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Date of the judgement

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1991.03.19

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Case Number

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1987(Gyo-Tsu)109

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Reporter

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Minshu Vol. 45, No. 3

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Title

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Judgment concerning a case in which the scope of claim of a patent is considered to have been restricted as a result of the correction of the detailed explanation of the invention and the drawings even when the relevant term stated in the scope of claim itself was not corrected

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Case name

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Case to seek revocation of a trial decision

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Result

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Judgment of the Third Petty Bench, quashed and remanded

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Court of the Second Instance

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Tokyo High Court, Judgment of April 30, 1987

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Summary of the judgement

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Where the technical meaning of the term "fixing components" as stated in the scope of claim cannot be considered to be unambiguously clear, and if the JPO issued a decision to permit the correction made by deleting, from the detailed explanation of the invention and the drawings, all of the

statements to the effect that adhesive agents (adhesive layers) serve as "fixing components" and such decision became final and binding, the term "fixing components" stated in the scope of claim is restricted to the extent that it does not include adhesive agents (adhesive layers), even when the relevant term itself stated in the scope of claim was not corrected

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## References

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### Articles 36 and 126 of the Patent Act

#### Patent Act

##### Article 36

(1) A person requesting the grant of a patent must submit an application to the Commissioner of the Patent Office stating the following:

(i) the name and domicile or residence of the applicant(s) for the patent, and if the applicant is a corporation, the name of its representative;

(ii) the date of submission;

(iii) the title of the invention; and

(iv) the name and domicile or residence of the inventor(s).

(2) The description, drawings (where required), and abstract must be attached to the application.

(3) The description as provided in the preceding paragraph must state the following:

(i) the title of the invention;

(ii) a brief explanation of the drawing(s);

(iii) a detailed explanation of the invention; and

(iv) the scope of claim(s).

(4) The detailed explanation of the invention as provided in item (iii) of the preceding paragraph must contain the purpose, structure and effect of the invention to the extent to enable any person ordinarily skilled in the art to which the invention pertains to work the invention easily;

(5) The statement of the scope of claims as provided in paragraph (3), item (iv) must comply with each of the following items:

(i) the invention for which a patent is sought is stated in the detailed explanation of the invention;

(ii) the statement is divided into items which state only such matters that are essential for the structure of the invention for which a patent is sought (such item is hereinafter referred to as a "claim"); and

(iii) the statement is composed in accordance with Ordinance of the Ministry of International Trade and Industry.

(6) The provisions of the preceding paragraph do not preclude an invention specified by a statement

in one claim from being identical with an invention specified by a statement in another claim.

(7) The abstract as provided in paragraph (2) must state a summary of the invention disclosed in the description or drawings, and any other matters as provided by Ordinance of the Ministry of International Trade and Industry.

#### Article 126

(1) The patentee may file a request for a trial with regard to the correction of the description or drawings attached to the application, only when such correction is limited to the following:

- (i) restriction of the scope of claims;
- (ii) correction of errors; and
- (iii) clarification of an ambiguous statement.

(2) The correction of the description or drawings under the preceding paragraph must not substantially enlarge or alter the scope of claims.

(3) In the case prescribed in paragraph (1), item (i), an invention constituted by the matters described in the corrected scope of claims must be one which could have been patented independently at the time of filing of the patent application.

(4) A request for a trial under paragraph (1) may be filed even after the lapse of the patent right; provided, however, that this does not apply after the patent has been invalidated in a trial under Article 123, paragraph (1).

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#### Main text of the Judgment

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The judgment in prior instance is quashed.

The case is remanded to the Tokyo High Court.

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#### Reasons

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Concerning the reasons for final appeal argued by the appeal counsel

I. The court of prior instance identified the gist of the invention in question as stated in the scope of claim contained in the description attached to the patent application in question, on the basis of the facts, inter alia, that said scope of claim stated as follows: "A clip consisting of multiple attachments that are fixed together and arranged so that each of them will be hooked onto object O, wherein each of said attachments has a part penetrating into the object 2, an enlargement part 4, a long and thin partition component 6 that extends from said part penetrating the object 2 and connects it with said enlargement part, and cuttable components 8 and 10 that connect each of said parts penetrating the object 2 together in a manner such that these parts are arranged in parallel with each other at intervals, and wherein easily cuttable fixing components 22 are provided between said enlargement

