

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

6. Court precedents relating to Amendment (Article 17bis(3)-(6) of the Patent Act)

Classification	Content	No.	Date of Decision (Case No.)	Relevant Portion of Examination Guidelines
81	As to whether amendment to claims adds a new matter or not	1	Intellectual Property High Court Decision, Jun. 23, 2008 (2007 (Gyo KE) No. 10409)	Part IV, Chapter 2
		2	Intellectual Property High Court Decision, Oct. 10, 2012 (2011 (Gyo KE) No. 10383)	
		3	Intellectual Property High Court Decision, Nov. 29, 2012 (2011 (Gyo KE) No. 10415)	
		4	Intellectual Property High Court Decision, Feb. 24, 2014 (2013 (Gyo KE) No. 10201)	
81-1	As to whether amendment that superordinate-conceptualizes claims adds a new matter or not	1	Intellectual Property High Court Decision, Jun. 27, 2012 (2011 (Gyo KE) No. 10292)	Part IV, Chapter 2 3.3.1(1)
		2	Intellectual Property High Court Decision, Sep. 10, 2013 (2012 (Gyo KE) No. 10425)	
81-2	As to whether amendment that specific-conceptualizes claims adds a new matter or not	1	Intellectual Property High Court Decision, Sep. 26, 2012 (2011 (Gyo KE) No. 10351)	Part IV, Chapter 2 3.3.1(2)
81-3	As to whether amendment that limits a numerical value against claims adds a new matter or not	1	Tokyo High Court Decision, Dec. 11, 2001 (2001 (Gyo KE) No. 89)	Part IV, Chapter 2 3.3.1(3)
		2	Intellectual Property High Court Decision, Apr. 27, 2006 (2005 (Gyo KE) No. 10709)	
		3	Intellectual Property High Court Decision, Aug. 31, 2006 (2005 (Gyo KE) No. 10767)	
81-4	As to whether amendment to	1	Intellectual Property High Court	Part IV, Chapter

	originate an excluding claim against claims adds a new matter or not		Decision, May 30, 2008 (2006 (Gyo KE) No. 10563)	2 3.3.1(4)
		2	Intellectual Property High Court Decision, Mar. 31, 2009 (2008 (Gyo KE) No. 10358)	
82	As to whether amendment to the description and drawings adds a new matter or not	1	Intellectual Property High Court Decision, Dec. 19, 2005 (2005 (Gyo KE) No. 10050)	Part IV, Chapter 2 3.3.2
		2	Intellectual Property High Court Decision, Jun. 29, 2006 (2005 (Gyo KE) No. 10607)	
83	As to whether it is contravention of Article 17bis(4) or not		–	Part IV, Chapter 3
84	As to whether it is contravention of Article 17bis(5) or not	1	Intellectual Property High Court Decision, Oct. 20, 2010 (2010 (Gyo KE) No. 10051)	Part IV, Chapter 4
84-1	As to whether it falls under deletion of claims of Article 17bis(5)(i) or not	1	Intellectual Property High Court Decision, Feb. 16, 2006 (2005 (Gyo KE) No. 10266)	Part IV, Chapter 4 3.
84-2	As to whether it falls under restriction in a limited way of claims of Article 17bis(5)(ii) or not	1	Intellectual Property High Court Decision, Apr. 25, 2005 (2005 (Gyo KE) No. 10192)	Part IV, Chapter 4
		2	Intellectual Property High Court Decision, Jan. 17, 2012 (2011 (Gyo KE) No. 10133)	2.
84-3	As to whether it falls under correction of error of Article 17bis(5)(iii) or not	1	Intellectual Property High Court Decision, Oct. 18, 2006 (2006 (Gyo KE) No. 10204)	Part IV, Chapter 4 4.
84-4	As to whether it falls under clarification of ambiguous statements of Article 17bis(5)(iv) or not	1	Intellectual Property High Court Decision, Oct. 11, 2005 (2005 (Gyo KE) No. 10156)	Part IV, Chapter 4 5.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2
Classification of the Case	81: As to whether amendment to claims adds a new matter or not
Keyword	

#### 1. Bibliographic Items

Case	"Advanced water treatment system" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, June 23, 2008 (2007 (Gyo KE) No. 10409)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-533066 (International Publication No. WO2001/030706)
Classification	C02F 1/78
Conclusion	Acceptance
Related Provision	Article 17bis(3)
Judges	IP High Court Fourth Division, Presiding judge: Nobuyoshi TANAKA, Judge: Naoki ISHIHARA, Judge: Hiroki KIMOTO

#### 2. Overview of the Case

##### (1) Summary of Claimed Invention

The advanced water treatment process for waste water according to the amended claimed invention is to provide an advanced water treatment technique based on the ozone treatment. According to the degree of contamination of water to be treated, various purifying steps such as hydrogen peroxide treatment, electrolysis treatment, ultraviolet radiation treatment, carbonized filter treatment and the like are scheduled in addition to the ozone treatment. The amended claimed invention relates to ozone treatment as a basic step in the art of an advanced water treatment method with continuous treatment.

##### (2) Disclosure of Detailed Description of the Invention

"The waste water treated in this example has relative high pollution loads, and it is required to treat human excreta. Therefore, the hydrogen peroxide solution treatment for processing foul odor and human excreta residue is carried out prior to the ozone treatment. In this case, it is advantageous that the foul-odor air generated from the water to be treated within the treatment system is mixed into the hydrogen peroxide solution as minute bubbles having an average particle diameter of approximately 0.01 to 0.02 mm, for oxidative destruction thereof. By forming the foul-odor air into the minute bubbles, the oxidative destruction thereof by

the hydrogen peroxide solution can be carried out with high efficiency. In respect of high-efficiency treatment, it is more advantageous that pH of the water to be treated is adjusted to 8 to 10 in advance, and still further advantageous that at least one of gold, copper oxide, and iron oxide is thrown into the water to be treated, for promotion of the oxidative treatment by the hydrogen peroxide solution. Then, after the hydrogen peroxide solution treatment, the ozone treatment, the ultraviolet radiation treatment, and the carbonized filter medium contact treatment are carried out, whereby the water to be treated can be purified to a quality level suitable for drinking water." (paragraph [0020]) (cited from the Court Decision)

(3) Technical common knowledge, etc. in consideration

"The ozone treatment and the hydrogen peroxide solution treatment are known as techniques of decomposing harmful substances present in water to be treated. According to these treatments, it is true that the harmful substances were subjected to oxidative destruction to some purpose, but almost all of these treatment techniques only mix ozone and the hydrogen peroxide solution with water to be treated, or simply agitate the resulting mixture. Therefore, it cannot be necessarily said that they are capable of fully achieving the effects of destroying harmful substances. Even now, the harmful substances, including dioxins, continue to increase in water systems in the environment, and hence the advent of a new advanced water treatment technique has been desired which promises more excellent treatment effects." (paragraph [0006]) (cited from the Court Decision)

(4)The Claims (before amendment and amended)

before amendment	Amended (Amended claimed invention)
<p>[Claim 1] An advanced water treatment process with continuous treatment for purifying water to be treated which contains harmful substances including dioxins and PCB, comprising the steps of:  mixing together ozone generated from an ozone generator and the water to be treated to obtain water to be treated which contains ozone;  passing the water to be treated which contains ozone through an ozone bubble-forming device with line mixer type arranged in a water pipe to obtain water to be treated which contains minute bubbles of ozone having an average particle diameter of 0.5 to 3 μm, and bringing the minute bubbles of ozone into contact with the water to be treated;  supplying to an ozone treatment tank the water to be treated which contains the minute bubbles of ozone;</p>	<p>[Claim 1] An advanced water treatment process with continuous treatment for treating water to be treated which contains harmful substances including dioxins and PCB with 0.025 kL to 14 kL per minute and <u>for purifying it to a quality level suitable for drinking water in view of the content of dioxins</u>, comprising:  <u>mixing the water to be treated</u>  <u>with ozone generated from an ozone generator and introduced to the water to be treated with 0.004 mg to 0.015 mg of ozone relative to 1 L of the water to be treated to obtain water to be treated which contains ozone;</u>  <u>passing the water to be treated which contains ozone through an ozone bubble-forming device with line mixer type arranged in a water pipe to obtain water to be treated which contains minute bubbles of ozone</u></p>

and carrying out oxidative destruction of the harmful substances in the water to be treated.	<u>having an average particle diameter of 0.5 to 3 μm;</u> <u>supplying to an ozone treatment tank the water to be</u> <u>treated which contains the minute bubbles of ozone;</u> <u>and</u> <u>carrying out oxidative destruction of the harmful</u> <u>substances in the water to be treated.</u>
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(5) Procedural History

- September 30, 2004 : Request for Appeal against an Examiner's Decision of Refusal (Fufuku No. 2004-20287)
- October 29, 2004 : Amendment (Present Amendment) (see the inventions of the above "before amendment" and "amended")
- October 30, 2007 : The present amendment is dismissed and the Appeal Decision of "the request of the present appeal is dismissed"

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
...although it can be said that the originally attached description etc. describes that the ultraviolet radiation treatment, the electrolysis treatment, the carbonized filter treatment and the like are performed in addition to the ozone treatment such that the water to be treated is purified to a quality level suitable for drinking water, the matter of "purifying it to a quality level suitable for drinking water in view of the content of dioxins" only by the ozone treatment is not described in the originally attached description etc., and it cannot be said that the matter is obvious from the matter stated in the originally attached description etc.	
Decision	
<p>Allegations by Plaintiff</p> <p>...the amended claimed invention is an invention of setting as a framework "advanced water treatment process for purifying content of dioxins and the like in water to a quality level suitable for drinking water" and specifying the ozone treatment method, as recited "advanced water treatment process with continuous treatment for treating water to be treated which contains harmful substances including dioxins and PCB with 0.025 kL to 14 kL per minute and for purifying it to a quality level suitable for drinking water in view of the content of dioxins".</p> <p>...the Appeal Decision has determined that the</p>	<p>Allegations by Defendant</p> <p>...the Appeal Decision has recognized that the Present Amendment is to include the matter of carrying out "ozone treatment" alone as "advanced water treatment process for purifying it to a quality level suitable for drinking water in view of the content of the dioxins" by substantially changing from "ozone treatment" in the "advanced water treatment process" having broader range than those including "purifying it to a quality level suitable for drinking water in view of the content of dioxins" into "ozone treatment" of the "advanced water treatment process" specifying the matter of "for purifying it to a quality level suitable for</p>

<p>Present Amendment contains the addition of new matter, upon a reason that the originally attached description etc. does not describe the matter of "purifying it to a quality level suitable for drinking water in view of the content of dioxins only by the ozone treatment", based on the erroneous understanding of the amended claimed invention. The determination of the Appeal Decision in which the Present Amendment had been dismissed is error in its premise.</p>	<p>drinking water in view of the content of dioxins".</p> <p>...since there is no error in the above recognition of the Appeal Decision, there is no error in the determination of dismissing the Present Amendment in the Appeal Decision, of which the Plaintiff is asserted.</p>
<p><b>Judgement by the Court</b></p> <p>...the technical matter recited in the latter part is the oxidative destruction process of the harmful substance by ozone, and there is no description in the claim whether a level of purification prescribed in the former part can be attained only by the ozone treatment.</p> <p><u>...considering that there are many cases to describe to indicate a premise of the invention in a so-called "front description" including to specify the technical field to which the invention belongs or the conventional technique in the technical field, the description of the former part sufficiently can be construed to be an invention relating to the ozone treatment as one step of treating water in the technical field of an advanced water treatment process with continuous treatment for "purifying water to a quality level suitable for drinking". It should be said to be difficult to determine promptly to include an invention of attaining the above-mentioned purpose only by the amended claimed invention as described in the Appeal Decision.</u></p> <p><u>...the advanced water treatment process for waste water according to the amended claimed invention provides an advanced water treatment technique based on the ozone treatment, and it should be said to be evident that the invention designs the various purifying steps including the hydrogen peroxide solution treatment, the electrolysis treatment, the ultraviolet radiation treatment, the carbonized filter treatment and the like in addition to the ozone treatment according to the degree of contamination of the water to be treated.</u> So, judging from these descriptions, it is reasonable that the amended claimed invention is an invention relating to the ozone treatment as a basic step in the technical field of the advanced water treatment process with continuous treatment. Even if there is a description of the former part of Claim 1 of the Claims according to the amended invention, it should be said to be clear not to encompass an invention of attaining the purifying level recited in the former part only by the ozone treatment.</p> <p>Therefore, it has to be said that the understanding of the Appeal Decision concerning the amended matter of the Present Amendment that "the invention according to claim 1 is an invention including "purifying water to a quality level suitable for drinking in view of the content of dioxins" only by the ozone treatment, upon stating the matter of "purifying water to a quality level suitable for drinking in view of the content of dioxins" in Claim 1" is erroneous.</p> <p>In addition, while the amended claimed invention includes an invention of "purifying water to a quality</p>	

level suitable for drinking in view of the content of dioxins" only by the ozone treatment, it cannot be said that such an invention falls within the scope of the matter stated in the originally attached description etc., based on the erroneous understanding for the amended matters and it has been considered that the Present Amendment is dismissed, without pausing to examine the remaining points. Accordingly, it has to say that the determination by the Appeal Decision of the Present Amendment be erroneous.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2
Classification of the Case	81: As to whether amendment to claims adds a new matter or not
Keyword	

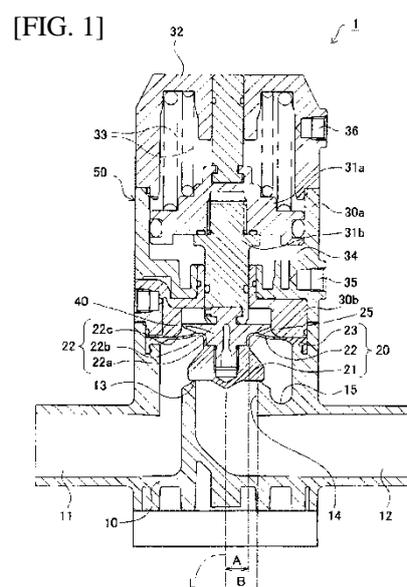
## 1. Bibliographic Items

Case	"Diaphragm valve" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 10, 2011 (2011 (Gyo KE) No. 10383)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-358675 (JP2006-162043A)
Classification	F16K 7/17
Conclusion	Acceptance
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding judge: Shuhei SHIOTSUKI, Judge: Akira IKESHITA, Judge: Kenjiro FURUYA

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The problem to be solved by the claimed invention is to improve durability of a diaphragm by preventing the concentration of stress on the neighborhood of a boundary between a valve element portion 21 and a film portion 22 of the diaphragm, in controlling supply of high-pressure fluid. The diaphragm comprises the valve element portion 21 contacting with a valve seat 13, the film portion 22 expanding to the outside from the valve element portion 21, and a fixing portion 23 formed on an outer peripheral edge of the film portion 22. The film portion 22 is provided with a vertical portion 22a connected with the valve element portion 21 and formed in the vertical direction, a horizontal portion 22c connected with the fixing portion 23 and formed in the horizontal direction, and a connecting portion 22b having a circular arc-shaped cross section for connecting the vertical portion 22a and the horizontal portion 22c. The end of a drive shaft 31b is provided with a backup 40 which is integrally fitted in the valve element portion 21



of the diaphragm for contacting with the vertical portion 22a and the connecting portion 22b to receive the film portion 22.

