

# PROVISIONS TO RESTRICT AMENDMENTS OR CORRECTIONS IN THE PATENT ACT AROUND THE JUDGMENT OF THE INTELLECTUAL PROPERTY HIGH COURT ON JUNE 12, 2008

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## ABSTRACT

Revisions have been made to the Patent Act, with the objectives of simplifying the trial system, solving cases in a reasonable manner, giving early judgments, reviewing the assignment of authority between the Japan Patent Office and the court, and globalizing the system, since 1993. This study reviews the series of Patent Act revisions that have been enacted and examines the provisions to strengthen protection of trade secrets in court, limit patent rights in actions for infringement, and restrict corrections, as well as the correction system related to the court. In this context, the author considers the provisions to restrict amendments or corrections in the Patent Act centering around the judgment of the Intellectual Property High Court on June 12, 2008, of the case “Clothes having a property to maintain shape.”

*Keywords:* trial for patent invalidation, request for correction, amendment, new matter, judgment rescinding the trial decision

## 1. INTRODUCTION

The Patent Act was significantly revised in 1993 (Law 26 [Note 1], 1993), and revisions to the law have been enacted almost every year since then. The objectives of these revisions are to modify systems related to the examination and trial system (including objections), patent right infringements, and litigation to rescind trial decisions. In addition, the revisions are aimed at simplifying examination and trial procedures, obtaining reasonable solutions to disputes, accelerating the legal procedures, reviewing the assignment of authority between the Patent Office and the court, and globalizing the Patent Act system. This study reviews the series of revisions to the law that have been enacted so far and examines the following aspects of the Patent Act system:(1) Introduction and review of the system for requesting

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corrections.(2) Establishment and abolition of the system for objections after the grant of a patent.(3) System for judgment (restriction of the right of use) (Patent Act Article 104-3) of invalidity in actions for infringement.(4) Restriction of amendments and corrections.(5) Introduction of requests for correction after referral of a case back to the original court in litigation rescinding a trial decision.(6) Reinforcement of the protection of trade secrets in the proceedings of patent infringement litigation.

In this report, the judgment of the case “Clothes having a property to maintain shape” (Intellectual Property High Court Judgment on June 12, 2008) is considered as an example to examine the provisions to restrict amendments or corrections in the Patent Act, introduced in particular by the Patent Act revision of 1993.

## **2. REVISIONS TO THE LAW**

### **2.1. Text**

The Patent Act system of Japan, which originated in the promulgation of the Patent Monopoly Act of 1885, was revised overall in 1888 and reorganized as the Patent Regulations. The current Patent Act system was subsequently constructed by a full-scale revision in 1959. Following this, the “re-examination system before trial examination” was established (Law 91, 1970) in 1970. A series of revisions were then made to the system, such as introduction of the “multiple claim system” in 1975 (Law 46, 1975) and a shift to the “revised multiple claim system” in 1988 (Law 27, 1987). “Restriction of amendments” in connection with about the scope of claims was included as a part of a simplification of the examination and trial procedure in the revised law of 1993 (Law 26, 1993, enforced from January 1, 1994). Further, with respect to corrections, a system for requesting corrections (Patent Act Article 134-2) (that is, a system to enable correction of the description, scope of claims, or drawings in the procedure of trials for patent invalidation) was introduced, making unlawful amendments or amendments or corrections that add new matter grounds for invalidity. Trials for the invalidation of corrections were thereby abolished.

Before the Patent Act was revised in 1993, a patentee was able to avoid the invalidation of all patent rights by filing a request for a separate trial for correction when a request for a trial for patent invalidation had been filed. However, when a trial for patent invalidation and a trial for correction were simultaneously pending, it was customary for the proceedings of the trial for invalidation to be suspended until the decision of the trial for correction had become final and binding. This was because the object of the proceedings of the invalidity trial might be changed by the decision of the trial for correction. Such cases caused delays in the proceedings of trials. Therefore, in this revision, the independent filing of a request for a trial for correction was prohibited while a trial for invalidation was pending. Instead, it became possible for a patentee to make substantially the same correction of contents as in a trial for correction by making a request for correction in the trial for invalidation. It also became possible for a patentee to file a request for a trial for correction while a trial for patent invalidation was pending in connection with litigation for rescinding of a trial decision.

