Patent Right	Date	October 5, 2023	Court	Intellectual Property High Court, Second Division
	Case number	2022 (Gyo-Ke) 10126		
- A case in which a JPO decision was rescinded on the grounds that the decision erred in the determination on whether or not a correction is compliant.				

Case type: Rescission of Trial Decision of Invalidation

Result: Granted

References: Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act

Related rights, etc.: Patent No. 6752438

Decision of JPO: Invalidation Trial No. 2020-800115

Summary of the Judgment

1. The present case is a suit against a trial decision that held a request for correction by the Plaintiff, who is a patentee, to be non-compliant and that invalidated a patent with regard to 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 issue of the present case is the presence or absence of a violation of the correction requirement.

2. The present judgment recognized the Plaintiff's claim to be well founded, and rescinded the present trial decision. The reasons are outlined as follows.

(1) A correction of the scope of claims etc. must be made "within the scope of the matters disclosed in the description, claims, or drawings attached to a written application" (Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act). This can be interpreted as requiring that the invention be fully disclosed from the time of filing the original application to thereby ensure prompt granting of rights and to prevent unforeseen disadvantages to third parties who acted on the premise of the scope of the invention disclosed at the time of filing the application. It is reasonable to interpret that the phrase "matters disclosed in the description, claims, or drawings attached to a written application" means technical matters that can be derived by a person ordinarily skilled in the art after taking the entire disclosure of the description, claims, or drawings into overall consideration (hereinafter merely referred to as "the original technical matters"). In a case where a correction does not introduce a new technical matter in relation to the original technical matters, it can be deemed that the correction is made "within the scope of the matters disclosed in the description, claims, or drawings."

(2) The contents of the original technical matters in the present case are as follows: [i] in preparing HFO-1234yf, by-products generated in the preparing process and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) can be present in small amounts as additional compounds; [ii] in Present Invention 1, 0.2 percent by weight or less of HFC-143a and 1.9 percent by weight or less of HFC-254eb are included as the additional compounds; and [iii] in some cases, the amount of HFO-1234yf contained in a composition that may be a working example of Present Invention 1 was 57.0, 77.0, 85.0, or 82.5 mole percent.

(3) Among compounds of Present Invention 1 (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), the present correction defined a lower limit of the contained amount of HFO-1234yf as 77.0 mole percent, and this numerical value itself is one that was stated in the present description. Then, the numerical value cannot be recognized to have remarkable technical significance even in light of the statement of the present description. Thus, the present correction cannot be deemed to have added a new technical matter with regard to Present Invention 1.

Therefore, the present correction does not introduce a new technical matter in relation to the original technical matters with regard to Present Invention 1.

(4) It is concluded that the present correction is recognized to be made "within the scope of the matters disclosed in the description, claims, or drawings." Thus, the present trial decision erred in determining that the present correction does not comply with the provision of Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act. Therefore, Ground 1 for Rescission (Error in the determination on whether the correction complies with the correction requirement) as asserted by the Plaintiff is well founded.

Judgment rendered on October 5, 2023
2022 (Gyo-Ke) 10126 Case of seeking rescission of trial decision
Date of conclusion of oral argument: August 1, 2023

Judgment

Plaintiff: The Chemours Company FC, Limited Liability Company

Defendant: AGC Inc.

Main text

1. The Court shall rescind the decision made by the Japan Patent Office (JPO) on August 17, 2022 with regard to the case of Invalidation Trial No. 2020-800115.

2. The court costs shall be borne by the Defendant.

Facts and reasons

No. 1 Judicial decision sought by the Plaintiff

The same gist as the main text.

No. 2 Outline of the case

The present case is a suit against a trial decision (hereinafter referred to as "the Present Trial Decision") that invalidated a patent with regard to inventions according to Claims 1 and 2 of Patent No. 6752438 (hereinafter referred to as "the Present Patent"), in which the issues are: the presence or absence of a violation of the correction requirement stipulated in Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2 of the same Act; and the presence or absence of a violation of the support requirement stipulated in Article 36, paragraph (6), item (i) of the same Act.