(2) Disclosure of Detailed Description of the Invention

"The originally attached description etc. (Exhibit A2) does not include a clear statement about the behavior "inversion" of the "film portion" but includes the following statement.

In the above statement, the method for addressing the problem of rapid deterioration caused by the concentration of stress on the boundary between the valve element portion and the film portion, in controlling supply of high-pressure fluid consistently. There is no description allowing understanding that this problem occurs even in a rolling diaphragm valve involving the inversion operation of the thin film.

The originally attached description includes FIG. 1 and FIG. 2 as examples of the claimed inventions and FIG. 3 as the background art. All of them show an ordinary diaphragm valve that is not a rolling diaphragm valve."

(Cited from the Court Decision)

(3) Considered common general knowledge etc.

"The term 'invert' generally means '(1) to tumble, or to tumble sth. (2) to turn upside down, or to turn sth upside down. (3) to change the direction of sth to its opposite, or to have sth changed to its opposite. (4) [mathematical] (inversion) the act of determining an arbitrary point or a symmetrical point in a figure relative to a certain fixed point. (5) (photography term) (reversal) to convert a negative image to a positive image, or vice versa ("*Kojien 6th edition*", *Iwanami shoten*' ... " (cited from the Court Decision)

(4) The Claims (Before and after the amendment) (only Claim 1 is shown)

Before the amendment	After the amendment (Amended invention)
<p>[Claim 1] A diaphragm valve arranged such that a valve seat is formed at a boundary between a first flow passage and a second flow passage formed in a body, a diaphragm coupled to a driving shaft on an actuator is brought into/out of contact with the valve seat to close/open an area between the first flow passage and the second flow passage,</p> <p>wherein the diaphragm comprises a valve element portion contacting with the valve seat, a film portion expanding to an outside from the valve element portion, and a fixing portion formed on an outer peripheral edge of the film portion, and the film portion comprises a vertical portion connected with</p>	<p>[Claim 1] A diaphragm valve arranged such that a valve seat is formed at a boundary between a first flow passage and a second flow passage formed in a body, a diaphragm coupled to a driving shaft on an actuator is brought into/out of contact with the valve seat to close/open an area between the first flow passage and the second flow passage,</p> <p>wherein the diaphragm comprises a valve element portion contacting with the valve seat, a film portion expanding to the outside from the valve element portion, and a fixing portion formed on an outer peripheral edge of the film portion, the film portion comprises a vertical portion connected with</p>

<p>the valve element portion and formed in a vertical direction, a horizontal portion connected with the fixing portion and formed in a horizontal direction, and a connecting portion having a circular arc-shaped cross section for connecting the vertical portion and the horizontal portion.</p>	<p>the valve element portion and formed in a vertical direction, a horizontal portion connected with the fixing portion and formed in a horizontal direction, and a connecting portion having a circular arc-shaped cross section for connecting the vertical portion and the horizontal portion,</p> <p>the end of the drive shaft includes a backup which is integrated with the diaphragm for contacting with the vertical portion and the connecting portion to receive the film portion, and</p> <p><u>the film portion is not inverted in the closing/opening.</u></p>
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(5) Procedural History

- November 29, 2010 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-26882),  
Written amendment (Present amendment) (see the invention recited in the above "After the amendment")
- October 11, 2011 : The present amendment was dismissed. Appeal decision: "The request for appeals fails to lie."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>By the present amendment, the amended invention claimed in Claim 1 includes a matter that "the film portion is not inverted in the closing/opening".</p> <p>The term 'invert' generally means '(1) to tumble, or to tumble sth. (2) to turn upside down, or to turn sth upside down. (3) to change the direction of sth to its opposite, or to have sth changed to its opposite. (4) ... the act of determining an arbitrary point or a symmetrical point in a figure relative to a certain fixed point. (5) ... to convert a negative image to a positive image, or vice versa ("<i>Kojien 6th edition</i>", <i>Iwanami shoten</i>). <u>From the expression that "the film portion is not inverted in the closing/opening", its technical significance cannot be clearly uniquely understood. Furthermore, it is not clearly mentioned in the description, the scope of claims, or the drawings originally attached to the application (hereinafter, referred to as "originally attached description etc.").</u></p> <p>In the notice of appeal, the requester alleges that the term "inverted" included in the matter represents the configuration "to exchange the top and bottom of part of the film portion" and the matter is shown in [Figure 2] in the originally attached drawings. The requester further alleges that ... point A shown in the reference drawings 1 and 2 hardly changes the positional relationship between the vertical portion 22a and the backup 40.</p>
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In the "film portion 22", especially the "connecting portion 22b" shown in [FIG. 1] and [Figure 2] in the originally attached drawings, however, a portion separated from the backup 40 by the "connecting portion 22b" bending in the opening of the valve exists between a connection point with the "vertical portion formed in the vertical direction" and a connection point with the "horizontal portion formed in the horizontal direction". Furthermore, the "connecting portion 22b" might have a point having the up-and-down relationship with an adjacent portion in the expanding direction of the "film portion 22" which is inverted in closing and opening of the valve.

Accordingly, it is not obvious that [FIG. 1] and [FIG. 2] in the originally attached drawings show a technical idea in which such a part that "inverts the film portion" between in closing and opening of the valve, as requested by the requester, does not exist in the "film portion 22". From matters mentioned in the originally attached description etc., it cannot be concluded that the matter concerned is obvious to a person skilled in the art or that it is equivalent to a matter mentioned in the originally attached description etc. Further, it cannot be concluded that the matter concerned does not fall under the introduction of new technical matters, in terms of a technical matter introduced by considering all matters mentioned in the originally attached description etc.

Decision

Allegations by Plaintiff

... As of the filing of the present application, the existing diaphragm valves are rolling diaphragm valves disclosed in FIGs. 2 and 3 on page 11 in Citation (Exhibit A1) and ordinary diaphragm valves disclosed in FIG. 1 on page 11 in Citation.

The rolling diaphragm valve is a diaphragm valve having a rolling film portion. The term "rolling" means that the film portion having a semi-arc-shaped portion and the position of the semi-arc-shaped portion of the film portion moves with the closing/opening operation of the valve element portion. That is, the rolling diaphragm valve is a diaphragm valve "which involves inversion of the film portion in closing/opening of the valve".

The ordinary diaphragm valve is a diaphragm valve with a film portion which has no semi-arc-shaped portion and does not roll. That is, the ordinary diaphragm is a diaphragm valve "which involves no inversion of the film portion in closing/opening of the valve".

... In the rolling diaphragm valve, due to its

Allegations by Defendant

... The plaintiff alleges that "the plaintiff added the expression that 'the film portion is not inverted in the closing/opening' as a matter specifying the invention, to Claim 1 to exclude a rolling diaphragm valve".

Therefore, in comparison with Citation (Exhibit A1), which relates to the rolling diaphragm valve, the expression that "the film portion is not inverted in the closing/opening" as an amendment matter, which meant "excluding rolling diaphragm valves", was added to Claim 1 in order to mean "excluding a rolling diaphragm valve". It is accordingly obvious that the claimed invention as of the filing already "included a rolling diaphragm valve". The originally attached description etc. (Exhibit A2) does not mention or indicate "excluding a rolling diaphragm valve". Further, it cannot be said that "excluding a rolling diaphragm valve" is obvious for a skilled person in the art or is a matter equivalent to a matter mentioned in the originally attached description etc. Thus, the amendment introduces a new technical matter, in

long stroke (several millimeters to tens of millimeters), the length of the film portion is long. If a high static pressure is applied on the long film portion, the film portion expands and deforms largely. If the rolling (opening/closing the valve) is performed with the film portion expanded and deformed, an area to expand and deform of the film portion changes so that the base portion of the film portion is deformed in a swinging manner. The repeated swinging deformation may cause whitening or deterioration of the resin of base portion of the film portion. Unless the swinging deformation of the base portion is reduced by using the backup, the base portion of the film portion may be whitened or deteriorated. To prevent such a situation, the film portion is provided with the backup mechanism.

In contrast, in the ordinary diaphragm valve, due to its short stroke (one millimeter or less), the length of the film portion is shorter than that of the rolling diaphragm valve. Thus, the film portion hardly expands and deforms. There is no possibility that the resin of the base portion of the film portion be whitened. Since there is no possibility that the base portion of the film portion be whitened, the backup mechanism is originally not required.

Citation (Exhibit A1) is an invention mainly relating to a rolling diaphragm valve. In a rolling diaphragm valve, the thickness of the film portion cannot exceed 0.5 mm. The reason is that if the thickness exceeds 0.5 mm, the rolling (inversion by 180° in the up and down directions) is not performed smoothly. Thus, in rolling diaphragm valves, the problem of whitening and the problem of durability caused by the thick film portion (0.9 mm in the example of the claimed invention) are unexpected problems which a person skilled in the art could not have expected.

terms of a technical matter introduced by considering all the matters mentioned in the originally attached description etc.

... The plaintiff alleges that "the plaintiff added the expression that 'the film portion is not inverted in the closing/opening' as the matter specifying the invention, in order to mean to 'exclude a rolling diaphragm valve', and the present amendment was made within the scope of matters mentioned in the originally attached description". This allegation can be understood to mean "excluding only a rolling diaphragm valve without excluding a non-rolling diaphragm valve".

However, since the meaning of "the film portion is not inverted in the closing/opening" cannot be same as that of "excluding a rolling diaphragm valve", the plaintiff's allegation is unjustifiable. That is, in a technical field of diaphragm valves, the term "inversion" is also used for non-rolling diaphragm valves, generally, so that, also in a non-rolling diaphragm valve, inverting the film portion in the closing/opening ... would have been the common general knowledge for a skilled in the art. Thus, the amendment matter that "the film portion is not inverted in the closing/opening" has the meaning of not only excluding a rolling diaphragm valve but also "excluding a non-rolling diaphragm valve", that is, it also includes the meaning of excluding an ordinary diaphragm valve, which is alleged by the plaintiff.

... Taking the behavior of the film portion of a general diaphragm valve into consideration, the expression that "the film portion is inverted" can be interpreted in two ways: "to turn the film portion upside down" and "to change the direction of the film portion to its opposite direction". Its technical meanings are not unique.

The originally attached description etc. (Exhibit

Although the plaintiff had repeated its allegation about unqualification of Citation (Exhibit A1), which relates to the rolling diaphragm valve, against the examiner several times during the examination, the examiner had not accepted it. In requesting appeals against the examiner's decision of refusal, the plaintiff added the expression that "the film portion is not inverted in the closing/opening" as a matter specifying the invention, to Claim 1 to exclude a rolling diaphragm valve. In inventions in a chemical field, a so-called "excluding claim" in a form of "excluding something" is allowed. In inventions in a machinery field, however, the expression "excluding a rolling diaphragm valve" was not a typical one and seemed to be inappropriate, thus, to exclude a rolling diaphragm valve in terms of the technical significance, the plaintiff added the expression that "the film portion is not inverted in the closing/opening" as a matter specifying the invention.

In the originally attached description, only an ordinary diaphragm valve excluding a rolling diaphragm valve is mentioned. A rolling diaphragm valve is not mentioned at all so that a rolling diaphragm valve is not a target of the invention. The reason is that, in a rolling diaphragm valve, assuming that "the thickness of the film portion is made approximately two times as thick as in the conventional diaphragm valve" is impossible, although the problem to be solved by the present application is based on this assumption. Based on this technical significance, the plaintiff, in the present amendment, added the expression that "the film portion is not inverted in the closing/opening" as the matter specifying the invention, to Claim 1, in order to mean to "exclude a rolling diaphragm valve".

Therefore, in comparison with Citation, a person skilled in the art would have understood that the

A2) mentions or indicates neither that "the film portion is not inverted in the closing/opening" nor "inversion". It mentions or indicates neither that the term "inversion" is defined as "to change its top and bottom" nor "to change the direction by 180°", which are alleged by the plaintiff, nor that the term "inversion" has a technical significance as a technical matter specifying a rolling diaphragm valve, the direction of the film portion is changed the direction by 180° in the up and down directions, the film portion has a semi-arc shape. The plaintiff alleges that the technical significance of the amended matter that "the film portion is not inverted in the closing/opening" is to "exclude a rolling diaphragm valve". However, the originally attached description etc. does not state or indicate even "excluding a rolling diaphragm valve", which is the technical significance.

... Although the plaintiff's allegation is considered, "top and bottom" of books and goods generally means "up and down", which is consistent with the interpretations of "to change its top and down" and "to change the direction by 180°" in the plaintiff's allegation. Furthermore, interpreting "the film portion is not inverted in the closing/opening" as "up and down in the adjacent portion of the film portion are not changed in the closing/opening" ... is consistent with behaviors of a diaphragm in a general diaphragm valve. Thus, by taking the plaintiff's allegation into consideration, in the appeal decision, the expression that "the film portion is not inverted in the closing/opening" is rationally interpreted as that "up and down in the adjacent portion of the film portion are not changed in the closing/opening".

