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Date of the judgement

1991.03.08

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Case Number

1987(Gyo-Tsu)3

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Reporter

Minshu Vol.45, No.3, at 123

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Title

Judgment upon the case concerning determination of the summary of the invention in relation to patent application

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Case name

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claim against the appeal decision

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Result

Judgment of the Second Petty Bench, Supreme Court
[Result] Quashed and reversed

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Court of the Second Instance

Tokyo High Court

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Summary of the judgement

The determination of the summary of the invention in relation to a patent application shall be made on the basis of the entry of the scope of the patent claim, unless there are special circumstances which allow the consideration of a detailed description of the invention, such as

in cases where the technological meaning of the entry in the scope of the patent claim cannot be understood clearly and unequivocally, or where, in the light of the entry of the detailed description of the invention, there is an obvious error in the entry of the scope of the patent claim.

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Main text of the judgement

The judgment of the original instance court shall be quashed.

The case shall be reversed to Tokyo High Court.

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Reasons

On the ground for appeal item 1 by the representatives for the jokoku appeal, Nobuo Kikuchi, Takashi Oshima, Seijiro Shimada, Jyoji Iwamatsu, Koji Obana, Akira Yonekura, Koishiro Izawa and Yoshihiko Funaoka:

1. According to the facts ascertained by the original instance court, (1) the adjudication by the Patent Office on the decision to reject the patent application by the jokoku appellee determined the summary of the invention under the patent application in accordance with the entry in the scope of the patent application extracted from the specifications of the patent application, denied the inventive step of the invention under application on the basis of the inventions entered in the first to the sixth quoted cases and ruled that the claim for adjudication did not stand, (2) the Patent Office ruled that for the detailed explanation of the invention in the specification of the patent application in the present case, items (1) to (10) of the excerpt of the specification are available.

2. The original instance court, based upon the above facts, ruled as follows and quashed the adjudication of the Patent Office on the ground that the adjudication had erred in the interpretation of the basic constituent elements of the invention under patent application, and as a result, unlawfully denied the inventive step of the invention, and that this error evidently affected the conclusion of the adjudication.

1) The method as indicated in the above mentioned (4) in the detailed description of the invention in the specification of the application is a method of measuring the glycerine which is isolated by the enzymatic saponification of the triglyceride by lipase (hereinafter, 'Ra-lipase') from Rhizopus arrihizus (the same as Rhizopus arritus). This is in fact the same in substance as

the composition of the invention applied for patent by the jokoku appellee under patent application No.130788 of 1970 concerning the method of measuring triglyceride by using Ra-lipase, i.e. 'the method of the quantitative measurement of triglyceride whose characteristic is the dissolution of neutral fat which does not contain lipoprotein or protein by lipase which is obtained by Rhizopus arrihizus when detecting triglyceride and/or neutral fat without protein which exist in combination with the lipoprotein in fluid, particularly body fluid, in a totally enzymatic and quantitative manner and the quantitative measurement of glycerine which is obtained as a decomposition product by means which are themselves publicly known'. According to the entry of the detailed description of the invention in the specification in the patent application, the invention under application in the present case is intended to improve the method of measurement as indicated in item (4). This presupposes the use of Ra-lipase.

2) According to item (4) of the specification, the inventor of the present invention under patent application is of the view that lipase other than Ra-lipase is incapable of fully decomposing triglyceride within the permissible time, and is unsuitable for the measuring of triglyceride by isolated glycerine. Therefore, the inventor would not have used the term 'lipase' in the basic composition of the scope of the patent claim for the present invention to include the above lipase which is unsuitable for measuring triglyceride.

3) Thus, the term 'lipase' as indicated in the detailed explanation in the specification of the patent application in the present case means Ra-lipase.

4) If this is the case, the method which is technologically substantiated as an improvement of the method of measurement as indicated in the above-mentioned item (4) is only the method which sues [uses] Ra-lipase. The tested cases as indicated in the specification of the patent application cover only those which used Ra-lipase.

5) Therefore, the term 'lipase' as indicated in the basic composition in the scope of patent claim for the present invention means Ra-lipase, although there is no limitation in the wording.

3. However, the above ruling of the original instance court is not justifiable. The reasons are as follows:

When examining whether the requirement for the patent as provided by Article 29, paragraphs 1 and 2 of the Patent Law, i.e. the novelty and inventive step of the invention, as prerequisites to compare this invention with the inventions indicated in the subparagraphs of the same provision, paragraph 1, the summary of the invention for which patent application has been made. This determination must be made on the basis of the entry in the scope of the patent claim as indicated in the specifications attached to the patent application, unless there are special circumstances. Only in cases such as where the technological meaning of the entry of the scope

of the patent claim cannot be understood clearly and unequivocally, or where, in the light of the entry of the detailed description of the invention, there is an obvious error in the entry of the scope of the patent claim, can the entry in the detailed explanation in the specification be taken into account. This is evident from Article 36, paragraph 5, subparagraph 2 of the Patent Law (concerning the present patent application, the Patent Law before the amendment by Law No.46 of 1975), which provides that in the scope of the patent claim, only matters which are essential to the composition of the invention under patent application shall be entered.