As a result, where a trial decision was made to the effect that the scope of claims was to be corrected, settlement of the case by the court was to be carried out by the court rescinding

the trial decision to the effect that the patent was to be invalidated without the court judging the substance of the said trial decision (see the judgment of the Supreme Court, March 9, 1999) [Note 2]). A new “catch ball phenomenon” consequently emerged due to the manner in which such trial decisions were rescinded (that is, the case was returned to the trial examiner), and delays in proceeding occurred again.

Therefore, under the revision of the Patent Act enacted in 2003 (Patent Act Article 126, Paragraph 2), a patentee may request a trial for correction not more than 90 days after having filed a request for litigation for rescinding of a trial decision. In addition, in recent years there have been frequent revisions to the law concerning amendments and corrections [Note 3]. As a result, the Patent Act system has become a difficult body of legislation that is full of patches.

## **2.2. Restriction of the amendment and correction of contents**

### **2.2.1. Prescribed purpose**

With regard to the amendment and correction of contents as provided in the major revision of the Patent Act of 1993, provisions concerning the addition of new matter in the case of making amendments (Patent Act Article 17-2, Paragraph 3) and in the case of a request for correction (Patent Act Article 126, Paragraph 3, applied *mutatis mutandis* to Patent Act Article 134-2, Paragraph 5) are prescribed as shown below. The purpose here is to stipulate that the addition of the new matter is not recognized for amendments of the description, scope of claims, or drawings, as in Europe and America. In this context, legislation is taken into account such as the provisions of Article 11 related to international applications based on the Patent Cooperation Treaty. [Note 4]

“Correction of the description, scope of claims, or drawings . . . shall remain within the scope of the matters disclosed in the description, scope of claims, or drawings attached to the application. . . .” (Patent Act Article 126, Paragraph 3)

“The plaintiff in a trial for patent invalidation may file a request for correction of the description, scope of claims, or drawings attached to the application only within the designated time limit. . . .” (Patent Act Article 134-2)

Moreover, the scope of corrections that can be made in a trial for correction is as follows: “. . . Any amendment of the description, scope of claims, or drawings . . . shall be made within the scope of the matters described in the description, scope of claims, or drawings originally attached to the application. . . .” (Patent Act Article 17-2, Paragraph 3)

In this report, the expression “description, scope of claims, or drawings originally attached to the application” is referred to as “original description, etc.”), and the expression “description, scope of claims, or drawings attached to the application” is referred to as “description, etc.”).

### **2.2.2. Examination Guidelines**

In addition, according to the current Examination Guidelines (Part 3, Section 1), the basic approach adopted with respect to amendments and corrections is as follows. Similar guidelines are applied with respect to corrections alone.

(a) An amendment that introduces matters extending beyond the “matters described in the original description, etc.” (i.e., an amendment containing new matter) is not acceptable.

(b) The phrase “matters described in the original description, etc.” refers not only to “matters expressly presented in the original description, etc.”, but also to “matters inherently presented in the original description, etc.”

(c) In order to conclude that an amendment is within the scope of “matters inherently presented in the original description, etc.,” the meaning of the particulars of the amendment shall be evident to a person skilled in the art in light of common general technical knowledge as of the filing date, as if it were written in the original description, etc., even though it is not expressly presented there.

(d) The addition of well-known art or commonly used art is not acceptable if the reason for the addition is simply because the art is well-known art or commonly used art. This type of addition is acceptable only if such art is inherently presented in the original description, etc.; that is, the art is evident to a person skilled in the art as if it were written in the original description, etc.

(e) In some cases, a matter is inherently presented to a person skilled in the art in light of several parts in the original description, etc. (e.g., problems to be solved and embodiments of an invention, a description, and drawings). [Notes 5, 6, 7]

### 2.2.3. Process of revision of the law

With regard to restriction of the contents of amendments and corrections of a description, the standard of “change of the gist” was prescribed prior to the revision of the law in 1993. There was a provision in the former Patent Act, Article 41, stating “An amendment that increases mentions of the scope of claims within the matter listed in the description, or the scope of claims or drawings originally attached to the application before service of the certified copy of the decision of publication of the application for opposition, is not considered to be changing the gist.” In other words, there was a concept called “change of the gist” of the description, the scope of claims, or the drawings, and amendments and corrections that did not change the gist were permitted.