... When the whole "film portion 22" is focused on, adjacent parts of the film portion partially change their relative up and down positional relation between in opening and closing of the valve. Regarding this,

<p>expression that "the film portion is not inverted in the closing/opening" as the matter specifying the invention "excludes a rolling diaphragm valve". The amendment to add this matter specifying the invention was made within the scope of matters mentioned in the originally attached description.</p>	<p>the appeal decision states that "In the 'film portion 22', especially the 'connecting portion 22b', a portion separated from the backup 40 by the 'connecting portion 22b' bending in opening of the valve exists between a connection point with "the vertical portion formed in the vertical direction" and a connection point with 'the horizontal portion formed in the horizontal direction'. Furthermore, the 'connecting portion 22b' might have a point having the up-and-down relationship with an adjacent portion in the expanding direction of the 'film portion 22'" which is inverted in closing and opening of the valve. Accordingly, the originally attached description etc. does not state or indicate that "up and down in the adjacent portion of the film portion are not changed in the closing/opening", that is, "the film portion is not inverted in the closing/opening". Therefore, the amendment falls under so-called addition of new matters.</p>
<p>Judgement by the Court</p> <p>... It is understood that FIG. 2 and FIG. 3 in Citation show the roll diaphragm type poppet valve element 122 which is different from the diaphragm type poppet valve element shown in FIG. 1, that the roll diaphragm type poppet valve element 122 includes the sleeve 124 integrated with the head portion 126 of the poppet valve element and extending from the head portion to the poppet valve element flange 128 in the axis direction, that the sleeve 124 performs "the rolling and non-rolling operations", and that the wall surface of the head portion 82 of the piston supports the inner surface of the sleeve 124. <u>The cited invention assumes the existence of the roll diaphragm type poppet valve element which is different from the diaphragm type poppet valve element, and a detailed description of the roll diaphragm type poppet valve element itself is not included. Thus, it is understood that, as of 29 June, 2001 when Citation was published, it was the common general knowledge requiring no special explanation that the technical area of diaphragm valves includes ordinary diaphragm valves and the different type of rolling diaphragm valves which involve "the rolling and non-rolling operations".</u></p> <p>... <u>In view of the general meaning and the common general knowledge of the term "inversion" as well as the plaintiff's allegation in the demand for appeal, it is clear that the configuration in which "closing and opening the valve without being inverted the film portion" added by the present amendment means that "a part of the top and bottom of the film portion does not become opposite, and more specifically, the roll and non-roll operation of the film, as in the roll diaphragm type poppet valve, is not involved in the opening and closing".</u></p> <p>... <u>It should be understood that the expression that "closing and opening the valve without being inverted</u></p>	

the film portion" just means that a part of the top and bottom of the film portion does not become opposite, in the same level as that the roll and non-roll operation of the film, as in the roll diaphragm type poppet valve, is not involved in the opening and closing. Addition of this matter introduces no new technical matter, in terms of a technical matter introduced by considering all the matters mentioned in the originally attached description etc.

... The meaning of the term "inversion" mentioned in Exhibit B1 to Exhibit B3 is understood as follows: in Exhibit B1, it means that the positional relationship between the supporting portion around the film portion 6 and the lower end of the valve element 3 with a convex spherical shape is inverted, as shown in FIG. 3; in Exhibit B2, it means that the curving direction of the outer circumferential portion of the diaphragm changes to an upward convex shape and a downward convex shape; and in Exhibit B3, it means the same as in Exhibit B2. Thus, it is in the different dimension from the configuration in which "closing and opening the valve without being inverted the film portion" of the present amendment. The statements in Exhibit B1 to Exhibit B3 cannot render the present amendment illegal.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2
Classification of the Case	81: As to whether amendment to claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Solder alloy" (Trial for Invalidation) Intellectual Property High Court Decision, November 29, 2012 (2011 (Gyo KE) No. 10415)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-33878 (JP2002-239780A)
Classification	B23K 35/26
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court First Division, Presiding judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention relates to a Sn-Ag based unleaded solder alloy. An object of the claimed invention is to provide a solder alloy at low cost that has excellent joining reliability and falling impact resistance without containing a great amount of Ag (2 mass% or less), and is characterized in that an  $Ag_3Sn$  intermetallic compound forms a network to be connected to each other.

## (2) Disclosure of Detailed Description of the Invention

"[0017]"

In the Sn-Ag based alloy, a network of an  $Ag_3Sn$  intermetallic compound is formed in a coagulated structure to improve the strength and the fatigue property of the solder. While a network of an  $Ag_3Sn$  intermetallic compound is not connected sufficiently to each other in an alloy consisting only of Sn-Ag, addition of 0.3 mass% or more Cu to the Sn-Ag based solder alloy tightens the ring-shaped network of the  $Ag_3Sn$  intermetallic compound inside the Sn-Ag based alloy to improve the strength and the fatigue property of solder bumps. Thus, the strength and the thermal fatigue resistance property required of solder bumps for electronic

components can be secured ...."(cited from the Court Decision)

(3) Common General Knowledge, etc. Considered

"...In an Sn-Ag based solder alloy, an Ag<sub>3</sub>Sn intermetallic compound's forming a network, the network's having a ring shape, and the Ag<sub>3</sub>Sn structure's being basically maintained even when a few % of another alloy element is added" are all recognized as common general knowledge." (cited from the Court Decision)

(4) The Claims (Before Amendment and After Amendment) (only Claim 1)

Before Amendment	After Amendment
[Claim 1] An unleaded solder alloy comprising: 1.0 to 2.0 mass% Ag; 0.3 to 1.5 mass% Cu; and the balance Sn with inevitable impurities.	[Claim 1] An unleaded solder alloy comprising: 1.2 to 1.7 mass% Ag; 0.5 to 0.7 mass% Cu; and the balance Sn with inevitable impurities, <u>and comprising an Ag<sub>3</sub>Sn intermetallic compound, wherein the Ag<sub>3</sub>Sn intermetallic compound forms a network to be connected to each other.</u>

(5) Procedural History

- November 28, 2007 : Submission of procedure amendment by defendant (patentee) (see the invention of the above-described "After Amendment")
- July 11, 2008 : Registration of establishment of the patent right
- May 2, 2011 : Request for trial for patent invalidation by plaintiff (Muko No. 2011-800074)
- November 11, 2011 : Trial Decision that "the request for the present is dismissed"

3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial Decision
<p>A The originally attached description states ...at the paragraph [0017].</p> <p>Thus, from the relevant description, the matter that the unleaded solder alloy that has a network of an Ag<sub>3</sub>Sn intermetallic compound in a coagulated structure in an Sn-Ag based alloy, and that contains the Ag<sub>3</sub>Sn intermetallic compound of which the ring-shaped network is tightened by addition of 0.3 mass% or more Cu to the Sn-Ag based solder alloy while the network of an Ag<sub>3</sub>Sn intermetallic compound is not connected sufficiently to each other in an Sn-Ag binary alloy can be obtained is understood obvious.</p> <p>Here, the "network" means a "network/net-like structure" ..., "net-like" means a "shape like a net", and "meshes of a net" means "gaps surrounded by a thread/wire woven into a net" (from Kojien, sixth edition).</p> <p>A "shape like gaps surrounded by a thread/wire woven into a net" can be said as a "ring shape", so that a "network" has attribution of a "ring shape", and a "ring-shaped network" is not substantively different from a "network".</p>

kkDecision	
<p>Allegations by Plaintiff</p> <p>A ...The amendment adding a constituent feature of "an unleaded solder alloy comprising an Ag<sub>3</sub>Sn intermetallic compound" is adding an abstract generic concept of "comprising" "an Ag<sub>3</sub>Sn intermetallic compound", which introduces a new technical matter into the originally attached description.</p> <p>B ...The originally attached description states "tightens the ring-shaped network of the Ag<sub>3</sub>Sn intermetallic compound" at the paragraph [0017]. However, the amendment by the present amendment that "the Ag<sub>3</sub>Sn intermetallic compound forms a network to be connected to each other" eliminates the limitation of the shape of "ring-shaped" in the originally attached description, and thereby the shape of the network is made unrelated, which changes the network into a more generic network. Further, "tightens" is not synonymous with "connected to each other"....</p> <p>C Propriety of the amendments "an unleaded solder alloy comprising an Ag<sub>3</sub>Sn intermetallic compound" and "the Ag<sub>3</sub>Sn intermetallic compound forms a network to be connected to each other" should be determined based on whether or not the amended constituent features are clearly stated in the originally attached description, or based on whether or not the amended constituent features are obvious to the extent that a third party can clearly recognize the amended constituent features as the features of the invention in light of the originally attached description or common general knowledge. The constituent features newly added to Claim 1 by the present amendment are not clearly stated in original Claim 1 or the "detailed explanation of the invention", and therefore are the matters that the</p>	<p>Allegations by Defendant</p> <p>"An unleaded solder alloy comprising an Ag<sub>3</sub>Sn intermetallic compound" means that "an unleaded solder alloy contains (has) an Ag<sub>3</sub>Sn intermetallic compound inside the unleaded solder alloy". It is obvious from the originally attached description at the paragraph [0017] that the unleaded solder alloy contains an Ag<sub>3</sub>Sn intermetallic compound inside the unleaded solder alloy. Because the unleaded solder alloy contains the Ag<sub>3</sub>Sn intermetallic compound, the following features that "the Ag<sub>3</sub>Sn intermetallic compound forms a network to be connected to each other" can be achieved.</p> <p>"Tightens the network" stated in the originally attached description at the paragraph [0017] means that a net-like structure ("a structure having the shape like a net) is formed without a gap. <u>It is obvious that when the net-like structure is formed without a gap, each element of the net-like structure has a ring shape. Thus, "ring-shaped" stated in the originally attached description at the paragraph [0017] has the same meaning as "tightens the network", so that removing the word "ring-shaped" from the claim does not change the network into a more generic network.</u></p> <p>In addition, <u>when the net-like structure is formed without a gap, the elements making up the net-like structure are connected to each other, so that "tightens the ring-shaped network of the Ag<sub>3</sub>Sn intermetallic compound" stated at the paragraph [0017] is synonymous with "the Ag<sub>3</sub>Sn intermetallic compound forms a network to be connected to each other".</u></p>

inventors themselves did not recognize at the time of filing of the application.

#### Judgement by the Court

In the originally attached description at the paragraph [0017], there are descriptions that "in the Sn-Ag based alloy, a network of an  $Ag_3Sn$  intermetallic compound is formed in a coagulated structure", and "the ring-shaped network of the  $Ag_3Sn$  intermetallic compound" exists in a similar manner also in the solder alloy prepared by adding 0.3 mass% or more Cu to the Sn-Ag based solder alloy, and the ring-shaped network becomes "tightened"....In addition, in an Sn-Ag based solder alloy, the  $Ag_3Sn$  intermetallic compound's forming a network, the network's having a ring shape, and the  $Ag_3Sn$  structure's being basically maintained even when a few % of another alloy element is added" are all recognized as the common general knowledge ....According to the originally attached description at the paragraph [0017] and the common general knowledge, it can be understood the followings are both obvious matters that the alloy according to Claim 1 of the originally attached description is "an unleaded solder alloy comprising an  $Ag_3Sn$  intermetallic compound" and "the  $Ag_3Sn$  intermetallic compound forms a network to be connected to each other".

From the above, the present amendment can be said to have been made within the scope of the matters stated in the originally attached description at the paragraph [0017], and the determination of the trial decision concerning this is therefore not in error.

The plaintiff alleges that in the originally attached description, there is no explicit description of "an unleaded solder alloy comprising an  $Ag_3Sn$  intermetallic compound", and the amendment is adding a generic concept of "comprising" "an  $Ag_3Sn$  intermetallic compound", which introduces a new technical matter that is not obvious from the originally attached description. However, in the Sn-Ag based alloy, the  $Ag_3Sn$  intermetallic compound forms a network, so that the amendment of "comprising" "an  $Ag_3Sn$  intermetallic compound" can be understood to merely confirm as a premise that the  $Ag_3Sn$  intermetallic compound exists in the alloy.

In addition, the plaintiff alleges that the amendment that "the  $Ag_3Sn$  intermetallic compound forms a network to be connected to each other" eliminates the limitation of the shape of "ring-shaped" from the description "tightens the ring-shaped network of the  $Ag_3Sn$  intermetallic compound" in the originally attached description at the paragraph [0017], so that the amendment describes a more generic concept. However, ...in the Sn-Ag based solder alloy, the  $Ag_3Sn$  intermetallic compound's forming a network, and the network's having a ring shape are recognized as common general knowledge, and therefore even if the limitation of the shape of "ring-shaped" does not exist in Claim 1, it cannot be said that the amendment describes a more generic concept.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2
Classification of the Case	81: As to whether amendment to claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

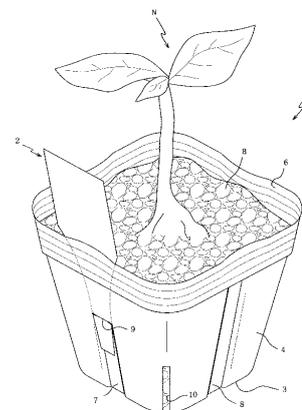
Case	"Seedling pot" (Trial for Invalidation) Intellectual Property High Court Decision, February 24, 2014 (2013 (Gyo KE) No. 10201)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-91839 (JP 2005-176823A)
Classification	A01G 9/02
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding judge: Takashi SHIMIZU, Judge: Yasushi NAKAMURA, Judge: Yuki NAKATAKE

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention relates to a seedling pot capable of fastening a display plate (2) on which information about the seedling is displayed in such a state that the plate stands approximately upright to an insertion opening (9) of a seedling pot (1) and capable of easily grasping a position to which the display plate is attached from the outside even in such a state that culture soil is stored in the seedling pot because the insertion opening is easily grasped from the outside of a side wall (4) by using a configuration of a first concave part (7) by which a side wall part including the insertion opening (9) is distinguished from the other side wall parts, and also relates to the seedling pot with the display plate.

