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Date of the judgement

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2008.07.10

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Case Number

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2007(Gyo-Hi)318

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Reporter

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Minshu Vol. 62, No. 7

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Title

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Judgment concerning whether or not, where a request for correction for multiple claims is filed while an opposition to patent case is pending and the correction is intended to restrict the scope of claims with regard to the particular claim for which the opposition to patent has been filed, the acceptability of the correction should be determined individually for each claim involved in the correction

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Case name

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Case to seek revocation of the decision to cancel a patent

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Result

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Judgment of the First Petty Bench, partially quashed and decided by the Supreme Court, partially dismissed

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Court of the Second Instance

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(Court of the First Instance) Intellectual Property High Court, Judgment of June 29, 2007

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Summary of the judgement

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Where a request for correction for multiple claims is filed while an opposition to patent case is pending and the correction is intended to restrict the scope of claims with regard to the particular claim for which the opposition to patent has been filed, the acceptability of the correction should be determined individually for each claim involved in the correction, and even if a matter for correction pertaining to a particular claim does not comply with the requirements for correction, it is unallowable to reject the correction in whole, including matters for correction pertaining to other claims only on the grounds of such incompliance.

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## References

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Article 113 and Article 120-4, paragraph (2) of the Patent Act (prior to the revision by Act No. 47 of 2003), Article 134-2, paragraph (1) of the Patent Act

Article 113 of the Patent Act (prior to the revision by Act No. 47 of 2003)

(Opposition to Patent)

Only within six months from the publication of the gazette containing a patent, any person may file with the Commissioner of the Patent Office an opposition to the patent on the grounds that the patent falls under any of the following items. In this case, if the patent covers two or more claims, the opposition may be filed for each claim:

- (i) where the patent has been granted on a patent application (excluding a written application in foreign language) with an amendment that does not comply with the requirements as provided in Article 17-2, paragraph (3);
- (ii) where the patent has been granted in violation of the provisions of Article 25, Article 29, Article 29-2, Article 32 or Article 39, paragraph (1) to paragraph (4);
- (iii) where the patent has been granted in violation of a treaty;
- (iv) where the patent has been granted on a patent application not complying with the requirements as provided in Article 36, paragraph (4) or paragraph (6) (excluding item (iv));
- (v) where matters stated in the description or drawings attached to the written application in foreign language are not within the scope of matters stated in the documents in foreign language.

Article 120-4, paragraph (2) of the Patent Act (prior to the revision by Act No. 47 of 2003)

(2) Only within the time limit designated under the preceding paragraph, the patentee may file a request for correction of the description, scope of claims or drawings attached to the application; provided, however, that such correction shall be limited to the following:

- (i) restriction of the scope of claims;

- (ii) correction of errors or incorrect translations; and
- (iii) clarification of an ambiguous statement.

Article 134-2, paragraph (1) of the Patent Act

(Request for correction in a trial for patent invalidation)

(1) The demandee in a trial for patent invalidation may file a request for a correction of the description, scope of claims or drawing(s) attached to the application only within the time limit designated in accordance with paragraph (1) or (2) of the preceding Article, paragraph (1) or (2) of the following Article or Article 153(2); provided, however, that such correction shall be limited to the following purposes:

- (i) restriction of the scope of claims;
- (ii) correction of errors in the description or of incorrect translations; and
- (iii) clarification of an ambiguous description.

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Main text of the judgement

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1. The judgment of prior instance is quashed with respect to the part concerning the decision to cancel the patent pertaining to Claim 1 of Patent No. 3441182.
2. The decision made by the Japan Patent Office on February 22, 2006 in Opposition Case No. 2003-73487 is revoked with respect to the part canceling the patent pertaining to Claim 1 of Patent No. 3441182.
3. The remaining part of the final appeal filed by the appellant of final appeal is dismissed.
4. The total cost of the suit shall be divided into four, one part of which shall be borne by the appellee of final appeal, and the rest by the appellant of final appeal.

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Reasons

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Concerning the reasons for the petition for acceptance of final appeal argued by the appeal counsels, KUMAKURA Yoshio, et al. (except for part of reasons excluded)

1. In this case, the appellant of final appeal who holds a patent, Patent No. 3441182 (hereinafter referred to as the "Patent"), seeks revocation of the decision to cancel the Patent (pertaining to Claims 1 to 4) made by the Japan Patent Office in the opposition to patent case.
2. The outline of the facts legally determined by the court of prior instance is as follows.
  - (1) The Patent relates to the invention entitled "Light Emitting Diode Module and Light Source of Light Emitting Diode," which is based on the patent application filed on August 26, 1994,

while claiming priority based on the earlier patent application filed in the United States on September 17, 1993. The Patent was registered on June 20, 2003. It has four claims.