In the revision of the law in 1993, it was stipulated that “an amendment must be within the matters listed in the original description, etc.” (Patent Act Article 17-2, Paragraph 3). It was also stipulated that a correction must remain “within the scope of matters described in the description, etc. or the original description, etc.” (Patent Act Article 126, Paragraph 3 and Article 134-2, Paragraph 1).

In other words, a new concept of “addition of new matter” was introduced, replacing “change of the gist.” The amended matter of the description, etc. was stipulated as “matter that can be introduced directly and integrally from the content of the original description, etc.” in addition to “matters described in the original description, etc.” in the original Examination Guidelines.

The Guidelines were rigorously formulated, applying the strict requirement that “an amendment changing even one character of the original description shall not be permitted.”

However, the Guidelines were considered to be excessively severe for applicants. The requirements were therefore amended in a revision of the Examination Guidelines in October, 2003, stipulating that “matters described in the original description, etc.” contained not only “matters expressly presented in the original description, etc.” but also “matters inherently presented in the original description, etc.” In other words, an amendment introducing matters extending beyond the matters described in the original description, etc. (i.e., an amendment containing new matter) was not acceptable. “Matters described in the original description, etc.” contained not only “matters expressly presented in the original description, etc.” but also “matters inherently presented in the original description, etc.” In addition, it was stipulated that “the meaning of the particulars of an amendment shall be evident to a person skilled in the art in light of common general technical knowledge as of the filing date, as if it had been written in the original description, etc. even though it is not expressly presented there, in order to conclude that the amendment is within the scope of matters inherently presented in the original description, etc.” The approach adopted with respect to the requirements for amendments is applied to the requirements for corrections as well.

Matters listed in items (b) to (e) of the Examination Guidelines mentioned above and the requirements for corrections are based on the judgment of “obviousness.” A requirement such as “obviousness” may appear to be purely an element of technical judgment, but in fact it has a high degree of the element of sensitivity, as mentioned later.

### **3. PROCESS OF REVISION OF THE LAW**

Under this current Patent Act system, many cases of litigation to rescind trial decisions regarding the admission of amendments and corrections have been submitted. [Note 8] Here, we examine the provisions restricting amendment or correction of a description centering around the case “Clothes having a property to maintain form” (2008 “ke” No. 10053), which is a representative case affecting amendments and corrections in such many cases.

#### **3.1. Progress of the case**

This case was a litigation to rescind a trial decision involving plaintiff C-com Co., Ltd. (“X”) and defendant Mitsui Chemicals, Inc. (“Y”).

The patent application in question (Japan patent application No. 2005-94080) was a new divided application that had been separated from a part of the original application (Japan patent application No. 2004-208966). The title of the invention of said original application was “Clothes having a property to maintain shape.” The establishment of this divided patent (hereafter referred to as “this patent”) was registered on March 24, 2006 (Japan Patent No. 3784398). However, a request for trial for patent invalidation with respect to this patent (Invalidation No. 2006-80082) was filed on May 9, 2006. This patent was invalidated at a trial on January 5, 2007 (first trial decision).

Plaintiff X instituted an action against the trial decision in the trial for patent invalidation against Y on February 13, 2007. Further, X filed a request for trial for correction (Correction No. 2007-390058) on May 10, 2007. The Intellectual Property High Court rescinded the trial decision (first trial decision) by a ruling in order to return the case to the trial examiner at the

Patent Office under Patent Act Article 181, Paragraph 2, on June 29, 2007. The trial panel conducted the trial for patent invalidation again. A notification of reasons for invalidation was served on October 30, 2007, stating that the correction did not comply with the requirements for corrections. The plaintiff requesting a trial submitted a written opinion on December 3, 2007. The trial decision (decision of the second trial; referred to hereafter as “the trial”) was rendered by the panel on January 8, 2008. The said decision was that the correction was not recognized and the patent was invalidated.