[FIG. 1]



## (2) Disclosure of Detailed Description of the Invention

"[0082]

In the above example, a case where the first concave part 7 has two functions: a function as a part to provide the insertion opening 9; and a function to guide the root of the seedling N toward the bottom wall 3 has been described. However, the first concave part 7 may have no function to guide the root of the seedling N toward the bottom wall 3 but have only a function as a part to provide the insertion opening 9. In such a case, the first concave part 7 does not need to have a belt-like shape as in the present example. The first concave part 7 may be, for example, depressed toward the side of the storage space 5 like a dimple on a face." (Cited from the Court Decision)

(3) The Claims (Before and after the amendment)

Before the amendment	After the amendment
<p>[Claim 1] (Original invention)</p> <p>A seedling pot and a seedling pot with a display plate, the seedling pot capable of fastening a display plate on which information about a seedling is displayed in such a state that the plate stands approximately upright to the seedling pot and capable of easily grasping a position to which the display plate is attached from an outside in such a state that culture soil is stored in the seedling pot.</p>	<p>[Claim 7]</p> <p>A seedling pot comprising: a bottom wall; a side wall standing upward from an edge part of the bottom wall; a storage space surrounded by the side wall and the bottom wall to store a seedling and culture soil; and an opening surface formed by an upper edge part of the side wall to put culture soil and a seedling into the storage space, wherein the side wall has a polygonal shape in a plan view, <u>in at least one face of the polygon-shaped side wall, a side wall surface at a side of the bottom wall has a stepped part relative to a side wall surface at a side of the upper edge part so as to be depressed toward a side of the storage space, the stepped part is formed at a position which is buried in the culture soil when the culture soil is stored in the storage space, the stepped part opens toward a part facing the opening surface of the stepped part</u> and has an insertion opening into which a display plate on which information about the seedling to be stored in the storage space is displayed is inserted, and the insertion opening is formed at an approximately center part in a circumferential direction on one face of the polygon-shaped side wall.</p>

(4) Procedural History

March 22, 2006 : Written amendment by the plaintiff (the patentee) (Present amendment) (see the invention recited in the above "After the amendment")

- September 29, 2006 : Registration to establish a patent right
- April 11, 2012 : Request for trial for invalidation on Claims 4 and 7 by the defendant (Muko No. 2012-800055)
- April 22, 2013 : Request for correction including deletion of Claim 4 by the plaintiff
- June 19, 2013 : Trial decision: "The correction is approved. .... The patent of the invention claimed in Claim 7 is invalidated."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>A From the originally attached description etc., <u>the "stepped part of the first concave portion 7" is understood. Since the stepped part is included in the first concave portion, it cannot be separated from the other components of the first concave portion (side walls B, C).</u> The originally attached description etc. does not describe a matter specifying the invention of only the "stepped part" separated from the "stepped part of the first concave portion 7". Thus, a new technical matter has been added.</p> <p>B .... The originally attached description etc. does not state or indicate "being continuous from a part other than the insertion opening". The side walls B, C have been deleted and only the "stepped part" has been extracted from the "concave portion" and made to be continuous from a part other than the insertion opening. Thus, a new technical matter has been added.</p> <p>C If "one having a stepped part formed over the whole circumference of the seedling pot" were included in the originally attached description, <u>the stepped part by itself could grasp the height position of the first concave part 7 but could not grasp the position in the circumferential direction (horizontal direction) and, of course, the position of the insertion opening 9 either.</u> The problem to be solved by the invention could not be solved.</p> <p>D ... Based on the expression in paragraph [0082] that "the first concave part 7 may have no function to guide the root of the seedling N toward the bottom wall 3 but have only a function as a part to provide the insertion opening 9", <u>all statements in the originally attached description etc. do not expect removal of all long walls vertically extending from the "concave part"</u> in a case where the first concave part 7 does not have a roving-preventing function. If the first concave part 7 is just a "concave part" without "a function to guide ... toward the bottom wall 3", a part which lacks part of the vertically extending long wall at "the side of the bottom wall 3" is simply expected.</p> <p>Consequently, from the expression in paragraph [0082] that "In such a case, the first concave part 7 does not need to have a belt-like shape as in the present example. The first concave part 7 may be, for example, depressed toward the side of the storage space 5 like a dimple on a face", a concave part that does not have a belt-like shape, for example, a depression like a dimple on a face is expected. <u>It cannot be expected that, by extracting the "stepped part" from the "concave part", a stepped part is formed over the whole circumference of the seedling pot or that a stepped part is formed over the whole width of one side wall.</u></p>
<p>Decision</p>

Allegations by Plaintiff	Allegations by Defendant
<p>(1) ... It is natural for an engineer (a person skilled in the art) to understand components of a single structure based on each function technically. ...</p> <p>..., at the time of filing, the respective components of the first concave part were described based on each function in such a way that a part to provide the insertion opening (stepped part (wide wall A)) was distinguished from parts to provide a roving-preventing function (long walls B, C) and both were understood and described as separate technical ideas. ...</p> <p>Consequently, <u>it would have been natural</u> for a person skilled in the art who contacted the originally attached description etc. to <u>understand the "stepped part" as a single configuration separated from the "first concave part", ...</u></p> <p>(2) The first concave part 7 is just an example. Whether a stepped part in an aspect other than the "first concave part" is read from the other descriptions needs to be considered.</p> <p>A ... it is stated that the long walls B, C have a roving-preventing function while the wide wall A has a function to provide the insertion opening. ... it is a well-known common general knowledge that the vertically extending long walls (corresponding to the long walls B, C of the first concave part) provide a roving-preventing function.</p> <p>In view of them, from the expression in paragraph [0082] that "the first concave part 7 may have no function to guide the root of the seedling N toward the bottom wall 3 but have only a function as a part to provide the insertion opening 9", <u>it is obvious to a person skilled in the art to "form the wide wall A without the long walls B, C".</u> Even if the wide wall A is formed without the long walls B,</p>	<p>The originally attached description etc. does not include a term "stepped part" at all. The originally attached description etc. only discloses that the first concave portion 7 has a fixed width in a horizontal direction of the side wall and has a band-like shape extending to the bottom wall side.</p> <p>... Since the position of the insertion opening is grasped by the first concave part 7 as a mark, a person skilled in the art might have recalled that <u>the first concave part 7 has a fixed width in a horizontal direction of the side wall (the width of the insertion opening).</u></p> <p>Even on the assumption that the original invention is not limited to the "first concave part 7" which is an example, <u>there is still no statement to indicate that the concave part has a limitless shape in the horizontal direction of the side wall.</u></p> <p>If the first concave part 7 included "one having a stepped part formed over the whole circumference of the seedling pot", <u>the stepped part by itself could not grasp the position of the first concave part 7 in the circumferential direction, and, of course, the position of the insertion opening 9 either.</u> Thus, such a first concave part would lose an important and useful function of showing the position of the insertion opening in the horizontal direction. Furthermore, the problem to be solved by the present invention could not be solved.</p> <p>Even if a seedling pot in which a vertically extending long wall provides a roving-preventing function and two or more steps are formed were well-known, <u>all matters mentioned in the originally attached description etc. could not expect removal of all long walls vertically extending from the "concave part" in a case where the concave part does not have a roving-preventing function.</u></p>

<p>C, ... <u>the insertion opening is formed at an approximately center part in a circumferential direction on the one face of the polygon-shaped side wall so that the position of the insertion opening in the circumferential direction can be grasped. Thus, the position of the insertion opening can be grasped from the side of the side wall.</u></p>	
<p>Judgement by the Court</p> <p>The "stepped part (a part difference in level)" shown in the present amendment and the present correction is specified to be formed such that the side wall surface at the side of the bottom wall is depressed toward the storage space relative to the side wall surface at the side of the upper edge part. However, what width the stepped part has relative to the width of the side wall surface is not specified. The "stepped part" includes even a technical matter that the stepped part is formed over the whole circumference of the side surface of the seedling pot and a technical matter that the stepped part is formed over the whole width of one side wall (hereinafter referred to as "technical matter A").</p> <p>B ... <u>The "first concave part" has a part of the side wall depressed toward the storage space further than the outer surface of the other side wall so that it has a function as a mark to grasp the position of the insertion opening from the outer surface of the side wall, though the position of the insertion opening, which is buried in the culture soil stored in the seedling pot, cannot be grasped from the opening surface.</u></p> <p>C ... In the stepped part, a region where the insertion opening is formed is undistinguishable from a region where an insertion opening is not formed. As a result, the position of the insertion opening cannot be grasped from the outer surface of the side wall. The configuration of the first concave part in which the side wall part including the insertion opening is distinguishable from the other side wall parts is provided as a solution of the technical problem to be solved by the present invention to easily grasp the insertion opening from the outer surface of the side wall. Thus, <u>if no first concave part is provided, the original technical problem to be solved by the invention fails to be solved. The technical matter A corresponds to a newly added technical matter.</u></p>	

(81-1)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(1)
Classification of the Case	81-1: As to whether amendment that superordinate-conceptualizes claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Musical tone generating method" (Trial for Invalidation) Intellectual Property High Court Decision, June 27, 2012 (2012 (Gyo KE) No. 10292)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H7-299185 (JP H9-44160A)
Classification	G10H 1/02
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding judge: Shuhei SHIOTSUKI, Judge: Akira IKESHITA, Judge: Kenjiro FURUYA

## 2. Overview of the Case

### (1) Summary of Claimed Invention

The claimed invention comprises: a first step of issuing a generation instruction for generating a designated sound; a second step of allocating the designated sound to one of plural sound generating channels and storing control data for the designated sound in a register in accordance with the channel to which the sound is allocated; a third step of issuing an operation start instruction at prescribed time intervals; a fourth step of executing a sound generating operation in each channel in accordance with each operation start instruction so as to generate plural waveform data samples for the respective channels together at a time arithmetically based on the control data stored in the register; a fifth step of combining the waveform data samples generated in the respective channels for each sample point to generate a piece of combined sample data for each sample point; and a sixth step of outputting the pieces of combined sample data for the respective sample points one by one in every sampling cycle. In the claimed invention, to operate musical tone waveform samples for the sound generation channels, the samples for plural sampling cycles are generated together at a time, and thus, an overhead in the operation of musical tone waveform samples can be reduced.

### (2) Disclosure of Detailed Description of the Invention

"In the present invention, since a preparatory process for respective sound generation channels needs to be performed only once for plural musical tone waveform sample operations, an overhead can be reduced. For this reason, the quality of the generated musical tone can be improved and the number of the simultaneous sound generation channels can be increased. Further, if the musical tone waveform sample operation is performed each time an MIDI event is input, the operations are distributed so that the number of generated sounds due to an initial processing of generating sound can be prevented from decreasing. Moreover, of the sound generation channels in the generating process, a channel in which a level of a musical tone (AGE waveform) has been sufficiently attenuated is excluded from the operation target at that point to become a non-sound generation channel." (paragraph [0013]) (Cited from the Court Decision)

(3) The Claims (Before and after the amendment) (Only Claim 1 is shown)

Before the amendment	After the amendment
<p>[Claim 1] A <u>musical tone</u> generating method comprising: a first step of instructing to generate plural musical tones; a second step of allocating a designated musical tone to one of channels and writing and storing control data for the corresponding musical tone in a register of the channel to which the tone is allocated; a third step of instructing to start operations at prescribed time intervals; a fourth step of executing musical tone generating operations in the respective channels one by one according to the instruction to start operations in the third step and generating pieces of waveform data for plural samples based on the control data for the plural channels stored in the registers of the channels; a fifth step of combining the generated pieces of waveform data for each sample and generating a combined sample for plural samples; and a sixth step of converting the combined sample for plural samples to an analog signal in every sampling cycle, wherein in the musical tone generating operation of the fourth step, for each sound generation channel, based on reading the control data once from the register of the channel, the pieces of waveform data for plural samples are generated in the sound generating channel from which the control data has been read</p>	<p>[Claim 1] A <u>sound</u> generating method comprising: a first step of issuing a generation instruction for generating a designated sound; a second step of allocating the designated sound to one of plural sound generating channels and storing control data for the designated sound in a register in accordance with the channel to which the sound is allocated; a third step of issuing an operation start instruction at prescribed time intervals; a fourth step of executing a sound generating operation in each channel in accordance with each operation start instruction so as to generate plural waveform data samples for the respective channels together at a time arithmetically based on the control data stored in the register, the sound generating operation being executed in a time period shorter than a time period to totalize sampling cycles of the plural samples to be generated; a fifth step of combining the waveform data samples generated in the respective channels for each sample point to generate a piece of combined sample data for each sample point; and a sixth step of outputting the pieces of combined sample data for the respective sample points one by one in every sampling cycle.</p>

and the control data after the generation of the pieces of waveform data is written in the register of the channel.	
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(4) Procedural History

- September 21, 1999 : Written amendment by the defendant (the patentee) (The written amendment includes changing "musical tone" to "sound")  
(see the invention recited in the above "After the amendment")
- November 19, 1999 : Registration to establish a patent right
- January 28, 2011 : Request for trial for invalidation by the plaintiff (Muko No. 2011-800012)
- August 9, 2011 : Trial decision: "The request for trial fails to lie."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>B The "musical tone" mentioned in the originally attached description is allocated to one of plural sound generating channels in accordance with performance information and the waveform is generated so that its sound is generated. The "musical tone" is defined only by the generating method thereof, irrespective of the specific contents of the waveform (e.g., a piano sound, a piece of music, etc.).</p> <p>Therefore, although various specific sounds are not mentioned in the originally attached description, a sound defined by the generating method falls within the matters mentioned in the originally attached description. It cannot be said that the amendment to "sound", which includes the sound defined by the generating method, was beyond the matters mentioned in the originally attached description.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>... The "designated sound" recited in the present invention 1 by the amendment is not limited to a sound "designated by performance information", and allocation of the sound to the sound generating channels is not limited to allocation performed "in accordance with performance information", either. Thus, the "designated sound" encompasses all general "sounds" other than "musical tones" which are defined in relation to performance information. Therefore, it falls under "the addition of new matters".</p>	<p>Allegations by Defendant</p> <p>(2) The "musical tone" mentioned in the originally attached description means "sound" used "as a component of music" and inherently has a meaning of "sound". Therefore, the amendment of the "designated musical tone" to the "designated sound" falls within the scope of the matters mentioned in the originally attached description.</p>

Judgement by the Court

However, the technical idea of the invention that generating pieces of data for plural samples together at a time reduces the load in the preparatory process, which is described in the originally attached description (paragraph [0013]), has no relation with whether what to be "designated" in Claim 1 is designated by performance information or any other information. There is no ground for a person skilled in the art to understand that the scope of the technical idea of the invention mentioned in the originally attached description does not include a case where information other than performance information designates the sound. Therefore, it is within the matters mentioned in the originally attached description that the designation is amended from the musical tone by performance information to the sound by some other information. It does not fall under the addition of new matter that "musical tone" is amended to "sound"

(81-1)-2

Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(1)
Classification of the Case	81-1: As to whether amendment that superordinate-conceptualizes claims adds a new matter or not
Keyword	

#### 1. Bibliographic Items

Case	"Marine vessel" (Trial for Invalidation) Intellectual Property High Court Decision, September 10, 2012 (2012 (Gyo KE) No. 10425)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-238381 (JP2009-67253A)
Classification	B63B 13/00
Conclusion	Acceptance
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding judge: Shuhei SHIOTSUKI, Judge: Akira IKESHITA, Judge: Takaaki SHINTANI

#### 2. Overview of the Case

##### (1) Summary of Claimed Invention

The claimed invention has an object to apply, to various kinds of marine vessels, a marine vessel structure capable of facilitating installation of various types of ballast water treatment apparatuses at appropriate in-board positions. The marine vessel structure is provided with a ballast water treatment apparatus which disposes of, removes or destroys microorganisms in ballast water during taking-in or discharge of ballast water, and the ballast water apparatus is installed in a rudder house positioned in a rear part of the marine vessel and higher than a water line.

##### (2) Disclosure of Detailed Description of the Invention

"[0030]

The rudder house 9 is adjacent to and near the engine house 8 in which the ballast pump 13 is installed. Thus, the piping length and piping installation space required for the treatment apparatus inlet-side piping system 15 and the treatment apparatus outlet-side piping system 16 can be small. Even pressure loss caused by ballast water treatment can be minimized.

Since the rudder house 9 is a non-explosion proof area, there is another advantage that provides less limitation to various controllers or electric apparatuses.

Since the rudder house 9 is positioned higher than the water line of the marine vessel, there is still another advantage that ballast water can be easily discharged from the marine vessel in an emergency.

The present invention is not limited to the embodiments. Modifications can be made as appropriate within the gist of the present invention." (Cited from the Court Decision)

(3) Considered common general knowledge etc.

