

Date	February 24, 2016	Court	Intellectual Property High Court, Fourth Division
Case number	2015 (Gyo-Ke) 10130		
<p>– A case in which the court ruled as follows: even if any technical idea is presented in an invention for which a patent is sought that is stated in the claims, the invention cannot be considered to fall under the "invention" prescribed in Article 2, paragraph (1) of the Patent Act if it is intended exclusively for a human mental activity, decision-making, abstract concept, or artificial arrangement itself and cannot be considered to utilize the laws of nature in solving the problem to be solved by the invention as a result of consideration of the invention as a whole in light of its technical significance.</p>			

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

Numbers of related rights, etc.: Trial against Examiner's Decision of Refusal No. 2014-18064 (the "Trial"), Patent Application No. 2012-279543 (the "Application")

Summary of the Judgment

The plaintiff filed a patent application for an invention titled "energy saving action sheet," but received an examiner's decision of refusal. In response to this, the plaintiff filed a request for a trial against the examiner's decision of refusal, and also amended the scope of claims through the amendment in question (the amended invention is referred to as the "Claimed Invention"). However, the plaintiff received a JPO decision dismissing the request (the "JPO Decision"). Therefore, the plaintiff filed this action to seek rescission of the JPO Decision.

The reasons given in the JPO Decision are as follows: The structure of the "energy saving action sheet" of the Claimed Invention and a means for presenting (recording/indicating) it are creations exclusively targeting human mental activities themselves, and cannot be considered to be creations of technical ideas utilizing the laws of nature; in addition, the function and effect that the Claimed Invention produces also cannot be considered to be effects utilizing the laws of nature, and the "energy saving action sheet" pertaining to the Claimed Invention does not fall under the "invention" set forth in Article 2, paragraph (1) of the Patent Act; in that case, the Claimed Invention does not fall under the "invention that is industrially applicable" as provided for in the main paragraph of Article 29, paragraph (1) of said Act; therefore, the Claimed Invention is not patentable pursuant to the provisions of said paragraph.

In this judgment, the court determined as outlined below, and ruled that the JPO Decision contains no error in its determination concerning whether the Claimed

Invention falls under the "invention." Based on this ruling, the court dismissed the plaintiff's claim.

(1) Whether the invention for which a patent is sought that is stated in the claims can be considered to fall under the "invention" provided for in Article 2, paragraph (1) of the Patent Act should be determined based on whether the invention can be considered to fall under the "creation of technical ideas utilizing the laws of nature" as a result of consideration of the invention as a whole in light of the underlying technical problem, the structure of a technical means for solving the problem, and the technical significance of effects, etc. drawn from the structure.

As mentioned above, an "invention" is a "creation of technical ideas utilizing the laws of nature." A mere human mental activity, decision-making, abstract concept, or artificial arrangement itself cannot be considered to be the laws of nature, and also does not utilize the laws of nature. Therefore, none of these can be immediately considered to be "utilizing the laws of nature."

Consequently, even if an invention for which a patent is sought that is stated in the claims presents some sort of technical idea, it cannot be considered to fall under the "invention" prescribed in Article 2, paragraph (1) of said Act if it is intended exclusively for a human mental activity, decision-making, abstract concept, or artificial arrangement itself and cannot be considered to be utilizing the laws of nature in solving the problem to be solved of the invention as a result of consideration of the invention as a whole in light of its technical significance.

(2) The Claimed Invention is as follows. [i] The "underlying technical problems" of the Claimed Invention are that it is difficult for a person who utilizes a table that lists and itemizes energy saving actions to understand at the first glance the amount of electricity, etc. that he/she can save by taking each energy saving action and that it is difficult for such a person to understand the energy saving actions to which he/she should give priority. [ii] As the "structure of the technical means for solving the problem," the Claimed Invention uses an "energy saving action sheet" consisting of the "third location axis that indicates the name of location in the building and the electric consumption per unit time in that location by the length of the axis," the "third time axis that indicates time on the scale," and the "third energy saving action identification area wherein the amount of electricity per unit time that can be saved by taking an energy saving action is indicated by the length of the axis in the direction of the third location axis and the duration time of an energy saving action is indicated by the length of the third time axis in the axial direction," and adopts a step of "indicating the estimated amount of electricity (an amount of electricity that can be understood based

on the area which represents the integrated value of the amount of electricity per unit time that can be saved by taking an energy saving action and the duration time of the energy saving action) which can be saved by taking an energy saving action indicated in the relevant third energy saving action identification area." [iii] Thereby, the Claimed Invention produces an "effect drawn from the structure of the technical means," specifically, a user can understand at the first glance the recommended time and location he/she should take an energy saving action and can also understand the estimated amount of electricity which he/she can save by taking each energy saving action.

In that case, the technical significance of the Claimed Invention can be considered to be intended exclusively for a human mental activity itself, that is, presenting an "energy saving action indicated in the third energy saving action identification area" that is recognized as characters and the "estimated amount of electricity that can be saved by taking an energy saving action" that is recognized as an area: both of which are indicated in the "energy saving action sheet," to a person who uses a medium called an "energy saving action sheet," thereby enabling such person to understand the energy saving action he/she should take and the estimated amount of electricity, etc. that he/she can save.

(3) In light of the technical significance of the Claimed Invention that was considered based on its technical problem, the structure of the technical means for solving the problem, and the effects, etc. drawn from the structure, the essence of the Claimed Invention is intended exclusively for a human mental activity itself and the Claimed Invention can be considered to neither be the laws of nature nor utilize the laws of nature. Therefore, the Claimed Invention as a whole should be considered not to fall under the "creation of technical ideas utilizing the laws of nature."

On these bases, the Claimed Invention does not fall under the "invention" provided for in Article 2, paragraph (1) of the Patent Act.