X instituted an action against the trial decision again on February 15, 2008. The court announced the judgment of dismissal of the trial decision on June 12, 2008. [Note 9]

### **3.2. Content of the invention in this patent**

First, let us examine the relevant parts of the description of the invention in this patent (Japan Patent No. 3784398) forming the basis of the trial decision and judgment, as follows:

“[0016] Shirt 10 is composed of a knit cloth with a border pattern (striped pattern) shown in Figure 1 (author’s note: and in Figure 4). The border pattern is not formed by changes in the color of the thread constituting the piece of cloth. It is formed by sewing pieces of cloth (e.g., main cloth 17 and sub-cloth 16) of plural types (pattern, color) three-dimensionally. Sub-cloth 16 of slightly wider dimensions than the border pattern is sewed on the rear of main cloth 17 between the pieces of main cloth 17. The ends 17a and 17a of main cloths 17 and 17 are exposed as the surfaces of the cloth cut apart without being sewed. End 17a of main cloth 17 rolls up to a surface according to the characteristics of the knit cloth. A three-dimensional line is formed on the changed part between the upper and lower border patterns.

“[0017] Flexible and shape-maintaining wires 20 and 20 are attached in appropriate positions of shirt 10. In other words, wires 20 and 20 are flexible and capable of maintaining their shape. For example, in the case of shirt 10 with a collar, wires 20 and 20 are attached to collar 13, collar hole (open part of the collar) 14, the lower part of sleeves 12, the lower part of the body of the shirt 11, and pocket flaps 15a of pockets 15. In addition, in the case of T-shirt 10, wires 20 and 20 are attached to the lower part of sleeves 12 and the lower part of the body of the shirt 11 (author’s note: cf. Figure 2).

“[0019] Wire 20 is attached to the back side so as not to be exposed to the surface of the clothes. For example, as shown in Figure 7 (author’s note: Figure 3 in this report), by forming a bag by sewing another cloth 19 on the back side of main cloth 17 constituting the surface of the clothes, and inserting wire 20 through the inside of the bag, wire 20 can be attached to the clothes. In this embodiment, as shown in Figure 8 (author’s note: Figure 4 in this report), by exposing another cloth 19 to the back side of sub-cloth 16 of the border pattern of the cloth, forming a bag between sub-cloth 16 and another cloth 19, and inserting wire 20 into the bag, wire 20 can be attached to the clothes.

“[0021] Wire 20 is attached to a fringe of collar 13 and a fringe of collar hole 14 around collar 13 of shirt 10 as shown in Figure 9(a) (author’s note: Figure 5(a) in this report). By this method, wire 20 can maintain collar 13 in a standing position as shown in Figure 9(b) (author’s note: Figure 5(b) in this report). In addition, wire 20 can maintain a part of collar 13 in bent position, collar hole 14 in a wavy shape, and the shirt in a three-dimensional shape.

“[0022] In pocket 15 of shirt 10, wire 20 is attached to the fringe of the hole of pocket 15 and pocket flap 15a. By this method, a pocket 15 formed three-dimensionally by extending out from the body of the shirt 11 and by bent pocket flap 15a can be maintained in a three-dimensional shape.”

### 3.3. Contents of the correction

The contents of claim 1 in the scope of claims for the invention of this patent can be divided into segments as follows:

“[Claim 1]

(1) Formation of a bag along the fringe of part of the body, a collar, a collar hole, and a pocket or pocket flap of clothes;

(2) Insertion of a wire through this bag, said wire being able to easily bend or create a wavy shape or to maintained a transformed shape;

(3) Clothes having a property to maintain shape by means of the above.”

The plaintiff filed a request for correction on July 26, 2007, and corrected claim 1 as follows.

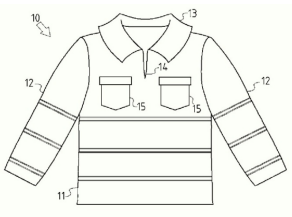


Figure1:A shirt with collar

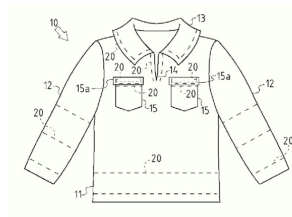


Figure2: Location of wires

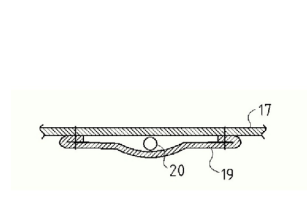


Figure3: A wire in clothes

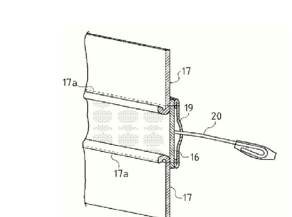


Figure4: A wire in clothes

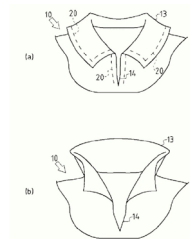


Figure5: A wire in a collar

“[Claim 1]

