

Judgments of Intellectual Property High Court (Grand Panel)

Date of the Judgment: 2005.11.11

Case Number: 2005 (Gyo-Ke) 10042

Title (Case):

Judgment upholding a Decision of Revocation in an opposition procedure by the Patent Office, in which the recitations of a claimed invention do not comply with statutory requirement (support requirement) in Article 36, Paragraph 1, Item 5 of Patent Law that was effective before the revision by Law No. 116 of 1994, with regard to a particular mathematical formulation that includes two technical variables, or “parameters”, each of which denotes a characteristic of an element of the claim, which is used in the claimed invention.

Related Statutory Provision(s):

Article 36[(5) (i)] of the Patent Law, before the revision by Law No. 116 of 1994 (corresponding to Article 36 (6) (i) of the Patent Law, after the revision)

Summary of the Judgment:

I Outline of the Case

1 Brief Summary of Facts

In the present case, a plaintiff who was a patentee of a patent titled “Manufacturing Methods of Polarizing Film” (hereinafter “the Patent”) alleged that the Decision of Revocation in the opposition procedure was erroneous and thus sought reversal of the Decision based on Law No. 47 of 2003, Appendix Article 2(9). The Decision of Revocation that had been issued by the Patent Office was based on failure to meet the description requirements in the specification accompanied with the patent application in the opposition procedure that had been filed before the date of enforcement of Law No. 47 of 2003, or January 1, 2004. (In this summary, “specification” includes “claims” according to the statutory definition before the revision of Law No. 24 of 2002.)

The claimed invention of the Patent includes an element that is defined with a range limited by a particular mathematical formulation. This mathematical formulation is expressed using two technical parameters, each of which denotes a characteristic of the element of the claimed invention. Thus the present invention is a so-called parameter invention. In the present judicial review, what is at issue is the permissibility of the specification disclosure, that is, whether the specification

discloses the invention sufficiently, as set forth in Article 36 of the Patent Law, so that the invention is awarded monopolization and exclusivity.

2 Issues

(1) With respect to Reason for Revocation 1

A. (Fulfillment of support requirements)

Regarding the invention claimed in the specification accompanied with the patent application, which is a so-called “parameter invention”, do claim recitations of the application comply with statutory requirements of the Patent Law, Article 36(5) (i) ? The requirement (hereinafter, “support requirement”) was revised by Law No. 116 of 1994 (“patent revision of 1994”) to become Article 36(6) (i) of the Patent Law.

B. (Legitimacy of addition to specification by submitting experiment data after filing)

When the above-specified issue A is negated, can a patentee-plaintiff assert legitimacy as to the support requirement on claims by submitting additional experimental data in the course of an opposition procedure for amending the detailed description of the specification to include data that is not found in the original specification?

C. (Legitimacy of *ex post fact* application of the Guidelines)

In the case that the “Guidelines” (the Examination Guidelines for Patent and Utility Model in Japan) regarding the examination of the description requirements are revised after the filing date of the invention, is it permissible for the Patent Office to apply the Guidelines to the invention?

(2) With respect to Reason for Revocation 2

Does the detailed description in the specification comply with the statutory requirements of the Patent Law, Article 36(4) before the patent revision of 1994?

II Outline of the Judgment

The Court concluded that the plaintiff’s assertion presented in the Reason for Revocation is not persuasive, because, with respect to issue (1), the recitations of a claim of the present specification do not comply with the support requirements, and thus issue (2) is not necessary to discuss. Regarding issue (1), the Court held as follows:

1 With respect to A (Fulfillment of the support requirements of the specification)

(1) Whether the claim recitations fulfill the support requirements or not should be determined by the following scheme: claim recitations are first compared with the detailed description of the specification; then the fulfillment is determined according to whether the claimed invention was described in the detailed description of the invention, whether the claimed invention can be regarded as though the skilled person in the art could have figured out the invention based on its recitations, or whether the claimed invention can be regarded as though the skilled person could have figured it out based on common technical knowledge at the filing date given that the recitations were not included nor suggested [in the detailed description of the specification]. It is the patentee to whom the burden of proof as to the support requirements is given to.

