

Patent Right	Date	October 5, 2023	Court	Intellectual Property High Court, Second Division
	Case number	2022 (Ne) 10094		
- A case in which an appeal was dismissed on the grounds that the prior instance dismissing the Plaintiff's claims is reasonable in its conclusion because the present patent has a reason for invalidation based on violation of the support requirement.				

Case type: Injunction, etc.

Result: Appeal dismissed

References: Article 104-3, paragraph (1), Article 123, paragraph (1), item (iv), and Article 36, paragraph (6), item (i) of the Patent Act

Related rights, etc.: Patent No. 6752438

Judgment of the prior instance: Tokyo District Court 2021 (Wa) 29388, Judgment rendered on August 2, 2022

#### Summary of the Judgment

1. The present case is one in which with regard to a patent for an invention titled "COMPOSITIONS COMPRISING 2,3-DICHLORO-1,1,1-TRIFLUOROPROPANE, 2-CHLORO-1,1,1-TRIFLUOROPROPENE, 2-CHLORO-1,1,1,2-TETRAFLUOROPROPANE, OR 2,3,3,3-TETRAFLUOROPROPENE" (Number of claims: 2), the Plaintiff, who is a patentee, sought an injunction against transfer, etc. and disposal of the Defendant's product on the grounds that the Defendant's product falls within the technical scope of the invention according to Claim 1 (present invention) and thus the production, sale, etc. of the Defendant's product infringe the present patent right.

The judgment in prior instance dismissed all of the Plaintiff's claims on the grounds that the present patent has a reason for invalidation based on lack of novelty on the premise of a violation of the division requirement and thus the Plaintiff may not exercise the present patent right against the Defendant under Article 104-3, paragraph (1) of the Patent Act. In response, the Plaintiff filed an appeal.

Incidentally, Claim 1 according to the present invention recites "A composition comprising HFO-1234yf, HFC-143a, and HFC-254eb, wherein the composition comprises 0.2 percent by weight or less of HFC-143a and 1.9 percent by weight or less of HFC-254eb."

2. As mentioned below, the present judgment determined that the statement of the claims violates Article 36, paragraph (6), item (i) of the Patent Act and that the Plaintiff may not exercise the patent right against the Defendant irrespective of whether the divisional application is valid and whether the correction is compliant. In conclusion, this judgment held that the prior instance, which reached the same

conclusion, is reasonable, and dismissed the appeal.

(1) Whether or not the statement of the claims complies with the support requirement should be determined by comparing between the statement of the claims and the statement of the Detailed Description of the Invention, and then examining: whether or not the invention stated in the claims is the invention stated in the Detailed Description of the Invention, and falls within the scope where a person ordinarily skilled in the art can recognize that the problem of the invention can be solved by the statement of the Detailed Description of the Invention; or whether or not, even if it is neither stated nor suggested in the Detailed Description of the Invention, the invention stated in the claims falls within the scope where a person ordinarily skilled in the art can recognize that the problem of the invention can be solved in light of the common general technical knowledge at the time of filing the application.

(2) The present description can be deemed to state the following: HFO-1234yf is known to have low global warming potential (GWP) and is a good candidate for replacing saturated HFC refrigerants with high GWP; in preparing HFO-1234yf, certain additional compounds are present in small amounts; as one of the additional compounds contained in a composition of the present invention, there is less than about 1 percent by weight of HFC-143a; and by-products generated in the process of preparing HFO-1234yf and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) fall under the additional compounds.

In this regard, it is evident from the statement itself of the present description that HFO-1234yf was already known to be useful as a compound with low global warming potential (GWP) prior to the date of filing the original application. Thus, if the present description does not state what technical significance the presence of the additional compounds in small amounts in preparing HFO-1234yf contributes to, what function and effect the presence thereof provides, and what problem is solved by the presence, the present description does not state the problem to be solved by the present invention. However, the present description does not state anything about these points, and even examining other statements, the present description is not found to include any portions that suggest the problem to be solved by the present invention.

The "problem to be solved by the invention" formally stated in the present description merely describes the technical field to which the present invention belongs, and is insufficient for a statement of the problem of the present invention, and there is no other choice but to deem that the present description does not state the problem of the present invention. Thus, it cannot also be deemed that a person ordinarily skilled

in the art can recognize that the problem of the invention can be solved by the statement of the present description.