" ... It is recognized that the term "non-explosion proof area" is generally used in the field of marine vessels. The term has the same meaning as "non-dangerous place", which is the antonym of a "dangerous place" (dangerous area or section). The term "non-explosion proof area" means a region requiring no explosion proof structure, that is, an area or section where no explosive mixed gas requiring special care to a structure, installation or use of electric apparatuses exists ..." (cited from the Court Decision)

(4) The Claims (Before and after the amendment) (Only Claim 1 and Claim 7 are shown in Before the amendment and After the amendment, respectively)

Before the amendment	After the amendment (Patented invention 7 after the amendment or Present invention 6)
[Claim 1] A marine vessel structure comprising a ballast water treatment apparatus disposing of, removing or destroying microorganisms in ballast water during taking-in or discharge of ballast water, wherein the ballast water treatment apparatus is installed in a rudder house positioned in a rear part of the marine vessel.	[Claim 7] A marine vessel comprising a ballast water treatment apparatus disposing of, removing or destroying microorganisms in ballast water during taking-in or discharge of ballast water, <u>wherein the ballast water treatment apparatus is installed in a non-explosion proof area positioned in a rear part of the marine vessel.</u>

(5) Procedural History

- March 24, 2010 : Written amendment (Present amendment) (see the invention recited in the above "After the amendment")
- May 14, 2010 : Registration to establish a patent right
- December 22, 2011 : Request for trial for invalidation by the defendants (Muko No. 2011-800262)
- April 10, 2012 : Request for correction by the plaintiff (the patentee) (e.g., correction to cancel Claim 6 and change Claim 7 to a new Claim 6)
- November 5, 2012 : Trial decision: The correction was approved. "... The patent for the invention claimed in Claim 6 is invalidated. ..."

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)
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The patented invention 7 after the amendment ... has a configuration in which "the ballast water treatment apparatus is installed in a non-explosion proof area positioned in a rear part of the marine vessel", which is not mentioned in the originally attached description, the claims or drawings.

A person skilled in the art might have interpreted the term 'non-explosion proof area' as 'non-dangerous area' or 'non-dangerous section'. However, a specific installation position of the 'ballast water treatment apparatus' other than the rudder house 9 is not specified, and thus, the ballast water treatment apparatus can be installed at any position (including the engine house) as long as it is a 'non-dangerous area (non-dangerous section)' other than the rudder house 9 in the rear part of the marine vessel. This departs from the original gist of the present invention in which 'the ballast water treatment apparatus is installed in the rudder house 9', which results in introduction of a new technical matter. This, which departs from a technical scope described in the description originally attached to the application, corresponds to a new matter, and thus, it is unpatentable by the provision of Article 17bis(3) of the Patent Law.

Therefore, the present invention 6 should be invalidated under the provision of Article 123(1)(i) of the Patent Law.

Decision

Allegations by Plaintiff

B [0030] in the originally attached description

Thus, a person skilled in the art who contacted the expression that "Since the rudder house 9 is a non-explosion proof area, there is another advantage that provides less limitation to various controllers or electric apparatuses" in [0030] in the originally attached description would have recognized that it is appropriate ....

... From [0030] in the originally attached description, using the configuration of installing the ballast water treatment apparatus in the non-explosion proof area, of the configurations of the present invention 6, a technical matter to solve the problem to be solved by the present invention to provide an appropriate installation position of the ballast water treatment apparatus in the marine vessel can be introduced.

C [0006] in the originally attached description

Paragraph [0006] in the originally attached

Allegations by Defendant

B Technical matter mentioned in the originally attached description etc.

To summarize the above arguments, the originally attached description etc. describes the object, configuration and effect of the invention in which the ballast water treatment apparatus is installed in the rudder house. A description of a technical matter concerning installation of the ballast water treatment apparatus in a position other than the rudder house is only in [0025], which describes its demerit in case where the ballast water treatment apparatus is installed in the engine house. The invention in which the ballast water treatment apparatus is installed in a position other than the rudder house is not described.

(2) Technical matter added by the present amendment

The present invention 6 encompasses: an invention in which the ballast water treatment apparatus is installed in a rudder house which is a non-explosion proof area positioned in a rear part of the marine vessel; and an invention in which the

<p>description includes the expression that "In a case where the ballast water treatment apparatus is installed in the marine vessel, by considering the cargo load amount or a dangerous area in a case of loading combustible cargoes, the ballast water treatment apparatus is preferably installed not in the center part of the marine vessel but in the stem or the stern". The term "dangerous area" has the same meaning as the "explosion proof area". Thus, a person skilled in the art who read this expression could have understand that the ballast water treatment apparatus is preferably installed by avoiding the explosion proof area (that is, in the non-explosion proof area).</p> <p>... Installing the ballast water treatment apparatus in the rudder house provides the following advantages: [1] a large installation space to install the ballast water treatment apparatus therein can be easily secured, [2] ..., [3] ..., [4]..., [5]..., [6]..., and [7]...</p> <p>The [1] to [7] are matters to be considered in determining the installation position of the ballast water treatment apparatus. It is preferable to satisfy as many matters of them as possible. However, these matters are not mentioned as requisites for the installation position of the ballast water treatment apparatus. More specifically, only because the rudder house is an area to satisfy all the conditions, the rudder house is considered as an appropriate position for the installation of the ballast water treatment apparatus. The originally attached description does not exclude installing the ballast water treatment apparatus in a position other than the rudder house.</p> <p>Therefore, [0030] and [0006] in the originally attached description introduce the technical matter to solve the problem by using the configuration of installing the ballast water treatment apparatus in the</p>	<p>ballast water treatment apparatus is installed in the non-explosion proof area positioned in the rear part of the marine vessel other than the rudder house.</p> <p>However, technical matters introduced by considering all matters mentioned in the originally attached description etc. do not encompass the latter invention in which the ballast water treatment apparatus is installed in the non-explosion proof area positioned in the rear part of the marine vessel other than the rudder house.</p> <p>Therefore, the invention in which the ballast water treatment apparatus is installed in the non-explosion proof area positioned in the rear part of the marine vessel other than the rudder house corresponds to an additional matter that is not a technical matter introduced by considering all the matters in the originally attached description etc. The present amendment, which added such a technical matter, does not comply with the requirement under Article 17bis (3) of the Patent Law.</p>
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<p>non-explosion proof area, of the configurations of the present invention 6. The present amendment does not introduce a new technical matter in relation with the technical matter concerned. The provision of Article 17bis(3) of the Patent Law is not violated.</p>	
<p>Judgement by the Court</p> <p>(1) Matters mentioned in the originally attached description</p> <p>... As the gist of the entire originally attached description, the rudder house is focused on as an installation place of the ballast water treatment apparatus, and although the term "non-explosion proof area" is mentioned only in [0030], the specific description including its meaning of the "non-explosion proof area" is not exemplified.</p> <p>(2) Consideration of the common general knowledge as of the filing</p> <p>... The originally attached description does not include the meaning of the term "non-explosion proof area" or exemplification of the "non-explosion proof area" other than the rudder house. However, in view of the common general knowledge, a person skilled in the art who contacted the originally attached description should have understood the meaning and the place of the "non-explosion proof area" clearly.</p> <p>(3) Matters mentioned in [0030]</p> <p>Regarding the "non-explosion proof area" which is a constitution of the present invention 6, as described above, [0030] in the originally attached description includes the expression that "Since the rudder house 9 is a non-explosion proof area, there is another advantage that provides less limitation to various controllers or electric apparatuses".</p> <p>The advantage mentioned here is described, literally, as an auxiliary effect of the rudder house. A person skilled in the art who contacted this description, however, should have understood that this effect is not limited to the rudder house and is a general effect of the "non-explosion proof area" which is in a different dimension from the rudder house.</p> <p>Accordingly, even if the gist of the originally attached description as a whole focuses on the rudder house and [0030] describes the effect of the rudder house literally, a person skilled in the art who contacted [0030] would not have understood that the "advantage that provides less limitation to various controllers or electric apparatuses" is not an effect unique to the rudder house but understood immediately that this effect is not limited to the rudder house and focuses on the "non-explosion proof area" having a broader meaning. Based on such understanding, he/she would also have understood that the "non-explosion proof area" is a single configuration almost irrespective of the rudder house.</p> <p>Therefore, <u>from [0030], one technical idea that provides an effect that "less limitation to various controllers or electric apparatuses" is provided by installing the ballast water treatment apparatus in the "non-explosion proof area". The "non-explosion proof area" of the present invention 6 is substantially stated in [0030].</u> It cannot be recognized that the configuration of the "non-explosion proof area" does not comply with the requirement under the provision of Article 17bis (3) of the Patent Law.</p>	

(81-2)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(2)
Classification of the Case	81-2: As to whether amendment that specific-conceptualizes claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

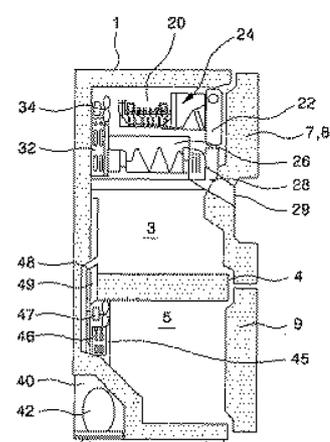
Case	"Refrigerator" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 26, 2012 (2012 (Gyo KE) No. 10351)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2006-507773 (JP 2006-521531A)
Classification	F25D 11/02
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding judge: Shuhei SHIOTSUKI, Judge: Tomoko MANABE, Judge: Minoru TABABE

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention is a refrigerator including a refrigerating chamber 3 formed at a relatively upper portion of a refrigerator body 1 and a freezing chamber 5 formed at a relatively lower portion of the refrigerator body 1, which comprises an ice making chamber 20 which is partitioned in the refrigerating chamber 3 by means of insulating walls and includes an icemaker 24 for making ice and an ice storage 26 for storing the ice made in the icemaker 24, a first heat exchanger 32 for generating cold air to regulate the temperature in the ice making chamber 20, and a second heat exchanger 46 for generating cold air to regulate the temperature in the freezing chamber 3 and the refrigerating chamber 5, wherein the first and second heat exchangers 32, 46 are components of a heat exchange cycle. This configuration provides some advantages in that the temperature in the refrigerating chamber can be accurately regulated, the loss of cold air can be minimized and the structures for supplying water into the icemaker and the dispenser can be simplified.

FIG. 3



(2) Disclosure of Detailed Description of the Invention

"... [0019] ...

"The ice making chamber may be detachably installed in the refrigerating chamber. The refrigerating chamber may be opened and closed by a pair of doors that are rotatably supported on hinges provided at upper and lower ends of both lateral sides of the refrigerator body.

... [0020] ...

"The ice-making chamber may be provided at one side of the door. The doors that open and close the refrigerating chamber may have widths different from each other. Gaskets may be provided at tip ends of the doors that open and close the refrigerating chamber such that they are brought into close contact with each other when the doors are closed.' ... " (cited from the Court Decision, line breaks are added as appropriate)

(3) The Claims (Before and after the amendment)

Before the amendment	After the amendment
<p>[Claim 1] A refrigerator including a refrigerating chamber formed at a relatively upper portion of a refrigerator body and a freezing chamber formed at a relatively lower portion of the refrigerator body, the refrigerator comprising:</p> <p>    a pair of refrigerating chamber doors formed pivotally at an edge of the refrigerating chamber to open and close the refrigerating chamber selectively;</p> <p>    an ice making chamber positioned behind one of the pair of refrigerating chamber doors, the ice making chamber positioned inside the refrigerating chamber while the door is closed;</p> <p>    a dispenser formed on the refrigerating chamber door and communicating with the ice making chamber to dispense ice in the ice making chamber to an outside; and</p> <p>    an ice dispensing duct passing through the refrigerating chamber door and having an inlet communicating with the ice making chamber and an outlet communicating with the dispenser, wherein the ice making chamber comprises:</p> <p>        an ice maker for making ice;</p> <p>        a storage chamber storing ice made by the ice</p>	<p>[Claim 1] A refrigerator including a refrigerating chamber formed at a relatively upper portion of a refrigerator body and a freezing chamber formed at a relatively lower portion of the refrigerator body, the refrigerator comprising:</p> <p>    a pair of refrigerating chamber doors formed pivotally at an edge of the refrigerating chamber to open and close the refrigerating chamber selectively;</p> <p>    an ice making chamber positioned behind one of the pair of refrigerating chamber doors and positioned inside the refrigerating chamber while the one of the doors is closed, <u>the ice making chamber being attached to a rear face of the refrigerating chamber door;</u></p> <p>    a dispenser formed on the refrigerating chamber door <u>and at a lower part of the ice making chamber</u> and communicating with the ice making chamber to dispense ice in the ice making chamber to an outside; and</p> <p>    an ice dispensing duct passing through the refrigerating chamber door having an inlet communicating with the ice making chamber and an outlet communicating with the dispenser, wherein the ice making chamber comprises:</p>

<p>maker; and  an ice conveying mechanism formed in the ice storage chamber and conveying ice in the ice storage chamber toward the inlet of the ice dispensing duct.</p>	<p>an ice maker for making ice;  a storage chamber storing ice made by the ice maker; and  an ice conveying mechanism formed in the ice storage chamber and conveying ice in the ice storage chamber toward the inlet of the ice dispensing duct.</p>
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(4) Procedural History

- July 2, 2010 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-14727)  
Written amendment (Present amendment) (see the invention recited in the above "After the amendment")
- June 21, 2011 : Appeal decision: The present amendment was dismissed, "The request for appeals fails to lie."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p>
<p>The related configuration between the ice making chamber and the refrigerating chamber door formed pivotally at an edge of the refrigerating chamber, described in the originally attached description etc., is naturally interpreted as follows: a) the ice making chamber is formed in the refrigerating chamber; b) existence of a connecting member such as a supply pipe between the ice making chamber and the refrigerating chamber door formed pivotally at the edge of the refrigerating chamber is not excluded, however, attaching the ice making chamber to the refrigerating chamber door is not disclosed or indicated; and c) a matter that 'the ice-making chamber may be provided at one side of the door' assumes the ice making chamber to be provided in the refrigerating chamber and means the configuration to provide the ice making chamber at the refrigerating chamber side of the door, according to the detailed explanation of the invention.</p> <p>Thus, the plaintiff's allegation in which ... 'the ice making chamber attached to a rear side of the refrigerating chamber door' is obvious from the description originally attached to the present application and the common general knowledge, cannot be applied.</p> <p>The amendment for adding 'the ice making chamber attached to a rear side of the refrigerating chamber door' introduces 'attaching the ice making chamber to the refrigerating chamber door provided to the refrigerating chamber pivotally', which is a new technical matter. The matter specifying the invention that 'the ice making chamber attached to a rear side of the refrigerating chamber door', which was added by the present amendment is beyond the scope of matters mentioned in the description, the scope of claims or the drawings originally attached to the application.</p>
<p>Decision</p>

