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| Date  | November 26, 2015   | Court | Intellectual Property High Court,<br>Fourth Division |
| Case number   | 2014 (Gyo-Ke) 10254 |       |  |
| <p>– A case in which the court found that the objective of Article 36, paragraph (6), item (ii) of the Patent Act is to prevent inconveniences such as the lack of clarity of the invention stated in the claim, leading to unexpected disadvantages to third parties, and that a determination as to whether or not the invention claimed in a patent application is clear enough should be made based not only on the information presented in the claims but also on the information presented in the description and drawings attached to the application. Moreover, it should be made from the perspective of whether the information presented in the claims can be considered to be so unclear that it would make third parties suffer unexpected disadvantages in light of the common general technical knowledge of the persons ordinarily skilled in the art as of the time of the filing of the application.</p> |                     |       |  |

References: Article 29, paragraphs (1) and (2), Article 36, paragraph (4), item (i) and paragraph (6), items (i) and (ii) of the Patent Act

Number of related IP right, etc.: Invalidation Trial No. 2014-800033 (the "Trial"), Patent No. 4779658 (the "Patent"), Publication of Unexamined Patent Application No. 2004-284654 ("Cited Document 1"), Publication of Unexamined Patent Application No. 2005-112428 ("Cited Document 2")

#### Summary of the Judgment

This is a case where the plaintiff requested a trial for patent invalidation for the Patent of the defendant for an invention titled "packing bag for fruit and vegetable, and vegetable packing body." Dissatisfied with the JPO decision to dismiss the request, the plaintiff sought rescission of that decision.

The grounds for the JPO decision were as follows: [i] Invention 1 satisfies the clarity requirement, the support requirement, and the enablement requirement; [ii] The inventions in question were patented without violating Article 29, paragraph (1), item (iii) and Article 29 paragraph (2) of the Patent Act in relation with Cited Documents 1 and 2.

The plaintiff alleged that all of the JPO's determinations mentioned above are illegal and constitute grounds for rescission. However, in this judgment, the court found as follows in summary with regard to the plaintiff's allegation that the violation of the clarity requirement constitutes grounds for rescission, and held that the plaintiff's allegation is groundless with regard to all of the other grounds for rescission as well. In conclusion, the court dismissed the plaintiff's claim:

"Article 36, paragraph (6), item (ii) of the Patent Act specifies that the invention

claimed in the patent application must be clearly stated in the claims. This provision was established in view of the fact that, if the invention presented in the claims is not clear enough, the technical scope of the invention protected by the patent would be unclear and could cause unexpected disadvantages to third parties. The objective of this provision is to prevent such inconvenience. A determination as to whether or not the invention claimed in a patent application is clear should be determined based not only on the information presented in the claims but also on the information presented in the description and drawings attached to the patent application. Moreover, that determination should be made from the perspective of whether the information presented in the claims can be considered to be so unclear that it would make third parties suffer unexpected disadvantages in light of the common general technical knowledge of the persons ordinarily skilled in the art as of the time of the filing of the application.

As mentioned above, Article 36, paragraph (6), item (ii) of the Patent Act requires that, as far as the information presented in the claims is concerned, 'the invention for which a patent is sought is clear.' This is the sole objective of this provision. Each applicant is not further required to describe all of the matters that could affect the functions of the invention or its operation and effect.

(omitted) The plaintiff alleged that the scope of the claims of Invention 1 covers a technology that is inferior to prior arts in terms of the significance of a freshness-keeping effect even though said technology satisfies the constituent features and that the invention-identifying matters concerning Invention 1 are not sufficient enough to identify the invention.

However, as mentioned in No. 2-2 above, according to the claim of Invention 1 (Claim 1), the significance of the structure is unequivocally clear. This means that no third parties will ever suffer unexpected disadvantages due to the lack of clarity of the technical scope of the patented invention. Therefore, the plaintiff's aforementioned allegation is groundless.

The plaintiff alleged that [i] since different types of fruits and vegetables have significantly different characteristics, the embodiments presented in the description cannot sufficiently prove that Invention 1 has a freshness-keeping effect and [ii] the invention-identifying matters concerning Invention 1 (the matters that affect the freshness-keeping effect) are not sufficient enough to identify the invention on the grounds that the outcomes of the experiment conducted by the plaintiff have revealed that the use of Invention 1 for various fruits and vegetables did not produce a good freshness-keeping effect and only produced a freshness-keeping effect that is inferior to

the one produced by prior arts.

However, the patent applicant is only required to specify in the claims all of the matters that he/she considers necessary to identify the invention (Article 36, paragraph (5) of the Patent Act). The patent applicant is permitted to determine what information should be disclosed as invention-identifying matters as long as such information satisfies the requirement specified in paragraph (6) of said Article. The objective of Article 36, paragraph (6), item (ii) of the Patent Act is not to describe all of the matters that could affect the functions of the invention or its operation and effect, but to require each patent applicant to provide information in the claims in such a way that the invention claimed in the patent application is clear.

Therefore, the aforementioned plaintiff's allegation of the violation of the clarity requirement on the grounds of the insufficiency of invention-defining matters (the matters that affect the freshness-keeping effect) is groundless."