

Date	May 30, 2007	Court	Intellectual Property High Court, Third Division
Case number	2006 (Ne) 10077		
– A case in which, with regard to the appellant's claim for an injunction based on its patent right granted based on a divisional application, the court determined that: the divisional application is an unlawful one that does not comply with the requirements for division, and its filing date is not retroactive to the time of the filing of the original application, and as a result, the patented invention lacks novelty, and there is thus a ground for invalidation for the Patent; on these grounds, the court concluded that the appellant is unable to exercise the patent right against the appellee.			

References: Article 29, paragraph (1), item (iii), Article 104-3, paragraph (1), and Article 123, paragraph (1), item (ii) of the Patent Act, Article 44, paragraph (1) of the Patent Act prior to the amendment by Act No. 26 of 1993

Numbers of related rights, etc.: Patent No. 3257597

Summary of the Judgment

The appellant holds a patent right relating to an ink tank for an ink jet recording device (Patent No. 3257597; the "Patent Right"). The appellant alleged that the appellee's act of importing and selling the ink tanks (the "appellee's products"), which were made by refilling ink in used ink tanks that were manufactured and sold by the appellant, constitutes infringement of the Patent Right. Based on this allegation, the appellant filed this action to seek an injunction against import, sale, etc. of the appellee's products and disposal thereof and payment of damages. The application pertaining to the appellant's patent is a divisional application (the "Divisional Application") derived from the original application (the "Original Application").

The court of prior instance dismissed the appellant's claims, holding as follows. The Divisional Application is an unlawful one that does not comply with the requirements for division prescribed in paragraph (1) of Article 44 of the Patent Act prior to the amendment by Act No. 26 of 1993 ("Article 44 of the Former Patent Act"), and its filing date is not retroactive to the time of the filing of the original application. Moreover, since the appellant's patent (the "Patent") is one that should be invalidated on the grounds of lack of novelty, the appellant is unable to exercise the Patent Right.

In this judgment, the court also determined as follows. The Divisional Application is an unlawful one that does not comply with the requirements for division, and its filing date is not retroactive to the time of the filing of the Original Application but is the actual filing date. The invention in question (the "Invention") lacks novelty as it is identical with the invention described in a publication distributed before the filing of

the Divisional Application, and there is thus a ground for invalidation for the Patent. Consequently, the appellant is unable to exercise the Patent Right against the appellee pursuant to the provisions of Article 104-3, paragraph (1) of the Patent Act. The court additionally stated the following reasons regarding the appellant's allegations of legitimacy of the Divisional Application.

(1) For applying the main clause of paragraph (2) of Article 44 of the Former Patent Act to a divisional application, it is necessary that the invention pertaining to the divisional application is stated in the description or drawings originally attached to the written application of the original application (the original description, etc. of the original application) or that said invention is obvious from the statements in the original description, etc. of the original application.

(2) The claims of Inventions 1 and 2 in the Divisional Application do not state the constituent feature "the outer edge of the ink removal opening is protruded more outward than the film."

(3) The original description, etc. of the Original Application contains a statement on an invention relating to an ink tank for an ink jet recording device wherein a "member which seals the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip," and also describes a structure intended to protect the film wherein "the outer edge of the ink removal opening is protruded more outward than the film" as an indispensable structure. However, the original description, etc. of the Original Application contains no statement concerning Inventions 1 and 2 that lack this constituent feature, nor can said feature be found to be obvious from the statements therein.

(4) In that case, the Divisional Application is an unlawful one that does not fall under the "new application" derived from a "patent application containing two or more inventions" as set forth in paragraph (1) of Article 44 of the Former Patent Act, in relation to the Original Application. Therefore, the filing date of the Divisional Application is not retroactive to the time of the filing of the Original Application.

Judgment rendered on May 30, 2007

2006 (Ne) 10077 Appeal Case of Seeking an Injunction against Patent Right Infringement

(Court of prior instance: Tokyo District Court; 2004 (Wa) 26092)

Date of conclusion of oral argument: March 28, 2007

Judgment

Appellant: Seiko Epson Corporation

Appellee: Ecorica Inc.