<p>Allegations by Plaintiff</p> <p>... Paragraph [0019] of the originally attached description includes the expression that "the ice making chamber may be detachably installed in the refrigerating chamber. The refrigerating chamber may be opened and closed by a pair of doors that are rotatably supported on hinges provided at upper and lower ends of both lateral sides of the refrigerator body." Paragraph [0020] includes the expression that "the ice making chamber may be provided at one side of the door". Thus, it is stated that "the refrigerator" recited in the claim includes the ice making chamber attached to one side of the pair of the rotatably supported doors. The expression "one side" ... obviously represents either the front face or the rear face of the door.</p> <p>If the ice making chamber is provided at the front face of the door, which is an outer side of the refrigerator, the size of the refrigerator becomes larger because the front face of the door needs a space for the ice making chamber, and temperature regulation in the ice making chamber becomes difficult so that the ice-making function may be stopped. It would have been almost impossible for a person skilled in the art to think such a design. In view of the common general knowledge of a person skilled in the art, it would have been understood that the expression of "one side of the door" means the rear face of the door, which is an inner side of the refrigerator. Therefore, the originally attached description discloses a technical matter to provide the ice making chamber at the rear face of the pair of the rotatably supported doors.</p>	<p>Allegations by Defendant</p> <p>... In the originally attached description, ... and the drawings, only the configuration in which the ice making chamber is provided in the refrigerator is disclosed, and even in ... the working-effect of the invention, only providing the ice making chamber inside the refrigerator is described.</p> <p>The description about the background art in the originally attached description describes that the ingenious point of the invention is in that an area where the ice making chamber is provided is changed from the inside of the freezing chamber to the inside of the refrigerating chamber. Providing the ice making chamber at an area other than the inside of the refrigerating chamber is not described in any of the scope of claims, the detailed description of the invention of the present invention and the drawings.</p> <p>Further, ... the expression that "the ice making chamber may be provided at one side of the door" in paragraph [0020], which just assumes the ice making chamber provided in the refrigerating chamber, does not mean that the ice making chamber is provided at one face of the door.</p> <p>Therefore, according to the originally attached description etc., the ice making chamber is provided just inside the refrigerating chamber. •</p>
<p>Judgement by the Court</p> <p>The present amendment adds, to Claim 1, restriction of attaching the ice making chamber to the rear face (back face) of one of the pair of refrigerating chamber doors. However, the detailed description of the invention ... in the description originally attached to the application only states the ice making chamber</p>	

provided at the inside of the refrigerating chamber, which is positioned behind (inside) the refrigerating chamber door, and does not state or suggest an ice making chamber incorporated in the door. Even in the drawings attached to the originally attached description, a configuration in which the ice making chamber is incorporated in the door is not found.

... Paragraph [0019] only states that "the ice making chamber may be detachably installed in the refrigerating chamber". It is difficult to understand that this statement implies a configuration in which the ice making chamber is incorporated in the refrigerating chamber door. Paragraph [0020] also states that "The ice making chamber may be provided at one side of the door". This sentence, however, is followed by the statement that "The doors that open and close the refrigerating chamber may have widths different from each other. Gaskets may be provided at tip ends of the doors of the refrigerating chamber such that they are brought into close contact with each other when the doors are closed". Thus, it is rational to recognize that the expression "one side of the door" focuses on the difference in structure between the pair (plurality) of the doors of the refrigerating chamber. Positioning the ice making chamber at one of the pair of the doors (more precisely, behind (inside) the one of the doors) is simply meant. Therefore, it cannot be understood that the aforementioned expression "one side of the door" indicates the rear face (inner face) of the refrigerating chamber door, or that the paragraph mentioned above means a configuration in which the ice making chamber is incorporated in the refrigerating chamber door.

(81-3)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 2 3.3.1(3)
Classification of the Case	81-3: As to whether amendment that limits a numerical value against claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Deep ultraviolet light lithography" (Opposition to the grant of a patent) Tokyo High Court Decision, Dec. 11, 2001 (2001 (Gyo KE) No. 89)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-287158 (JP H7-50253A)
Classification	H01L 21/027
Conclusion	Acceptance
Related Provision	(Former Act) Article 120quarter(3), Article 131(2)
Judges	Tokyo High Court, Eighteenth Civil Affairs Division, Presiding judge: Noriaki NAGAI, Judge: Shuhei SHIODSUKI, Judge: Hidehumi HASHIMOTO

## 2. Overview of the Case

### (1) Summary of Claimed Invention

[Objective] The present invention relates to a new short wavelength lithography system.

[Configuration] A lithography system according to the present invention includes a narrow bandwidth adjustable laser that operates in a wavelength of a range of deep ultraviolet light.

### (2) Disclosure of Detailed Description of the Invention

"[0002] [Background of the Invention] The present invention relates to an optical lithography, and more particularly, to apparatus and a method for short wavelength optical lithography that is adopted to fabricate a high quality fine line semiconductor device.

[0003] it is known that a resolution limit ( $L_{min}$ ) for identical lines and intervals in an optical image projection system is represented by the following.

[0004]  $L_{min} = K\lambda/NA$  (1)

where,  $K$  is a constant, and this value is in a range from 0.4 to 1.0 typically and depends on manufacturing and irradiation conditions and resist characteristics,  $\lambda$  is a wavelength of an exposure radiant ray, and  $NA$  is a

numerical aperture of a projection optical device.

[0005] From the expression (1), it is found that a minimum shape that is printable can be reduced by making  $\lambda$  small or by increasing NA. However, a focal depth of a system varies in inverse proportion to  $(NA)^2$ , and, thus, in an actual high resolution system, it is advantageous to reduce  $\lambda$  rather than increasing NA usually to achieve a desired  $L_{min}$ . The present invention relates to a new short wavelength lithography system.

[0014] Each lens included in apparatus 14 of Fig. 2 is produced only from quartz glass. Quartz glass is a highly transparent high stability material for short wavelength light, and, further, quartz glass can be processed finely in accordance with designated lens design. Regardless of having such obvious advantages, the present applicant is the first person who advocates use of a single optical material (quartz glass) for producing a high quality lens assembly for short wavelength (deep UV, for example) optical lithography based on a laser irradiation. Conventionally, in order to correct color aberration, it has been usual to produce a lens using complex materials.

[0015] After having tried to design a lens assembly to be produced only from quartz glass, the present applicant has recognized that, in order to avoid the color aberration problem in an assembly of a single optical material, it is required for a laser source to be coupled to this assembly that it has an extremely narrow bandwidth practically. When the bandwidth of a laser source is not sufficiently narrow, the color aberration problem cannot be avoided, resulting in causing a blur in a projected image on a wafer 40 (Fig. 2) to which laser beam is irradiated.

[0016] However, the present applicant has discovered that all appropriate short wavelength laser sources having sufficient power have extremely broad bandwidth in essence. One obvious action that should be taken at this time is, as is the case with other researchers, to redesign the lens assembly in order to avoid the color aberration problem within the range of bandwidth of a laser source that is available. However, this requires use of an optical material other than quartz glass together. For this reason, the present applicant has taken an unapparent method of keeping lens design only by quartz glass just as it is, and redesigning a laser source such that it shows a sufficiently narrow bandwidth. Not only has more excellent lens design been realized by this particular approach, but also the road to achieve electronic focal point tracking and electronic adjustment of a laser source was opened. By electronic adjustment of a laser source, it becomes possible to make the laser source conform to the operating characteristics of a lens assembly, as described later in detail.

[0017] As an example, a laser 12 contained in apparatus 10 of Fig. 1 includes an excimer laser. A laser of this classification of a wavelength of a range below 4000 angstrom to below 2000 angstrom, for example, has ability to perform UV radiation. There are lot of documents that introduce excimer lasers and application of those to lithography. ...By way of example, the laser 12 of Fig. 1 includes a pulse KrF gas excimer laser designed to operate at the nominal center wavelength of 2484 angstrom.(the fluorine component within KrF is extremely toxic.) As an example, a pulse reiteration speed of the laser 12 is selected as being about 1000 pulse per second.

[0018] Essentially, the KrF excimer laser 12 (Fig. 1) has a spectrum bandwidth of about 10 angstrom at the half-value point of electric power. However, because it has been reconfirmed that, for a lens assembly of quartz glass only for high resolution lithography, a laser source bandwidth of about 0.1 angstrom or less is

required to avoid color aberration problem, the present applicant made the laser 12 and a bandwidth narrowing means be coupled to each other, and, by this, has succeeded to obtain output that has a power half-value point bandwidth of only 0.05 angstrom at a point of 2484 angstrom. Although power of each of these pulses is about 5 mj in the reiteration speed of 1000 pulse per second, it is sufficient for homogeneous high resolution high throughput lithography.

[0019] Several methods can be used for narrowing the inherent bandwidth of the laser 12. In Fig. 3, one appropriate assembly to perform this is shown (in this drawing, portions 42 and 44 of the laser are also shown). A beam 46 radiated from the laser is transmitted through a standard low fineness ratio etalon 48 and enters a conventional grazing incidence beam diffraction grating 50. A high reflection ratio mirror 52 is located in a manner facing conventional grazing incidence beam diffraction grating 50. As an example, the diffraction grating 50 has the number of grooves of 3000 to 4000 per 1 mm. The elements 48 and 50, and 52 form an adjustment means and a bandwidth narrowing means, respectively. This assembly is also shown in Fig. 1, and a reference number 54 is given to it ("bandwidth narrowing" is also called a "linewidth reduction" in this field).

[0022] In this technology, there are known some apparatus to perform output adjustment or bandwidth narrowing of a short wavelength laser as is performed by the bandwidth narrowing means 54. ...A paper published by T. J. Mckee et al. in IEEE Journal of Quantum Electronics), Vol. 1, QE-15, No. 5, May, 1979 issue, pp. 332-334, "Operating and Beam Characteristics, Including Spectral Narrowing of a TER Rare-Gas Halide Excimer Laser"...

[0048] An operation of the focal point tracking apparatus is as follows. ...the center wavelength is increased by 0.1 angstrom. By this, the focal point distance of a lens is reduced by 1 micron, and, in this way, assumed 1 micron decrease in distance between a lens and a wafer is corrected accurately." (extracted from the decision)

(3) The Claims (before amendment and after amendment)

Before amendment	After amendment
<p>[Claim 12] A method for fabricating a device, the method comprising: a step of causing laser radiation having characteristics of relatively broad bandwidth; a step of turning at least part of said radiation to a workpiece via a lens assembly located within a route of said radiation, wherein said assembly is an assembly that shows large color aberration of an unacceptable level in response to said relatively broad bandwidth radiation; a step of narrowing bandwidth of said radiation sufficiently such that said assembly shows low color aberration of an acceptable level; and a step of further processing said workpiece to complete said device from said workpiece.</p>	<p>[Claim 1] (2) Gist of the invention concerning claim 9 after correction (before amendment) (corresponding to the above-mentioned claim 12)</p> <p>A method for fabricating an integrated circuit from a semiconductor material, the method comprising: a step of causing ultraviolet excimer laser irradiation of a narrowed bandwidth of 0.1 Å or less; a step of turning at least part of said narrow bandwidth irradiation via a lens assembly of quartz glass only located within a route of said irradiation to a semiconductor material; and a step of further processing said semiconductor material in order to complete said integrated circuit from said</p>

	<p>semiconductor material.</p> <p>(3) Gist of the invention concerning claim 9 after correction (after amendment)</p> <p>A method for fabricating an integrated circuit device from a workpiece including a semiconductor material, the method comprising: a step of causing KrF excimer laser pulse radiation having characteristics of a relatively broad bandwidth; a step of turning at least part of said radiation to a workpiece having a resist layer via a lens assembly of quartz glass only located within a route of said radiation, wherein, said assembly is an assembly showing large color aberration of an unacceptable level in response to said relatively broad bandwidth radiation, and wherein, before said radiation is turned to said lens assembly, <u>power of each pulse of radiation whose bandwidth has been made to be narrowed is at least 5 mj</u>; a step of sufficiently narrowing a bandwidth of said radiation to a bandwidth of 0.1 angstrom or less at a power half-value point such that said assembly shows low color aberration of an acceptable level; and a step of further processing said workpiece to complete said device from said workpiece.</p>
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(4) Procedural History

- Mar. 20, 1998 : Registration of establishment patent right
- Dec. 4, 1998 : Opposition to the grant of a patent (Igi No. 10-75824)
- Dec. 15, 1999 : Demand for correction
- Jan. 14, 2000 : Notice of reasons for rejecting a demand for correction
- Aug. 4, 2000 : Written amendment
- Oct. 17, 2000 : "Determination that said that "the patent is rescinded."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Determination
<p>...The technological matter included in the correction matter after amendment of "power of each pulse of radiation whose bandwidth has been narrowed is at least 5 mj" means that power of each pulse of radiation</p>

whose bandwidth has been made to be narrowed is 5 mj or more, and, therefore, it is a matter that is unexplained in the description in question before correction that only prescribes "power of each pulse is about 5 mj" (paragraph [0018]). The above-mentioned amendment that amends the correction matter such that it includes a technological matter that is unexplained in the description before the correction is amendment that changes the gist of the written request for correction.

Therefore, the above-mentioned amendment falls under a change of the gist of the written request, and does not conform to the prescription of Patent Act Article 131(2) as applied mutatis mutandis pursuant to the provisions of Patent Act Article 120quarter(3).

**Decision**

**Allegations by Plaintiff**

...In the present invention, radiation beam of a krF excimer laser is narrowed to a spectrum bandwidth of 0.1 angstrom or less to avoid a color aberration problem in a lens assembly of quartz lens only, and, in a working example of paragraph [0018], it was narrowed to 0.05 angstrom from a spectrum bandwidth of 10 angstrom. However, there is a risk that, if a spectrum bandwidth is narrowed, power of a laser beam pulse reduces accordingly, and becomes weak power that is not sufficient to adequately expose a resist on a wafer. Therefore, paragraph [0018] has reported that, even in the case of a spectrum bandwidth of 0.05 angstrom, power of about 5 mj was obtained, and this is sufficient power for homogeneous high resolution high throughput lithography, and has confirmed feasibility of a quartz lens system.

...Power of about 5 mj here has been reported as sufficient power for homogeneous high resolution high throughput lithography, and, therefore, it is suggested as a matter of fact that power greater than this is power that assures homogeneous high resolution high throughput lithography.