(3) Even if a portion formally stated as "problem to be solved by the invention" in the present description is interpreted to describe the problem of the present invention and it is understood that the problem of the present invention is to "provide a composition useful for a heat transfer composition," the present description cannot be deemed to state the composition of the present invention (the present description includes a statement in terms of mole percent, but the statement cannot be converted into weight percent because the statement includes unknown materials). In addition to this, the present description neither states nor suggests anything about in what meaning a composition having such a structure will be a "useful" composition beyond the usefulness of HFO-1234yf.

Thus, a person ordinarily skilled in the art also cannot understand from the statement of the present description that the composition of the present invention is a "useful" composition as a heat transfer composition.

(4) It is the same irrespective of whether the filing date is the date of filing the original application or the date of filing the divisional application that a person ordinarily skilled in the art cannot recognize that the problem of the present invention can be solved by the statement of the present description.

(5) Further, even if the present correction adds a lower limit of "77.0 mole percent or more" to the definition of HFO-1234yf in Claim 1 according to the present invention, a reason for invalidation based on a violation of the support requirement will be present. Thus, the re-defense of the correction cannot resolve the reason for invalidation based on the violation of the support requirement.

Judgment rendered on October 5, 2023

2022 (Ne) 10094 Appeal case of seeking injunction against patent infringement, etc.

(Prior instance: Tokyo District Court 2021 (Wa) 29388)

Date of conclusion of oral argument: August 1, 2023

### Judgment

Appellant: The Chemours Company FC, Limited Liability Company

Appellee: AGC Inc.

### Main text

1. The appeal shall be dismissed.
2. The Appellant shall bear the costs of the appeal.
3. The additional period for the Appellant to file a final appeal and a petition for acceptance of final appeal against this judgment shall be 30 days.

### Facts and reasons

Abbreviations of terms and their meanings shall follow the judgment in prior instance, except for those given in this judgment. In addition, all of the terms "Attachment" in the quoted portions in the judgment in prior instance are amended to "Attachment of the judgment in prior instance."

#### No. 1 Object of the appeal

1. The judgment in prior instance shall be reversed.
2. The Appellee may not produce, use, transfer, or offer to transfer a product as stated in the List of the Defendant's Product in the Attachment of the judgment in prior instance.
3. The Appellee must dispose of the product as stated in the List of the Defendant's Product in the Attachment of the judgment in prior instance.
4. The Appellee shall bear the court costs in both the first and second instance.
5. Declaration of provisional execution

#### No. 2 Outline of the case

##### 1. Summary of the case

The present case is one in which the Appellant (Plaintiff in prior instance; hereinafter referred to as "the Plaintiff"), who is a patentee of a patent for an invention titled "COMPOSITIONS COMPRISING 2,3-DICHLORO-1,1,1-TRIFLUOROPROPANE, 2-CHLORO-1,1,1-TRIFLUOROPROPENE, 2-CHLORO-1,1,1,2-TETRAFLUOROPROPANE, OR 2,3,3,3-TETRAFLUOROPROPENE"

(Patent No. 6752438, the present patent), asserts that a product as stated in the List of the Defendant's Products in the Attachment of the judgment in prior instance (Defendant's product) falls within the technical scope of the invention pertaining to the Present Patent and that acts of the production, use, transfer, or offer to transfer of the Defendant's product by the Appellee (Defendant in prior instance; hereinafter referred to as "the Defendant") constitute infringement of the Present Patent Right, and the Plaintiff seeks injunctive relief of the transfer, etc. of the Defendant's Product and disposal thereof pursuant to Article 100, paragraphs (1) and (2) of the Patent Act.

The judgment in prior instance dismissed all of the Plaintiff's claims, on the grounds that the Present Patent has a reason for invalidation based on lack of novelty and that thus the Plaintiff may not exercise the Present Patent Right against the Defendant pursuant to Article 104-3, paragraph (1) of the Patent Act. Therefore, the Plaintiff filed this appeal.

## 2. Basic facts, issues, and assertions on the issues by the parties

Except for the following amendments and the addition of supplementary assertions by the parties in this instance in 3 below, basic facts, issues, and assertions on the issues by the parties are as stated in 1 to 3 of "No. 2 Outline of the case" in "Facts and reasons" in the judgment in prior instance, and thus, such statements shall be quoted.

(1) The phrase "The invention according to Claim 1 (hereinafter referred to as 'the present invention')" on page 3, line 6 is amended to "The statement of Claim 1 (hereinafter, the invention according to Claim 1 will be referred to as 'the present invention')", the phrase "the description" on the same page, line 7 is amended to "the description and drawings", and the phrase "Exhibit Ko 18" on the same page, line 23 is amended to "Exhibits Ko 18-1 and 18-2".

