

Patent Right	Date	January 29, 2020	Court	Intellectual Property High Court, Fourth Division
	Case number	2019 (Gyo-Ke) 10021		
<p>- A case in which, in regards to the JPO decision which invalidated a patent invention titled "APPARATUS, SYSTEM, AND PROGRAM FOR FINANCIAL MERCHANDISE TRANSACTION MANAGEMENT", the court held that the corrections which the plaintiff made in the trial stage were within the scope of the matters disclosed in the Description and the like, and thus do not fall under a case of addition of new matters, so that the JPO decision is unlawful due to its error in judgment as to the requirements for correction.</p>				

Case type: Rescission of Trial Decision of Invalidation

Result: Granted

References: Article 126, paragraph (5) of the Patent Act

Related rights, etc.: Patent Application No. 2014-230868, Patent No. 5826909

Decision of JPO: Invalidation Trial No. 2017-800060

Summary of the Judgment

1. The present case is a lawsuit seeking rescission of the JPO decision to invalidate the patent for the Invention titled "APPARATUS, SYSTEM, AND PROGRAM FOR FINANCIAL MERCHANDISE TRANSACTION MANAGEMENT".

In the trial for invalidation, Plaintiff filed a request for corrections to correct the Scope of Claims (Corrections). In response, the JPO held that the Corrections cannot be approved because [i] the matters for correction pertaining to the Corrections concern the addition of new matters and thus the Corrections do not comply with the provisions of Article 126, paragraph (5) of the Patent Act, which is applied mutatis mutandis pursuant to Article 134-2, paragraph (9) of the same Act, and [ii] the amendment of the Written Correction Request modifies the overall substance of the Written Correction Request, and thus does not comply with the provisions of Article 131-2, paragraph (1) of the Patent Act, which is applied mutatis mutandis pursuant to Article 134-2, paragraph (9) of the same Act. Accordingly, the JPO rendered a decision to the effect of invalidating the invention for the Patent on the grounds that the reasons for invalidation that Defendant asserted are all reasonable.

Plaintiff filed the present lawsuit seeking rescission of the JPO decision, and asserted, as the grounds for rescission, error in judgment as to the requirements for correction.

2. In the judgment of the present case, the court held as outlined below and

rescinded the JPO Decision.

(1) Regarding the amendment of the Written Correction Request

There is no error in JPO Decision to the effect that the amendment of the Written Correction Request, as made by Plaintiff, does not comply with Article 131-2, paragraph (1) of the Patent Act, which is applied mutatis mutandis pursuant to Article 134-2, paragraph (9) of the same Act.

(2) Regarding the Corrections

A. It is acknowledged that Claim 1 before the Corrections describes a process by an "order information generation means" of "placing a market order in addition to validating a limit order for settling said market order" "at the start of sales transaction".

B. It is understood from the statement of the Description that an "order information generation part 16" generates an "order information group" based on the "information processed by an order receiving part 12", and performs the process of recording the "generated order information group" on an "order table 181" (Figure 2A), and that an "order information generation part 16" performs a process of generating the "first order information group" by, for example, setting, in an order table 181, a flag which exclusively validates/invalidates order information, so that, when the order information is generated, the "first order" that is included in a "first order information group" is generated as a "valid order information", and the "second order information" is generated as "invalid order information". On the other hand, it is acknowledged that the Description discloses, as "one embodiment" of the "Invention", that, when an "order information generation part 16", which is an "order information generation means", generates a "first order information group", it validates/invalidates each of the "first order" and the "second order" that are included in the "first order information group", and that, when a "contract information generation part 14", which is a "contract information generation means", performs a process of contracting a "market order" based on a "first order 51a" which is included in a "first order information group", it performs a process of changing the "second order" (limit order) and the "stop order" for settling such "market order" from "invalid" to "valid".

In that case, it is acknowledged that the Description discloses the technical matter that, when the "order information generation means"

("order information generation part 16") generates the "first order information group", it validates/invalidates the order information that is included in the "first order information group".

Also, given that the Description indicates the words, "needless to say, the above embodiment is one example of the Invention and it does not mean that the Invention is limited to the above embodiment" ([0076]), it is understood that in the "Invention", the process of changing the "second order" (limit order) and the "stop order" for settling the "market order" of the "first order" from "invalid" to "valid" is not limited to the embodiments that are performed by a "contract information generation means" ("contract information generation part 14").

C. It is understood that the matters for correction pertaining to the Corrections are such that, in regards to the matter which reads, before the Corrections, "at the start of sales transaction, placing a market order in addition to validating a limit order for settling said market order", there is the addition of the matter as to validating not only a "limit order for settling said market order" but also a "stop order for settling the aforementioned market order", so that in the Corrected Invention, an "order information generation means" performs a process of "placing a market order in addition to validating a limit order for settling said market order as well as a stop order for settling the aforementioned market order" "at the start of sales transaction".

However, in light of the findings of the above A and B, it is acknowledged that the aforementioned structure of the Corrected Invention is not something that introduces a new technical matter in relation to the technical matter which results from combining all the matters indicated in the Description, the Scope of Claims, or Drawings attached to the written application for the Patent Application, so that it is acknowledged that the matters for correction were made within the scope of the matters disclosed in the Description and the like attached to the written application for the Patent Application and thus do not fall under a case of addition of new matters.

(3) From what is described above, the decision rendered by the JPO in the present case is erroneous, and such erroneous decision ascribes to the error in the findings of the gist of the invention, which is the subject of the trial concerning whether or not there are reasons for invalidation, so that such error affects the

conclusion of the JPO Decision.