Patent Right	Date	June 11, 2020	Court	Intellectual Property High Court, First Division
	Case number	2019(Gyo-Ke) 10115		
- A case in which conformance to the support requirement and the clarity requirement was determined for the patent invention titled "LIGHT EMITTING DEVICE, RESIN PACKAGE, RESIN MOLDED BODY, AND MANUFACTURING METHOD THEREOF".				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

References: Article 29, paragraph (2), Article 36, paragraph (6), items (i), (ii), Article 44, paragraph (1), Article 126, paragraph (5), Article 134-2, paragraph (9) of the Patent Act,

Related rights, etc.: Invalidation Trial No. 2017-800061, Patent No. 5825390

Summary of the Judgment

1. This case is a suit against trial decision made by the JPO in which, when Plaintiff made a claim for a trial for invalidation of the patent held by Defendant of the invention titled "LIGHT EMITTING DEVICE, RESIN PACKAGE, RESIN MOLDED BODY, AND MANUFACTURING METHOD THEREOF", the decision of the JPO dismissing the request was rendered and thus, Plaintiff sought rescission thereof. Plaintiff asserted as reasons for rescission an error in determination related to the correction requirement (addition of new matter), an error in determination related to the description requirement (Article 36, paragraph (6), items (i), (ii) of the Patent Act), an error in determination of inventive step, and an error in determination of inventive step involved in violation of the division requirement.
2. The judgment dismissed Plaintiff's claim by holding as follows in brief on the description requirement (error in determination related to (Article 36, paragraph (6), items (i), (ii) of the Patent Act)).

   (1) Interpretation of description in Claim 1

   In Claim 1 of the Scope of Claims in the patent after the correction, there are descriptions that "on each of the first to fourth outer side surfaces of the resin package, the resin portion embedded in the notch portion, the resin portion formed above the lead, and the lead exposed from the resin portion are formed on the same surface so as to constitute a cutting surface" ..., according to this, it is interpreted to refer to a matter that the resin portion and the lead exposed

therefrom "are formed on the same surface so as to constitute a cutting surface".

Moreover, in the present description, it is described that "inside a die sandwiched by an upper die 61 and a lower die 62, a thermosetting resin 23 containing a light-reflective substance 26 is transfer-molded so as to form a resin molded body 24 in a lead frame 21", (...) and "the resin molded body 24 and the lead frame 21 are cut along the notch portion 21a" (...) and thus, by cutting both the lead frame and the thermosetting resin along the notch portion after formation of the resin molded body, it is found that the resin portion embedded in the notch portion, the resin portion formed above the lead, and the lead exposed from the resin portion are inevitably formed on the same surface on the outer side surface of the resin package, and this is also obvious from Figure 1 of the present description.

Therefore, it can be interpreted that the "same surface" referred to in Claim 1 of the Scope of Claims means that the resin portion and the lead are formed on the same surface on the outer side surface of the resin package.

(2) Conformance to support requirement

It is reasonable to determine the support requirement by comparing the description in the Scope of Claims and the description in the Detailed Description of the Invention, and whether or not it can be found that the invention described in the Scope of Claims is the invention described in the Detailed Description of the Invention and in such a scope that it can be recognized that the problem of the invention can be solved by a person ordinarily skilled in the art by the description in the Detailed Description of the Invention.

... The problem of the present corrected inventions 1 and 2 is such that, in relation with a light emitting device using light emitting elements such as a light emitting diode (LED), a laser diode (LD), and the like, in order to manufacture a matrix-state package substrate for mounting the light emitting element, a flat-plate shaped lead frame is mounted on a die, a thermosetting resin composition for light reflection is poured therein, and heated pressurization/molding is performed by a transfer molding machine, but since a close contact area between the flat-plate shaped lead frame and the thermosetting resin composition disposed thereon is small, it has a problem that the lead frame and the thermosetting resin composition can be separated easily when the package substrate is singulated into individual light emitting devices, and the problem remains to be solved.

The light emitting device in the present corrected inventions 1 and 2 employs the structure having the resin package in which the resin portion and the lead are

formed on the same surface on the outer side surface in order to solve the problem, and the thermosetting resin is embedded in the notch portion provided on the lead and thus, the close contact area between the lead and the thermosetting resin is made larger, and close contact between the two can be improved.

In view of the constituent features as a whole of the present corrected inventions 1 and 2, it is obvious that they specify characteristic and a novel structure for the light emitting device obtained by the manufacturing method described in the Detailed Description of the Invention. Moreover, even in the case of manufacture in a so-called "multiple simultaneous production method" in which, after a plurality of light emitting devices are formed in a lump sum as the result of the structure, they are cut out into individual pieces, in addition to the effect that separation between the lead and the resin portion does not occur easily, an effect that the obtained light emitting device has highly close contact between the lead and the resin portion is also exerted. These effects are based on the structure of the article called the "notch portion" provided on the lead in a specific form, and the structure required for that is specified in the present corrected inventions 1 and 2 (...).

Then, the invention described in the Scope of Claims is the invention described in the Detailed Description of the Invention and can be considered to be within a scope that can be so recognized that a person ordinarily skilled in the art could have solved the problem of the invention by the description in the Detailed Description of the Invention.

(3) Conformance to clarity requirement

It is reasonable to determine conformance to the clarity requirement from the viewpoint on whether the description in the Scope of Claims is unclear enough to give an unexpected disadvantage to a third party on the basis of the description in the Scope of Claims, the description in the description, drawings, and the common general technical knowledge of a person ordinarily skilled in the art at the time of filing.

The meaning of the "same surface" referred to in Claims 1 and 2 in the Scope of Claims is as described ... above, and the meaning thereof is clear, and it cannot be considered that the description in the Scope of Claims is unclear enough to give unexpected disadvantage to a third party.