1. History of procedures at the JPO

(1) The Plaintiff is a patentee of the Present Patent for the 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." For the Present Patent, a divisional application was filed on September 4, 2019 (Filing date of the original application: May 7, 2009, Priority claim under the Paris Convention: May 7, 2008, United States of America), and establishment of a patent right was registered on August 21, 2020 (Exhibit Ko 46).

(2) The Defendant filed a request for a trial for invalidation of the Present Patent (Number of claims: 2) on November 30, 2020. The Japan Patent Office

examined this request as the case of Invalidation Trial No. 2020-800115. The Plaintiff submitted a written request for correction (Exhibit Ko 32; hereinafter, correction made by this written request for correction will be referred to as "the Present Correction") on April 5, 2021, requesting that the Scope of Claims of the Present Patent be corrected. However, the Japan Patent Office held that the Present Correction shall not be allowed, and rendered the Present Trial Decision that "the patent for the inventions according to Claims 1 to 2 of Patent No. 6752438 shall be invalidated" (for the overseas resident, 90 days were added to the statute of limitations for filing an action) on August 17, 2022. A certified copy of the Present Trial Decision was served on the Plaintiff on the 26th of the same month.

The Plaintiff filed the present suit on December 15 of the same year.

2. Summary of the invention

(1) The statement of Claims 1 and 2 in the Scope of Claims of the Present Patent before the Present Correction is as follows (hereinafter, the term "claim" will refer to a claim in the Scope of Claims of the Present Patent unless otherwise specified; hereinafter the invention according to Claim 1 before the Present Correction will be referred to as "Present Invention 1," the invention according to Claim 2 before the Present Correction will be referred to as "Present Invention 2," and both inventions will be collectively referred to as "the Present Invention").

[Claim 1]

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.

[Claim 2]

A composition comprising HFO-1234yf, HFC-143a, and HFC-254eb, wherein the composition comprises 0.1 to 0.2 percent by weight of HFC-143a and 0.7 to 1.9 percent by weight or less of HFC-254eb.

(2) Contents of the Present Correction

(Correction Matter 1)

The statement "HFO-1234yf" in Claim 1 is corrected to recite "77.0 mole percent or more of HFO-1234yf."

(Correction Matter 2)

The statement "HFO-1234yf" in Claim 2 is corrected to recite "82.5 mole percent or more of HFO-1234yf."

3. Summary of reasons of the Present Trial Decision

(1) Whether the Present Correction complies with the correction requirement

A. Contents of Correction Matters 1 and 2

Correction Matters 1 and 2 pertaining to the Present Correction are as mentioned in 2(2) above.

B. Examination on whether or not Correction Matter 1 is compliant

(A) The invention according to Claim 1 after the Present Correction (hereinafter, Present Invention 1 and Present Invention 2 after the Present Correction will be referred to as "Present Correction Invention 1" and "Present Correction Invention 2," respectively, and both inventions will be collectively referred to as "the Present Correction Invention") defines a composition comprising all of "HFO-1234yf," "HFC-143a," and "HFC-254eb," in which, regarding the contained amount of these components, the contained amount of "HFC-143a" is 0.2 percent by weight or less, and the contained amount of "HFC-254eb" is 1.9 percent by weight or less, and in which the contained amount of "HFO-1234yf" is 77.0 mole percent or more; i.e., the composition encompasses the contained amount of "HFO-1234yf" being 77.0 mole percent and comprises "HFO-1234yf" with any content rate within a high range that exceeds 77.0 mole percent.

(B) Regarding the composition comprising all of "HFO-1234yf," "HFC-143a," and "HFC-254eb," Table 5 ([Table 6]) (hereinafter merely referred to as "Table 5 ([Table 6])") in the description and drawings attached to a written application for the Present Patent (hereinafter collectively referred to as "the Present Description") does not show that component analysis was performed for all of the components in compositions prepared through a reaction of HFC-244bb. In addition, the reaction of HFC-244bb was not intended to prepare a composition comprising the specific component. Table 5 ([Table 6]) only shows that component analysis was performed for outflow in the middle of the reaction (during conversion) of HFC-244bb. It is unclear whether components contained in the outflow are only those listed in Table 5 ([Table 6]) (the component analysis might be limited to check preparing progress). Further, since Table 5 ([Table 6]) does not show molecular weights and weights of components regarded as unknown, the contained amounts of "HFC-143a" and "HFC-254eb" expressed as percent by weight are unclear. Thus, the contained amount of "HFO-1234yf" expressed as mole percent in Present Correction Invention 1 cannot be derived from numerical values of the contained amount of "HFO-1234yf" in Table 5 ([Table 6]). Therefore, a person ordinarily skilled in the art cannot derive the composition of Present Correction Invention 1 from the statement of the Present Description.