(2) The phrase "it is clearly stated that" on page 5, line 11 is amended to "in the present description, it is clearly stated that."

(3) The phrase "the description of the present original application as originally filed (hereinafter referred to as "the description of the original application as originally filed"), etc." on page 8, line 2 is amended to "the description (Exhibit Otsu 4), claims, and drawings originally attached to a written application of the present original application (hereinafter referred to as 'the description of the original application as originally filed')", and each instance of the phrase "the description, etc. of the original application as originally filed" on the same page, lines 4, 5, and 10 is amended to "the description of the original application as originally filed".

(4) The phrase "Exhibit Otsu 6" on page 8, line 16 is amended to "Unexamined

Patent Application Publication No. 2018-154841, Exhibit Otsu 6."

(5) The phrase "the description, etc. of the original application as originally filed" on page 10, line 8 is amended to "the description of the original application as originally filed," and at the end of line 13 of the same page, a line break is inserted, and the phrase "Incidentally, in order to be used as a cited document for novelty, it is required that a 'specific technical idea' should be disclosed in the cited document. Thus, in the case where the present invention is recognized as lacking novelty on the basis of the Exhibit Otsu 6 document, as the specific technical idea, the Exhibit Otsu 6 document is deemed to disclose an aspect in which HFC-143a is 0.2 percent by weight or less and HFC-254eb is 1.9 percent by weight or less in addition to HFO-1234yf. In this case, the application does not violate the division requirement." is added.

(6) The phrase "a new technical effect that is caused by" ... "and that is not found in raw material components" on page 12, line 3 is amended to "a new technical effect that is produced by" ... "and that is not found in raw material components," and each instance of the phrase "the present invention" on the same page, line 23 and page 13, line 11 is amended to "the statement of the claims for the present invention".

(7) The phrase "the present correction invention" on page 14, line 20 is amended to "the statement of the claims for the present correction invention." In addition, after "is as" on the same page, line 23, the phrase ", because the Defendant also does not dispute that the Defendant's product comprises 77.0 mole percent or more of HFO-1234yf" is added, and at the end of line 24 of the same page, the phrase "If it is produced as a 'product,' regardless of whether it is in the process of reaction or distillation, the 'product' is a subject of working acts under the Patent Act. The Defendant's assertion is erroneous that the statement pertaining to 'Intermediate Product' in the List of Defendant's Product in the Attachment of the judgment in prior instance cannot be deemed to specify a structure of the subject product. The remainder of the counterarguments to the Defendant's assertions are as mentioned in (1) [Plaintiff's Assertions] B above." is added.

(8) After "the Defendant's product" on page 15, line 19, the phrase ", as mentioned in (1) [Defendant's Assertions] above," is added.

(omitted)

No. 3 Judgment of this court

This court determines that the Present Patent should be finally invalidated due to a violation of Article 36, paragraph (6), item (i) of the Patent Act and that the

Plaintiff may not exercise the Present Patent Right against the Defendant pursuant to Article 104-3, paragraph (1) of the same Act, on the grounds that it can be recognized that the statement of the claims for the present invention violates the support requirement regardless of whether or not the divisional application is legal and that even if the present correction is valid, the statement of the claims for the present invention violates the support requirement. The reasons are as follows.

1. Present invention

(1) The present description states as shown in Attachment "Patent Gazette" (Exhibit Ko 2).

(2) Outline of the present invention

According to the statement in (1) above, the present invention relates to a field of compositions useful for heat transfer compositions, etc., and new environmental regulations have led to the need for new compositions for use in refrigeration, air conditioning, and heat pump apparatus, and against this background, compounds with low global warming potential are of particular interest, and under these circumstances, in the present invention, it has been found that in preparing new compounds with low global warming potential, such as 1234yf, certain additional compounds are present in small amounts ([0001] to [0003] of the present description; hereinafter, a four-digit number enclosed in [ ] merely refers to a paragraph of the present description unless otherwise specified).

