemical Industry Co., Ltd.

Counsel patent attorney: ASAHINA Sota

Same as above: AKIYAMA Fumio

Defendant: NAKAJIMA Makoto, Commissioner of the Japan Patent Office

Designated representative: TOYOOKA Shizuo

Same as above: KANOMATA Toshio

Same as above: SUEMASA Kiyoshige

Same as above: MIYASHITA Masayuki

Same as above: YANAGI Kazuko

Main Text

The plaintiff's claim is dismissed.

The plaintiff shall bear the court costs.

Facts and reasons

No. 1 Judicial decision sought by the parties

1. Plaintiff

(1) A decision made by the Japan Patent Office (JPO) on Opposition No. 2003-70728 on November 26, 2004 shall be rescinded.

(2) The defendant shall bear the court costs.

2. Defendant

The same effect as the main text

No. 2 Outline of the case

With regard to an opposition to the grant of a patent which was filed before the enforcement of Act No. 47 of 2003 (January 1, 2004) for a patent for the invention entitled "Polarizing film manufacturing method" that is held by the plaintiff, the JPO made a decision to revoke the patent on the grounds of deficiency in the statement in the description attached to the written application of the patent application (which refers to a "description" as a filing document that includes the "scope of claims" as prescribed in the Patent Act before the revision by Act No. 24 of 2002; the same shall apply hereinafter). In response to this, the plaintiff filed this case to seek the rescission of the decision based on Article 2, paragraph (9) of the Supplementary Provisions of Act No. 47 of 2003,

alleging that the determination in the decision is erroneous.

The patent includes, as a constituent feature, a product specified by the range indicated by certain mathematical formulas using two technical parameters that indicate characteristic values, and it is related to a parameter invention. The invention is considered as bringing about an effect of making it possible to manufacture polarizing films which are superior in durability and polarization performance and also have good performance in the characteristic of stability at the time of manufacture. However, with regard to the legality of statements in the description, that is, whether an invention that is worth monopolistic and exclusive protection by a patent is disclosed in the description in such a manner that complies with the provisions of Article 36 of the Patent Act, the major issues of this case are (1) whether the description satisfies the support requirement or the enablement requirement, (2) whether it is advisable to supplement the content described in the description through ex-post facto submission of experimental data not contained in the statements in the description, and (3) whether it is advisable to retroactively apply the Examination Guidelines for Patent and Utility Model.

No. 3 Facts undisputed by the parties

1. Development of procedures at the JPO

(1) The plaintiff filed a patent application (Patent Application No. 1993-287608; hereinafter referred to as the "Application") for an invention entitled "Polarizing film manufacturing method" on October 21, 1993. The JPO made a decision to the effect that a patent is to be granted for the Application, and the establishment of the patent right was registered as Patent No. 3327423 (hereinafter this patent shall be referred to as the "Patent") on July 12, 2002.

(2) After that, an opposition to the grant of a patent (hereinafter referred to as the "Opposition") was filed against the Patent. The JPO examined the Opposition as Opposition No. 2003-70728 and made a decision to the effect that "The patent for the claims of Patent No. 3327423 is to be revoked" (Note: this is understood as meaning that the patent for claims 1 to 3 of Patent No. 3327423 is to be revoked) on November 26, 2004. A copy of the decision was delivered to the plaintiff on December 18, 2004.

2. Description of claims 1 to 3 (hereinafter claim 1 shall be referred to as "Claim 1") in the scope of claims in the description attached to the written application of the Application (Exhibit Ko No. 3; hereinafter referred to as the "Description")

[Claim 1] A polarizing film manufacturing method which is characterized by that, in manufacturing a polarizing film by uniaxially stretching a polyvinyl alcohol raw film, a polyvinyl alcohol film which is 30 to 100 μm thick and for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range indicated by the following formulas is used as a raw film and the polyvinyl alcohol film is uniaxially stretched

1.2 to 2 times in the dyeing treatment process and is further uniaxially stretched 2 to 6 times in the boron compound treatment process, respectively:

$$Y > -0.0667X + 6.73 \dots (I)$$

$$X \geq 65 \dots (II)$$

X: Complete dissolution temperature (°C) of a 2 cm-square film piece in hot water

Y: Equilibrium swelling degree (weight fraction) calculated by dividing the weight of the film after dipping by the weight of the film after drying as indicated in the following formula when a 10 cm-square film piece is dipped in a constant temperature water bath of 20°C for 15 minutes for swelling and is then dried at 105°C for two hours

[Claim 2] A manufacturing method described in claim 1 which is characterized by using a polyvinyl alcohol raw film of which the complete dissolution temperature is 65 to 90°C

[Claim 3] A manufacturing method described in claim 1 which is characterized by using a polyvinyl alcohol raw film of which the average degree of polymerization is 2,600 or higher

(hereinafter, the inventions described in claims 1 to 3 shall be referred to as "Invention 1" to "Invention 3," respectively, and Inventions 1 to 3 shall be collectively referred to as the "Inventions")

3. Reasons for the decision

The reasons for the decision are as described in a copy of the original "decision on opposition" separately attached, and the gist thereof is as follows. (1) The constituent feature of Invention 1 is to use a polyvinyl alcohol film (hereinafter a polyvinyl alcohol film shall be referred to as "PVA film" and polyvinyl alcohol shall be referred to as "PVA") for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range indicated by the following formulas: $Y > -0.0667X + 6.73$ [hereinafter referred to as "Formula (I)"] and $X \geq 65$ [hereinafter referred to as "Formula (II)"]. The range defined by these two formulas is extensive, but there are not sufficient working examples to provide convincing evidence that all of those that satisfy these mathematical formulas bring about an effect that is superior in polarization performance and durability performance. In addition, it cannot be confirmed by other means, in light of the statement in the Description and common general technical knowledge in the relevant field, that all of those that satisfy the aforementioned two formulas bring about the aforementioned superior effect. Moreover, grounds and reasons for arriving at the aforementioned two formulas are unclear. Therefore, in the end, the inventions for which a patent is sought, that is, Invention 1 and Inventions 2 and 3 which cite Invention 1, cannot be recognized as those described in the detailed explanation of the invention. Consequently, the statement of the scope of claims in the Description violates the provisions of Article 36, paragraph (5), item (i) of the Patent Act (Note: it is understood as meaning Article 36, paragraph (5), item (i) of the Patent Act before revision by

Act No. 116 of 1994 [hereinafter referred to as the "1994 Revision Act"] [Article 36, paragraph (6), item (i) of the Patent Act after said revision]; hereinafter referred to as "Article 36, paragraph (5), item (i) of the Old Patent Act"). (2) The range which satisfies the aforementioned two formulas prescribed in claim 1 is extensive. It is thus ambiguous, even in consideration of the detailed explanation of the invention in the Description, what manufacturing conditions (degree of polymerization of PVA, dry substrate, drying temperature, drying time, etc.) are required to obtain a film that satisfies the aforementioned two formulas and is superior in polarization performance and durability performance (Note: This is understood as meaning that it is ambiguous, even in consideration of the detailed explanation of the invention in the Description, what manufacturing conditions are required to obtain a PVA film that satisfies the aforementioned two formulas). Therefore, the detailed explanation of the invention in the Description is not recognized as describing the purpose, constitution, and effect of the invention to the extent that a person ordinarily skilled in the art can easily work the invention. Consequently, it violates Article 36, paragraph (4) of the Patent Act (Note: This is understood as meaning Article 36, paragraph (4) of the Patent Act before revision by the 1994 Revision Act; hereinafter referred to as "Article 36, paragraph (4) of the Old Patent Act"). (3) Consequently, the patent for Inventions 1 to 3 was granted for a patent application which does not satisfy the requirements prescribed in Article 36, paragraph (4) and paragraph (5), item (i) of the Old Patent Act and falls under Article 113, item (iv) of the Patent Act. Therefore, it should be revoked (Note: This is understood as an error in application of laws and regulations; it should be stated that the patent should be revoked pursuant to Article 4, paragraph (2) of Cabinet Order No. 205 of 1995 that is based on Article 14 of the Supplementary Provisions of the 1994 Revision Act.).

No. 4 Grounds for rescission of the decision alleged by the plaintiff

The determination in the decision to the effect that the statement in the Description violates the provisions of Article 36, paragraph (5), item (i) and paragraph (4) of the Old Patent Act is erroneous (grounds for rescission 1 and 2), and it is obvious that the error affects the conclusion of the decision. Therefore, the decision should be rescinded as one going against law.

1. Ground for rescission 1 (error in the determination of violation of Article 36, paragraph (5), item (i) of the Old Patent Act)

(1) In the decision, the JPO determined as follows: "The range defined by two formulas, ' $Y > -0.0667X + 6.73$ ' and ' $X \geq 65$,' is extensive. There are not sufficient working examples to provide convincing evidence that all of those that satisfy these mathematical formulas bring about an effect that is superior in polarization performance and durability performance. In addition, it cannot be confirmed by other means, in light of the statement in the description of the patent (Note: the Description) and common general technical knowledge in the relevant field, that all of those that

satisfy the aforementioned two formulas bring about the aforementioned superior effect" (second paragraph on page 4 of the copy of the original decision). However, despite submission of an experimental results certificate which describes ten pieces of experimental data (Exhibit Ko No. 6; hereinafter referred to as "Ko No. 6 Experimental Certificate") by the plaintiff at the stage of the proceedings of the Opposition, the determination was made based only on four pieces of data in total, specifically, two pieces of data on working examples 1 and 2 and two pieces of data on comparative examples 1 and 2, which are described in the Description, without taking Ko No. 6 Experimental Certificate into account at all, on the premise that there is no other experimental data than these four pieces of data. The determination is erroneous as mentioned below.