(C) The Present Description only states matters supporting that the statement

"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]; hereinafter, a four-digit number enclosed in [ ] refers to a paragraph number of the Present Description unless otherwise specified). For example, even if the statement on a composition comprising more than 85.0 mole percent of "HFO-1234yf" is examined, a method for obtaining a composition comprising predetermined amounts of additional compounds as defined in Claim 1 after the Present Correction cannot be understood. In addition, from the statement of the Present Description, it cannot be deemed that the contained amount of HFO-1234yf has a lower limit as a preferable range and that the lower limit is 77.0 mole percent.

(D) Thus, Correction Matter 1 introduces a new technical matter in relation to the technical matters derived by taking the entirety of the Present Description into overall consideration and should be deemed not to be made within the scope of matters disclosed in the Present Description. Therefore, Correction Matter 1 does not comply with the provision of Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act.

C. Examination on whether or not Correction Matter 2 is compliant

(A) Correction Matter 2 is intended to limit the contained amount of "HFO-1234yf" to "82.5 mole percent or more" regarding the "composition comprising HFO-1234yf, HFC-143a, and HFC-254eb, wherein the composition comprises 0.1 to 0.2 percent by weight of HFC-143a and 0.7 to 1.9 percent by weight or less of HFC-254eb" in Claim 2 before the Present Correction.

(B) However, in Table 5 ([Table 6]), there is no other choice but to deem that the contained amounts of "HFC-143a" and "HFC-254eb" expressed as percent by weight are unclear.

In addition, the Present Description does not state about a composition comprising more than 85.0 mole percent of "HFO-1234yf" and predetermined amounts of additional compounds as defined in Claim 2 after the Present Correction, which is the same as in B(C) above.

(C) Thus, Correction Matter 2 introduces a new technical matter in relation to the technical matters derived by taking the entirety of the Present Description into overall consideration and should be deemed not to be made within the scope of matters disclosed in the Present Description. Therefore, Correction Matter 2 does not comply with the provision of Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act.

D. For the foregoing reasons, the Present Correction is not allowable.

(2) Violation of the support requirement of the Present Invention

A. Taking into consideration the Present Description together with the statement of the Scope of Claims, the Present Invention can be deemed to be premised on a composition in which contained amounts of certain additional compounds incorporated in preparing the compound HFO-1234yf are very small and which is used for applications for which usefulness of the composition is confirmed. Thus, the problem of the Present Invention can be found to provide a composition that comprises 1234yf with low global warming potential (GWP) and that is useful for 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 (hereinafter referred to as "heat transfer compositions, etc.").

B. In Table 5 ([Table 6]), there is no other choice but to deem that the contained amounts of "HFC-143a" and "HFC-254eb" expressed as percent by weight are unclear. In addition, from the statement of the Present Description, it cannot be understood that the composition comprising all of "HFO-1234yf," "HFC-143a," and "HFC-254eb," in which predetermined amounts of "HFC-143a" and "HFC-254eb" are contained, like the Present Invention, is stated.

Further, the Present Invention does not define the contained amount of "HFO-1234yf" and can also comprise components other than "HFO-1234yf," "HFC-143a," and "HFC-254eb." Thus, if "HFO-1234yf" is contained in very small amount (e.g., a large amount of refrigerant with high GWP is contained) or if large amounts of other compounds that are toxic to the human body, easily flammable or explosive, excessively corrosive to equipment, or the like are contained, it is clear that the fact that the composition comprises "HFO-1234yf" with low global warming potential (GWP) does not make it useful for heat transfer compositions, etc.