2. Issue 2-2 (Whether or not the defense of invalidity based on a violation of the support requirement as a reason for invalidation is established)

(1) Whether or not the statement of the claims complies with the support requirement should be determined by comparing between the statement of the claims and the statement of the Detailed Description of the Invention, and then examining: whether or not the invention stated in the claims is the invention stated in the Detailed Description of the Invention, and falls within the scope where a person ordinarily skilled in the art can recognize that the problem of the invention can be solved by the statement of the Detailed Description of the Invention; or whether or not, even if it is neither stated nor suggested in the Detailed Description of the Invention, the invention stated in the claims falls within the scope where a person ordinarily skilled in the art can recognize that the problem of the invention can be solved in light of the common general technical knowledge at the time of filing the application.

(2) With regard to the present case, as the "problem to be solved by the invention," the present description (hereinafter, the same applies to the description of the original application as originally filed) states that "The applicants have found that

in preparing new compounds with low global warming potential, such as 1234yf, certain additional compounds are present in small amounts." ([0003]). In addition, the present description states that: "According to the present invention, there is provided a composition comprising HFO-1234yf and at least one additional compound selected from the group consisting of HFO-1234ze, HFO-1243zf, HCFC-243db, HCFC-244db, HFC-245cb, HFC-245fa, HCFO-1233xf, HCFO-1233zd, HCFC-253fb, HCFC-234ab, HCFC-243fa, ethylene, HFC-23, CFC-13, HFC-143a, HFC-152a, HFO-1243zf, HFC-236fa, HCO-1130, HCO-1130a, HFO-1336, HCFC-133a, HCFC-254fb, HCFC-1131, HFC-1141, HCFO-1242zf, HCFO-1223xd, HCFC-233ab, HCFC-226ba, and HFC-227ca. The composition comprises less than about 1 percent by weight of the at least one additional compound." ([0004]); and "Among several uses for HFO-1234yf, uses as refrigerants, heat transfer fluids, aerosol propellants, and foam expansion agents have been particularly suggested. In addition, it has also been found that HFO-1234yf has low global warming potential (GWP) as recorded by V. C. Papadimitriou, et al. in Physical Chemistry Chemical Physics, 2007, volume 9, pages 1-13. Thus, HFO-1234yf is advantageous. As seen above, HFO-1234yf is a good candidate for replacing saturated HFC refrigerants with high GWP." ([0010]). Taking into overall consideration the statements of [0013], [0016], [0019], [0022], [0030], and [Figure 1] in addition to the above statements, the present description can be deemed to state the following: HFO-1234yf is known to have low global warming potential (GWP) and is a good candidate for replacing saturated HFC refrigerants with high GWP; in preparing HFO-1234yf, certain additional compounds are present in small amounts; as one of the additional compounds contained in the composition of the present invention, there is less than about 1 percent by weight of HFC-143a; and by-products generated in the process of preparing HFO-1234yf and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) fall under the additional compounds.

In this regard, it is evident from the statement itself of [0010] that HFO-1234yf was already known to be useful as a compound with low global warming potential (GWP) prior to the date of filing the original application. Thus, if the present description does not state what technical significance the presence of the additional compounds in small amounts in preparing HFO-1234yf contributes to, what function and effect the presence thereof provides, and what problem is solved by the presence thereof, the present description does not state the problem to be solved by the present invention. However, the present description does not state anything about these points, and even examining the remainder of the statements, the present description is



not found to include any portions that suggest the problem to be solved by the present invention. The present description states in "technical field" that "The present disclosure relates to a field of compositions useful as heat transfer compositions, aerosol propellants, foaming agents, blowing agents, solvents, cleaning agents, carrier fluids, displacement drying agents, buffing abrasion agents, polymerization media, expansion agents for polyolefins and polyurethanes, gaseous dielectrics, fire extinguishers, and fire extinguishers in the form of liquid or gas. In particular, the present disclosure relates to a composition that is useful for heat transfer compositions, such as compositions comprising 2,3,3,3-tetrafluoropropene (HFO-1234yf or 1234yf) or 2,3-dichloro-1,1,1-trifluoropropane (HCFC-243db or 243db), 2-chloro-1,1,1-trifluoropropane (HCFO-1233xf or 1233xf), or 2-chloro-1,1,1,2-tetrafluoropropane (HCFC-244bb)." ([0001]). However, from this statement, the problem to be solved by the present invention cannot be understood, because this statement merely describes the technical field to which the present invention belongs.

Thus, the "problem to be solved by the invention" formally stated in the present description is insufficient for a statement of the problem of the present invention, and there is no other choice but to deem that the present description does not state the problem of the present invention. Therefore, it also cannot be deemed that a person ordinarily skilled in the art can recognize that the problem of the present invention can be solved by the statement of the present description.

