

judgedate:

October 13, 1977

caseid:

1974 (Gyo-Tsu) 107

casename:

A case of seeking rescission of the JPO decision

casetitle:

Judgment on the case where an invention is incomplete and on reasons for refusal of a patent application

summary_judge:

In the case where an invention claimed in a patent application is incomplete as an invention, the patent application should be refused on the grounds that the invention claimed in the patent application does not correspond to the invention as referred to in the main clause of Article 29, paragraph (1) of the Patent Act.

court second:

Tokyo High Court, Judgment of September 18, 1974

references:

Article 2, paragraph (1), Article 29, paragraph (1), and Article 49, item (i) of the Patent Act

Main Text

The judgment in prior instance shall be quashed.

The present case shall be remanded to Tokyo High Court.

Reasons

Concerning the first and second grounds for the final appeal by the Appellant's attorneys ●●●●, ●●●●, ●●●●, and ●●●●

Article 2, paragraph (1) of the Patent Act (hereinafter referred to as the "Act") provides that "the term 'invention' as used in this Act means a highly advanced creation of technical ideas utilizing the laws of nature" and that the "invention" must be technical ideas, that is, ideas which relate to technology. In light of the purpose of the patent system, it is reasonable to construe that the technical content of the invention must be constituted in a concrete and objective manner to the extent that a person ordinarily skilled in the art can repeatedly work the technical content to achieve the desired technical effect. If the technical content is not constituted to the above extent, it must be deemed that the invention is incomplete and that such invention cannot be considered to be the "invention" as defined in Article 2, paragraph (1) of the Act (See the judgment rendered by the Third Petty Bench of this Court on January 28, 1969, 1964 (Gyo-Tsu) 92, Minshu Vol. 23, No. 1, Page 54). Incidentally, as reasons for refusal of a patent application, Article 49, item (i) of the Act provides that an invention claimed in a patent application (hereinafter referred to as the "invention of the application") is unpatentable pursuant to the provision of Article 29 of the Act. Article 29 of the Act provides in the main clause of paragraph (1) that one of the requirements for patentability is that the invention of the application is an "invention with industrial applicability." The "invention" referred to therein should be understood as the meaning of the "invention" referred to in Article 2, paragraph (1) of the Act. Thus, in the case where the invention of the application is incomplete as an invention, it should be deemed that it is expected and required originally and naturally by the Act to refuse the patent application on the grounds that the invention of the application does not correspond to the "invention" as referred to in the main clause of Article 29, paragraph (1) of the Act. It must be deemed that it was an erroneous interpretation and application of the above-mentioned respective Articles of the Act for the judgment in the prior instance to rescind the present JPO decision on the grounds that it is not permissible to refuse the patent application for the reason that the invention is incomplete. The argument is well founded, and it is clear that the above illegality affects the conclusion of the judgment.

Thus, without going so far as to determine other arguments, it is unavoidable that the judgment in the prior instance shall be quashed. Then, it is necessary to remand the present case to the court of prior instance in order to have the court of prior instance determine and judge whether or not the invention of the present application is incomplete as an invention as mentioned in the present JPO decision.

For the foregoing reasons, in accordance with Article 7 of the Administrative Case Litigation Act and Article 407, paragraph (1) of the Code of Civil Procedure, and based on the unanimous opinion of all judges, the judgment is rendered as mentioned in the main text.

Supreme Court, First Petty Bench

Presiding Judge DANDOU Shigemitsu
Judge KISHIGAMI Yasuo
Judge FUJISAKI Masato
Judge MOTOYAMA Toru