

Patent Right	Date	February 19, 2020	Court	Intellectual Property High Court, Fourth Division
	Case number	2018 (Gyo-Ke) 10165		
- A case in which, concerning a JPO decision which dismissed a request for a trial for patent invalidation of a patent for an invention titled "STABLE BICARBONATE ION-CONTAINING DRUG SOLUTION", the court rescinded the JPO decision by holding that there is error in judgment on whether or not differences are easily conceivable.				

Case type: Rescission of Trial Decision to Maintain

Result: Granted

References: Article 29, paragraph (2) of the Patent Act

Related rights, etc.: Invalidation Trial No. 2017-800015, Registration No. 5636075

Summary of the Judgment

The present case is one in which Plaintiff sought rescission of the JPO decision which was rendered in response to the Plaintiff's request for a trial for invalidation of a patent in regards to Claims 1 through 14 of an invention titled "STABLE BICARBONATE ION-CONTAINING DRUG SOLUTION" (Patent No. 5636075; hereinafter referred to as "Patent"). The JPO approved corrections being made by the Patentee and rendered a decision to the effect that the "request for a trial concerning the inventions pertaining to Claims 1, 2, 6, 7, and 11 of the Patent shall be dismissed. The request for a trial concerning the inventions pertaining to Claims 3 through 5, 8 through 10, and 12 through 14 of the Patent is groundless".

In the judgment of the present case, the court rescinded the JPO Decision by ruling as outlined below.

1. Regarding the invention pertaining to Claim 12 (hereinafter referred to as "Corrected Invention 12")

(1)The invention indicated in Exhibit Ko 3 (International Publication No. WO 2006/041409) (hereinafter referred to as "Cited Invention 2-2-1'") and Corrected Invention 12) have the following differences.

[Difference (Exhibit Ko 3-3-a'')]

Corrected Invention 12 describes that "after the drug solution is prepared, the formation of insoluble fine particles and precipitates is substantially suppressed for at least 27 hours" as a matter used to specify the invention, whereas Cited Invention 2-2-1' does not describe any corresponding matter used to specify the invention.

[Difference (Exhibit Ko 3-3-b'')]

Corrected Invention 12 is an invention of a "drug solution for blood purification", whereas Cited Invention 2-2-1' is an invention of a "mixed solution for immediate use" which consists of "a pair of single solutions" or in which such first single solution and second single solution are mixed at the volume ratio of 20:1.

[Difference (Exhibit Ko 3-3-c'')]

Corrected invention 12 describes, as a matter used to specify the invention, that Solution A and Solution B both contain water, whereas Cited Invention 2-2-1' does not describe any corresponding matter used to specify the invention.

[Difference (Exhibit Ko 3-3-d'')]

The magnesium ion concentration of a "drug solution for blood purification" in Corrected Invention 12 is 1.0 mEq/L, whereas in Cited Invention 2-2-1', the magnesium ion concentration of a "mixed solution for immediate use" is calculated as 1.2 mEq/L.

- (2) Unlike the decision made by the JPO, the court of the present case found that [Difference (Exhibit Ko 3-3-a'')], [Difference (Exhibit Ko 3-3-b'')], and [Difference (Exhibit Ko 3-3-d'')] are all easily conceivable by a person ordinarily skilled in the art, as described below.

A. [Difference (Exhibit Ko 3-3-b'')]

According to the statements of Exhibit Ko 3, it is understood that the "medical solution" of Exhibit Ko 3 can be adapted for a patient suffering from acute renal failure, so that there is a motivation for attempting to use the "medical solution" of Exhibit Ko 3 for a "drug solution for blood purification".

B. [Difference (Exhibit Ko 3-3-d'')]

Considering the common general technical knowledge or well-known art pertaining to commercially available dialysate and substitution fluid, making adjustments to the magnesium ion concentration of the solution for immediate use according to Exhibit Ko 3 within the scope of the values found in commercially available dialysate and substitution fluid is a design choice which can be selected, as needed, by a person ordinarily skilled in the art.

C. [Difference (Exhibit Ko 3-3-a'')]

When the statements of the scope of claims for Corrected Invention 12 (Claim 12) and the statements of the Specification are comprehensively taken into account, it is understood that the structure of Corrected Invention 12 pertaining to this difference is realized by specifying the component compositions of Fluid A and Fluid B of Corrected Invention 12 as well as the

ion concentration thereof to be those indicated in Claim 12. Accordingly, the structure of Corrected Invention 12 pertaining to this difference is provided naturally if the structure of Corrected Invention 12 pertaining to the differences described above in A and B is applied to Cited Invention 2-2-1'.

D. Remarkable effects

It is acknowledged that the remarkable effects as claimed by Defendants are naturally provided if the structure pertaining to the differences described above in A and B are applied to Cited Invention 2-2-1'. Accordingly, it cannot be said that such effects are beyond the predictions of a person ordinarily skilled in the art.

2. Regarding the invention pertaining to Claim 13 (hereinafter referred to as "Corrected Invention 13")

The [Difference (Exhibit Ko 3-3-e'')] (bicarbonate ion concentration) between Cited Invention 2-2-1' and Corrected Invention 13 is a design choice which can be selected, as needed, by a person ordinarily skilled in the art like the above 1 (2) B.

3. Regarding the invention pertaining to Claim 14 (hereinafter referred to as "Corrected Invention 14")

Like the case described above in 1 (2) C, the [Difference (Exhibit Ko 3-3-a'')] (the requirement of "pH 7.5 or more" being added to the Difference (Exhibit Ko 3-3-a'')) between Cited Invention 2-2-1' and Corrected Invention 14 is naturally provided if the structure of Corrected Invention 14 pertaining to the Differences is applied to Cited Invention 2-2-1'.

4. Regarding the inventions pertaining to Claims 3 through 5, and 8 through 10

The case described above in 1 applies similarly to the inventions pertaining to Claims 3 and 8, and the case described above in 2 applies similarly to the inventions pertaining to Claims 4 and 9, and the case described above in 3 applies similarly to the inventions pertaining to Claims 5 and 10.