(3) Even if the statement in [0001] above is understood to describe the problem of the present invention, it cannot be recognized that a person ordinarily skilled in the art can recognize that the problem can be solved by the statement of the present description, as mentioned below.

That is, in this case, it should be understood that the problem of the present invention is "to provide a composition that is useful for heat transfer compositions, such as compositions comprising 2,3,3,3-tetrafluoropropene (HFO-1234yf or 1234yf) or 2,3-dichloro-1,1,1-trifluoropropane (HCFC-243db or 243db), 2-chloro-1,1,1-trifluoropropane (HCFO-1233xf or 1233xf), or 2-chloro-1,1,1,2-tetrafluoropropane (HCFC-244bb)."

In the present invention, the problem should be solved by a composition comprising [i] HFO-1234yf, [ii] 0.2 percent by weight or less of HFC-143a, and [iii] 1.9 percent by weight or less of HFC-254eb.

However, the present description cannot be deemed to state the composition comprising [i] to [iii] above. That is, [0121] to [0123] (Table 5 ([Table 6])) state, as Working Example 15, four examples of compositions comprising HFO-1234yf, HFC-

143a, and HFC-254eb, in which the compositions were generated upon conversion from HCFC-244bb into HFO-1234yf without a catalyst (heated temperatures (°C) are 550, 574, 603, and 626, respectively), and state that the amounts of HFC-143a contained in the compositions were 0.1, 0.1, 0.2, and 0.2 mole percent, respectively, and the amounts of HFC-254eb contained in the compositions were 1.7, 1.9, 1.4, and 0.7 mole percent, respectively. However, the compositions stated in Table 5 ([Table 6]) contain "unknown" components, and it is impossible to know molecular weights of the "unknown" components. Thus, in the same Table, the contained amounts of HFC-143a and HFC-254eb expressed as mole percent cannot be converted into those expressed as percent by weight. Therefore, there is no other choice but to deem that the present description does not state the composition having a structure of [i] to [iii] above. In addition to this, the present description neither states nor suggests anything about in what meaning a composition having such a structure will be a "useful" composition beyond the above usefulness of HFO-1234yf. Thus, a person ordinarily skilled in the art also cannot understand from the statement of the present description that the composition having the structure of [i] to [iii] above is a "useful" composition as heat transfer compositions.

Therefore, a person ordinarily skilled in the art cannot recognize that the problem of the present invention can be solved by the statement of the present description.

(4) As mentioned above, even if it is considered that the divisional application is valid, and the filing date is the filing date of the original application (May 7, 2009), it cannot be deemed that the statement of the claims for the present invention complies with the support requirement, and therefore, the patent for the present invention should be invalidated by a request for an invalidation trial (Article 123, paragraph (1), item (iv) and Article 36, paragraph (6), item (i) of the Patent Act). This is also true even if the divisional application is invalid and the filing date is the filing date of the divisional application (September 4, 2019).

### 3. Issue 3 (Whether or not the re-defense of the correction is established)

In the present correction invention as well, only the lower limit "77.0 mole percent or more" is set with regard to HFO-1234yf in Claim 1 for the present invention. Even taking into overall consideration the statements of the claims after the present correction and the present description, it has not revealed what technical significance the lower limit has and what problem can be solved by this. In addition, as with 2(2) and (3) above, it remains the same that the present description does not state a problem to be solved by the structure of the composition according to the

present correction invention and a method for solving the problem. Thus, even if the correction is valid, for the same reasons as mentioned in 2(2) and (3), the statement of the claims for the present correction invention has the reason for invalidation based on the violation of the support requirement. Therefore, the re-defense of the correction cannot resolve the reason for invalidation based on the violation of the support requirement.

Consequently, without going so far as to determine the legality of the present correction and the remainder of the issues, the Plaintiff may not exercise the present patent right against the Defendant pursuant to Article 104-3, paragraph (1) of the Patent Act.

#### 4. Conclusion

For the foregoing reasons, all of the Plaintiff's claims are unfounded. Thus, the judgment in prior instance that dismissed all of the Plaintiff's claims is reasonable in its conclusion. Therefore, the appeal shall be dismissed, and the judgment is rendered as mentioned in the main text.

Intellectual Property High Court, Second Division

Presiding Judge: SHIMIZU Hibiku

Judge: ASAI Ken

Judge: KATSUMATA Kumiko

Attachment "Patent Gazette" (omitted)