That is, the formula, " $Y > -0.0667X + 6.73$ " [Formula (I)], was arrived at by plotting 14 pieces of experimental data in total, including ten pieces of data described in Ko No. 6 Experimental Certificate which are based on experiments that the plaintiff conducted during the period between May and August 1993 before filing the Application, as well as four pieces of experimental data on working examples, etc. described in the Description. Moreover, paragraph [0013] of the Description states that PVA films of which complete dissolution temperature in hot water (X) is 65°C or lower cannot be practically used as they partially dissolve or deteriorate during the process of stretching. Therefore, a person ordinarily skilled in the art can easily understand that a PVA film for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range limited by two formulas, Formula (I) and Formula (II), brings about an effect that is superior in polarization performance and durability performance.

The decision states that the range limited by the aforementioned two formulas is extensive. However, equilibrium swelling degree (Y) is a value calculated by dividing the weight of the film after dipping by the weight of the film after drying, and it is certainly not lower than 1, as its lower limit is 1 in the case where the weight before and after dipping is the same. In addition, "complete dissolution temperature" in the Inventions are almost the same as the "/maximum allowable water temperature." According to Figure 100 indicating the relationship between heat treatment temperature and maximum allowable water temperature of PVA, which is included in Koichi Nagano, et al., *Pobaru kaitei shinpan* (Poval: revised new edition) (April 1, 1981, published by Kobunshi Kankokai; Exhibit Ko No. 8; hereinafter referred to as "Ko No. 8 Document"), "complete dissolution temperature of 65°C or higher" corresponds to "heat treatment temperature of 110 °C or higher." According to Figure 101 indicating the relationship between heat treatment temperature and swelling degree in said document, swelling degree is approximately 1.5 or lower if "heat treatment temperature is 110°C or higher." Then, as equilibrium swelling degree is equal to swelling degree plus 1 ("Kobunshi kagaku (Polymer chemistry)," *Kobunshi gakkai ronbunshu* (Collection of papers by the Society of Polymer Science), vol. 12, no. 128 (December 25, 1955,

published by the Society of Polymer Science; Exhibit Ko No. 10), the upper limit of equilibrium swelling degree is around 2.5 at the highest in the case of complete dissolution temperature in hot water of 65°C or higher in the Inventions. Therefore, the substantive upper limit never exceeds 3.0 even in consideration of measurement error and other conditions. On the other hand, the lower limit of complete dissolution temperature in hot water (X) is 65°C as defined in Claim 1 and the upper limit thereof is substantially around 90°C. In this manner, the range which satisfies the two formulas, Formula (I) and Formula (II), is never extensive without limit. Moreover, Figure 1 in Attachment 2 is the result of plotting 14 pieces of data in total, specifically, the eight pieces of experimental data and two pieces of comparative experimental data described in Ko No. 6 Experimental Certificate, in addition to two working examples and two comparative examples described in the Description. As revealed by Figure 1, the scope of working is not very narrow compared to the range limited by the aforementioned two formulas.

Incidentally, the defendant alleges that the plaintiff's allegation to the effect that the upper limit of equilibrium swelling degree is 3.0 is groundless as the heat treatment temperature calculated based on Figure 100 in Ko No. 8 Document (110 °C) differs from the heat treatment temperature of working example 2 described in the Description (90 °C). However, if other conditions are completely the same, both of these heat treatment temperatures become completely the same. Figure 104 in Ko No. 8 Document indicates that swelling degree significantly differs even at the same heat treatment temperature if only the degree of saponification differs by only 1%. The resin of the aforementioned working example 2 and the resin of Ko No. 8 Document differ in the degree of saponification by 0.4% and also significantly differ in the degree of polymerization. Therefore, it is natural that the heat treatment temperature of the aforementioned working example 2 differs from a value calculated based on Figure 100 in Ko No. 8 Document. Consequently, the defendant's allegation is unreasonable.

As mentioned above, taking into account the ten pieces of experimental data described in Ko No. 6 Experimental Certificate and the four pieces of experimental data stated in the Description, the number of specific examples is sufficient to arrive at the aforementioned two formulas, and is also sufficient to confirm that those that satisfy the aforementioned two formulas bring about a superior effect.

(2) In the decision, the JPO determines as follows: "Addition of experiments that were conducted under significantly different experimental conditions is not a supplement to the working examples of the Inventions but is an addition of new working examples, and those experimental results cannot be taken into account in the proceedings of this case (Note: the Opposition)" (paragraph 4 on page 5 of the copy of the original decision). However, this determination is erroneous as mentioned below.

A. Experiments 1 to 8 described in Ko No. 6 Experimental Certificate merely controlled complete

dissolution temperature in hot water and equilibrium swelling degree only by using well-known art. In said experiments 1 to 8, drying was conducted at a temperature of 90°C or higher, which was higher than the drying temperature in the working examples described in the Description (30 or 40°C), while the drying time was within 10 minutes, which was much shorter than the drying time in said working examples (24 hours). In the aforementioned working examples in which experiments were conducted in the laboratory, drying time was long as there was no constraint on drying time. However, the aforementioned experiments 1 to 8 were conducted by using actual equipment, and drying time was significantly limited in relation to the manufacturing time. Therefore, drying time was short, and drying temperature was set higher merely for the purpose of shortening drying time. It is general common knowledge that when setting drying temperature higher, drying time only needs to be shortened accordingly. Taking this into account, the conditions of these experiments do not significantly differ.

Consequently, the pieces of experimental data described in Ko No. 6 Experimental Certificate supplement the working examples described in the Description. Therefore, the determination in the decision to the effect that Ko No. 6 Experimental Certificate cannot be taken into consideration is unreasonable.

B. The defendant alleges that experiments 1 to 8 described in Ko No. 6 Experimental Certificate differ from the working examples in the Description in the experimental conditions. However, all of such allegations are erroneous as below.

(A) The defendant alleges that experiments 1 to 8 described in Ko No. 6 Experimental Certificate and the working examples described in the Description significantly differ in the drying conditions.

However, drying only requires evaporation of water. Drying temperature is to be arbitrarily selected, and it is not the case that a specific temperature is required for drying. With regard to drying time, it is common general technical knowledge that drying time becomes shorter if drying temperature is higher and that drying time becomes longer if drying temperature is lower. In this manner, drying temperature and drying time are arbitrarily selected. Therefore, the defendant's allegation that the drying conditions significantly differ only because drying temperature is different is unreasonable.

(B) The defendant alleges that experimental conditions differ significantly in cases where drying temperature is higher than glass transition temperature (experiments 1 to 8 described in Ko No. 6 Experimental Certificate) and in cases where it is lower (working examples described in the Description), as it is commonly predicted that their effects on the tissue conditions of PVA differ significantly.

However, PVA in the drying process is the aqueous solution of PVA, which is water in which PVA is dissolved, and in the first place, such PVA which dissolves in solvent has no glass transition

temperature. The defendant alleges that it is commonly predicted that cases where drying temperature is higher than glass transition temperature and cases where it is lower significantly differ in the effects on the tissue conditions of PVA, based on the glass transition temperature of solid PVA which is as stated in the Kagakudaijiten Henshu Iinkai, ed., *Kagakudaijiten 2* (Comprehensive chemistry dictionary 2) (at 523-524; June 1, 1993; published by Kyoritsu Shuppan Co., Ltd.; Exhibit Otsu No. 1) and Kagakudaijiten Henshu Iinkai, ed., *Kagakudaijiten 8* (Comprehensive chemistry dictionary 8) (at 767; June 1, 1993; published by Kyoritsu Shuppan Co., Ltd.; Exhibit Otsu No. 2), but such allegation by the defendant is unreasonable.

(C) Based on the statement in Ko No. 8 Document, the defendant alleges that the working examples described in the description of the Patent and experiments 1 to 8 described in Ko No. 6 Experimental Certificate significantly differ in the experimental conditions because drying temperature for the former is 30 to 40°C while that for the latter is 85 to 102°C and the degree of crystallization differs depending on the drying temperature.

However, Ko No. 8 Document describes the relationship between heat treatment temperature and degree of crystallization of a PVA film manufactured by drying, and does not describe the relationship between drying temperature and degree of crystallization in the case of manufacturing a PVA film by evaporating water from an aqueous solution of PVA. The aforementioned defendant's allegation confuses drying conditions with heat treatment conditions, and is thus unreasonable.

As alleged by the defendant, there are times when the degree of crystallization becomes higher if drying temperature is higher and lower if drying temperature is lower. However, this relationship is realized only where many other manufacturing conditions are exactly the same. As other manufacturing conditions of experiments 1 to 8 described in Ko No. 6 Experimental Certificate and those of the working examples described in the Description are not exactly the same, it is impossible to organize them simply based on drying temperature.

(3) The Inventions significantly contribute to the development of the industry as methods of manufacturing polarizing films for liquid crystals which have superior polarization performance. Even if there is slight deficiency in the description of the detailed explanation of the invention in the Description, it cannot be justified to revoke the patent for such useful inventions only for the reason of such a minor deficiency. In particular, the requirements of a description have changed with the times, and at least as of the time of filing the Application, it was not required to describe all experimental data which serve as the basis as working examples in a description for patent applications for parameter inventions, such as the Inventions.

That is, although the Examination Guidelines for Patent and Utility Model that serve as standards for the interpretation and application of the provisions of Article 36, paragraph (5), item (i) and paragraph (4) of the Old Patent Act, which are applicable to the Application, were fully

revised in June 1993, the Guidelines did not provide for any standard for the description requirements of a description of a patent application for a parameter invention. Through the revision by the 1994 Revision Act, the provisions of Article 36, paragraph (4) of the Old Patent Act before said revision were revised, and the description requirements of a description were revised to a large extent, such as the provisions of Article 36, paragraph (5) and paragraph (6), item (ii) of the Patent Act after said revision being newly established. The Examination Guidelines for Patent and Utility Model, which serve as standards for the interpretation and application of these provisions, are those after the revision in October 2000, whereby standards for the description requirements of a description of a patent application for a parameter invention were added for the first time. Moreover, the Examination Guidelines for Patent and Utility Model after the revision in October 2003 state the following standards for the description requirements of a description of a patent application for a parameter invention.