(2) An element of the present invention is a material that is limited in a range determined by a particular mathematical formulation. The mathematical formulation includes two technical variables, or parameters, each of which denotes a characteristic of the element. Specifically, the element is a poly-vinyl-alcohol based material film ("PVA film") whose complete salvation temperature, X, and balanced degree of swelling, Y, fall within a range that is denoted by a particular mathematical formulation [of X and Y] . Thus, the present invention is a so-called parameter invention. Claim recitations of such invention shall meet the support requirements if (i) the detailed description in the specification discloses a technical meaning in the relationship between the range denoted by the mathematical formulation and its effects, or performances, at least in such a way that the skilled person is able to understand it at the time of filing even if particular examples are not included in the specification; or (ii) [the detailed description] includes the disclosure of examples in a manner that the skilled person can recognize, by consulting the common technical knowledge at the time of filing, that the intended effects, or performances, would have been realized when [X and Y for the claimed invention fall within] the range denoted by the mathematical formulation.

(3) The detailed description of the present specification includes only two examples and two comparative examples for showing the effectiveness of the above structure. The examples merely show that polarizer films with considerable durability and tolerance for high stretch rate are realized by PVA films with specific sets of complete salvation temperature, X, and a balanced degree of swelling, Y; whereas, the comparative example merely show that polarizer films with poor durability and poor tolerance for high stretch rates are realized by PVA films with

other specific sets of complete salvation temperature, X, and a balanced degree of swelling, Y. Therefore, such description does not disclose examples in such a way that the skilled person can recognize, by consulting the common technical knowledge at the time of filing, that the intended effects, or performances, would have been realized when the [numerical values of the characteristics for the PVA films] fall within the range [denoted by the mathematical formulation in the claim recitations]. Therefore, the claim recitations do not meet the support requirements.

2 With respect to B (Legitimacy of addition to specification by submitting experiment data after filing)

(1) With respect to the so-called parameter invention, notably the present invention, if we take into consideration the fact that the detailed description, which neither discloses the examples so specifically that the skilled person can recognize the problem solved by the present invention, nor discloses [the invention] in such a manner that the [disclosure of] detailed description can be expanded or generalized into what is recited in the claims by consulting the technical knowledge on the filing date; then, under the objective of the patent system in which [sufficient] disclosure is assumed for any granted patent, it is not allowed that the [scope of the] detailed description is expanded or generalized to what is recited in the claims for the purpose of satisfying the support requirements by submitting experimental data after the filing date, wherein the data is new matter that not disclosed in the detailed description.

(2) The experimental data that has been filed by the plaintiff during the opposition procedure discloses (i) performance measurement results of polarizer film obtained from PVA films of a specific set of [values for] complete salvation temperature, X and a balanced degree of swelling, Y; and (ii) relationships between the polarizer film performance and the set of [values for] complete salvation temperature, X, and balanced degree of swelling, Y, for PVA films, wherein the relationships are determined based on the measurement results. Both of them have never been disclosed specifically in the detailed description, thus they are disclosed nothing but after the filing date. Therefore, in light of the above-mentioned (1), [such experimental data] are not allowed to be consulted [as grounds for the claimed invention] because they are introducing new matter into the detailed description.

3 With respect to C (Legitimacy of *ex post fact* application of the Guidelines)

(1) Whether the claim recitations meet the support requirements or not should be determined by the objective of pertinent provisions of the Patent Law. The Guideline is not a law, but merely an examination standard which has been made in the

Patent Office for the purpose of ensuring equality and rationality in patent examinations as to whether a patent application meets the patentability requirements under the Patent Law. Thus, the holding in 1(2) is not affected by whether or not the standards in the Guideline that is applicable to the present invention includes the interpretation of the above-mentioned provision of the Patent Law.

(2) Since the standards of the Guideline, which was revised in October 2002, conform with the objective of Article 36 Paragraph 5 Item 1 of Patent Act before the 2002 revision, which was revised in 1994, there is no violation of law even when the standards are retroactively applied in an *ex post fact* manner to a patent that was filed before a filing date on which the revised standard went into effect.

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