Main Text

1. This appeal shall be dismissed.
2. The appellant shall bear the cost of the appeal.

Facts and reasons

No. 1 Objects of the appeal

1. The judgment in prior instance shall be revoked.
2. The appellee shall not import, sell, or display for sale the products stated in Item Lists 1 to 6 attached to the judgment in prior instance.
3. The appellee shall dispose of the products set forth in the preceding paragraph that are present in its head office, branch offices, business offices or warehouses.
4. The appellee shall pay to the appellant 5,000,000 yen and the amount accrued thereon at the rate of 5% per annum for the period from December 29, 2004 to the date of completion of the payment.
5. The appellee shall bear the court costs for both the first and second instances.
6. Declaration of provisional execution

No. 2 Outline of the case

1. Summary of the case

The appellant, who holds a patent right relating to an ink tank for an ink jet recording device (Patent No. 3257597), alleged that the appellee's act of importing and selling the ink tanks stated in Item Lists 1 to 6 attached to the judgment in prior instance (hereinafter referred to as the "Defendant's Products") which were made into products by refilling ink in used ink tanks that were manufactured and sold by the appellant constitutes infringement of the aforementioned patent right. Based on this allegation, the appellant filed this action to seek an injunction against import, sale, etc. of the Defendant's Products and disposal thereof under Article 100 of the Patent Act and payment of 5,000,000 yen as a partial claim under Article 709 of the Civil Code and Article 102, paragraphs (2) and (3) of the Patent Act.

In the judgment in prior instance, the court first ruled as follows: Although the application pertaining to the appellant's patent is a divisional application extracted from the original

application, it is an unlawful one that does not comply with the requirements for division prescribed in paragraph (1) of Article 44 of the Patent Act prior to amendment by Act No. 26 of 1993 (hereinafter referred to as "Article 44 of the Former Patent Act"), and its filing date is not retroactive to the time of the filing of the original application. The court then ruled that the appellant is unable to exercise the aforementioned patent right pursuant to the provisions of Article 104-3, paragraph (1) of the Patent Act because there is a ground for invalidation (Article 123, paragraph (1), item (ii) of said Act), i.e., violation of Article 29, paragraph (1), item (iii) of said Act (lack of novelty), for the appellant's patent. Based on this ruling, the court dismissed all of the appellant's claims. Dissatisfied with this, the appellant filed this appeal against the judgment in prior instance.

(omitted)

No. 3 Court decision

This court also finds as follows. The divisional application in question (the "Divisional Application") is an unlawful one that does not comply with the requirements for division, and its filing date is not retroactive to the time of the filing of the original application in question (the "Original Application") but is the actual filing date (December 21, 2000). The invention in question (the "Invention") lacks novelty as it is identical with the invention described in a publication (Exhibit Otsu 9) distributed before the filing of the Divisional Application, and there is thus a ground for invalidation (Article 123, paragraph (1), item (ii) of the Patent Act), i.e., violation of Article 29, paragraph (1), item (iii) of said Act, for the patent in question (the "Patent"). Consequently, this court also determines that the appellant is unable to exercise the patent right in question (the "Patent Right") against the appellee pursuant to the provisions of Article 104-3, paragraph (1) of said Act.

The reason thereof is as stated in No. 3, 1. to 3. (from the last line of page 68 to line 10 of page 85 of the judgment in prior instance) in the "Facts and reasons" section in the judgment in prior instance. Therefore, the relevant part is cited (however, "(Article 44 of the Patent Act)" in line 9 of page 69 of the judgment in prior instance is altered to "(Article 44 of the Former Patent Act)," and "Article 44, paragraph (1) of the Patent Act prior to amendment by Act No. 116 of 1994" in lines 10 to 11 of page 78 of the same is altered to "Article 44, paragraph (1) of the Former Patent Act").

Furthermore, the following reasons are added to the appellant's allegations (legitimacy of the Divisional Application; in relation to Issue (2)A.) in this instance.