(2) On December 26, 2003, an opposition to the Patent (pertaining to Claims 1 to 4) was filed, which led to an opposition case pending before the Japan Patent Office as Opposition Case No. 2003-73487. On December 7, 2005, while the opposition case was pending, the appellant, in accordance with the provision of Article 120-4, paragraph (2) of the Patent Act prior to the revision by Act No. 47 of 2003 (the clauses of the Patent Act prior to said revision shall hereinafter be referred to as "former Article 120-4 of the Patent Act" and the like), filed a request for correction of the scope of claims stated in the description attached to the application (this correction shall hereinafter be referred to as the "Correction"). The Correction consisted of matters to correct the respective claims in the scope of claims, namely, Matter for Correction (a) to correct Claim 1, Matter for Correction (b) to Correct Claim 2, Matter for Correction (c) to correct Claim 3, and Matter for Correction (d) to correct Claim 4. The appellant asserted that Matter for Correction (a) was intended to restrict the scope of claims and Matter for Correction (b) was intended to clarify an ambiguous statement. Matters for Correction (c) and (d), as the appellant him/herself asserted, were intended to correct mere clerical errors, and whether or not they are accepted will have no effect on a decision to be made by the Japan Patent Office as to cancellation of the Patent. The statements of Claims 1 and 2 before and after the Correction are as indicated in the attachment.

(3) On February 22, 2006, in the aforementioned opposition to patent case, the Japan Patent Office made a decision to reject the Correction and cancelled the Patent pertaining to Claims 1 to 4 (hereinafter referred to as the "Decision"). The summary of the reasons for the Decision is as follows.

(a) Matter for Correction (b) is intended neither to restrict the scope of claims, correct errors or incorrect translations nor clarify an ambiguous statement, and it substantially enlarges the scope of claims. Therefore, it does not comply with the provisions of the proviso to Article 126, paragraph (1) of the Patent Act prior to the revision by Act No. 116 of 1994 or of paragraph (2) of said Article which is applied mutatis mutandis pursuant to former Article 120-4, paragraph (3) of the Patent Act. In consequence, without needing to make a determination on other matters for correction, the Correction which covers Matter for Correction (b) cannot be accepted.

(b) The invention to be defined based on the statement of the scope of claims before the Correction is unpatentable under Article 29, paragraph (2) of the Patent Act because a person skilled in the art would have been able to easily make the invention by referring to the invention disclosed in a publication distributed in Japan prior to the filing of the patent application.

3. The court of prior instance dismissed the appellant's claim to seek revocation of the Decision,

holding as follows.

The Japan Patent Office made the Decision to reject the Correction in whole on the grounds that Matter for Correction (b) failed to comply with the requirements for correction, without making a determination on other matters for correction. This conclusion cannot be deemed to be illegal. Where a request for a (trial for) correction is filed for the purpose of correcting multiple matters stated in the description or drawings attached to the application, if the correction will have a substantial effect on the scope of claims, the Japan Patent Office shall be required to make a (trial) decision on whether or not to accept the correction of all matters for correction in whole, unless the requester clearly declares that he/she intends to correct a specific matter(s) among the multiple matters for correction by taking measures such as amending the matters for correction stated in the written request for (trial for) correction. Even where, when viewed objectively, a particular matter(s) among the multiple matters for correction is not technically indivisible from other matters and it would be beneficial to the requester if the correction is accepted only with regard to such particular matter(s), it is appropriate to construe that the Japan Patent Office shall not be allowed to make a (trial) decision to accept the correction only with regard to such particular matter(s) (See 1978 (Gyo-Tsu) No. 27 and 28, judgment of the First Petty Bench of the Supreme Court of May 1, 1980, Minshu Vol. 34, No. 3, at 431). This rule is also applicable under the revised multiple claiming system (the method of stating claims as prescribed in Article 36, paragraph (5) of the Patent Act after the revision by Act No. 27 of 1987). In the written request for correction submitted for the Correction, the requester did not clearly declare that he/she intended to correct a specific matter(s) among the multiple matters for correction, and therefore the request for the Correction should inevitably be deemed to be indivisible.