parts in a manner such that these components connect these parts together, and said fixing components are sufficiently weaker than said cuttable components (8 and 10) so that said adjoining enlargement parts can be separated from one another manually by twisting force." Based on this, the court of prior instance found as follows. [1] Taking into consideration the statements in the section of the detailed explanation of the invention in the description in question, it is found that the fixing components are provided between the enlargement parts of the attachments to connect these parts together but are sufficiently weak that they can be easily cut by such means as the twisting force caused by the series of successive actions by the hand of the person who connects the attachments to the objects with an attaching tool (gun), and therefore, that the structure of the fixing components stated in the scope of claim of the invention should be interpreted as meaning what is thus found. Apart from this, the scope of claim does not contain any statement that concretely limits the material, shape, size or any other aspect of the fixing components, and hence anything that satisfies said requirement is included in the scope of fixing components. [2] The section of the detailed explanation of the invention in the description in question and the drawings contain statements concerning an example in which solid adhesive agents (adhesive layers) are used as the fixing components. (3) There is no difference in terms of the function and effect between the adhesive layers and other types of fixing components. Given these, the court of prior instance determined that the term "fixing components" stated in the scope of claim of the invention in question includes solid adhesive agents (adhesive layers).

II. According to the transcript of the trial decision issued by the Japan Patent Office (JPO) (Trial Decision No. 1983-6902) submitted by the appeal counsel and the case records, the following facts are found: in response to the appellant's request for a trial for correction, the JPO issued a decision on March 31, 1987, after the conclusion of oral argument in the prior instance of this case, and permitted the correction of the patent in question, which was made by deleting Figures 12 and 13 pertaining to the adhesive layers from the description in question and the drawings, and by deleting the part of the explanation pertaining to these figures from the detailed explanation of the invention, as a correction made for the purpose of clarification of an ambiguous statement as provided in Article 126, paragraph (1), item (iii) of the Patent Act: and on May 20, 1987, the transcript of the JPO decision was served upon the appellant, and thus said decision became final and binding. Although the JPO decision contains a statement that the JPO accepted the appellant's request while regarding the correction intended by the appellant as constituting clarification of an ambiguous statement, the appellant filed a request for a trial for correction for the purpose of clarification of an ambiguous statement or restriction of the scope of claim. Furthermore, when making said decision, the JPO also examined whether or not the appellant's request satisfies the requirement for accepting a request for a trial for correction filed for the purpose of restriction of the scope of claim under paragraph (1), item (i) of said Act, that is, whether or not the invention constituted by the matters

described in the corrected scope of claim, as provided in paragraph (3) of said Article, is one which could have been patented independently at the time of filing of the patent application, and finally determined that the appellant's request for a trial for correction satisfies said requirement.

The court of prior instance found and determined that the term "fixing components" includes adhesive agents (adhesive layers) by taking into consideration the statements in the section of the detailed explanation of the invention in the description in question and the drawings which pertain to adhesive agents (adhesive layers), and such finding and determination by the court of prior instance are acceptable as those reached through the method for identifying the gist of the invention to be employed in the case where the technical meaning of a term stated in the scope of claim cannot be unambiguously clear. However, given that the JPO decision to permit the correction became final and binding, and as a result, all of the statements pertaining to adhesive agents (adhesive layers) were deleted from the description and the drawings although the relevant term stated in the scope of claim was not itself corrected, it is appropriate to construe that there is no longer room for identifying the gist of the invention by considering that adhesive agents (adhesive layers) are included in the scope of fixing components as stated in the scope of claim contained in the description in question retrospectively as of the time of the filing of the application.

III. Consequently, it is found that when the JPO decision to permit the correction of the patent in question became final and binding, the structure of the fixing components as stated in the scope of claim of the invention in question was restricted to the extent that it does not include adhesive agents (adhesive layers) retrospectively as of the time of the filing of the application, and therefore it must be said that the administrative disposition on which the judgment in prior instance was based has been modified by the subsequent administrative disposition, and thus the ground prescribed in Article 420, paragraph (1), item (viii) of the Code of Civil Procedure exists with regard to the judgment in prior instance. In such case, it is appropriate to quash the judgment in prior instance on the grounds that there was violation of laws and regulations that apparently affects the judgment, and remand the case to the court of prior instance to have it further examine the case (see 1983 (Gyo-Tsu) No. 124, judgment of the Third Petty Bench of the Supreme Court of May 28, 1985, Saibanshu Minji No. 145, at 73).

Therefore, according to Article 7 of the Administrative Case Litigation Act, and Article 407, paragraph (1) of the Code of Civil Procedure, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices.

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Presiding judge

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Justice SAKAUE Toshio

Justice TEIKA Katsumi

Justice SONOBE Itsuo

Justice SATO Shoichiro

Justice KABE Tsuneo

(This translation is provisional and subject to revision.)