
Date of the judgement

2000.02.29

Case Number

1998(Gyo-Tsu)19

Reporter

Minshu Vol.54, No.2, at 582

Title

The Capability of Repetition in the Methods of Breeding and Multiplication of New Breeds of Plants

Case name

Claim for the Revocation of the Adjudication

Result

Judgment of the Third Petty Bench, dismissed

Court of the Second Instance

Tokyo High Court

Summary of the judgement

The possibility of repetition in the process of breeding in an invention of a 'method of breeding and multiplying new breed of plants' is sufficient, if people in the same business are able to reproduce the plant in a scientific way, and does not have to have high probability of reproduction.

Main text of the judgement

The appeal shall be dismissed.

The cost of appeal shall be borne by the appellants.

Reasons

On the grounds of appeal items 1 to 4 of the representatives for the jokoku appellant, Yasuo Shimada, Kozo Ozaki, and Masahiko Sudo:

1. Facts lawfully ascertained by the original instance court are as follows:

1) P held a patent (patent No.1459061) for the invention of the 'method of breeding and multiplying new breed of peach - yellow peach' (date of application; October 24, 1977; hereinafter, 'the Patent' and 'the Invention' respectively).

2) The scope of the patent claim indicated in the specification attached to the document of adjustment in relation to the Patent (hereinafter, 'the Specification') was as follows:

'A method in which a breed of peach called 'Tusverter', a cross breed of the previously publicly known breed of Tuscan peach solely used as tinned peach and another breed of peach Elverter, as seeds and pollens respectively, is used as seeds and crossbred with a wild yellow peach breed with yellow flesh by the inventor; plants grown from the seeds thus obtained are selected and as a result, a new breed of yellow peach, as explained in the main text in detail and indicated in the chart, which has large leaves of a needle shape with an edge which is not as choppy as Tusverter, with flowers in pale scarlet colour in the centre of the stem, with many pollens which fertilises between themselves, which bears many round-shaped fruits with tough skin, the colour being generally yellow with scarlet in the part facing the sun and has a beautiful appearance, the flesh of the fruit being yellow, with a dense texture without much fibre, and with a core surrounded by a part without much colour, has sweet taste with slight acidity but without much difference in taste between the top and the bottom part, and has a fragrance, is created and multiplied by normal means without fertilisation'.

3)

(1) In fruit plants, the mechanism of inheriting individual characteristics is such that the hereditary elements which form the basis of individual characteristics influence each other, and

cannot necessarily be ruled by the Law of Mendel; reproduction of fruit plants with an identical genetic structure can be achieved only with a very low probability. However, even if the genetic structure is different, an identical characteristic can partly appear, and therefore, by repeating the breeding process, it is possible to reproduce fruit plants with identical characteristics.

(2) The gist of the Invention is that regardless of the identity of the hereditary mechanism which serves as a basis of the characteristics, which is the goal of the breeding, characteristics which are aimed for are obtained. Characteristics of each part of the yellow peach obtained by the Invention (hereinafter, 'the Yellow Peach') vary; some represent the characteristics of the Tusverter, or Late Yellow Peach, which is the parent breed of the Yellow Peach, or have intermediate features. However, judging from the identity of the characteristics themselves, in the light of the knowledge of the science of heredity and breeding, it is possible to reproduce peaches which have the same characteristics as the peach which is the target breed of the Invention by repeating the breeding process of the Yellow Peach, although the level of probability may be low.

(3) In the Specification, it is indicated that in the breeding process of the Yellow Peach, selection should be made by using the intermediate characteristics of the parent breeds as a criterion; for people in the business of breeding fruit plants, this criterion for selection can be objectively recognised and is clear.

(4) At the time of the application of the Patent, it was possible for the people in the business of breeding fruit plants to obtain Late Yellow Peach, which is the parent breed of the Yellow Peach, but by 1995, the location of the original plant came to be unknown.

4) The jokoku appellants applied to the Patent Office for the adjudication of the annulment of the Patent on September 18, 1989. The Patent Office examined the application as case of adjudication No.15082 of 1989, and dismissed the application on February 16, 1991.

5) P died on February 4, 1995 and the appellee inherited the Patent.

2. In the present case, the jokoku appellants is claiming the revocation of the adjudication on the ground that the Invention lacks the possibility of repetition and therefore does not qualify as a patent.

3. An invention is a creative thought on a specific technology based on the use of the Law of the

Nature. The content of the technology which has been created has to be specific and objective enough to the extent that a person who has a normal level of knowledge and expertise in the given area of technology can repeat it and achieve the aimed technical goal; inventions whose content has not reached this level are incomplete as an invention and cannot be regarded as an 'invention' as provided by Article 2, subparagraph 1 of the Patent Law (Supreme Court 1964 (gyo-tsu) No.92, Judgment of the Supreme Court, Third Petit Bench, January 28, 1969; Minshu 23-1-54). Thus, in order to qualify as a patent 'based upon the Law of the Nature' as provided in this provision, it is required that people in the same business can achieve the same result by repeating the invention, i.e. the possibility of repetition. This possibility of repetition in the process of breeding in an invention for a 'method of breeding and multiplying new breed of a plant' in the light of its nature, is sufficient, if people in the same business are able to reproduce the plant in a scientific way, and do not have to have a high probability of reproduction. This is because in such inventions, once a new breed is obtained, the breed can be reproduced by using the traditional method of multiplication, and even if the probability is low, if the growing of the new breed is possible, it is possible to achieve the technical goal of the given invention.

4. In the present case, as mentioned above, the breeding process of the Invention enables the scientific reproduction of peaches which have the same characteristics of the Yellow Peach by repeating it, and although the probability is low, the Invention should be regarded to have the possibility of repetition. Incidentally, it is sufficient if the possibility of repetition existed at the time of the patent application, and therefore, the subsequent loss of the parent breed, Late Yellow Peach, does not affect the above ruling.

The judgment of the original instance court which is in line with the above is justifiable, and there is no unlawfulness as argued by the appellant. The arguments merely criticise the selection of evidence and fact-finding of the original instance which belongs to the exclusive competence of the original instance court, or criticise the judgment of the original instance court from a unique point of view, and cannot be accepted.

On the ground of appeal item 5:

The facts ascertained by the original instance court on the relevant points are justifiable in the light of the evidence listed in the judgment of the original instance court, and in the light of the ascertained facts, the ruling of the original instance court that the modification of the Specification does not qualify as the change of the summary is justifiable. The arguments merely criticise the selection of evidence and fact-finding of the original instance which belongs to the exclusive competence of the original instance court, or criticise the judgment of the

original instance court from a unique point of view, and cannot be accepted.
Therefore, the justices unanimously rule as the main text of the judgment.

Presiding judge

Justice MOTOHARA Toshibumi

Justice CHIKUSA Hideo

Justice KANATANI Toshihiro

Justice OKUDA Masamichi

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