

Date	December 5, 2012	Court	Intellectual Property High Court, Fourth Division
Case number	2012 (Gyo-ke) 10134		
<p>– A case in which the court held as follows:</p> <ul style="list-style-type: none"> - Even if the creation of technical ideas made for the purpose of solving a certain problem is very concrete, beneficial, and useful, as long as the problem-solving process solely uses a principle or law involving human mental activities, a principle or law in the field of social science, an artificial arrangement, or a mathematic formula, etc., and does not involve any laws of nature, such creation of technical ideas may not be regarded as an "invention" as provided for in Article 2, paragraph (1) of the Patent Act; and - In the case of a patent application for "Energy Saving Action Sheet," the act of recognizing and assessing the size of each area and understanding the meaning of the size based on the psychological principle (cognitive mechanism) may entirely be regarded as mental activities of human beings and not as the utilization of the laws of nature. 			

References:

Article 2, paragraph (1) and the main clause of Article 29, paragraph (1) of the Patent Act

Summary of Judgment

This is a case where the plaintiff sought rescission of a trial decision of the Japan Patent Office (JPO), which dismissed a request for a trial against an examiner's decision of refusal of the patent application filed for an invention titled the "Energy Saving Action Sheet" (hereinafter such trial decision and invention shall be referred to as the "JPO Trial Decision" and "Invention," respectively).

The JPO Trial Decision was made on the following grounds: (i) the Invention may not be regarded as an industrially applicable invention and therefore does not fall under the main clause of Article 29, paragraph (1) of the Patent Act; and (ii) even if the Invention may be regarded as an invention patentable under the Patent Act, any person skilled in the art could have easily conceived of the Invention.

The plaintiff sought rescission of the JPO Trial Decision on the following grounds: (i) erroneous determination on patentability and (ii) erroneous determination as to whether any person skilled in the art could have easily conceive of the Invention.

In this judgment, the court dismissed the plaintiff's request by holding as follows in regard to the grounds mentioned in (i) above.

Article 2, paragraph (1) of the Patent Act defines "invention" as "the highly

advanced creation of technical ideas utilizing the laws of nature." Since a human being has the ability to act and make decisions freely, a human being's act, such as performing a certain mental activity, making a certain decision, adopting a certain behavior, etc., per se may not be directly regarded as the utilization of the laws of nature even if such act is recognized to have beneficial and useful effects.

Therefore, even if the creation of technical ideas made for the purpose of solving a certain problem is very concrete, beneficial, and useful, as long as the problem-solving process solely uses a principle or law involving human mental activities, a principle or law in the field of social science, an artificial arrangement, or a mathematic formula, etc., and does not involve any laws of nature, such creation of technical ideas may not be regarded as an "invention" specified in said provision.

The Invention is a layout of a chart named "Energy Saving Action Sheet," which is characterized by the content of information presented in the chart, i.e., the names and meanings of the "axes" and "areas." The presentation of the name and meaning of each axis and area per se is not the direct utilization of the laws of nature. When the Invention, "Energy Saving Action Sheet," is presented to a person, the person would be able to recognize and assess the size of each area and understand the meaning of the size. However, this does not prove the existence of any technical characteristics that go beyond the simple act of recording or presenting a conventional table.

The function and effect brought about by the configuration of the Invention have a basis in the psychological principles (cognitive mechanism), i.e., a person who sees an "area," which expands in two directions: along one axis as well as along another axis (determining the size of the area), can recognize and assess the significance in accordance with the size of the area and can also understand the meaning of each "area," if the name and meaning of each "axis" and "area" are described. Such recognition and assessment of the size of each area and the understanding of the meaning of the size based on psychological principles may entirely be regarded as the mental activities of human beings but not as the utilization of the laws of nature.

On these grounds, the configuration of the Invention, "Energy Saving Action Sheet," and the means of presentation thereof (recording and display) may entirely be regarded as a creation that has a basis in the mental activities of human beings but not as a creation of technical ideas utilizing the laws of nature. Furthermore, the function and effect brought about by the Invention may not be regarded as an effect brought about by use of the laws of nature. Therefore, the Invention, "Energy Saving Action Sheet," may not be regarded as an "invention" as provided for in Article 2, paragraph (1) of the Patent Act.

Judgment rendered on December 5, 2012; the original was received on the same day; court clerk 2012 (Gyo-Ke) 10134, Case of Seeking Rescission of a JPO decision

Date of conclusion of oral argument: November 21, 2012

Judgment

Plaintiff: Nihon Techno Co., Ltd.

Defendant: Commissioner of the JPO

Main Text

The plaintiff's claim shall be dismissed.

The plaintiff shall bear the court costs.

Facts and reasons

No. 1 Claims

The JPO decision rendered regarding Trial against Examiner's Decision of Refusal No. 2010-24151 on March 6, 2012 is rescinded.

No. 2 Background

The plaintiff alleges that there are grounds for rescission as stated in 4. below in the JPO decision in question (the "JPO Decision"; the summary of the reasons therefor is as stated in 3. below) shown in (a copy of) the written decision attached to this judgment, which dismissed a request for a trial against an examiner's decision of refusal in relation to the application in question (the "Application") for which the statement of the scope of claims is stated as stated in 2. below, which was filed through the proceedings as stated in 1. below.