4. However, we cannot affirm the holdings of the court of prior instance mentioned above, on the following grounds.

(1) The basic structure of the Patent Act is that one decision to grant a patent or one trial decision to maintain the patent shall be made for one patent application as one administrative disposition, and based on this decision, one patent shall be granted and one patent right shall come into existence, which means a patent shall not be granted individually for each claim. Based on such structure, even if a patent application contains multiple claims, there is no choice but to make a decision of grant or decision of refusal for the patent application in whole as an indivisible subject unless the applicant divides the patent application, or in other words, the Patent Act does not permit treating a patent application as a divisible subject, i.e. making a decision of grant for the patent application with regard to some claims while making a decision of refusal for the same patent application with regard to other claims. This is obvious from the texts of Article 49 and Article 51 of the Patent Act, as well as the very existence of the

procedure for division of patent application. On the other hand, in order to deal with some cases where it may be inappropriate to carry through the principle of treating a patent or patent right which covers multiple claims as an indivisible subject, the Patent Act clearly provides for exceptional clauses to the effect that such patent or patent right may be treated while dividing it for each claim. These exceptional clauses include Article 185 of the Patent Act which provides that a patent or patent right covering two or more claims shall be deemed to have been granted or shall be deemed to exist for each claim, and the second sentence of the main clause of former Article 113 of the Patent Act which provided that "if the patent covers two or more claims, the opposition may be filed for each claim" (the second sentence of the main clause of Article 123, paragraph (1) of the Patent Act which provides for a request for a trial for patent invalidation has the same effect).

(2) In view of the basic structure of the Patent Act explained above, we examine the relevant provisions on correction. With regard to a trial for correction, there is no express provision that permits treating a request for trial for correction while dividing it for each claim, which would correspond to the provisions of the second sentence of the main clause of former Article 113 of the Patent Act or the second sentence of the main clause of Article 123, paragraph (1) of the Patent Act. Furthermore, a request for trial for correction substantially serves as a kind of new application (See Article 126, paragraph (5) and Article 128 of the Patent Act). In light of these facts, we can find that the Patent Act contemplates treating a request for trial for correction covering multiple claims in whole as an indivisible subject, in the same manner as treating a patent application covering multiple claims.

On the other hand, a request for correction under the provision of former Article 120-4, paragraph (2) of the Patent Act (hereinafter referred to as a "request for correction") is a procedure incidental to an opposition to a patent case, and in terms of its position under the Patent Act, it differs from a request for trial for correction, which is an independent trial procedure. If a request for correction is filed for the purpose of restricting the scope of claims with regard to a specific claim for which an opposition to patent has been filed, as the request for the Correction, for instance, it is not necessary to satisfy the requirements for independent patentability (former Article 120-4, paragraph (3) and former Article 126, paragraph (4) of the Patent Act). Thus, a request for correction is expected to be treated in a different manner from a request for trial for correction, and in this respect, unlike a request for trial for correction, a request for correction cannot be deemed to be substantially equivalent to a new application. Since a request for correction filed for the purpose of restricting the scope of claims with regard to the particular claim for which an opposition to patent has been filed can be deemed to substantially serve as a defensive measure against an opposition to patent that may be filed for each claim, it is appropriate to comprehend that a patentee who files a request for correction

desires to make correction individually for each claim, and if such individual correction for each claim is not allowed, it would amount to a considerable imbalance between the offense and the defense in an opposition to patent case. In light of these points, it is reasonable to consider that since an opposition to patent may be filed individually for each claim and whether or not to cancel the patent shall be determined individually for each claim, in response to such procedure for an opposition to patent, it is also allowable to file a request for correction individually for each claim when filing a request for correction for the purpose of restricting the scope of claims with regard to the particular claim for which an opposition to patent has been filed, and the acceptability of the correction shall be determined individually for each claim.

The appellee argues that the description that is to depict an invention must always be understood in whole as an indivisible subject. However, in view of the fact that as a result of the revision to the Patent Act by Act No. 27 of 1987, the provision stipulating the one-invention per one-application principle was deleted and it became possible to state multiple claims for one invention, we cannot find any grounds to support the construction argued by the appellee under the Patent Act after said revision. The aforementioned judgment of the First Petty Bench of the Supreme Court of May 1, 1980, determined that partial correction should in principle be denied. This judicial precedent addressed a request for trial for correction filed for the purpose of correcting multiple matters stated in the scope of claim for a utility model, which cannot be deemed to contain more than one claim. Its purport can be construed to be applicable where a request for correction is filed for the purpose of correcting multiple matters relating to a specific claim included in the scope of claims, but it is not applicable in cases, as in this case, where a request for correction is filed for the purpose of correcting matters relating to each of the multiple claims and a judgment is to be made as to whether or not the acceptability of the correction should be determined individually for each claim.