1. Regarding the legitimacy of the Divisional Application

Article 44, paragraph (1) of the Former Patent Act provides that "An applicant for a patent

may extract one or more new patent applications out of a patent application containing two or more inventions only at the time when he/she is able to amend the description or drawings attached to the written application or within the allowable time limit for such amendment." The main clause of paragraph (2) of said Article provides that "In the case referred to in the preceding paragraph, the new patent application shall be deemed to have been filed at the time of filing of the original patent application." For applying the main clause of paragraph (2) of said Article to a divisional application, it is necessary that the invention pertaining to the divisional application is stated in the description or drawings originally attached to the written application of the original application (the "Original Description, etc. of the Original Application") or that said invention is obvious from the statements in the Original Description, etc. of the Original Application.

Looking at this case, the scope of claims of Invention 1 pertaining to the Divisional Application (Claim 1) is stated as follows: "An ink tank for an ink jet recording device comprising [a] an ink container, [b] an ink removal opening into which an ink supply needle can be inserted, which is cylindrically formed on the bottom surface of said container, and in which said ink flows, [c] a ring-like seal material which is provided on said ink removal opening and is in elastic contact with the outer circumference of said ink supply needle, thereby preventing leakage of ink, and [d] a film which seals the side of said seal material into which said ink supply needle is inserted and is also bonded to said ink removal opening." In addition, the scope of claims of Invention 2 pertaining to the Divisional Application (Claim 2) is stated as follows: "In an ink tank that is inserted and removed from an ink jet recording device, which has a cylindrical barrel, the tip of which is formed into a conical surface, so that it connects to a recording head provided on the carriage, and has an ink supply needle on which an ink supply hole, the diameter of which is sufficient to retain ink by meniscus, is pierced; an ink tank for an ink jet recording device comprising [a] an ink container, [b] an ink removal opening into which an ink supply needle can be inserted, which is cylindrically formed on the bottom surface of said container, and in which said ink flows, [c] a ring-like seal material which is provided on said ink removal opening and is in elastic contact with the outer circumference of said ink supply needle, thereby preventing leakage of ink, and [d] a film which seals the side of said seal material into which said ink supply needle is inserted and is also bonded to said ink removal opening." The scope of claims of Inventions 1 and 2 does not state the constituent feature "the outer edge of the ink removal opening is protruded more outward than the film."

An invention relating to an ink tank for an ink jet recording device wherein a "member which seals the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip" is stated in the Original Description, etc. of the Original Application (the "Original Description, etc."; Exhibit Otsu 6), from which the

Divisional Application was extracted. It is recognized that the Original Description, etc. also describe a structure intended to protect the film wherein "the outer edge of the ink removal opening is protruded more outward than the film" as an indispensable structure. However, there is no statement concerning Inventions 1 and 2, which lack this constituent feature, in the Original Description, etc. of the Original Application, nor can it be recognized that Inventions 1 and 2 are obvious from the statements therein. Therefore, the Divisional Application is an unlawful one that does not fall under the "new application" extracted from a "patent application containing two or more inventions" as set forth in Article 44, paragraph (1) of the Former Patent Act, in relation to the Original Application. Therefore, the filing date of the Divisional Application is not retroactive to the time of the filing of the Original Application but is December 21, 2000, which is the actual filing date.

The reasons for such determination are mentioned below in a new section titled "Determinations on the appellant's allegations."

2. Determinations on the appellant's allegations

(1) For the reasons as outlined below, the appellant alleges that the Original Description, etc. of the Original Application includes the Invention which does not have a structure wherein "the outer edge of the ink removal opening is protruded more outward than the film" because said structure cannot be considered to be an indispensable structure that affects the function and effect of the invention stated in the original description of the Original Application. That is, for the following reasons, the appellant alleges that all the matters of the Invention are stated in the Original Description, etc. of the Original Application so as to enable a person ordinarily skilled in the art to accurately understand them and easily work the Invention.

A. The purpose of the Invention is to solve the following technical problems in prior arts: "large numbers of air bubbles flow to the recording head at the time of replacement of an ink tank, which causes the occurrence of defective printing" (Problem [i]) and "it is necessary to ensure the safety of the ink supply needle because the tip thereof is sharply processed and thus is dangerous" (Problem [ii]).