Furthermore, regarding compositions falling within the full scope of the Present Invention (that can comprise any component other than "HFO-1234yf," "HFC-143a," and "HFC-254eb"), the Present Description neither states that it was confirmed whether such compositions were useful for heat transfer compositions, etc., nor is there common general technical knowledge that the compositions falling within the full scope of the Present Invention will be useful for heat transfer compositions, etc.

Thus, a person ordinarily skilled in the art cannot recognize that the problem of the Present Invention is solved by the Present Invention that is not originally stated in

the Present Description, nor can a person ordinarily skilled in the art recognize that the problem of the Present Invention is solved by the Present Invention that does not define that the predetermined amount of "HFO-1234yf" is contained and that does not define components other than "HFO-1234yf," "HFC-143a," and "HFC-254eb."

C. Therefore, the statement of Claims 1 and 2 before the Present Correction does not comply with the provision of Article 36, paragraph (6), item (i) of the Patent Act.

(omitted)

No. 5 Judgment of this court

1. Present Invention before the Present Correction

(1) The Present Description states as shown in Attachment "Patent Gazette" (Exhibit Ko 46).

(2) Summary 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 such new compounds with low global warming potential, such as 1234yf, certain additional compounds are present in small amounts ([0001] to [0003]).

2. Whether or not the Present Correction is compliant

(1) The Present Correction intends that the statement "HFO-1234yf" in Claim 1 should be corrected to recite "77.0 mole percent or more of HFO-1234yf" (Correction Matter 1) and that the statement "HFO-1234yf" in Claim 2 should be corrected to recite "82.5 mole percent or more of HFO-1234yf" (Correction Matter 2), both of which define a lower limit for the contained amount of HFO-1234yf in the composition of the Present Invention.

(2) The Present Correction was requested by the Plaintiff together with the submission of a written answer (Exhibit Ko 31) in response to the service of a written request (Exhibit Ko 30) that was filed for a trial for invalidation of the Present Patent (Exhibit Ko 32; the main clause of Article 134-2, paragraph (1) of the Patent Act).

(3) A correction of the Scope of Claims, etc. must be made "within the scope of the matters disclosed in the description, claims, or drawings attached to a written

application" (Article 134-2, paragraph (9) and Article 126, paragraph (5) of the Patent Act). This can be interpreted as requiring that the invention be fully disclosed from the time of filing the original application to thereby ensure prompt granting of rights and to prevent unforeseen disadvantages to third parties who acted on the premise of the scope of the invention disclosed at the time of filing the application. It is reasonable to interpret that the phrase "matters disclosed in the description, claims, or drawings attached to a written application" means technical matters that can be derived by a person ordinarily skilled in the art after taking the entire disclosure of the description, claims, or drawings into overall consideration (hereinafter merely referred to as "the original technical matters"). In a case where a correction does not introduce a new technical matter in relation to the original technical matters, it can be deemed that the correction is made "within the scope of the matters disclosed in the description, claims, or drawings."

(4) Correction Matter 1

A. (A) The statement of the Scope of Claims according to Present Invention 1 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." According to the literal wording, it is sufficient if the composition comprises HFO-1234yf, 0.2 percent by weight or less of HFC-143a, and 1.9 percent by weight or less of HFC-254eb, and it can be interpreted that the composition can fall within the Scope of Claims regardless of the contained amount of HFO-1234yf.

(B) The Present Description 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]), "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]). In view of these statements, the Present Description can be deemed to state that in preparing HFO-1234yf, certain additional compounds are present in small amounts and that there is less than about 1 percent by weight of HFC-143a as one of the

additional compounds contained in the composition of the Present Invention.

In addition, taking into the overall consideration the statements of [0013], [0016], [0019], [0022], [0030], and [Figure 1], the Present Description can be deemed to state that 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.

Further, Working Example 15 stated in [0121] to [0123] (Table 5 ([Table 6])) states four examples of the 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, 626, respectively), and states that the contained amounts of HFO-1234yf in the compositions were 57.0, 77.0, 85.0, and 82.5 mole percent, respectively.