(1) Sewing additional cloth behind the main cloth constituting the surface of the clothing and forming a bag along the edge of the body, a collar, a collar hole and a pocket or pocket flap of a piece of clothing;

(2) Insertion of a wire through this bag, said wire being able to bend easily or maintain a transformed shape ;

(3) Clothes having a property to maintain their shape by means of the above.”

In other words, claim 1 was corrected as regards (1) and (2) by the said request for correction.

(1) Correction of the phrase from “the part of a body, a collar, a collar hole” to “a collar.”

(2) Addition of “sewing additional cloth behind the main cloth constituting the surface of the clothing.”

#### **3.4. Trial decision**

The chief trial examiner decided that the correction should be dismissed. The trial decision is as follows.

“It is sure that the following sentences are included in [0017] [0019] of this description.

(1) As regards shirt 10, wires 20 and 20 are attached to part of the sleeves 12, and the lower part of the body of the shirt 11.

(2) A bag is formed along the edge of the body of the piece of clothing, the collar, the collar hole and a pocket or pocket flap of the clothing (claim 1).

(3) By forming a bag by sewing another cloth 19 on the reverse of the main cloth 17 that constitutes the surface of the clothing, and inserting wire 20 through the inside of this bag, wire 20 can be attached to a piece of clothing.

However, the following sentence (4) is not included in [0017] [0019] of the description.

(4) Sewing another piece of cloth on the reverse of the main piece of cloth constituting the surface of the clothing and forming a bag along the edge of part of the body, the collar, the collar hole and a pocket or the pocket flap of the clothing.

And sentence (4) is not obvious from this description, etc. Therefore, said correction has not been made to the matters listed in the description, etc. In other words, the purpose of this correction is not to limit the scope of claims. On the contrary, this correction substantially enlarges or alters the scope of claims.”

The chief trial examiner decided that the patent of the invention (No.3784398) should be invalidated and that the request for correction should be dismissed for the above reasons.

#### **3.5. Issues in the litigation rescinding the trial decision**

The patentee X filed an action against the trial decision in the trial.

##### **3.5.1. Assertion of the plaintiff (the gist)**

The following matter is included in [0017] [0019] to [0022] of the description and [figure 2];

“Sewing another cloth on the reverse of the main cloth constituting the surface of a piece of clothing and forming a bag along the edge of part of the body of the clothing, the collar, the collar hole and a pocket or a pocket flap of the clothing.”



### 3.5.2. Assertion of the defendant (the gist)

The wire is not attached to the edge of the collar of the clothing, a pocket or a pocket flap but to the body of the clothing from [figure 7] (author's note: figure 3 in this report) and [figure 8] (author's note: figure 4 in this report). In addition, the following sentence is not obvious from this description, etc.; sewing another piece of cloth to the rear of the main piece of cloth constituting the surface of the clothing and forming a bag along the edge of part of the body, the collar, the collar hole and a pocket or a pocket flap of the clothing.

This insistence is the same as that of the trial decision.

### 3.5.3. Judgment of the court (the gist)

About the propriety of this correction

In general, it may be reasonably admitted that a correction has been made "within the matter listed in the description, etc." when said correction does not contain any new technical matter related to any of the description, etc. from the point of view of a person skilled in the art under Patent Act Article 126 Paragraph 3 to apply *mutatis mutandis* to Code Article 134-2 Paragraph 5,

When a person corrects the description, etc. to add a restriction to the scope of the claims and the content of said corrections is inherently written in said description, etc., or when said corrections are obvious from said description, etc., said correction should be allowed as long as it does not contain any new matter. And it may be said that "said correction has been made within the scope listed in the description, etc." [Note 10]

The court considered whether said correction was "made within the content of the description, etc." after it pronounced on the above matter.