1. Developments in procedures at the JPO

(1) The plaintiff filed a patent application (Patent Application No. 2010-82481; a divisional application of Patent Application No. 2009-295281 (hereinafter referred to as the "Original Application") that was filed on December 25, 2009) for an invention titled "energy saving action sheet" on March 31, 2010 (Exhibit Ko No. 1).

(2) The plaintiff received an examiner's decision of refusal on August 16, 2010, and filed a request for a trial against the examiner's decision of refusal on October 27 of the same year (Exhibit Ko No. 4). The plaintiff submitted a written amendment on February 7, 2012 (Exhibit Ko No. 2; hereinafter referred to as the "Amendment"; the description after the Amendment (Exhibit Ko No. 1) is referred to as the "Description").

(3) The JPO examined the aforementioned request as Trial against Examiner's Decision of Refusal No. 2010-24151, and rendered the JPO Decision to the effect that "the request for a trial in question is to be dismissed" on March 6, 2012. A certified copy of the JPO Decision was served to the plaintiff on the 16th of the same month.

2. Statement of the scope of claims

The invention stated in Claim 1 of the scope of claims after the Amendment (hereinafter referred to as the "Claimed Invention") is as follows (Exhibit Ko No. 2). Slash marks in the following text indicate line feeds in the original text.

An energy saving action sheet comprising the first place axis that shows the names of multiple places in a building and indicates electric energy that can be saved at each of those places per unit time by axial length, / the first time axis that indicates time with a scale of time and / the first energy saving action placement area designed to show an energy saving action to be taken in a certain area specified by the first place axis and the first time axis, / which furthermore has the first energy saving action identification area, which shows electric energy that can be saved by taking an energy saving action per unit time by the length in the direction of the first place axis and the duration of the energy saving action by the length in the direction of the first time axis and / also shows an energy saving action indicated in the relevant first energy saving action identification area and approximate electric energy that can be saved by taking said energy saving action (electric energy that can be calculated based on the area that is the integrated value of electric energy that can be saved by taking the energy saving action per unit time and the duration of the energy saving action).

3. Summary of the reasons for the JPO Decision

(1) The reasons for the JPO Decision are, in short, as follows: [i] the Claimed Invention does not fall under the main clause of Article 29, paragraph (1) of the Patent Act as it cannot be recognized as an industrially applicable invention; and [ii] even if the Claimed Invention is an invention under the Patent Act, a person ordinarily skilled in the art could have easily conceived of the Claimed Invention based on the invention described in Cited Reference 1 mentioned later or the invention described in Cited Reference 2 mentioned later, and therefore, the Claimed Invention is not patentable pursuant to the provisions of paragraph (2) of said Article.

A. Cited Reference 1: Publication of Unexamined Patent Application No. 2008-104310 (Exhibit Ko No. 10)

B. Cited Reference 2: Ministry of Economy, Trade and Industry, ed., "Energy White Paper 2006: Toward Restructuring of the National Strategy Centering on Energy Security" (Gyosei Corporation, July 30, 2006), p. 77 (Exhibit Ko No. 11)

(omitted)

No. 4 Court decision

1. Regarding the Claimed Invention

(1) Claimed Invention

The statement of the scope of claims of the Claimed Invention is as described in II.2. above,

and the "energy saving action sheet" of the Claimed Invention is as follows.

[i] An energy saving action sheet comprising the first place axis that shows the names of multiple places in a building and indicates electric energy that can be saved at each of those places per unit time by axial length,

[ii] the first time axis that indicates time with a scale of time and

[iii] the first energy saving action placement area designed to show an energy saving action to be taken in a certain area specified by the first place axis and the first time axis,

[iv] which furthermore has the first energy saving action identification area, which shows electric energy that can be saved by taking an energy saving action per unit time by the length in the direction of the first place axis and the duration of the energy saving action by the length in the direction of the first time axis and

[v] also shows an energy saving action indicated in the relevant first energy saving action identification area and approximate electric energy that can be saved by taking said energy saving action (electric energy that can be figured out based on the area that is the integrated value of electric energy that can be saved by taking the energy saving action per unit time and the duration of the energy saving action)

(2) The following is stated in the Description (Exhibit Ko No. 1).

(omitted)

(3) Features of the Claimed Invention

According to the aforementioned statements in the Description, the "energy saving action sheet" of the Claimed Invention comprises [i] the first place axis that shows the names of places and indicates electric energy per unit time, [ii] the first time axis that indicates time and [iii] the first energy saving action placement area designed to show an energy saving action to be taken in a certain area specified by the first place axis and the first time axis, and [iv] has the first energy saving action identification area be provided on the first energy saving action placement area and [v] shows approximate electric energy that can be saved by taking an energy saving action indicated in the relevant first energy saving action identification area, thereby producing the effect of enabling a person to understand the time when and the places where an energy saving action should be taken at first glance and the effect of enabling a person to understand approximate electric energy that can be saved by taking each energy saving action.