(A) The Examination Guidelines prescribe the case where "the content disclosed in the detailed explanation of the invention can neither be expanded nor generalized to the scope of the claimed invention, even in light of the common general technical knowledge as of the time of filing the application" as "Typical Examples of Violation of Article 36, paragraph (6), item (i)," and cite the following case as Example 10: the case where "in an invention aiming to specify a product (e.g., a polymer composition, a plastic film, a synthetic fiber or a tire) by limiting function and characteristic, etc. numerically, a sufficient number of specific examples covering the whole numerical range described in the claims is not shown, and furthermore by referring to other statement in the detailed examination of the invention or in light of the common general technical knowledge as of the time of filing the application, the relevant specific examples can neither be expanded nor generalized to the whole numerical range described in the claims."

(B) The Guidelines prescribe the case where "(2) an invention is unclear due to the technical defect existing in the matters defining the invention or from the technical meaning or technical relation of matters defining the invention being not comprehensible" as "Typical Examples of Violation of Article 36, paragraph (6), item (ii)," and prescribe the case where "(ii) technical meaning of matters defining the invention can not be understood" as one of such cases. As Example 1, the Guidelines cite "Dying powder defined by a specific numerical range of specific formula X" (Specific formula X is shown only as a result obtained and its technical meaning cannot be understood even when taking into consideration the description, drawings, and the common general technical knowledge as of the time of filing the application. However, if the process that leads to the formula or the reason to determine the numerical range of the formula, etc., (including the case where the numerical range was obtained from the result of experiment) is described in the description to the extent that its technical meaning can be understood, the technical meaning can be understood in

many cases.)

However, these standards are those for the interpretation and application of Article 36, paragraph (6), items (i) and (ii) of the current Patent Act. Even if they are retroactively applicable, their application should be limited to patent applications filed on and after January 1, 1995, on which the Patent Act after revision by the 1994 Revision Act, which includes corresponding provisions, became applicable.

It should be considered as extremely unreasonable and unacceptable to revoke the Patent only on the grounds of deficiency in the statement in the Description by retroactively applying the Examination Guidelines for Patent and Utility Model concerning the description requirements of a description, which were set after the filing of the application for the Patent, despite the fact that the issue of whether the Description satisfies the description requirements did not become a question at all in the examination of the Application.

(4) According to the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act, the invention claimed in the scope of claims must have a substantial corresponding relationship with the invention described in the detailed explanation of the invention. In addition, the Examination Guidelines for Patent and Utility Model provide that "It is necessary to state in the detailed explanation of the invention at least one mode that an applicant for a patent considers to be the best among the 'modes for working the invention' showing how to work the claimed invention." The detailed explanation of the invention in the Description (Exhibit Ko No. 3) states that a specific PVA film for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range indicated by two formulas, Formula (I) and Formula (II), "can be manufactured by adjusting the drying conditions at the time of producing a polyvinyl alcohol film or the heat treatment conditions, etc. after the production of a polyvinyl alcohol film" (paragraph [0012]). In addition, as for working examples, two working examples which the patentee considers to be the best are described therein. Therefore, for the Inventions, the inventions claimed in the scope of claims substantively correspond to the inventions described in the detailed explanation of the invention, and also conform to the content of the aforementioned Examination Guidelines.

The Inventions are those made by finding the fact that, of publicly known PVA films, those for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range of specific numeric values, are suitable as materials for polarizing films. There is no reason for requiring that the method of specifying publicly known PVA films be described in detail.

2. Ground for rescission 2 (error in the determination of violation of Article 36, paragraph (4) of the Old Patent Act)

(1) In the decision, the JPO rules as follows: "Even in consideration of the detailed explanation of the invention in the description of the Patent (Note: the Description), ambiguity remains concerning what manufacturing conditions (degree of polymerization of PVA, dry substrate, drying temperature, drying time, etc.) are required to obtain a film that satisfies the aforementioned two formulas and is superior in polarization performance and durability performance. Therefore, the description of the Patent is not recognized as one that describes the purpose, constitution, and effect of the invention to the extent that a person ordinarily skilled in the art can easily work the invention" (third paragraph on page 4 of the copy of the original decision). Based thereon, the JPO determined that the statement of the detailed explanation of the invention in the Description violates Article 36, paragraph (4) of the Old Patent Act. However, this determination is erroneous as mentioned below.

(2) Complete dissolution temperature (X) indicates the solubility of a film measured under specific conditions, and indicates the temperature at which a crystal that is harder to dissolve compared to amorphous parts completely dissolves. A high complete dissolution temperature indicates that the size of crystals is large as crystals of PVA dissolve at a high temperature, while a low complete dissolution temperature indicates that the size of crystals is small as crystals of PVA dissolve at a low temperature. On the other hand, equilibrium swelling degree (Y) indicates the degree of swelling of a film by water which is measured under specific conditions. In general, swelling by water occurs at the amorphous parts of PVA. A high equilibrium swelling degree indicates a low degree of crystallization with increased amorphous parts, while a low equilibrium swelling degree indicates a high degree of crystallization with fewer amorphous parts.

In the case of directly questioning the size of crystals or the degree of crystallization, it is necessary to measure these values through X-ray analysis, etc. However, as it is impossible to obtain a completely amorphous body of PVA, accurate values cannot be obtained even through X-ray analysis. Consequently, in the Inventions, complete dissolution temperature and equilibrium swelling degree were used as indexes as substitute for the size of crystals and the degree of crystallization, while focusing attention on the relationship between PVA films with specific complete dissolution temperature and equilibrium swelling degree and the characteristics of polarizing films obtained therefrom. Thus, they could arrive at the two formulas prescribed in Claim 1.

(3) Incidentally, in the case of manufacturing a PVA film, the degree of polymerization of PVA, aqueous solution concentration of PVA, drying roll can be cited as the conditions for controlling the degree of crystallization and size of crystals of the PVA film, in addition to drying conditions and heat treatment conditions after the production of the film [paragraph [0012] of the Description (Exhibit Ko No. 3)]. For example, in working examples 1 and 2 and comparative examples 1 and 2

described in the Description, PVA films were manufactured in the same drying time (24 hours). However, in the same drying time, as long as other conditions are the same, if drying temperature is low, PVA is rapidly cooled. Consequently, crystals do not sufficiently grow, and the degree of crystallization thus becomes low and the size of crystals becomes small. On the contrary, if drying temperature is high, PVA is gradually cooled. Consequently, crystals grow, and the degree of crystallization thus becomes high and the size of crystals becomes large. It is only necessary to set drying temperature higher in order to manufacture PVA films with the same degree of crystallization in a shorter drying time than 24 hours, in the aforementioned examples.

Various conditions intricately relate to crystallization of polymer films such as PVA films, though the degree of their contribution differs. Therefore, manufacturing conditions are not directly and unambiguously decided in the case of manufacturing a film with a specific degree of crystallization. Consequently, it is not that the degree of crystallization or the size of crystals of a PVA film is directly and unambiguously decided if drying temperature and drying time are specified, nor can the manufacturing conditions of a PVA film be directly or unambiguously decided if the degree of crystallization or the size of crystals of the film is specified.

As methods of controlling the degree of crystallization and the size of crystals of a polymer film by arbitrarily setting or changing the conditions for controlling the degree of crystallization and the size of crystals, there are various methods, such as control of stereoregularity of polymers, rapid cooling from the molten state (the size of crystals becomes smaller), gradual cooling from the molten state (the size of crystals becomes larger), and heat treatment. Specifically looking at them with regard to PVA films, for example, Ko No. 8 Document states that (1) the swelling degree and degree of crystallization can be controlled by changing the drying method to high-temperature drying, high-humidity drying, and air drying, etc. in the drying process after aqueous solution of PVA is cast, that (2) further heat treatment after the drying process is generally conducted to promote crystallization, and that (3) it is possible, by raising the heat treatment temperature, to increase the degree of crystallization, raise the maximum allowable water temperature of a PVA film, and lower the swelling degree (Figure 103 on page 215, lines 8 and 9 on page 219, Figure 98 on page 212, and Figures 100 and 101 on page 214). In addition, *Poribiniruarukoru (torifuruorosakusanbiniru wo shuppatsumonoma toshita)* (Polyvinyl alcohol (starting from trifluoroacetic acid vinyl)) (First edition, first print, June 15, 1991, published by Kobunshi Kankokai; Exhibit Ko No. 9) also states that the degree of crystallization, distance between crystals, and the size of crystalline region can be controlled by heat treatment temperature (Table 6-6 on page 80).

(4) The aforementioned methods of controlling the size of crystals and the degree of crystallization of a PVA film had already been well-known among persons ordinarily skilled in the art as of the

time of filing the Application, and it can be said that it was very easy for a person ordinarily skilled in the art to control the size of crystals (complete dissolution temperature) and the degree of crystallization (equilibrium swelling degree) by arbitrarily setting and changing the drying method, drying temperature, heat treatment temperature, etc. of the film.

Then, as long as the methods of controlling the size of crystals (complete dissolution temperature) and the degree of crystallization (equilibrium swelling degree) are well-known among persons ordinarily skilled in the art as mentioned above, a person ordinarily skilled in the art can very easily manufacture a PVA film that satisfies two formulas, Formula (I) and Formula (II), based on the common general technical knowledge as of the time of filing the Application, without needing to describe it in the detailed explanation of the invention in the Description. Therefore, it should be said that the detailed explanation of the invention in the Description describes the purpose, constitution, and effect of the invention to the extent that a person ordinarily skilled in the art can easily work the Inventions.