(3) In consequence, Where a request for correction for multiple claims is filed while an opposition to patent case is pending and the correction is intended to restrict the scope of claims with regard to the particular claim for which the opposition to patent has been filed, the acceptability of the correction should be determined for each claim involved in the correction, and even if a matter for correction pertaining to a particular claim does not comply with the requirements for correction, it is unallowable to reject the correction in whole, including matters for correction pertaining to other claims only on the grounds of such incompliance.

(4) In this case, the appellant filed the request for the Correction containing Matter for Correction (a), arguing that said matter for correction is intended to restrict the scope of claims. Since Matter for Correction (a) pertains to Claim 1 for which an opposition to patent was filed, it is necessary to determine the acceptability of the correction with regard to Matter for Correction (a) individually, or separately from other matters for correction pertaining to other

claim. However, the Japan Patent Office made the Decision only on the grounds that Matter for Correction (b) pertaining to Claim 2 failed to comply with the requirements for correction, without making examination on Matter for Correction (a) pertaining to Claim 1, to the effect that the Correction should be rejected in whole, including Matter for Correction (a). The Decision contains a defect that must be eliminated in that while rejecting the Correction, it defined the patented invention based on the statement of the scope of claims before the Correction and canceled the Patent for the part pertaining to Claim 1. The determination of the court of prior instance that ignored such defect contains violation of laws and regulations that apparently affects the judgment.

5. The appeal counsels' argument is well-grounded, and the judgment of prior instance should inevitably be quashed with respect to the part concerning the decision to cancel the Patent pertaining to Claim 1. According to our holdings shown above, the appellant's claim to seek revocation of the decision to cancel the Patent with respect to said part is well-grounded, and therefore we have decided to revoke the part of the Decision which canceled the Patent pertaining to Claim 1.

With regard to the remaining part of the final appeal concerning the decision to cancel the Patent pertaining to other claims, since the reasons for the petition for acceptance of final appeal were excluded by the order to accept the final appeal, we have decided to dismiss said part of the final appeal.

Therefore, 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 KAINAKA Tatsuo

Justice YOKOO Kazuko

Justice IZUMI Tokuji

Justice SAIGUCHI Chiharu

Justice WAKUI Norio

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Attachment

1. Statement of the scope of claims before the Correction

Claim 1: A light emitting diode module for providing a light source that comprises two or more light emitting diode lamps, each of which has at least two connection leads, an anode bus bar, a



cathode bus bar, and a means to mechanically and electrically connect said light emitting diode lamps between said anode bus bar and said cathode bus bar by mechanical engagement connection

Claim 2: A light emitting diode module for providing light that comprises an almost planate anode bus bar, an almost planate cathode bus bar adjoined in parallel with said anode bus bar, two or more light emitting diodes, and a connection means to mechanically and electrically connect said light emitting diodes between said anode bus bar and said cathode bus bar which consists of parts of said bus bars, each part being transformed from the plane surface of said bus bars and engaged with the corresponding lead by engagement fitting

2. Statement of the scope of claims after the Correction (corrected parts are put in square brackets.)

Claim 1: A light emitting diode module for providing a light source that comprises two or more light emitting diode lamps, each of which has at least two connection leads, an anode bus bar, a cathode bus bar, and a means to mechanically and electrically connect said light emitting diode lamps between said anode bus bar and said cathode bus bar by mechanical engagement connection, [wherein said bus bars characteristically create electrical connections and also create mechanical supports for said light emitting diode lamps]

Claim 2: A light emitting diode module for providing light that comprises an almost planate anode bus bar, an almost planate cathode bus bar adjoined in parallel with said anode bus bar, two or more light emitting diodes, and a connection means to mechanically and electrically connect said light emitting diodes between said anode bus bar and said cathode bus bar which consists of parts of said bus bars, each part being transformed from the plane surface of said bus bars and engaged with the corresponding lead [by mechanical engagement connection, wherein said bus bars characteristically create electrical connections and also create mechanical supports for said light emitting diode lamps]

(This translation is provisional and subject to revision.)