In the present case, according to the above facts ascertained by the original instance court, in the entry of the patent claim concerning the present invention, there is no indication that the lipase which is used for the enzymatic saponification of triglyceride is limited to Ra-lipase. Nor are there special circumstances as mentioned above. Therefore, the lipase as indicated in scope of the patent claim of the present invention cannot be understood to be limited to Ra-lipase. The original instance court ruled that the present invention under application is intended to be an improvement of the method of measurement as indicated in item (4) above, but the method which is technologically substantiated as an improvement is only the method which uses Ra-lipase, and that the tested cases as indicated in the specification of the patent application cover only those which used Ra-lipase. However, since, in the technological area of the method of measurement related to the present invention, it cannot be said that it is common technological knowledge amongst those in the business that lipase other than Ra-lipase cannot possibly be used, it cannot be deduced that the method which is technologically substantiated as an improvement is only the method which uses Ra-lipase or that that the tested cases as indicated in the specification of the patent application cover only those which used Ra-lipase, and that therefore, the lipase as indicated in the scope of the patent claim only means Ra-lipase.

4. If this is the case, the ruling of the original instance court, which, based upon the facts ascertained by the original instance court, concluded that the lipase which is indicated in the scope of the patent claim for the present invention means Ra-lipase, and the enzyme which is adopted by the present invention is only Ra-lipase, erred in the interpretation and application of the law concerning the determination of the summary of the invention which is a prerequisite to the examination of the existence of the progressiveness in patent application, and it is evident that this breach of law affects the conclusion of the original instance court. The argument which raises this point is with grounds and without considering other grounds of appeal, the judgment of the original instance court cannot but be quashed.

Therefore, in order to examine the case further, the case shall be reversed to the original instance court. In accordance with Article 7 of the Law on Administrative Litigation and Article 407, paragraph 1 of the Code of Civil Procedure, the justices unanimously rule as the main text

of the judgment.

The Supreme Court, the Second Petty Bench

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Presiding judge

Justice NAKAJIMA Toshijiro

Justice FUJISHIMA Akira

Justice KAGAWA Yasukazu

Justice KIZAKI Ryohei

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Excerpts from the patent specification

The scope of the patent claim

The method of measurement of triglyceride characterised by saponification in the presence of carboxyle esterase and alkali metal or alkali earth metal within the alkil group with 10-15 carbon atoms and alkil sulphate when measuring triglyceride by measuring enzymatic saponification and isolated glycerine using lipase.

Detailed description of the invention

(1) the present invention involves a new method and a reagent for measuring triglyceride by saponification of glyceride and measuring the isolated glycerine in this process.
(2) the publicly known method saponifies triglyceride with alcoholic alkali and measures the glycerine which emerges.
(3) A serious shortcoming of this publicly known method is the saponication using alcoholic alkali. This process of saponication makes the original method which should be implemented accurately and smoothly, more complicated. This is because the saponication process itself takes 20 - 30 minutes at a temperature of 70 Celsius. Before starting the measurement of the glycerine, it has to be neutralised and isolated by a centrifuge.
(4) This shortcoming has been removed by the enzymatic saponification of triglyceride in the publicly known method 1. In this process, lipase from the Rhizopus arrhizus was used. It was not anticipated that within the time allowed, lipase could decompose triglyceride into fat and glycerine in the buffer fluid when this method is used. It was found that other lipase, particularly the publicly known pancreas lipase was unsuitable.

(5) However, the shortcoming of this enzymatic decomposition is that it still takes a long time for saponification to occur and furthermore, it requires a large amount of expensive enzyme. In order to obtain time for the reaction, 1mg of enzyme for each experiment is needed. Furthermore, the time needed for the reaction exceeds 30 minutes and it is therefore unsuitable particularly for mechanical experiments in a laboratory in cases where experiments are repeated. Moreover, the isolated fatty acid forms an indissoluble soap of calcium ion and magnesium ion which makes the fluid opaque, and unless this is isolated by a centrifuge, it will result in error of measurement.

(6) The purpose of the present invention is to remove these shortcomings and provide a method of measurement of triglyceride by enzymatic saponification. Using this method, the necessary amount of lipase and the necessary time required are significantly reduced, and furthermore, there is no need to isolate the soap which is precipitated.

(7) This is achieved by the invention with the method of measurement of triglyderide via the measurement of enzymatic saponification and isolated glycerine by using lipase. In this process, the saponification proceeds in the presence of carboxyl esterase and alkali metal or alkali earth metal with 10-15 carbon atoms within the alkil group and alkil sulphate.

(8) Regarding the lipase, lipase extracted from Rhizopus arrhizus is advantageous.

(9) The reagent for the implementation of the method by this invention comprises that which is used for detecting glycerine and in addition, lipase, carboxyl esterase, alkali metal or alkali earth metal with 10-15 carbon atoms within the alkil group and alkil sulphate and in some cases, serum alpmin.

(10) Within the scope of advantageous reagent, the particularly suitable reagent is the following: lipase extracted from Rhizopus arrhizus.

(*Translated by Sir Ernest Satow Chair of Japanese Law, University of London)