No. 5 Counterarguments of the defendant

The determination in the decision to the effect that the statement in the Description violates the provisions of Article 36, paragraph (5), item (i) and paragraph (4) of the Old Patent Act is not erroneous, and all the grounds for rescission alleged by the plaintiff are groundless.

1. Regarding ground for rescission 1 (error in the determination of violation of Article 36, paragraph (5), item (i) of the Old Patent Act)

(1) Whether the statement of the scope of claims conforms to the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act is determined through consideration of the substantial corresponding relationship between the invention claimed in the scope of claims and the one described as an invention in the detailed explanation of the invention in a description. If the aforementioned claimed invention is determined as one that exceeds the scope described in the detailed explanation of the invention in such a manner that a person ordinarily skilled in the art can recognize that the problem to be solved by the invention can be solved, it should be understood that the statement cannot be considered as conforming to the provisions of said item.

(2) The statement of the scope of claims in the Description cannot be considered as conforming to the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act as mentioned below.

A. The detailed explanation of the invention in the Description only describes the methods of manufacturing four kinds of films shown in working examples and comparative examples to indicate the relationship between the values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of a PVA film and the specific characteristics of a polarizing film which is obtained by using said PVA film as a raw film.

It is recognized, from a graph (Figure 1 in Attachment 1) plotting the values of complete

dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of the PVA films used in the aforementioned working examples and comparative examples, that, with a PVA film for which complete dissolution temperature (X) is around 70 to 75°C, a polarizing film with desired characteristics can be obtained when equilibrium swelling degree (Y) is 1.8 (or 1.9 or higher and 2.0 or higher), while such a polarizing film cannot be obtained when equilibrium swelling degree (Y) is lower than that. However, it is hardly possible to draw, from these four points alone, a conclusion that the range of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) whereby desired characteristics can be obtained is the range in which complete dissolution temperature in hot water (X) is 65°C or higher and equilibrium swelling degree (Y) exceeds the value calculated by the formula, " $-0.0667X + 6.73$ " [Formula (I)].

In that case, it cannot be said that the detailed explanation of the invention in the Description describes the manufacturing method pertaining to Invention 1, that is, the fact that a polarizing film obtained has desired characteristics based on the condition that a PVA film with specific thickness and specific complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) as prescribed in Claim 1 is used as a raw film, and that the polarizing film is manufactured under specific stretching conditions as prescribed in Claim 1, to the extent that a person ordinarily skilled in the art can understand such fact. In addition, it is not recognized that the knowledge that a polarizing film with desired characteristics can be obtained by being manufactured by using such a PVA film as a raw film under said stretching conditions was the common general technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application. That is, it cannot be said, even in light of the common general technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application, that the content disclosed in the detailed explanation of the invention in the Description can be expanded or generalized to the scope of the invention claimed in Claim 1.

B. Therefore, Invention 1 and Inventions 2 and 3 which cite Invention 1 exceed the scope described in the detailed explanation of the invention so that a person ordinarily skilled in the art can recognize that the problem to be solved by the invention can be solved. Accordingly, the statement of the scope of claims in the Description cannot be considered as conforming to the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act.

Incidentally, the plaintiff alleges that, in Invention 1, when complete dissolution temperature in hot water (X) is 65°C or higher, the upper limit of equilibrium swelling degree (Y) is around 2.5 at the highest and that the substantial upper limit never exceeds 3.0 even in consideration of measurement error and other conditions. However, according to Ko No. 6 Experimental Certificate, the heat treatment temperature of working example 2 described in the Description (Exhibit Ko No. 3) is 90°C (Table 1 on page 7), and it does not conform to the premise of the plaintiff's allegation,

"if heat treatment temperature is 110°C or higher." Therefore, the ground of the plaintiff's aforementioned allegation is unclear.

The plaintiff also alleges that the range that satisfies two formulas, Formula (I) and Formula (II), does not indicate an indefinitely extensive range because equilibrium swelling degree (Y) is 1 or higher and its upper limit never exceeds 3.0, while the lower limit of complete dissolution temperature in hot water (X) is 65°C and its upper limit is substantially 90°C. However, even if the ranges of values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) are as alleged by the plaintiff, it is obvious that the range is more extensive than the range of the two working examples described in the detailed explanation of the invention in the Description. Therefore, the fact remains that it cannot be said, based on the only two working examples for which the effect has been actually confirmed, that PVA films other than those used in the working examples necessarily bring about a superior effect as long as they satisfy the two formulas, Formula (I) and Formula (II). In addition, even if the upper limit of equilibrium swelling degree (Y) is 3.0, it is obvious that the ranges of values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) remain more extensive, compared to the areas of distribution of the two working examples described in the Description.

(3) In determining violation of Article 36, paragraph (5), item (i) of the Old Patent Act, the experimental data described in Ko No. 6 Experimental Certificate cannot be taken into consideration, as mentioned below.

A. Advisability of taking the experimental data into consideration in relation to the content of experiments described in Ko No. 6 Experimental Certificate

(A) The conditions of the experiments described in Ko No. 6 Experimental Certificate and those of the experiments of the working examples described in the Description significantly differ from each other, as mentioned below.

a. The drying temperature, drying time, and dry substrate of the two working examples described in the Description are 30 to 40°C, 24 hours, and PET (polyethylene terephthalate), respectively. On the other hand, in experiments 1 to 8 described in Ko No. 6 Experimental Certificate, the drying temperature and drying time are 85 to 102°C and two to ten minutes, respectively, and the dry substrate is PET for experiments 1 to 3 and is SUS (Note: stainless steel) for experiments 4 to 8.

b. Out of the aforementioned experimental conditions, focusing attention on drying temperature, drying temperature in experiments 1 to 8 described in Ko No. 6 Experimental Certificate is 85 to 102°C, at the temperature near the boiling point of water, and it is significantly far from 30 to 40°C, at temperature near room temperature, in working examples 1 and 2 described in the Description. Also taking into consideration the change of state of water and drying time, experiments 1 to 8 and working examples significantly differ in terms of drying conditions.

The glass transition temperature of PVA is approximately 65 to 85°C (Exhibits Otsu No. 1 and No. 2 cited in No. 4, 1(2)B(B) above), and it is commonly predicted that the effect on the tissue conditions of PVA significantly differs between the case where drying temperature is higher than the glass transition temperature (experiments 1 to 8 described in Ko No. 6 Experimental Certificate) and the case where it is lower (working examples 1 and 2 described in the Description). Moreover, according to the statement in Ko No. 8 Document, the degree of crystallization of PVA differs depending on heat treatment temperature even if the heat treatment temperature is between 30 and 100°C. The working examples described in the Description and experiments 1 to 8 described in Ko No. 6 Experimental Certificate differ in drying temperature; therefore, they express different degrees of crystallization depending on the drying temperature. Consequently, the working examples and experiments 1 to 8 significantly differ in terms of the experimental conditions.

The plaintiff's allegation that the experimental conditions in relation to drying conditions do not significantly differ is unreasonable for the aforementioned reason. Furthermore, the allegation is equivalent to alleging that the result is the same even if drying temperature is set as 200 or 300°C if drying time is shorter. The plaintiff's allegation is unreasonable as it obviously disregards the glass transition temperature and softening temperature of the material, change of state of water, etc.

c. With regard to dry substrates, SUS, which is different from the PET that is used for the working examples described in the Description, is used for experiments 4 to 8, which are more than a half of experiments 1 to 8 described in Ko No. 6 Experimental Certificate. The purpose of using different dry substrates is unclear. However, it is commonly anticipated that thermal characteristics of substrates in the drying process differ due to difference in the materials of the dry substrates. Therefore, experiments 4 to 8 using a different dry substrate differ from the working examples described in the Description in the experimental conditions in this point as well.

(B) As mentioned above, experiments 1 to 8 described in Ko No. 6 Experimental Certificate significantly differ from the working examples described in the Description in drying temperature and drying time. In addition, experiments 4 to 8 described in Ko No. 6 Experimental Certificate and comparative experiments 1 and 2 differ from the working examples described in the Description in terms of dry substrate, and taking an overall look at the experiments, their experimental conditions significantly differ from those of the working examples described in the Description. Therefore, experimental data described in Ko No. 6 Experimental Certificate do not supplement the working examples and comparative examples described in the Description, but they are the addition of new working examples. Consequently, the experimental data cannot be taken into consideration in determining violation of Article 36, paragraph (5), item (i) of the Old Patent Act.

Incidentally, the plaintiff alleges that experiments 1 to 8 described in Ko No. 6 Experimental Certificate were conducted by using actual equipment and that they were conducted with short

drying time as drying time is significantly limited in relation to the manufacturing time. However, there is no reason that drying time cannot be made longer even if experiments are conducted by using actual equipment. In this regard, the results of experiments in Ko No. 6 Experimental Certificate lack credibility and cannot be considered as supplementing the working examples and comparative examples described in the Description.

B. Advisability of taking the experimental data described in Ko No. 6 Experimental Certificate into consideration in relation to the state of the art as of the time of filing the Application

(A) Whether the statement of the scope of claims conforms to the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act should be determined taking into consideration the common general technical knowledge of persons skilled in the art as of the time of filing a patent application, in addition to the description and drawings attached to the written application of the patent application.

Therefore, where the experimental data described in Ko No. 6 Experimental Certificate falls under the common general technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application, it can be taken into consideration in the aforementioned determination. However, otherwise, it cannot be taken into consideration.

(B) Invention 1 is a method of manufacturing a polarizing film that has advanced polarization performance and durability performance, etc. by using a PVA film with specific thickness, complete dissolution temperature in hot water (X) that is higher than a specific value, and equilibrium swelling degree (Y) which is higher than the value calculated by a function thereof, Formula (I), as described in Claim 1, as a raw film and by stretching the PVA film under specific conditions as described in Claim 1.