According to the description,

(A) About the location of the wire, the edge of the collar, a pocket and a pocket flap are written in [0017][0021]and [0022].

(B) There is mention of "sewing another cloth on the reverse of the main cloth constituting the surface of the clothing, and inserting wire 20 into this bag, then wire 20 can be attached to the clothing" in [0019].

Then a person skilled in the art can allow that the above matter (B) is obvious by considering the entire description.

The defendant insisted that the content of [0019] means only "the body of the piece of clothing". However, the court admitted that the correction was made "within the matter written in the description, etc."

## 4. DISCUSSION

### 4.1. Correction

In this case, both the plaintiff and the defendant agreed that the sentence “Sewing another cloth on the reverse of the main cloth constituting the surface of the clothes and forming a bag along the edge of part of the body, collar, collar hole and pocket or pocket flap of the clothing” should not appear in the description. The trial examiner at the Japan Patent Office expressed the same opinion. However, the court overturned the trial decision and assumed that the correction provided by the patentee should be effective.

#### 4.1.1. Authorization of the matter of correction

The patentee’s corrections are described in the following sentences (see above 3.3).

(1) The phrase “the part of a body, a collar, a collar hole” is changed to “a collar.”

(2) The sentence “sewing another cloth to the reverse of the main cloth constituting the surface of the clothing.”

I carefully inspected all of the assertions of the plaintiff and the defendant, the trial decision and the judgment, and I had no questions about the content of said correction.

#### 4.1.2. Judgment of the court

Matters regarding the correction of the above sentences (1)(2) are not directly included in the description.

The parties, the trial and the court have no other opinions in this regard.

At first the court pointed out following (A) (B), and judged that they were valid evidence for allowing the correction.

(A) The edge of the collar, a pocket and a pocket flap of a piece of clothing are shown as the location of wires. (cf.[0017] [0021] [0022])

(B) The sentence “to sew another cloth on the reverse of the main cloth constituting the surface of the clothing and insert a wire into this bag” describes the structure and installation of the wire [0019].

I do not question the decision of the court because (A)(B) above are included in the description as shown above in 3.2.

However, the following statement presents another important question concerning the decision of the court. This is whether or not a person skilled in the art could easily understand the following technical matters derived from the entire description.

The Examination Guidelines (above 2.2.2), contain the following sentences.

(a) An amendment that introduces matters extending beyond the “matters described in the original description, etc.” i.e., an amendment containing a new matter) is not acceptable.

(b) The phrase “matters described in the original description, etc.” refers not only to “matters expressly and inherently presented in the original description, etc.”

(c) To conclude that an amendment is within the scope of “matters inherently presented in the original description, etc.,” the meaning of the particulars of the amendment shall be evident to a person skilled in the art in light of common general technical knowledge as of the filing date, as if it were written in the original description, etc., even though it is not expressly presented there. The original description contains technical matter meaning “to attach a wire to the collar of a piece of clothing,” but it does not mean “to sew another cloth to the reverse of the main cloth constituting the surface of a piece of clothing and inserting a wire into the resulting bag, when said wire is attached to the edge of part of the body, collar, collar hole, pocket or pocket flap of clothing.

The judgment says that a person skilled in the art could easily understand that the above technical matters by referring to the entire written description. However, I think that the technical matter should not only mean the above but also be obvious by comparison with the Examination Guidelines.

Therefore, I am certain that the judgment of the court deviates from the provision of Patent Act Article 17-2 Paragraph 3.

Here, what does “technical matters derived from the entire written description of the description” mean? It is defined in a previous case “Solder-resist “disclaimer” (Intellectual Property High Court, Judgment on May 30, 2008)” [Note 10] as follows.

“The matter written in the description means technical matters derived from the entire description. The amendment can be made within the matter included in the description or drawing, that is, this amendment does not introduce a new technical matter. And the correction should be decided according to the same standard as the amendment.”

This is the same aim as in the present case.

However, what does the word “totaling” in “the technical matter led by totaling written matters of the description” mean in these judgments?