The term "energy saving action indicated in the first energy saving action identification area" is identified by the first energy saving action identification area provided on the first energy saving action placement area. Therefore, such action is considered to include various types of actions, such as "power-off of an air-conditioning system," "mode change of an

air-conditioning system," "power-off of a ventilation fan," "power-off of lighting," and "pulling out the plug of unused electric equipment." However, these actions are taken at multiple places in a building, and said term means each one of "energy saving actions" that is specifically identifiable.

2. Regarding Ground for Rescission 1 (an error in the determination concerning whether the Claimed Invention falls under an invention)

(1) Regarding utilization of the laws of nature

Article 2, paragraph (1) of the Patent Act defines "invention" as the "highly advanced creation of technical ideas utilizing the laws of nature." As long as human beings are able to freely act and make decisions by themselves, their specific mental activities, decisions, forms of behavior and other acts per se cannot be immediately considered to be the utilization of the laws of nature even if such acts are recognized as having beneficial and useful effects.

Therefore, no matter how concrete, beneficial and useful the creation of technical ideas designed for the purpose of solving a problem may be, it does not fall under the "invention" prescribed in said paragraph if the means for solving the problem solely utilizes principles or rules involving human mental activities, principles or rules in the field of social science, artificial arrangements or mathematic formulas, etc. and does not involve the utilization of the laws of nature.

(2) Regarding the structure of the Claimed Invention

The structure mentioned in [i] to [v] in 1.(1) above specifies the layout of a chart titled "energy saving action sheet" by attaching a name and a meaning to each of the axes (the "first place axis" and the "first time axis") and the areas specified by these axes (the "first energy saving action placement area" and the "first energy saving action identification area"). Therefore, the structure is characterized by the content of presented information, i.e., the names and meanings of the "axes" and "areas."

The presentation of the "axes" in the chart and the "areas" specified by the axes while attaching a name (the "first place axis," the "first time axis," the "first energy saving action placement area," and the "first energy saving action identification area") and a meaning to each of them respectively per se does not involve the direct utilization of the laws of nature, but it enables human beings to recognize and understand the size of each area and understand the meaning of the size when they are presented with the "energy saving action sheet" of the Claimed Invention.

Moreover, the "energy saving action sheet" of the Claimed Invention is designed to be presented to human beings, and is not intended to be read by some sort of equipment. In addition, the Claimed Invention does not technically specify any form, such as recording on paper or other medium and indication on a display screen, as means for presenting the sheet to

human beings. Therefore, the Claimed Invention cannot be considered to have a technical feature that goes beyond the recording and indication of a general chart.

(3) Regarding the problem, as well as function and effect of the Claimed Invention

According to the aforementioned statements in the Description, the Claimed Invention solves problems with conventional art, that is, difficulty in understanding how much electric energy or electric power rate can be saved by taking each energy saving action at first glance and difficulty in understanding what energy saving action should be preferentially taken, and thereby produces the effect of enabling a person to understand the time when and the places where an energy saving action should be taken at first glance and the effect of enabling a person to understand approximate electric energy that can be saved by taking each energy saving action.

The aforementioned function and effect of the Claimed Invention is achieved by utilizing psychological principles (cognitive mechanism), i.e., a person who sees an "area" that expands in two directions, that is, the direction along one axis and the direction along another axis (the size of the area) can recognize and understand the size in accordance with the size of the area and can also understand the meaning of each "area" if a name and a meaning is attached to each "axis" and "area." Recognizing and understanding the size of each area and understanding the meaning of the size thereof based on such psychological principles is solely based on human mental activities and cannot be considered to involve the utilization of the laws of nature.

(4) Regarding the plaintiff's allegation

The plaintiff alleges that the Claimed Invention has its technical feature in the way of presenting information and that it produces the "effect" of enabling a person to "easily read and understand" the sheet based on said feature.

However, even if the "energy saving action sheet" pertaining to the Claimed Invention falls under presentation of information, presenting information while attaching a name (such as the "first place axis") and a meaning to each "axis" in a chart and each "area" specified thereby per se neither involves the direct utilization of the laws of nature nor technically specifies means for presentation to human beings in any way, as mentioned above. Therefore, it cannot be said that the Claimed Invention has a technical feature that goes beyond the recording and indication of a general chart. In addition, the effects, such as being easy-to-read, are achieved by utilizing the psychological principles and cannot be considered to be those achieved by utilizing the laws of nature.

(5) Brief summary

As mentioned above, the structure of the "energy saving action sheet" of the Claimed Invention and the means for presenting (recording or indicating) it are creations based on human mental activities, and cannot be regarded as creations of technical ideas utilizing the laws of

nature. Moreover, the function and effect produced by the Claimed Invention cannot be considered to be an effect produced by utilizing the laws of nature. Therefore, the "energy saving action sheet" pertaining to the Claimed Invention does not fall under the "invention" as prescribed in Article 2, paragraph (1) of the Patent Act.

3. Conclusion

On these grounds, the plaintiff's claim shall be dismissed without the need for making a determination on Ground for Rescission 2.

Intellectual Property High Court, Fourth Division

Presiding judge: DOI Akio

Judge: TAKABE Makiko

Judge: SAITO Iwao