The plaintiff alleges that the formula, " $Y > -0.0667X + 6.73$ " [Formula (I)], was arrived at by adding 10 pieces of experimental data described in Ko No. 6 Experimental Certificate to 4 pieces of experimental data on the working examples and comparative examples described in the Description and by plotting the 14 pieces of experimental data in total. However, even if it is usual practice, in chemical fields, including the manufacture of polarizing films such as the Inventions, to find a range in which a desired thing can be obtained by organizing many experimental data in this manner, a preferred range drawn based on the experimental data cannot be considered as common general technical knowledge as of the time of filing the Application for persons ordinarily skilled in the art. The plaintiff says that it could draw the relationship between the aforementioned desired characteristics and complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of a PVA film only based on the aforementioned multiple pieces of experimental data, and it is, rather, just making a self-admission that the aforementioned preferred range and experimental data serving as the basis thereof cannot be considered as having been common general

technical knowledge.

Then, as the experimental data described in Ko No. 6 Experimental Certificate cannot be considered as having been the common general technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application, it cannot be taken into consideration in determining violation of Article 36, paragraph (5), item (i) of the Old Patent Act.

C. Consequently, the determination in the decision to the effect that the experimental data described in Ko No. 6 Experimental Certificate cannot be taken into consideration in determining violation of Article 36, paragraph (5), item (i) of the Old Patent Act is not erroneous.

The plaintiff alleges that it drew the two formulas, " $Y > -0.0667X + 6.73$ " [Formula (I)] and " $X \geq 65$ " [Formula (II)], as prescribed in Claim 1 by adding 8 pieces of experimental data and 2 pieces of comparative experimental data described in Ko No. 6 Experimental Certificate to the two working examples and two comparative examples described in the Description and by plotting the 14 pieces of experimental data in total (see Figure 1 in Attachment 2). However, as mentioned above, the experimental data described in Ko No. 6 Experimental Certificate cannot be taken into consideration in determining violation of Article 36, paragraph (5), item (i) of the Old Patent Act. Therefore, the plaintiff's aforementioned allegation is erroneous in its premise.

(4) With regard to whether the Description satisfies the description requirements, the plaintiff alleges that it is not permitted to revoke the Patent only on the grounds of deficiency in the statement in the Description by retroactively applying the Examination Guidelines for Patent and Utility Model concerning the description requirements of a description, which were set after the filing of the application for the Patent.

However, the decision determined whether the Description satisfies the description requirements absolutely pursuant to laws and regulations, and it did not retroactively apply the Examination Guidelines for Patent and Utility Model, which were set after the filing of the application for the Patent. Therefore, the plaintiff's allegation is unreasonable.

2. Regarding ground for rescission 2 (error in the determination of violation of Article 36, paragraph (4) of the Old Patent Act)

(1) Invention 1 is to control drying temperature, etc. so as to concurrently satisfy the two formulas concerning equilibrium swelling degree (Y) and complete dissolution temperature in hot water (X), " $Y > -0.0667X + 6.73$ " [Formula (I)] and " $X \geq 65$ " [Formula (II)]. Even if a method of separately controlling equilibrium swelling degree (Y; degree of crystallization) or complete dissolution temperature in hot water (X; size of crystals) has been well-known as alleged by the plaintiff, it cannot be said that the conditions for manufacturing a film that concurrently satisfies the aforementioned two formulas has been well-known among persons skilled in the art. Consequently, the plaintiff's allegation, "the method of manufacturing a film is obvious from the common general

technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application without needing to describe it in the detailed explanation of the invention," is groundless.

In addition, the plaintiff's allegation that the conditions for manufacturing a PVA film with a specific size of crystals and degree of crystallization cannot be directly and unambiguously specified is the self-acknowledgement of the fact that a PVA film to be used as a raw film in the Inventions can be manufactured only through trial and error. Therefore, it is obvious that a person ordinarily skilled in the art cannot easily work the Inventions.

(2) As is clear from Figure 1 in Attachment 1, the two working examples described in the Description are found in a small region within an area that concurrently satisfies the two formulas shown in said figure. On the other hand, the range that concurrently satisfies the two formulas, Formula (I) and Formula (II), in the Description is extensive far beyond the range covered by the aforementioned two working examples. Therefore, a person ordinarily skilled in the art cannot easily assume the manufacturing conditions under which a PVA film for which the relationship between equilibrium swelling degree (Y) and complete dissolution temperature in hot water (X) is within such a range can be manufactured.

Though the Description describes the two working examples and two comparative examples, the plaintiff's allegation that the conditions for manufacturing a PVA film with a specific size of crystals and degree of crystallization cannot be directly and unambiguously specified contradicts the aforementioned statement on the working examples and comparative examples and also denies the meaning of working examples, which should specifically indicate the best mode for working the invention. Therefore, the plaintiff's allegation is unreasonable.

(3) A person ordinarily skilled in the art cannot understand, merely from the statement of the detailed explanation of the invention in the Description, that a polarizing film with desired characteristics can be obtained by adopting the constitution of Invention 1, as mentioned in 1(2) above. In addition, the plaintiff also recognizes that the relationship between the constitution and effect does not fall under the common general technical knowledge of persons ordinarily skilled in the art as of the time of filing the Application.

In that case, according to the constitution of Invention 1, it cannot be said that the corresponding relationship with a desired effect, i.e., obtaining a polarizing film for which the fading temperature in water is 60°C or higher and which "neither is cut nor displays cracks even if it is stretched 6.4 times during the boric acid treatment," is described in the detailed explanation of the invention in the Description.

In order for the plaintiff to allege, while taking into consideration the experimental data described in Ko No. 6 Experimental Certificate, that it disclosed in the Description that a polarizing film with desired characteristics can be obtained by using a PVA film for which the value of

complete dissolution temperature in hot water (X) exceeds 65°C [Formula (II)] and the value of equilibrium swelling degree (Y) exceeds the value calculated by the formula, " $-0.0667X + 6.73$ " [Formula (I)], respectively, and has obtained a patent for Invention 1 based on this knowledge, the experimental data supporting such knowledge should have originally been described in the detailed explanation of the invention in the Description.

(4) As mentioned above, the decision is not erroneous in determining that the detailed explanation of the invention in the Description is not recognized as describing the purpose, constitution, and effect of the invention to the extent that a person ordinarily skilled in the art can easily work the invention.

No. 6 Judgment of this court

1. Regarding ground for rescission 1 (error in the determination of violation of Article 36, paragraph (5), item (i) of the Old Patent Act)

(1) Article 36, paragraph (5) of the Old Patent Act provides that "The statement of the scope of claims as provided in paragraph (3), item (iv) shall comply with each of the following items," and item (i) thereof provides that "the invention for which a patent is sought is stated in the detailed explanation of the invention" (said item has become Article 36, paragraph (6), item (i) of the Patent Act as it is by the 1994 Revision Act, leading to the present day; hereinafter also referred to as the "Support Requirement of a Description").

The purpose of the patent system is to encourage inventions and contribute to the development of industry by granting patents to the inventions on the premise of disclosure of the inventions and thereby guaranteeing the monopolistic and exclusive working of the inventions as a business for a certain period of time. A description, which a person who intends to obtain a patent for an invention should attach to the written application, originally has the role of clarifying the scope (technical scope of the patented invention) to which a patent right extends after establishment of the patent right, as well as disclosing the technical content of the invention to the public. Therefore, it should be said that in order to obtain a patent by describing an invention in the scope of claims, it is necessary to describe the invention in the detailed explanation of the invention in the description so that a person ordinarily skilled in the art can recognize that the problem to be solved by the invention can be solved. The Support Requirement of a Description prescribed in Article 36, paragraph (5), item (i) of the Old Patent Act limits the statement of the scope of claims as shown in the aforementioned provision because if an invention not described in the detailed explanation of the invention is described in the scope of claims, a monopolistic and exclusive right will arise for an undisclosed invention, and it will deprive the general public of the benefits of free use and will cause the likelihood of inhibiting the development of industry, which goes against the aforementioned purpose of the patent system.

Whether the statement of the scope of claims satisfies the Support Requirement of a Description should be determined by considering, through comparison of the statement of the scope of claims and the statement of the detailed explanation of the invention, whether the invention described in the scope of claims is the invention described in the detailed explanation of the invention that is within the scope for which a person ordinarily skilled in the art can recognize, based on the statement of the detailed explanation of the invention, that the invention can solve the problem to be solved by the invention, and also by considering whether the invention described in the scope of claims is an invention within the scope which a person ordinarily skilled in the art can recognize, in light of the common general technical knowledge as of the time of filing the application, that the invention can solve the problem to be solved by the invention, even without the statement and indication thereof. For the existence of the Support Requirement of a Description, it is reasonable to understand that the patent applicant (the plaintiff in the lawsuit to seek the rescission of the trial decision dismissing a request for a trial against an examiner's decision of refusal) or the patentee (the plaintiff in the lawsuit to seek the rescission of a decision revoking the patent or the lawsuit to seek the rescission of a trial decision upholding a request for a trial for patent invalidation based on Article 2, paragraph (9) of the Supplementary Provisions of Act No. 47 of 2003; the defendant in the lawsuit to seek the rescission of a trial decision dismissing a request for a trial for patent invalidation) assumes the burden of proof.

Based on the aforementioned perspectives, this case is to be considered.

(2) Regarding the statement of the scope of claims in the Description

Claim 1 pertaining to Invention 1 describes a manufacturing method in which, in manufacturing a polarizing film by uniaxially stretching a polyvinyl alcohol raw film, a polyvinyl alcohol film (PVA film) which is 30 to 100 μm thick and for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range indicated by two formulas, Formula (I) and Formula (II), is used. In addition, both claims 2 and 3 pertaining to Inventions 2 and 3 in the scope of claims cite Claim 1.