The court mentions that we must not introduce a new technical matter and thus realize a correction. And the court says that a correction must not deviate from the meaning of the original description. This judgment seems to be compatible with the Examination Guidelines. However, the reason for the criterion still seems vague.

In general, the use of a wire to maintain the shape of a collar is well known and commonly used by those skilled in the art of the apparel industry.

However, the question remains as to whether sewing another cloth on the reverse of the main cloth of the collar and inserting a wire into the resulting bag are a well-known or commonly used art.

I am sure that such techniques are not obvious to a person skilled in the art. Furthermore, it cannot be a well-known art or commonly used art because documents about the art that

predate this patent could not be found at the trial or the court. I suggest that this is one of the most important problems.

Moreover, the judgment of the case includes unclear messages.

Here it should be mentioned that the judgment of the case “food packing container” (Supreme Court judgment on January 24, 1980) states as follows.

“In an action against a trial decision in a patent invalidation trial, it is permitted that the court establishes a common sense technique employed by a person skilled in the art in the patent application at the filing date, based on documents that did not appear in the trial procedure, to clarify the significance of said document.”

This coincides with the Examination Guidelines (d) (above 2.2.2(d)). I am certain that the correction concerned cannot pass the “obviousness” test even if the technical standard at the time of the application of the patented invention was clarified at the suit stage.

I may say that the issue in this case is related to whether “obviousness” was recognized. “Obviousness” is related to “easiness.” However, the recognition of obviousness does not necessarily mean the recognition of easiness. [Note 7]

The Intellectual Property High Court decided “totally” after considering assertions of the plaintiff, the defendant, and the evidence. Then it is finally judged based on “conviction.” Here, conviction means a judgment based on the judge’s feelings about the facts that he/she must confirm during the litigation stage (Jurisprudence glossary of terms (3rd edition), Yuhikaku). Judgment based on feelings is very sensitive. And the confirmation of a conviction is extremely delicate. Hence, I am sure that the formation of “obviousness” by the “totally” judgment is sufficiently sensitive.

The final judgment of the court should depend on sensitivity. In this respect, sensitivity is an important element as regards trials and courts.

#### **4.2. Amendment and correction requirement**

The Patent Office has started to review the Examination Guidelines based on this judgment.

It is quite natural that excessive regulation with respect to the addition of new matter is undesirable. However, I do not agree that the Patent Office can revise this easily based on the above judgment.

#### **4.3. Requirement of the new matter addition of amendment or the correction**

I do not understand the judgment of the case “Clothes having a property to maintain shape” as above. However, I agree with the judgment of the court to some extent other than in this case because the examination undertaken by the Japan Patent Office is very strict when making amendments and corrections to a description, etc.

## 5. CONCLUSIONS

There is no doubt that the patent examination and trial procedures are complicated for the parties involved. A trial involving patent invalidation and a request for correction, a trial for correction, and litigation rescinding the trial decision have a complicated effect on each other. And the parties should be concerned about the procedure. This is because the authorities concerned capriciously and repeatedly revised the Patent Act system to expedite the promotion of efficiency, simplification, globalization of the patent trials and the litigation rescinding the trial decision. As a result, the Patent Act has become very complex and includes many examples of paraphrasing and application rules and is full of artificial constructions that limit the application year of the revision. In addition, the Examination Guidelines and the Trial Manual have become difficult to understand. There is a further problem regarding the criterion for the addition of new matter to an amendment and correction.

The criterion for the addition of new matter is a difficult problem that has affected those concerned since the law was revised in 1993. As with the judgment in this report, it is desirable to realize a judgment that relaxes the standards for the addition of new matter. And I consider that it is desirable to predate the standard for the change in the gist before the law revision of 1993. In fact, I believe the 1993 revision to have been unnecessary.

The revision of the Patent Act involves many cases that can be settled by the modification of the use of the Act. This judgment is a good example. It should not be easy to modify the patent system by revising the Patent Act.

In addition, various problems are inherent in the Patent Act system. The Patent Act system is not limited solely to special companies and industries. Education, medicine and medical care are also affected. In particular, the person concerned should consider that inventors form the core support of any Patent Act system. Without temporary argument, those concerned should think carefully and thus contribute to the true development of the Patent Act system.