**Allegations by Defendant**

...It is common knowledge of a person skilled in the art that, in order to realize high resolution high throughput lithography, power of each pulse is required to be within some appropriate finite range. Therefore, the statement of paragraph [0018] as "although power of each of these pulses is about 5 mj, it is sufficient for homogeneous high resolution high throughput lithography." is suggesting that, in a person skilled in the art, the value of about 5 mj that is power of each pulse is within a some appropriate finite range to achieve high resolution high throughput lithography together with a power half-value point bandwidth of 0.05 angstrom, and, thus, it cannot be said that it is teaching constitution that "power of each pulse of radiation whose bandwidth has been narrowed is at least 5 mj".

**Judgment by the Court**

...In the description before the correction, there are statements that "in an actual high resolution system, it is advantageous to reduce  $\lambda$  rather than increasing NA usually to achieve a desired Lmin."(paragraph [0005]), "the present applicant has discovered that all appropriate short wavelength laser sources having sufficient

power have extremely broad bandwidth in essence. One obvious action that should be taken at this time is, as is the case with other researchers, to redesign the lens assembly in order to avoid the color aberration problem within the range of bandwidth of a laser source that is available. However, this requires to use an optical material other than quartz glass together." (paragraph [0016]), and, "a laser 12 contained in apparatus 10 of Fig. 1 includes an excimer laser. A laser of this classification of a wavelength of a range below 4000 angstrom to below 2000 angstrom, for example, has ability to perform UV radiation. There are lot of documents that introduce excimer lasers and application of those to lithography." (paragraph [0017]). According to these, it is found that "an appropriate short wavelength laser source having sufficient power" whose bandwidth has not been narrowed is used for high resolution lithography. Then, when a bandwidth is narrowed, it is inconceivable that power of a short wavelength laser source is increased, but rather it is reduced in reality, and, therefore, it can be found that the power of each pulse of a laser source in paragraph [0016] and paragraph [0017] is larger than, the power of each pulse in paragraph [0018], that is, about 5 mj. In other words, it should be said that there is also stated in the description before the correction that a short wavelength laser source having power of each pulse larger than about 5 mj is being used for high resolution lithography in effect.

5 With this in mind, when further consideration is made to the statement of paragraph [0018], the statement of "has succeeded to obtain output that has a power half-value point bandwidth of only 0.05 angstrom at a point of 2484 angstrom." means that, by obtaining output of a short wavelength and a narrow bandwidth, high resolution can be achieved. And, regarding the subsequent statement of "although power of each of these pulses is about 5 mj in the reiteration speed of 1000 pulse per second, it is sufficient for homogeneous high resolution high throughput lithography.", it is reasonable to interpret it as meaning that, although, by narrowing bandwidth, there is a risk that power becomes less than power necessary for achieving high throughput, the result of experimentation showed that power of each pulse was about 5 mj, and it has been confirmed that it does not cause problems in maintaining high resolution and also achieving high throughput. According to this interpretation, it is obvious that the statement of paragraph [0018] of "although it is about 5 mj, ...it is sufficient." means that about 5 mj or more is acceptable, in other words, "being at least 5 mj".

Besides, the statement of "power of each pulse of radiation whose bandwidth has been made to be narrowed is at least 5 mj" in claim 9 after the present amendment is a statement as to radiation power, and it is not a statement as to power of light irradiated to "a workpiece including a semiconductor material" (irradiation power). Then, although it can be realized easily to make irradiation power be smaller than radiation power by such as placing an absorption filter, in contrast, it is obvious that it is difficult to make irradiation power be larger than radiation power. If it is so, while, by narrowing a bandwidth, there is a risk that output power becomes small and high throughput cannot be achieved, on the other side of the coin, even if output power (radiation power) is too large, it should be said that this does not immediately lead to failing to maintain high resolution, and, therefore, that the statement of paragraph [0018] as "although it is about 5 mj, ...it is sufficient." must be interpreted as the above-mentioned explanation is further backed.

(Note) It should be noted that this decision is about a dispute of whether the case falls under a change of the gist of a written demand for correction or not.

(81-3)-2

Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(3)
Classification of the Case	81-3: As to whether amendment that limits a numerical value against claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Marking method of transparent material" (Trial for Invalidation) Intellectual Property High Court Decision, April 27, 2006 (2005 (Gyo KE) No. 10709)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-243439 (JP H11-156568A)
Classification	B23K 26/00
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Third Division, Presiding judge: Hisao SATO, Judge: Ryoichi MIMURA, Judge: Yuji KOGA

## 2. Overview of the Case

### (1) Summary of Claimed Invention

In the claimed invention, the depth of a light condensing point is kept approximately constant with an  $f\theta$  lens even if the optical axis of a laser light is inclined against a substrate surface so that marks can be formed to be dispersed in a relatively wide area of the thin glass substrate without damaging the substrate surface. Further, since a moving distance of the light condensing point in an in-plane direction is proportional to the change in inclination of the optical axis of the laser light before entering the  $f\theta$  lens, a pattern with little distortion can be drawn.

### (2) Disclosure of Detailed Description of the Invention

"Regarding the thickness of a making object, the originally attached description includes the following expressions:

- a. paragraph [0009]: "The object of the present invention is to provide a marking method suitable for the marking to a thin transparent substrate.";
- b. paragraph [0013]: "It has been found that if the marking is carried out to a glass substrate with a thickness of 1 to 2 mm, a crack is generated not only inside the substrate but also on the substrate surface.";

c. paragraph [0017]: "As the transparent glass substrate 1, for example, a synthetic quartz substrate with a thickness of 10 mm is used."; and

d. paragraph [0031]: "If the marking is carried out to a PMMA substrate with a thickness of 2 mm," (cited from the Court Decision)

### (3) The Claims (Before and after the amendment)

Before the amendment	After the amendment
<p>[Claim 1] A marking method comprising: preparing a marking object; and carrying out marking to an inside of the marking object while a laser light in a wavelength area transmitting a material to form the marking object is condensed inside the marking object with a f<math>\theta</math> lens.</p>	<p>[Claim 1] A marking method comprising: preparing a marking object <u>with a thickness of 2 mm or less</u>; and carrying out marking to an inside of the marking object while a laser light in a wavelength area transmitting a material to form the marking object is condensed inside the marking object with a f<math>\theta</math> lens, wherein in the carrying out the marking, the depth of a light condensing point of the laser light from a surface of the marking object is regulated so as to position the light condensing point of the laser light inside the marking object by taking a refractive index of the material of the marking object into consideration.</p> <p>[Claim 3]</p> <p>The marking method according to Claim 1, wherein the thickness of the marking object is <u>1 mm or more</u>.</p>

### (4) Procedural History

- August 17, 2001 : Written amendment by the plaintiff (the patentee side) (see the inventions recited in the above "Before the amendment" and "After the amendment")
- September 14, 2001 : Registration to establish a patent right
- March 1, 2005 : Request for trial for invalidation by the defendant (Muko No. 2005-80064)
- August 17, 2005 : Trial decision: "... The patent is invalidated."

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial decision
<p>... The statement a does not show a specific numerical scope of the thickness of "the thin transparent substrate".</p> <p>The statement b describes a problem in the evaluation experiment of the marking with the convex lens. However, it is not stated clearly that the present invention solves this problem. Further, in the statement c,</p>

which describes the example of the present invention, the thickness is 10 mm. Thus, it cannot be understood that the present invention has an object to carry out the marking to an object with a thickness of 1 to 2 mm.

The statement d, which also describes the example of the present invention, does not include a description indicating that "a thickness of 2 mm" is the upper limit of the thickness of the marking object.

Therefore, it cannot be concluded that the originally attached description etc. states that the thickness of the marking object is "2 mm or less" or "1 mm or more".

Therefore, the written amendment mentioned above was made beyond the scope of matters mentioned in the originally attached description etc. and it does not comply with the requirement under Article 17bis(3) of the Patent Law.

Decision

Allegations by Plaintiff

... A person skilled in the art could have understood sufficiently that the originally attached description states and explains that a "thin" substrate makes the marking difficult, by considering the length of a crack. The crack inside the glass substrate, as described in the statement h, exhibits no criticality where its property suddenly changes. However, it is explained that if the crack has a length of approximately 500 μm in the thickness direction of the glass substrate, the thickness of the substrate to be subject to internal marking exceeds 500 μm but is less than a thickness which can generate a 500-μm crack without difficulty. That is, it is explained that the thickness of the substrate is 1 mm or more, which is larger than 500 μm, and "2 mm or less", which is thinner than the thickness which can generate a 500-μm crack without difficulty.

... The difficulty in marking to a substrate with a thickness of 2.3 mm is described (paragraph [0006]). Thus, although the statement a does not include a specific numerical scope showing that the thickness of the "thin" transparent substrate is 2 mm or less, the originally attached description explains that the term "thin" indicates the thickness of 2 mm or less.

Allegations by Defendant

... It is alleged that the "thin" transparent film can be specified to have a thickness of "2 mm or less". However, a 500-μm crack is just a numerical value under the specific condition described in paragraph [0012]. It cannot be a ground to limit the thickness of the object of the present invention to 2 mm or less.

... just describes that a mark can be formed by carrying out the marking inside the marking object in accordance with the method disclosed in the description, in the cases where the synthetic quartz substrate with a thickness of 10 mm is used and where the PMMA substrate with a thickness of 2 mm is used. On the other hand, the originally attached description does not state that a mark is formed in a marking object with a thickness less than 2 mm, at all. Similarly, the originally attached description does not state that a marking object with a thickness of 1 mm or more is preferably used, at all.

<p>... The internal marking inside the <u>PMMA</u> with a thickness of <u>2 mm</u>, in which internal marking is difficult, is succeeded. It shows that the internal marking can be carried out to a material to which internal marking is more easily carried out than to the PMMA, even if the object is thinner.</p>	
<p>Judgement by the Court</p> <p>... It is recognized that the length of a crack is affected even by energy of a laser light and a focal distance of the f<math>\theta</math> lens 14. Thus, it cannot be understood that, generally, "a crack with a length of approximately 500 <math>\mu</math>m in the thickness direction of the glass substrate is generated", irrespective of a laser light or a lens condition.</p> <p>Therefore, the plaintiff's allegation, which is on the premise of the length of the crack generated in the thickness direction of the glass substrate is 500 <math>\mu</math>m, cannot be adopted because of the premise.</p> <p>... Although the originally attached description (Exhibit A17) includes the description that "Since the crack 6 extends toward the substrate surface 2 on which a laser light from the light condensing point Q is incident, the depth H2 of the light condensing point Q is preferably larger than half of the thickness of the substrate 1." (paragraph [0022]), it is just understood from this description that since the crack extends toward the substrate surface, the light condensing point is preferably positioned at a deep point. <u>It does not further indicate a relation between the thickness of the substrate and the length of the crack generated in the thickness direction of the glass substrate.</u> Even a statement that allows such an indication is not included. <u>It cannot be recognized at all that the originally attached description includes a statement which allows understanding of a specific thickness such as "2 mm or less" or "1 mm or more" in terms of the relation with the length of the crack generated in the thickness direction of the glass substrate.</u></p> <p>... It is mentioned that the marking can be made only to the inside of the synthetic quartz substrate with a thickness of 10 mm and the PMMA substrate with a thickness of 2 mm without damaging the respective substrate surfaces. In view of this, it can be understood that the example of <u>the PMMA substrate with a thickness of 2 mm</u> described in the originally attached description, <u>shows a lower limit of the thickness (an example of the thinnest thickness)</u> of a transparent substrate to the inside of which the marking was successfully made. However, it cannot be understood at all that this example shows an upper limit of the thickness (a numerical value of a maximum thickness).</p> <p>As described, the originally attached description does not state at all that a mark is formed inside a marking object with a thickness less than 2 mm or that a marking object with a thickness of 1 mm or more is preferably used, and it cannot be recognized that a description which a person skilled in the art who contacted the originally attached description could have obviously understood these matters is included.</p>	

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Relevant portion of Examination Guidelines	Part IV, Chapter 2, Section 3, 3.1 (3)
Classification of the Case	81-3: As to whether amendment that limits a numerical value against claims adds a new matter or not
Keyword	

#### 1. Bibliographic Items

Case	"Thin film transistor" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, August 31, 2006 (2005 (Gyo KE) No. 10767)
Source	Website of Intellectual Property High Court
Classification	H01L 29/786
Application No.	Japanese Patent Application No. 2001-67986 (JP 2001-291876A)
Conclusion	Acceptance
Related Provision	(Former) Article 17bis(2) and (Former) Article 17(2)
Judges	IP High Court Third Division, Presiding judge: Hisao SATO, Judge: Ichiro OTAKA, Judge: Kazuhide SHIMASUE

#### 2. Overview of the Case

##### (1) Summary of Claimed Invention

The claimed invention relates to a thin film device such as a thin film insulator gate type field effect transistor (thin film transistors or TFTs), in which a crystalline semiconductor film constituting the thin film transistor is crystallized by nickel and is characterized in that "(i) the concentration of nickel contained in the crystalline semiconductor film is  $1 \times 10^{16} \text{ cm}^{-3}$  to  $1 \times 10^{19} \text{ cm}^{-3}$ , and (ii) the upper limit of the nickel concentration does not exceed  $1 \times 10^{19} \text{ cm}^{-3}$  by removing nickel."