(3) Regarding the statement of the detailed explanation of the invention in the Description

A. The Description (Exhibit Ko No. 3) describes the following matters.

(A) "[Field of industrial application] The invention (Note: the Inventions) relates to a method of manufacturing a polarizing film which is superior in durability performance and polarization performance and also has good performance in stability at the time of manufacturing." (paragraph [0001])

(B) "[Prior art] ... In the case of a polyvinyl alcohol polarizing film, an iodine-dyed product is good in polarization performance but is inferior in moisture resistance and heat resistance, and it has a drawback, that is, deterioration in the degree of polarization under a high-humidity or

high-temperature atmosphere, i.e. inferior durability. On the other hand, a colorant-dyed product is inferior in polarization performance but has an advantage of being superior in durability. In this manner, polyvinyl alcohol polarizing films have good and bad points; therefore, it is actually inevitable to use them accordingly depending on the performance required for the final use. Consequently, if a polyvinyl alcohol polarizing film which is superior in both polarization performance and durability is developed, it will be very useful for expansion of its use, etc. Thus, the applicant suggested using a PVA film which is 30 to 100 μm thick and for which the complete dissolution temperature in hot water is 65 to 90°C as a raw film in manufacturing a polarizing film by uniaxially stretching a polyvinyl alcohol raw film in at least either the dyeing process or the boron compound treatment process (Unexamined Patent Application Publication No. 1992-173125). By this method, a polarizing film for which the durability under high-temperature and high-humidity conditions was improved and for which the degree of polarization does not change even if it is left as it is for a long period of time was obtained." (paragraphs [0002] to [0005])

(C) "[Problem to be solved by the invention] However, although a polarizing film which is superior in durability under high-temperature and high-humidity conditions was assuredly obtained in Unexamined Patent Application Publication No. 1992-173125 as a result of further studies made by the inventor, etc., it was revealed that polarization performance and durability performance, etc. cannot be stabilized only with the provisions on the thickness and complete dissolution temperature in hot water of a polyvinyl alcohol raw film, that is, the degree of polarization of products may vary due to a slight fluctuation in the manufacturing conditions and meticulous process management is required. For the manufacturing method published in said publication, experiment was conducted by manufacturing a polarizing film which was uniaxially stretched up to 7.2 times in the end. However, it is not easy to control the stretch ratio with high accuracy in the production process. If a film is stretched more than 7.2 times in the process, problems arise, for example, the film breaks or displays cracks. In this regard, sufficient attention must be paid to the production management. In other words, a raw film that can bear excessive stretching, which is hard to avoid especially in the process of stretching a film, has come to be required. Therefore, the development of a method of manufacturing a polarizing film which has high polarization performance and durability performance and will not breakeven at the time of excessive stretching as mentioned above: that is, a superior polarizing film which can bear a high stretch ratio." (paragraphs [0006] and [0007])

(D) "[Means for solving the problem] As a result of carrying on dedicated studies to solve the problem, the inventor, etc. found that, in manufacturing a polarizing film by uniaxially stretching a polyvinyl alcohol raw film, the aforementioned purpose can be achieved based on the conditions that a polyvinyl alcohol film which is 30 to 100 μm thick and for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the

range indicated by the following formulas is used as raw film, and that the polyvinyl alcohol raw film is uniaxially stretched 1.2 to 2 times in the dyeing treatment process and is further uniaxially stretched 2 to 6 times in the boron compound treatment process, respectively; particularly if the polyvinyl alcohol film is one for which the average degree of polymerization is 2,600 or higher. Thereby, the inventor, etc. completed the Inventions.

$$Y > -0.0667X + 6.73 \dots (I)$$

$$X \geq 65 \dots (II)$$

X: Complete dissolution temperature (°C) of a 2 cm-square film piece in hot water

Y: Equilibrium swelling degree (weight fraction) calculated by dividing the weight of the film after dipping by the weight of the film after drying as indicated in the following formula when a 10 cm-square film piece is dipped in a constant temperature water bath of 20°C for 15 minutes for swelling and is then dried at 105°C for two hours." (paragraph [0008])

(E) "A film for which complete dissolution temperature is 65°C or lower cannot be used in practice as it partially dissolves or deteriorates at the time of stretching, while a film of which complete dissolution temperature is 90°C or higher cannot be sufficiently stretched and trouble tends to occur at the time of stretching. Even if the complete dissolution temperature of a film is within the aforementioned range, if its equilibrium swelling degree indicated by Formula (I) is outside the range indicated by the upper formula, problems occur, such as deterioration in the polarization performance and durability performance of the polarizing film and deterioration in the stability of manufacturing, etc. Therefore, it becomes difficult to obtain an intended polarizing film." (paragraph [0013])

(F) "[Working examples] A PVA film which is 80 μm thick and of which the complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) were the following values was dipped in a water solution composed of 0.2g/1 of iodine and 60g/1 of potassium iodide at 30°C for 240 seconds and was concurrently uniaxially stretched 1.2 times, and was then dipped in a water solution composed of 60g/1 of boric acid and 30g/1 of potassium iodide and was concurrently treated with boric acid for five minutes while being uniaxially stretched 6 times. After that, the PVA film was dried for 24 hours at room temperature. Thereby, a polarizing film was obtained. Measuring the fading temperature in water of the obtained polarizing film to evaluate moisture resistance and heat resistance, the values were as follows. For working examples 1 and 2, neither breaks nor cracks were found in the film even when the film was uniaxially stretched 6.4 times during the boric acid treatment after dyeing, while, for comparative examples 1 and 2, the film broke when the stretch ratio during the boric acid treatment after dyeing exceeded 6 times.

	Working example 1	Working example 2	Comparative example 1	Comparative example 2
Complete dissolution temperature (X) (°C)	71.6	72.0	74.5	75.3
Equilibrium swelling degree (Y)	2.4	2.2	1.6	1.6
Range of (Y) <calculated value>	Y > 1.95	Y > 1.93	Y > 1.76	Y > 1.71
Fading temperature in water (°C)	63	62	52	54

"

(Abstract of the statement in paragraphs [0020] to [0026])

(G) "[Effect of the invention] The invention shows a superior effect in the polarization performance and durability performance of a polarizing film and an excellent effect in stability at the time of manufacturing a polarizing film by using a polyvinyl alcohol film with specific complete dissolution temperature in hot water and equilibrium swelling degree as a raw film and by uniaxially stretching it at least in the boron compound treatment process." (paragraph [0027])

B. According to the statement in the Description as found above, the detailed explanation of the invention in the Description is recognized as describing the following. (1) Conventional PVA polarizing films have good and bad points, and the development of a PVA polarizing film which is superior in both polarization performance and durability had been desired (A(B) and (C) above). (2) A polarizing film for which durability under high-temperature and high-humidity conditions has been improved and for which the degree of polarization does not change even if it is left as it is for a long period of time can be obtained by the method described in Unexamined Patent Application Publication No. 1992-173125 (A(B) above); however, polarization performance and durability performance, etc. cannot be stabilized by this method, that is, the degree of polarization varies due to slight fluctuations in the manufacturing conditions, and problems had arisen at a high stretch ratio, such as breaks and cracks in the film (A(C) above). (3) The inventor, etc. found that a polarizing film with high polarization performance and durability which can bear a high stretch ratio can be manufactured by adopting the constitution described in Claim 1 in the scope of claims in the Description, taking into account the existence of such a problem in prior art (A(C) and (D) above).

Specifically, the detailed explanation of the invention is recognized as describing the following. Highly-durable polarizing films of which the fading temperature in water was 63°C and 62°C, respectively, and which neither broke nor cracked even at the stretch ratio of 6.4 were obtained from a PVA film for which the complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) were 71.6°C and 2.4 [within the range indicated by Formula (I)] (working example 1) and a PVA film of which the complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) were 72.0°C and 2.2 [within the range indicated by Formula (I)] (working example 2). On the other hand, insufficiently-durable polarizing films of which the fading temperature in water was 52°C and 54°C, respectively, and which broke if the stretch ratio exceeded 6.0 were obtained from a PVA film for which the complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) were 74.5°C and 1.6 [outside the range indicated by Formula (I)] (comparative example 1) and a PVA film for which the complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) were 75.3°C and 1.6 [outside the range indicated by Formula (I)] (comparative example 2) (A(F) above).

According to the statement in A(D) and (E) above, it is recognized that it is considered as an essential means for solving the problem of prior art that complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) are in a relationship that satisfies the two formulas, Formula (I) and Formula (II). However, there is no statement that proves that a person ordinarily skilled in the art can recognize that the problem can be solved if complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) are in a relationship that exists in the range that satisfies the two formulas, Formula (I) and Formula (II), other than the aforementioned working examples.

(4) Comparison between the invention described in the detailed explanation of the invention and the invention described in the scope of claims

A. As instructed in (1) above, in order to obtain a patent by describing an invention in the scope of claims, it is necessary to describe the invention in the detailed explanation of the invention in the description so that a person ordinarily skilled in the art can recognize that the problem to be solved by the invention can be solved. As is clear from (2) above, the Inventions include, as a constituent feature, a product specified by a range indicated by certain formulas using two technical parameters which indicate characteristic values, and relate to a parameter invention. It is reasonable to understand that, in order that the statement of the scope of claims satisfies the Support Requirement of a Description for such inventions, the detailed explanation of the invention needs to describe the technical meaning of the relationship between the range indicated by the formulas and the obtained effect (performance) to the extent that a person ordinarily skilled in the art can understand it as of the time of filing the application without requiring the disclosure of any specific examples, or to

describe said meaning by disclosing specific examples to the extent that a person ordinarily skilled in the art can recognize, in consideration of the common general technical knowledge as of the time of filing the application, that the desired effect (performance) can be obtained within the range indicated by the formulas.