## NOTES

[1] "1993 Law 26" is abbreviation of "The 26th Law established in 1993". The abbreviations below follow the same pattern.

[2] Refer to the case "a great diameter square shape steel tube" Supreme Court judgment March 9, 1999 (Law Cases Reports No. 1671, p. 133)

[3] Law revisions (almost every year); 1993 Law 26, 1994 Law 116, 1996 Law 68, 1998 Law 51, 1999 Law 41, 2002 Law 24, 2003 law 47, 2004 Law 79, 2004 Law 120 (revision of the Court Act), 2005 Law 56, 2006 Law 55, 2008 Law 16.

[4] Patent Cooperation Treaty, <http://www.wipo.int/pct/ja/texts> (an amendment required after a preliminary international examination)

Article 11 An applicant who files a request for a preliminary international examination limits in period to establish in Ordinance of the Ministry of Economy, Trademark and Industry and, within the matter listed in the description at the time of the international application to modify said request, the scope of the request or drawings, can amend the description, scope of the request or drawings.

[5] Tokyo High Court judgment on July 1, 2003 (2002 (ke) 3;a litigation rescinding the trial decision) The judgment in this case "Network transmission system devices such as the game,

pachinko” (Court HP) is useful, when a person understands the meaning of an expression described as “a matter which is obvious from mentions such as the original description, etc.

The phrase, “matters found in the original description, etc.” means either matters really presented in the original description, etc. or obvious matter written in the original description, etc. even if the matter is not listed therein.” And, in order to conclude that the matter is obvious from the description, it is necessary that any person skilled in the art can understand that the matter is deemed to be written in it even if no mention is included therein. It is insufficient that a person can easily understand from an explanation of the description.

[6] Revised PCT Guidelines: An amendment that does not exist explicitly in an original application (expressly present) and which introduces information that cannot be called that there was in an original application inherently (inherently present) are judged as the one that added subject matter more than the contents of an original application to. “Inherently present” information is not explicitly mentioned. This means that the implication of a missing matter becomes clear when a person skilled in the art closes the original disclosure. It is merely lack to say that it seems to be the meaning.

[7] Relations with Patent Cooperation Treaty (PCT) Article 33

In the translated sentence of PCT Article 33, the term “obviousness” is used. In this case, “obviousness” is a translation of the term “obviousness” used in the American Patent Act. This word corresponds to “easiness” in Japan. In contrast, the term “obviousness” used by the Examination Guidelines in Japan means “a thing that is already clear without requiring any proof by itself (Koujien sixth edition)” as used in the suit examples.

[8] See; Intellectual Property High Court judgment October 31, 2007 (Court HP), Intellectual Property High Court judgment July 25, 2007 on (Court HP), Intellectual Property High Court judgment December 20, 2006 (Court HP), Intellectual Property High Court judgment May 31, 2005 (Court HP), Tokyo High Court judgment March 28, 2000 (Court HP), Tokyo High Court judgment October 29, 2003 (Court HP), Tokyo High Court judgment March 26, 2003 (Court HP), Tokyo High Court judgment October 29, 2002 (Court HP), Tokyo High Court judgment July 11, 2002 (Court HP), Tokyo High Court judgment February 19, 2002 (Court HP), Tokyo High Court judgment December 11, 2001 (Court HP), Tokyo High Court judgment July 17, 2001 (Court HP), Tokyo High Court judgment May 23, 2001 (Law Cases Reports No.1756, pp. 128), Osaka District Court judgment April 24, 2001 (Court HP), Tokyo High Court judgment November 9, 2000 (Court HP), Tokyo High Court judgment March 28, 2000( Court HP), Tokyo High Court judgment August 26, 1999(Court HP).

[9] This case was sent back to the Japan Patent Office by the judgment of the Court (June 12, 2008). And the trial decision was accomplished as follows. “The demand for a request for correction is not approved. This patent is invalidated.” (The third trial decision on September 18, 2008). That is why C-com Co., Ltd., (the patentee of the request dealt with by the trial) did not institute an action against the trial decision of invalidation. The said trial decision was effective.

[10] Judgment of Intellectual Property High Court, May 30, 2008; the case “Solder-resist “disclaimer” (A great consultation case), Law Cases Reports, p. 47 (2009)

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