

Patent Right	Date	May 27, 2022	Court	Tokyo District Court, 46th Civil Division
	Case number	2020 (Wa) 13326, 13331		
- A case in which the court dismissed a claim for an injunction against manufacture, etc. on the grounds of infringement of a patent right under a patent for an invention titled "ELDECALCITOL-CONTAINING AGENT FOR PREVENTING FOREARM FRACTURES."				

### Summary of the Judgment

The present case is one in which the Plaintiff, who holds a patent right for an invention titled "ELDECALCITOL-CONTAINING AGENT FOR PREVENTING FOREARM FRACTURES," seeks an injunction against the production, import, transfer, and offer to transfer of medicinal products, as well as disposal of the same, for which the Defendants have each obtained a manufacturing and marketing approval, against the Defendants under Article 100, paragraphs (1) and (2) of the Patent Act on the grounds that both of the same medicinal products fall within the technical scope of the invention concerning the above-mentioned patent right.

All of the inventions under examination in the present case (hereinafter referred to as the "present inventions") relate to using eldecalcitol for use in the prevention of forearm fractures. While the issues in the present case are wide-ranging, this judgment dismissed the Plaintiff's claim, on the grounds that the patent for the present inventions has a reason for invalidation based on lack of novelty and that the reason for invalidation is not resolved by a request for correction made by the Plaintiff in the procedure of a trial for invalidation concerning the same patent right.

The invention under consideration for the determination of novelty in the present case relates to using eldecalcitol for use as a therapeutic agent for osteoporosis (hereinafter referred to as the "comparative invention"). This judgment found that use in the comparative invention is at least partially identical to use as the "prevention of forearm fractures" in the present invention, on the grounds that the therapeutic agent for osteoporosis is a medicinal product which prevents new fracture and that the radius (part of the forearm bone) as well as the vertebral body, etc. was known as one of the major sites where a fracture can occur due to osteoporosis.

In this regard, the Plaintiff asserted that the present invention is recognized to have novelty, by restricting a fracture prevention target to the forearm only, not to the entire body. However, this judgment held that it is not possible to distinguish between the use in the comparative invention and the use in the present invention when eldecalcitol is administered, on the grounds that when eldecalcitol was used as a therapeutic agent for osteoporosis, an effect of preventing forearm fractures was specifically expected as

well as that of preventing fractures in other sites of the body, and that mechanisms of action for preventing fractures assumed by the comparative invention and the present invention are identical. Further, the Plaintiff asserted that a remarkable effect of eldecacitol on the prevention of forearm fractures was found for the first time through the present invention. However, this judgment held that the remarkable effect asserted by the Plaintiff cannot be recognized from the statement of the description, and therefore, the Plaintiff's assertion lacks its premise.