B. Then, looking at whether the statement in the Description satisfies the Support Requirement of a Description mentioned in A above in relation to the statement of Claim 1 in the scope of claims, as considered in (3) above, the detailed explanation of the invention in the Description describes adoption of the constitution described in Claim 1 as a means for manufacturing a polarizing film which solves the problem of conventional PVA polarizing films, is superior in durability and polarization performance, and also has good performance in stability at the time of manufacturing. However, as specific examples intended to indicate the effectiveness of adopting said constitution, the detailed explanation of the invention merely describes two working examples, which indicate the fact that a polarizing film that was highly durable and could bear a high stretch ratio was obtained from a PVA film with specific values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y), and two comparative examples, which indicate the fact that a polarizing film that /was insufficiently durable and could not bear a high stretch ratio was obtained from a PVA film with other specific values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y).

On the other hand, in the Inventions, a polarizing film with the aforementioned desired performance can be obtained if complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) that a PVA film used as a raw film should satisfy are in a relationship that exists in the range defined by the two formulas, " $Y > -0.0667X + 6.73$ [Formula (I)]" and " $X \geq 65$ [Formula (II)]." There is no evidence sufficient to recognize that a person ordinarily skilled in the art could recognize as of the time of filing the Application, without requiring the disclosure of any specific examples, that the aforementioned range is defined based on the formula which is the basis of Formula (I), " $Y = -0.0667X + 6.73$ " (hereinafter referred to as the "Basic Formula of Formula (I)"), and the formula which is the basis of Formula (II), " $X = 65^{\circ}\text{C}$ " (hereinafter referred to as the "Basic Formula of Formula (II)").

In addition, in Figure 1 in Attachment 1 (there is no dispute over the content indicated in the figure between the parties), the Basic Formula of Formula (I) is indicated by an oblique full line and the Basic Formula of Formula (II) is indicated by a vertical dashed line on an X-Y plane on which X-axis indicates complete dissolution temperature in hot water (X) of a PVA film of 60 to 100°C and Y-axis indicates equilibrium swelling degree (Y) of 1.0 to 3.0, and the values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of PVA films used for the aforementioned working examples and comparative examples are plotted. As seen in the figure,

it is obvious that it is possible to draw a direct line or curved line based on another formula between the aforementioned two working examples and two comparative examples, other than the aforementioned oblique full line that indicates the Basic Formula of Formula (I), on said X-Y plane. Originally, it is also clear that it has not been proven that whether the desired effect (performance) can be obtained can be distinguished by any direct line or curved line on said X-Y plane as a borderline. Therefore, it can hardly be said that the aforementioned four specific examples alone precisely support the contention that the aforementioned oblique full line is a borderline which defines the range in which the desired effect (performance) can be obtained.

In that case, it should be considered impossible for a person ordinarily skilled in the art who sees the Description to recognize, even in consideration of the common general technical knowledge as of the time of filing the Application, that the aforementioned four specific examples prove that a polarizing film which solves the problem of conventional PVA polarizing films and has the aforementioned desired performance can be manufactured only if complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of a PVA film are in a relationship that exists in the range defined by the aforementioned oblique full line indicating the Basic Formula of Formula (I) and the aforementioned dashed line indicating the Basic Formula of Formula (II). Therefore, such statement in the detailed explanation of the invention in the Description alone cannot be considered as describing the invention by disclosing specific examples to the extent that a person ordinarily skilled in the art can recognize, in consideration of the common general technical knowledge as of the time of filing the Application, that the desired effect (performance) can be obtained within the range indicated by the formulas. Consequently, it cannot be said that the statement of Claim 1 in the scope of claims in the Description satisfies the Support Requirement of a Description.

C. The plaintiff also alleges that the range that satisfies the two formulas, Formula (I) and Formula (II), does not indicate an indefinitely extensive range because equilibrium swelling degree (Y) is 1 or higher and its upper limit never exceeds 3.0, while the lower limit of complete dissolution temperature in hot water (X) is 65°C and its upper limit is substantially 90°C.

However, even if the ranges of the values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) are as alleged by the plaintiff, it cannot be said that the Basic Formula of Formula (I) has been precisely supported by the aforementioned four specific examples, as mentioned in B above. Therefore, it still cannot be said, based on the two working examples for which the effect has actually been confirmed, that PVA films other than those used in the working examples necessarily bring about the aforementioned desired effect only if they satisfy the two formulas, Formula (I) and Formula (II). Consequently, the plaintiff's aforementioned allegation cannot be accepted.

(5) The plaintiff alleges as follows. In consideration of ten pieces of experimental data described in Ko No. 6 Experimental Certificate, which the plaintiff submitted at the stage of the proceedings of the Opposition, and the four pieces of experimental data described in the Description, the number of specific examples is sufficient to arrive at the two formulas, Formula (I) and Formula (II), and is also sufficient to confirm that PVA films that satisfy the aforementioned two formulas bring about a superior effect. However, in the decision, the JPO ruled, without taking Ko No. 6 Experimental Certificate into consideration and based only on the four examples in total, specifically, the two working examples, working examples 1 and 2, and the two comparative examples, comparative examples 1 and 2, which are described in the Description, that there are not sufficient working examples to provide convincing evidence that all of those that satisfy the aforementioned two formulas bring about an effect that is superior in polarization performance and durability performance and that it cannot be confirmed, in light of the statement in the Description and common general technical knowledge in the relevant field, that those that satisfy the aforementioned two formulas bring about the aforementioned superior effect. However, this determination is erroneous.

A. However, as mentioned in (4)A, for parameter inventions, such as the Inventions, of which constituent feature includes a product specified by the range indicated by certain formulas using two technical parameters that indicate characteristic values, it is understood that, in order that the statement of the scope of claims satisfies the Support Requirement of a Description, it is necessary to describe, in the detailed explanation of the invention, the invention by disclosing specific examples to the extent that a person ordinarily skilled in the art can recognize, in consideration of the common general technical knowledge as of the time of filing an application, that a desired effect (performance) can be obtained within the range indicated by certain formulas using parameters (technical parameters). This understanding is based on the original role of a description, that is, clarifying the scope to which the effect of a patent right extends after establishment of the patent right (technical scope of a patented invention) as well as disclosing the technical content of the invention for which a patent is sought to the public. This naturally includes the purpose of clarifying that the range indicated by the formulas is not a mere speculation but is supported by experimental results. If so, it should not be permitted to satisfy the Support Requirement of a Description by expanding or generalizing the content described in the detailed explanation of the invention to the scope of the invention described in the scope of claims by supplementing the content outside the statement by submitting experimental data after filing a patent application, although the detailed explanation of the invention does not disclose specific examples to the extent that a person ordinarily skilled in the art can recognize that the problem to be solved by the invention can be solved and it cannot be said, even in consideration of the common general technical knowledge of

persons ordinarily skilled in the art as of the time of filing the Application, that the content disclosed in the detailed explanation of the invention can neither be expanded nor generalized to the scope of the invention described in the scope of claims. This is because such act goes against the purpose of the patent system.

B. Looking at this case, Ko No. 6 Experimental Certificate is an experimental result certificate dated August 3, 2004, which was prepared by A (chief of the functional materials laboratory of the central research institute), who is the plaintiff's employee. The certificate describes the following. (1) A conducted experiments 1 to 8 and comparative experiments 1 and 2 during the period from May 18 to August 25, 1993, which is before the date of filing the Application, for the purpose of clarifying that a polarizing film which is superior in polarization performance and durability performance, etc. can be obtained when using a PVA film that satisfies the two formulas, Formula (I) and Formula (II), and making clear the basis based on which the two formulas, Formula (I) and Formula (II), were developed. (2) In experiments 1 to 8, PVA films for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) /was within the range of the two formulas, Formula (I) and Formula (II), were obtained by arbitrarily setting the average degree of polymerization of PVA, average degree of saponification of PVA, drying temperature, drying time, etc., and the fading temperature in water of polarizing films manufactured from the above PVA films was measured. In addition, the possibility of the film breaking where it is uniaxially stretched 6.4 times during the boric acid treatment process was verified. (3) In comparative experiments 1 and 2, PVA films for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) was outside the range of the two formulas, Formula (I) and Formula (II), were obtained by arbitrarily setting the aforementioned conditions such as the degree of polymerization of PVA, and the fading temperature in water of polarizing films manufactured from those PVA films was measured. In addition, the possibility of the film breaking where it is uniaxially stretched 6.4 times and 5.1 times, respectively, during the boric acid treatment process was verified. (4) Figure 1 in Attachment 2 (Note: the content indicated by the figure is substantially the same as that of Figure 2 in Attachment 1) organizes the results of these experiments, and it revealed that a polarizing film for which the fading temperature in water is high and which is superior in polarization performance and durability performance can be obtained if a PVA film for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) satisfies the two formulas, Formula (I) and Formula (II).

C. In that case, even accepting the statement in Ko No. 6 Experimental Certificate as they are, experimental data described in Ko No. 6 Experimental Certificate simply disclose, after the filing of the Application, the results of measuring the performance of polarizing films obtained from PVA

films with specific values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y), and the relationship between the values of complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of PVA films and the performance of polarizing films obtained which is determined based on the measured data, both of which are not specifically disclosed in the detailed explanation of the invention in the Description. It should not be permitted to take the data into consideration as a supplement of the aforementioned content described in the detailed explanation of the invention outside the statement therein, in light of the instruction in A above. Therefore, the plaintiff's aforementioned allegation cannot be accepted.

(6) As considered above, a person ordinarily skilled in the art cannot recognize, based on the matters described in the detailed explanation of the invention in the Description and the common general technical knowledge as of the time of filing the Application, that the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) of a PVA film that is necessary as a means for manufacturing a polarizing film, which solves the problem of conventional PVA polarizing films, is superior in durability and polarization performance, and also has good performance in stability at the time of manufacturing, can define the range indicated by the two formulas, Formula (I) and Formula (II). Therefore, the aforementioned detailed explanation of the invention cannot be considered as describing the invention of a polarizing film manufacturing method in which a PVA film for which the relationship between X and Y is within the range indicated by the two formulas, Formula (I) and Formula (II).