(C) However, the Present Description states neither any suggestion of technical significance about comprising HFC-143a and HFC-254eb as the additional compounds in preparing HFO-1234yf, nor any suggestion of technical significance about the amounts of HFO-1234yf in the compound being 57.0, 77.0, 85.0, and 82.5 mole percent.

B. On the basis of each statement in A above, the contents of the original technical matters in the present case are as follows: [i] in preparing HFO-1234yf, by-products generated in the preparing process and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) can be present in small amounts as additional compounds; [ii] in Present Invention 1, 0.2 percent by weight or less of HFC-143a and 1.9 percent by weight or less of HFC-254eb are included as the additional compounds; and [iii] in some cases, the amount of HFO-1234yf contained in a composition that may be a working example of Present Invention 1 was 57.0, 77.0, 85.0, or 82.5 mole percent.

C. Among compounds of Present Invention 1, the Present Correction defined a lower limit of the contained amount of HFO-1234yf as 77.0 mole percent, and this numerical value itself is one that was stated in the Present Description, as mentioned in A(B) and B above. Then, the numerical value cannot be recognized to have remarkable technical significance even in light of the statement of the Present Description. Thus, the Present Correction cannot be deemed to have added a new technical matter with regard to Present Invention 1.

Therefore, the Present Correction does not introduce a new technical matter in relation to the original technical matters with regard to Present Invention 1.

(5) Correction Matter 2

A. The statement of the Scope of Claims according to Present Invention 2 recites "A composition comprising HFO-1234yf, HFC-143a, and HFC-254eb, wherein the composition comprises 0.1 to 0.2 percent by weight of HFC-143a and 0.7 to 1.9 percent by weight or less of HFC-254eb." According to the literal wording, it is sufficient if the composition comprises HFO-1234yf, 0.1 to 0.2 percent by weight of HFC-143a, and 0.7 to 1.9 percent by weight of HFC-254eb, and it can be interpreted that the composition can fall within the Scope of Claims regardless of the contained amount of HFO-1234yf.

B. On the basis of each statement in A above and in (4)A(B) above, the contents of the original technical matters in the present case are as follows: [i] in preparing HFO-1234yf, by-products generated in the preparing process and impurities contained in HFO-1234yf or its raw materials (HCFC-243db, HCFO-1233xf, HCFC-244bb) can be present in small amounts as additional compounds; [ii] in Present Invention 2, 0.1 to 0.2 percent by weight of HFC-143a and 0.7 to 1.9 percent by weight of HFC-254eb are included as the additional compounds; and [iii] in some cases, the amount of HFO-1234yf contained in a composition that may be a working example of Present Invention 2 was 57.0, 77.0, 85.0, or 82.5 mole percent.

C. Among compounds of Present Invention 2, the Present Correction defined a lower limit of the contained amount of HFO-1234yf as 82.5 mole percent, and this numerical value itself is one that was stated in the Present Description, as mentioned in B above and in (4)A(B) above. Further, the numerical value cannot be recognized to have remarkable technical significance even in light of the statement of the Present Description. Therefore, for the same reasons as mentioned in (4)C above, the Present Correction does not introduce a new technical matter in relation to the original technical matters with regard to Present Invention 2.

(6) Summary

Therefore, it should be deemed that the Present Correction does not introduce a new technical matter in relation to the original technical matters.

3. Grounds for rescission

According to the above, it is concluded that the Present Correction is recognized to be made "within the scope of the matters disclosed in the description, claims, or drawings." Thus, the Present Trial Decision erred in determining that the Present Correction does not comply with the provision of Article 126, paragraph (5) of the Patent Act as applied mutatis mutandis under Article 134-2, paragraph (9) of the same Act. Therefore, Ground 1 for Rescission (Error in the determination on whether the correction complies with the correction requirement) as asserted by the

Plaintiff is well founded.

In addition, regarding Ground 2 for Rescission as well, the invention subject to the determination on a violation of the support requirement should be the Present Correction Invention, whereas the invention determined by the Present Trial Decision is the Present Invention. Therefore, it is inescapable to rescind the Present Trial Decision.

No. 6 Conclusion

For the foregoing reasons, the Plaintiff's claim is well founded and thus shall be affirmed. Therefore, 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)