B. The following matters are stated in the original description of the Original Application as a means for solving Problem [ii]: The adoption of the structure achieved by combining a structure of "a film that is provided on the ink removal opening and seals the side thereof into which the ink supply needle is inserted (which is penetrable even with an ink supply needle with an unsharpened tip)" and a "ring-like seal material which is in elastic contact with the outer circumference of the ink supply needle, thereby preventing leakage of ink" respectively produce the following functions and effects – "film 4 is easily penetrable even with ink supply needle 9, which is formed of resin and is safe, because the total thickness of film 4 is sufficiently thin, at around 50 μm " (Function and Effect [i]) and "the inner circumference of packing 6, which is

held between ink removal opening 3 and film 4, and the outer circumference of ink supply needle 9 are closely attached to each other, thereby ensuring the sealing of a connection between ink tank 1 and ink supply needle 9" (Function and Effect [ii]).

C. Certainly, the original description of the Original Application discloses a structure which ensures protection of a film to eliminate the risk of damages to the film due to a user's error (a structure wherein "the outer circumference of the ink removal opening is protruded more outward than the film"). However, this structure is not to solve the original problems to be solved by the invention, but is merely an additional structure and does not affect Function and Effect [ii] at all. Therefore, the structure wherein "the outer circumference of the ink removal opening is protruded more outward than the film" is not indispensable, and it should not be considered to be integral with the structure wherein the material for sealing the ink removal opening is a film.

D. In the ink tank stated in the original description of the Original Application, the film will not be torn if a user treats it with caution, attention, care, or consideration. It is a matter which is obvious from the original description of the Original Application that if a user treats the film as such, the use of a structure for protecting the film, which is a measure for preventing the film from being torn, would be unnecessary. In addition, it is generally obvious to persons ordinarily skilled in the art that where a three-tiered film consisting of aluminum, polystyrene, and nylon tiers with the total thickness of 50 μm is stuck on the supply opening of an ink tank, the film will not be easily broken.

E. According to A. to D. above, in the Invention, the structure stated in the original description of the Original Application wherein "the outer circumference of the ink removal opening is protruded more outward than the film" is made into a generic concept, and is not considered to be indispensable. However, there is no change in terms of the purpose as well as the function and effect stated in the original description of the Original Application.

(2) However, there is no reason for the aforementioned allegations of the appellant, as explained below.

A. (A) The statements in the original description of the Original Application (Exhibit Otsu 6) are as outlined below.

More specifically, the following points are recognized. [i] In prior art for extracting (supplying) ink from an ink tank used for an ink jet recording device, ink was extracted by first sealing the ink removal opening of an ink tank with a rubber closure and subsequently inserting a metallic ink supply needle that could penetrate through a rubber closure into said rubber closure. However, there was a problem in that the ink supply needle had to be one with a sharp tip so as to enable it to penetrate through a rubber closure and thus was dangerous. Therefore, as a means for solving this problem, an invention relating to an ink tank wherein the "member for

sealing the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip" is stated in the original description of the Original Application. [ii] Regarding three-tiered film 4 consisting of aluminum, polystyrene, and nylon tiers, which is stated as a working example of the "Invention," there are the following statements in the original description of the Original Application: "Film 4 is easily penetrable even with ink supply needle 9 which is formed of resin and is safe because the total thickness of film 4 is sufficiently thin, at around 50 μm . On the other hand, however, there is the risk that a user may carelessly tear film 4 due to his/her handling thereof. Therefore, the invention ensures that finger 16, etc. of a user does not firmly and directly touch film 4 as indicated in Figure 4 and prevents a user from carelessly tearing film 4 when replacing ink tank 1 by making ink removal opening outer edge 3a be protruded more outward than film 4 and be shaped into an outer ring." (paragraph [0014]); "Regarding the amount of protrusion of ink removal opening outer edge 3a, ... it was revealed that it is preferable to make said amount (h) fall under the following formula in its relationship with the maximum inside diameter (d) of ink removal opening outer edge 3a: $h \geq d/10$. At this time, as long as a user treats film 4 in the usual manner, film 4 will never be torn, for example, unless the user intentionally digs his/her nail into film 4." (paragraph [00015]); "In the case of using a thin film as film 4 that is arranged at ink removal opening 3, it is necessary to protect film 4 with more certainty. ... It is possible to achieve the purpose with a simple structure by making ink removal opening outer edge 3a be protruded more outward than film 4. Furthermore, it is also appropriate to protect film 4 with more certainty by sticking high-strength second film 20 to the end of ink removal opening outer edge 3a, as indicated in Figure 6." (paragraph [0017]). [iii] The following is stated as the effect of the Invention in the original description of the Original Application: "It is possible to protect the film at low cost with a simple structure and prevent a user from carelessly tearing the film by making the ink removal opening outer edge of an ink tank be protruded more than the film" (paragraph [0018]).