On the other hand, as mentioned in (2) above, Claim 1 describes the invention of a polarizing film manufacturing method in which a PVA film for which the relationship between complete dissolution temperature in hot water (X) and equilibrium swelling degree (Y) is within the range indicated by the two formulas, Formula (I) and Formula (II). Therefore, it is inevitable to say that the statement of the scope of claims of Invention 1 claimed in Claim 1 and of Inventions 2 and 3 claimed in claims 2 and 3 which cite Claim 1 exceeds the scope of the invention described in the detailed explanation of the invention in the Description.

Consequently, the statement of the scope of claims in the Description does not satisfy the Support Requirement of a Description, and it should thus be considered to be one that violates the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act. Therefore, the determination in the decision to that effect is not erroneous.

(7) In response to this, the plaintiff alleges as follows. As the time of filing the Application, it was not required to describe all experimental data that serve as the basis as working examples in a description for patent applications for parameter inventions, such as the Inventions; it should be considered extremely unreasonable and unacceptable to revoke the Patent only on the grounds of deficiency in the statement in the Description by retroactively applying the Examination Guidelines

for Patent and Utility Model concerning the description requirements of a description which were set after the filing of the application for the Patent despite the fact that whether the Description satisfies the description requirements did not become a question at all in the examination of the Application.

A. However, whether the statement of the scope of claims in the Description satisfies the Support Requirement of a Description prescribed in Article 36, paragraph (5), item (i) of the Old Patent Act should be determined in line with the purpose of said provisions of the Patent Act. According to the purpose of the provisions, interpretation as in (4)A above should be adopted with regard to the Support Requirement of a Description for parameter inventions, such as the Inventions.

B. The Examination Guidelines for Patent and Utility Model indicate basic ideas for examiners who engage in the examination of requirements for patentability, and are also widely used by applicants as an indicator for application management, etc. However, they are absolutely determination standards which were prepared for the purpose of contributing to securing the fairness and reasonableness of determinations made by the JPO concerning whether a patent application satisfies the requirements for patentability provided for in the Patent Act. They were not set as "review standards" mentioned in Article 5 of the Administrative Procedure Act (excluded from the application of the provisions of said Article pursuant to Article 195-3 of the Patent Act), and are not legal rules. Therefore, whether the content of interpretation of the aforementioned provisions of the Patent Act has been specifically prescribed as standards in the Examination Guidelines for Patent and Utility Model applicable to the application for the Patent does not affect the interpretation mentioned in (4)A above. In addition, the Examination Guidelines for Patent and Utility Model revised in October 2003 (Exhibit Ko No. 11) cite the case where "the content disclosed in the detailed explanation of the invention can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general technical knowledge as of the time of filing an application" as one of the types of violation of the Support Requirement of a Description. In addition, the Guidelines cite the case where "in an invention which is going to specify a product ... by limiting function and characteristic, etc. numerically, a sufficient number of specific examples covering the whole numerical range described in the claims is not shown, and furthermore by referring to other statement in the detailed examination of the invention or in light of the common general technical knowledge as of the time of filing an application, the relevant specific examples can neither be expanded nor generalized to the whole numerical range described in the claims" as an example thereof. It is obvious in light of the holding mentioned in (5)A above that this specific standard conforms to the purpose of the provisions of Article 36, paragraph (5), item (i) of the Old Patent Act. Because of this, even if the result is the same as that in the case of retroactively applying the standard to a description for a patent for which an application was filed before patent

applications to which the specific standard applies, the problem of violation of law shall not arise.

C. In this regard, the plaintiff alleges that the Examination Guidelines for Patent and Utility Model revised in October 2003 are the standards for the interpretation and application of Article 36, paragraph (6), items (i) and (ii) of the current Patent Act and that even if the Guidelines are retroactively applied, the subject of application should be limited to patent applications filed on and after January 1, 1995, when the Patent Act after revision by the 1994 Revision Act which includes the corresponding provisions became applicable. The plaintiff also alleges that, in the Inventions, the invention claimed in the scope of claims substantially corresponds to the invention described in the detailed explanation of the invention and that the detailed explanation of the invention conforms to the content of the Examination Guidelines for Patent and Utility Model, "It is necessary to state in the detailed explanation of the invention at least one mode that an applicant for a patent considers to be the best among the 'modes for working the invention' showing how to work the claimed invention." However, in light of the instructions above, the plaintiff's allegations cannot be accepted.

2. According as above, the plaintiff's allegation of an error in the determination in the decision to the effect that the statement of the scope of claims in the Description does not satisfy the Support Requirement of a Description and thus violates Article 36, paragraph (5), item (i) of the Old Patent Act (ground for rescission 1) is groundless. Therefore, the grounds for rescission alleged by the plaintiff are groundless without needing to determine whether the determination in the decision to the effect that the statement of the detailed explanation of the invention in the Description violates paragraph (4) of said Article is erroneous. Moreover, there is no other defect for which the decision should be rescinded. As noted in No. 3, 3(3), the decision violates law as it made an error in application of laws and regulations. However, it is obvious that the violation does not affect the conclusion of the decision.

Therefore, the plaintiff's claim is groundless and thus shall be dismissed, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Special Division

Presiding judge: SHINOHARA Katsumi

Judge: TSUKAHARA Tomokatsu

Judge: SATO Hisao

Judge: AOYAGI Kaoru

Judge: OKAMOTO Gaku

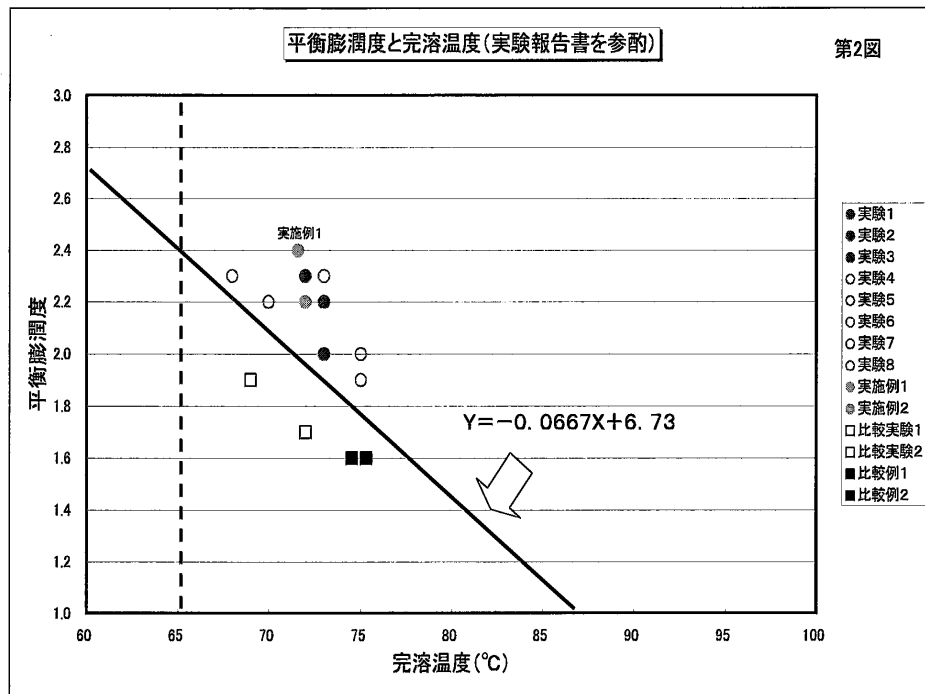
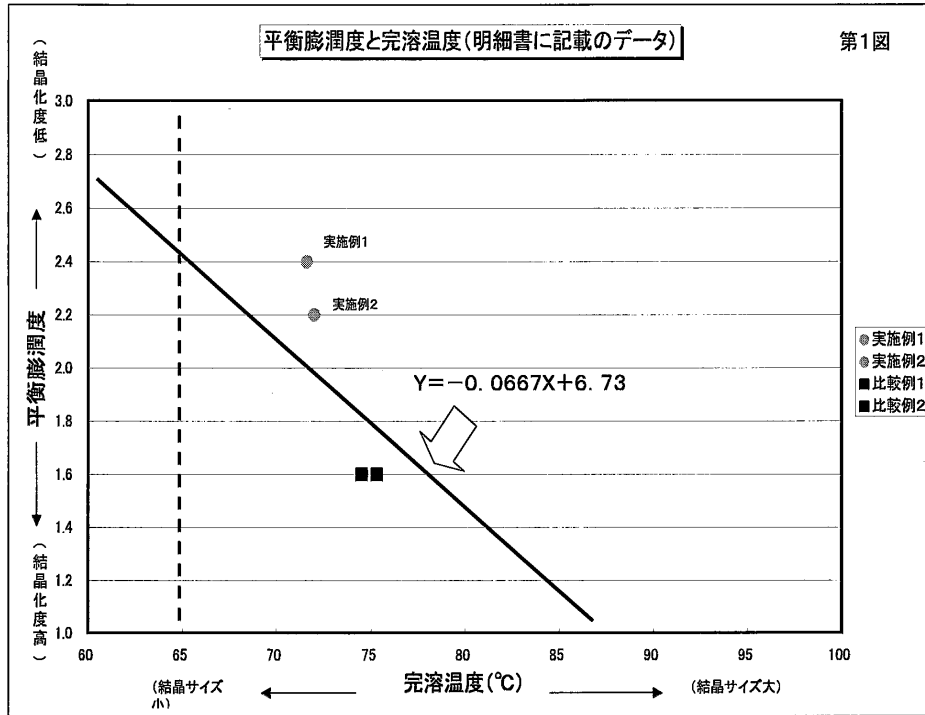


图 1

平衡溶解度与溶解温度