(B) According to the above, the original description of the Original Application (Exhibit Otsu 6) is recognized as disclosing the following: [a] In order to solve the problem that the tip of the ink supply needle must be sharp so as to penetrate through a rubber closure that seals the ink removal opening and thus is dangerous, an ink tank wherein the "member for sealing the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip" was adopted; however, along with this, the film that seals the ink removal opening became thin; as a result of this, the problem arises that a user may carelessly tear the film when replacing the ink tank; [b] A structure wherein the ink removal opening outer edge is protruded more than the film was adopted as a means for solving said problem; [c] Where the amount of protrusion is the certain amount (more than one-tenth of the maximum

inner diameter of the ink removal opening outer edge), the film will never be torn as long as a user treats it in the usual manner; however, where the amount of protrusion is less than said certain amount, there is the risk that the film may be torn even if a user treats it in the usual manner.

B. In addition, the explanatory drawings (Figures 1 to 6; Exhibit Otsu 6) of the working examples stated in the original description of the Original Application indicate the condition where the outer edge of the ink removal opening is protruded more outward than film 4 and do not indicate a structure of an ink tank wherein the outer edge of the ink removal opening is not protruded more than film 4. In the original description of the Original Application, there is no statement that discloses or suggests a means for protecting film 4 (for example, adjustment of the thickness and strength of film 4) without using a structure wherein the outer edge of the ink removal opening is protruded more than film 4.

Incidentally, the applicant has submitted Exhibit Ko 35 (report dated February 27, 2007) and Exhibit Ko 36 (report dated February 26, 2007) with the allegation that a three-tiered film consisting of aluminum, polystyrene, and nylon tiers with the total thickness of around 50 μm will never be easily broken if it is stuck on the supply opening of an ink tank. However, the content of the statements in these reports is knowledge that is based on the research and development of films for an ink supply opening conducted in or after around 1993, which is after the filing date of the Original Application (February 19, 1992), or on the ink cartridge products released around that time or thereafter. Therefore, said content cannot be taken into account as common general technical knowledge as of the time of the filing of the Original Application.

C. Piecing the aforementioned matters together, according to the Original Description, etc. of the Original Application (Exhibit Otsu 6), it is indicated that a structure wherein "the outer edge of the ink removal opening is protruded more outward than the film" is a distinctive structure which is indispensable for solving a series of problems in an ink tank in which the "member that seals the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip." That is, the Original Description, etc. of the Original Application is considered to exclude the art that does not have a structure wherein "the outer edge of the ink removal opening is protruded more outward than the film" in an ink tank in which the "member that seals the ink removal opening of an ink tank" is a "film which is penetrable even with an ink supply needle with an unsharpened tip" by clearly indicating that the problem remains in said art. Therefore, it is reasonable to understand that the technical idea in which the aforementioned structure is not an indispensable constituent feature (the technical idea which is a generic concept) is not disclosed at all in the Original Description, etc. of the Original Application, even taking into account all parts thereof.

For these reasons, the appellant's allegation that the Invention for which the structure wherein "the outer edge of the ink removal opening is protruded more outward than the film" is not an indispensable structure is stated in the Original Description, etc. of the Original Application is unacceptable.

3. Summary

Therefore, the Divisional Application is an unlawful one that does not comply with the requirements for division. Consequently, its filing date is not retroactive to the time of the filing of the Original Application and thus is December 21, 2000, which is the actual filing date thereof.

No. 4 Conclusion

On these bases, it is concluded that there is no reason for all of the appellant's claims in this action without the need for making determinations on other issues. Therefore, the judgment in prior instance to the same effect is reasonable.

Consequently, this appeal filed by the appellant shall be dismissed as there is no reason therefor. The judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Third Division

Presiding judge: IIMURA Toshiaki

Judge: OTAKA Ichiro

Judge: SHIMASUE Kazuhide