##### (2) Disclosure of Detailed Description of the Invention

"In the present invention, nickel, iron, cobalt, platinum or palladium is used. These materials are not desirable for silicon which is used as a semiconductor material. If such a material is contained excessively in the silicon film, it is necessary to remove the material. With respect to nickel, when a growing crystal of nickel silicide arrives its final points, i.e., the crystallization has been completed, as a result of the above-described reaction, the nickel silicide is easily dissolved in hydrofluoric acid or hydrochloric acid. The nickel contained in the substrate can be reduced by treating the nickel with these acids. Further, in order to positively reduce nickel, iron, cobalt, platinum, and palladium, it has been found that annealing is preferably

conducted at 400 to 650°C in an atmosphere containing chlorine such as hydrogen chloride, various kinds of methane chloride ..., various kinds of ethane chloride ..., or various kinds of ethylene chloride ..., after completing the crystallization step. Especially, the material which can be used most easily is trichloroethylene ... We have discovered that preferred concentration of nickel, iron, cobalt, platinum in the silicon film according to the present invention is  $1 \times 10^{15} \text{ cm}^{-3}$  to 1 atomic %, more preferably  $1 \times 10^{16} \text{ cm}^{-3}$  to  $1 \times 10^{19} \text{ cm}^{-3}$ . At lower concentrations, the crystallization does not progress sufficiently. At higher concentrations, the characteristics and the reliability deteriorate." (paragraph [0011])" (cited from the Court Decision)

"it can be recognized that the Examples 2, 3 and 6 describe an example of the thin film transistor in which a treatment of "nickel silicide which arrives its final points of crystallization with hydrofluoric acid or hydrochloric acid" or a nickel removing step by "annealing at 400 to 650°C in an atmosphere containing chlorine" (paragraph [0011]) is not performed ..." (cited from the Court Decision)

(3) The Claims (Before amendment and Amended) (Claim 1 is only described)

Before amendment (Present first amended invention)	Amended (Present second amended invention)
<p>[Claim 1] A thin-film transistor comprising:</p> <p>a crystalline semiconductor film containing nickel formed on a substrate;</p> <p>a gate insulating film formed on the crystalline semiconductor film; and</p> <p>a gate electrode formed on the gate insulating film</p> <p>wherein the crystalline semiconductor film is crystallized by the nickel,</p> <p>the concentration of the nickel contained in the crystalline semiconductor film is <math>1 \times 10^{16} \text{ cm}^{-3}</math> to <math>1 \times 10^{19} \text{ cm}^{-3}</math>, and</p> <p>by removing the nickel, the upper limit of the nickel concentration in the crystalline semiconductor film does not exceed <math>1 \times 10^{19} \text{ cm}^{-3}</math> of the above concentration.</p>	<p>[Claim 1] A thin-film transistor comprising:</p> <p>a crystalline semiconductor film containing nickel formed on a substrate;</p> <p>a gate insulating film formed on the crystalline semiconductor film; and</p> <p>a gate electrode formed on the gate insulating film</p> <p>wherein the crystalline semiconductor film is crystallized by the nickel,</p> <p>the concentration of the nickel contained in the crystalline semiconductor film is <math>1 \times 10^{16} \text{ cm}^{-3}</math> to <math>1 \times 10^{19} \text{ cm}^{-3}</math>, and</p> <p><u>the upper limit of the nickel concentration in the crystalline semiconductor film does not exceed <math>1 \times 10^{19} \text{ cm}^{-3}</math> of the above concentration, by removing the nickel.</u></p>

(4) Procedural History

- September 26, 2002 : Request for Appeal against an Examiner's Decision of Refusal (Fufuku No. 2002-18694)
- November 26, 2004 : Notice of reasons for refusal
- January 28, 2005 : Amendment (Present first amendment) (see the above invention of "Before

- amendment")
- February 24, 2005 : Final notice of reasons for refusal
- April 4, 2005 : Amendment (Present second amendment) (see the above invention of "Amended")
- September 12, 2005 : Dismissal of the Present second amendment, and Appeal Decision of "the request of the Present Appeal is dismissed"

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>The Present second amendment is not made within the scope of the matter stated in the specification or the drawing which is originally attached to the request of the present application (hereinafter, the specification and the drawing are collectively referred to as an "original specification of the present application". Exhibit A2), is the addition of new matter, does not comply with the provision of Article 17(2) as applied mutatis mutandis Article 17bis(2) of the former Patent Law provided as 1994 Law No. 116, and should be dismissed as illegal. In addition, the Present first amendment does not comply with the requirement prescribed in the same paragraph since the first amended invention is not stated in the original specification of the present application, and is the addition of new matter. Therefore, the present application should be refused.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>The Appeal Decision has determined that (i) "since the inventions according to amended Claims 1 and 2 are a product invention, it cannot be accepted that the invention is of simultaneously defining at different points, wherein "<math>1 \times 10^{19} \text{ cm}^{-3}</math>" which is the upper limit of "nickel concentration" is a value obtained from performing the step of "removing the nickel" in the matter of "the concentration of the nickel contained in the crystalline semiconductor film is <math>1 \times 10^{16} \text{ cm}^{-3}</math> to <math>1 \times 10^{19} \text{ cm}^{-3}</math>", while "<math>1 \times 10^{16} \text{ cm}^{-3}</math>" which is the lower limit is a value obtained from not performing the step of "removing the nickel" (...hereinafter, referred to as a recognition (i)), and (ii) "therefore, as long as the description of amended Claims 1 and 2, since "<math>1 \times 10^{19} \text{ cm}^{-3}</math>" which is the upper limit of "nickel concentration" is a value obtained from "removing the nickel", it should be recognized that the "<math>1 \times 10^{16} \text{ cm}^{-3}</math>" which is the lower</p>	<p>Allegations by Defendant</p> <p>A In a constitution of "product invention", it is needless to say that <u>the nickel concentration range of the crystalline semiconductor film at one point</u> which is really present, for example, either of the concentration range in the matter before removing nickel or the concentration range in the matter after removing nickel <u>can be only defined</u>.</p> <p>In addition, the constitution of "the upper limit of the nickel concentration in the crystalline semiconductor film does not exceed <math>1 \times 10^{19} \text{ cm}^{-3}</math> of the above concentration, by removing the nickel" in the Present second amended invention is of the upper value of the nickel concentration range of the crystalline semiconductor film in the "product invention" which is limited by a manufacturing method. <u>The Present second amended invention relates to "thin-film transistor" as manufactured upon completing each step, not defining those during the</u></p>

<p>limit is a value obtained from "removing the nickel" (...hereinafter, referred to as a recognition (ii)). Thereupon, the Appeal Decision has determined that the Present second amendment is not made within the scope of the matter stated in the original specification of the present application, since there is no description in the original specification of the present application that "<math>1 \times 10^{16} \text{ cm}^{-3}</math>" which is the lower limit of "nickel concentration" is a value obtained from "removing the nickel".</p> <p>However, ...the Present second amended invention is of removing the nickel until reaching the upper limit, as long as the nickel is excessive. The "<math>1 \times 10^{16} \text{ cm}^{-3}</math>" which is the lower limit of "nickel concentration" in the Present second amended invention is not a value obtained by "removing the nickel". The recognitions (i) and (ii) in the Appeal Decision are error.</p>	<p><u>manufacturing. Accordingly, to "remove the nickel" from the crystalline semiconductor film before forming the thin-film transistor on the crystalline semiconductor film is an indispensable step, no matter what the nickel concentration range which is remained in the crystalline semiconductor film after crystallization is high or low. The concentration range of the crystalline semiconductor film in the thin-film transistor is obtained after removing the nickel. If the nickel removing step is not performed, the crystalline semiconductor film of the Present second amended invention cannot provide a predetermined effect that "the thin-film transistor having almost uniform quality is always manufactured". The nickel removing step is an indispensable technical matter which characterizes the Present second amended invention.</u></p> <p><u>...although the portion of "removing the nickel" of the Present second amended invention is apparent description to technically limit that "the upper limit of the nickel concentration in the crystalline semiconductor film" "does not exceed <math>1 \times 10^{19} \text{ cm}^{-3}</math> of the above concentration, it cannot be substantially recognized to clear the technical meaning of the upper limit of the nickel concentration range. It is natural that the lower limit of the nickel concentration range of the crystalline semiconductor film also means the lower limit of the nickel concentration range of the crystalline semiconductor film after removing the nickel.</u></p>
<p><b>Judgement by the Court</b></p> <p>...it can be understood that claim 1 in the Present second amendment describes ...the crystalline semiconductor film constituting the thin-film transistor is crystallized by nickel, and (i) the concentration range of nickel contained in the crystalline semiconductor film is <math>1 \times 10^{16} \text{ cm}^{-3}</math> to <math>1 \times 10^{19} \text{ cm}^{-3}</math>, and (ii) the upper limit of the nickel concentration does not exceed <math>1 \times 10^{19} \text{ cm}^{-3}</math> by removing the nickel.</p> <p>In addition, in the literal of claims 1 and 2, when the concentration of nickel is below <math>1 \times 10^{19} \text{ cm}^{-3}</math>, not only there is no description to perform the step of removing nickel (nickel removing step), but also there are</p>	

separated descriptions that the concentration range of nickel is " $1 \times 10^{16} \text{ cm}^{-3}$  to  $1 \times 10^{19} \text{ cm}^{-3}$ " (the above-mentioned (i)) and that "the upper limit of the nickel concentration in the crystalline semiconductor film does not exceed  $1 \times 10^{19} \text{ cm}^{-3}$  of the above concentration by removing the nickel" (the above-mentioned (ii)). In light of these descriptions, it can be understood that claims 1 and 2 in the Present second amendment clarify that  $1 \times 10^{16} \text{ cm}^{-3}$  which is the lower limit of the nickel concentration does not directly correlate with the nickel removing step.

Accordingly, it is recognized that the thin-film transistor recited in claim 1 in the Claims in the Present second amendment does not need the nickel removing step, but includes those not performing the nickel removing step.

B In addition, there is no description in the "detailed explanation of the invention" of the original specification of present application (Exhibit A2) to indicate that the nickel removing step is necessarily performed before forming the thin-film transistor. Instead, ...there is the description that the nickel removing step is needed in the case of excessively containing nickel and there is the description of the thin-film transistor in the Example in which the nickel removing step is not performed.

C ...while the Present second amended invention performs the nickel removing step to be the range of the upper limit when the upper limit of the nickel concentration exceeds  $1 \times 10^{19} \text{ cm}^{-3}$ , it can be recognized that the Present second amended invention does not need to perform the nickel removing step in the other case, and includes that the concentration range of nickel in the crystalline semiconductor film is  $1 \times 10^{16} \text{ cm}^{-3}$  to  $1 \times 10^{19} \text{ cm}^{-3}$  without performing the nickel removing step. Accordingly, the recognitions (i) and (ii) in the Appeal Decision that " $1 \times 10^{16} \text{ cm}^{-3}$ " which is the lower limit of the nickel concentration in the Present second amended invention is a value obtained by "removing the nickel" are error.

In addition, according to the descriptions that the original specification of present application describes that the nickel removing step is necessary to be the range of the upper limit when the upper limit of the nickel concentration exceeds  $1 \times 10^{19} \text{ cm}^{-3}$ , and the Examples describes the thin-film transistor not performing the nickel removing step, the Present second amendment as the amended matter, that "the upper limit of the nickel concentration in the crystalline semiconductor film does not exceed  $1 \times 10^{19} \text{ cm}^{-3}$  of the above concentration, by removing the nickel." is made within the matter stated in the original specification of present application and the Present second amendment is the clarification of an ambiguous description, as recognized in the Appeal Decision.

Therefore, the determination of the Appeal Decision that the Present second amendment corresponds to the addition of new matter to be illegal is error.

(81-4)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(4)
Classification of the Case	81-4: As to whether amendment to originate an excluding claim against claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Photosensitive and thermosetting resin composition and a method of forming a solder resist pattern" (Trial for Invalidation) Intellectual Property High Court Decision, May 30, 2008 (2006 (Gyo KE) No. 10563)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2009, page 47, HANREI TIMES No. 1290, page 224
Application No.	Japanese Patent Application No. S62-299967 (JP H1-141904A)
Classification	C08G 59/40
Conclusion	Dismissal
Related Provision	(Former) Article 134(2), Proviso
Judges	IP High Court Special Division, Presiding Judge: Tomoichi TUKAHARA, Judge: Tetsuhiro NAKANO, Judge: Toshiaki IIMURA, Judge: Nobuyoshi TANAKA, Judge: Hiroki MORISHITA

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention is characterized in that, for the component (D) in the components of (A) to (D), employed was a particulate epoxy resin having poor solubility to the diluent in use as the thermosetting component. Such epoxy resin particles remained encased by a photosensitive prepolymer, and thereby, those effects are provided that the solubility and developability of the photosensitive prepolymer were not reduced, the exposed part thereof became less liable to the erosion by a developing solution, and also the storage life of the composition was extended.

(2) The description of Example 2, which was considered, from "the specification of the prior application (the specification originally attached to the request of Japanese Patent Application No. S62-114079, which was published as JP S63-278052A)"

""Example 2: A mixture consisting of about 230 parts by weight of a cresol novolak epoxy resin

(EOCN104) having an epoxy equivalent of about 230, 230 parts by weight of cellosolve acetate (an inert organic solvent), about 75 parts by weight of acrylic acid, about 2 parts by weight of hydroquinone monomethyl ether, and about 2 parts by weight of triethylamine as an esterification catalyst was reacted at about 80 °C for 20 hours to give an epoxy acrylate having an acid number of about 12. Then, to the resultant reaction product, about 74 parts by weight of phthalic anhydride was added to react at about 80 °C for 2 hours; to about 100 parts by weight of which, 5 parts by weight of pentaerythritol tetraacrylate, 10 parts by weight of polyfunctional epoxy resin (TEPIC), about 2 parts by weight of 2-methylantraquinone, and about 1 part by weight of dimethylbenzylketal, 0.5 parts by weight of 2-ethyl-methylimidazole are mixed to yield a composition of this invention. Then, this composition was applied in a thickness of 0.01~0.02 mm by the curtain coater method to one side of a copper-clad laminate, and then dried by heating at about 60 °C for 60 minutes to make it non-adhesive at room temperature; further, a negative film having a desired pattern was firmly contacted thereto, which was exposed to ultraviolet irradiation having a strength of 25 mw/cm<sup>2</sup> at a wavelength of 365 nm for 10 seconds and then developed with an aqueous solution of 1% sodium carbonate; and then, was cured at 150 °C for 30 minutes to provide heat resistance. On the resultant coating, the pattern having spaces between lines of 200 μm was represented, and also the coating had the solder dip resistance at 250 °C for 60 seconds." ..."

(Cited from the court decision)

(3) The Claims (before the corrections/after the corrections) (only Claim 1 provided)

before the corrections	after the corrections (the invention 1 of this case)
<p>[Claim 1] A photosensitive, thermosetting resin composition, comprising:</p> <p>(A) one or more photosensitive prepolymers having at least two ethylenically unsaturated bonds in one molecule, selected from one or more groups of (a), (b) and (c) below: ...;</p> <p>(B) a photoinitiator;</p> <p>(C) a photopolymerizable vinyl monomer and/or an organic solvent as a diluent; and</p> <p>(D) a particulate epoxy compound having at least two epoxy groups in one molecule and having poor solubility to the above diluent in use, wherein the epoxy compound is at least one solid or semi-solid epoxy compound selected from a groups consisting of diglycidyl phthalate resin ....</p>	<p>[Claim 1] A photosensitive, thermosetting resin composition, comprising:</p> <p>(A) one or more photosensitive prepolymers having at least two ethylenically unsaturated bonds in one molecule, selected from one or more groups of (a), (b) and (c) below: ...;</p> <p>(B) a photoinitiator;</p> <p>(C) a photopolymerizable vinyl monomer and/or an organic solvent as a diluent; and</p> <p>(D) a particulate epoxy compound having at least two epoxy groups in one molecule and having poor solubility to the above diluent in use, wherein the epoxy compound is at least one solid or semi-solid epoxy compound selected from a groups consisting of diglycidyl phthalate resin ....;</p> <p>provided that excluded are the photosensitive, thermosetting resin compositions comprising (A) a "reaction product obtained by reacting an</p>

	<u>epoxyacrylate, which has been obtained through the reaction of a cresol novolak epoxy resin and acrylic acid, with phthalic anhydride"; (B) "2-methylantraquinone" and "dimethylbenzylketal" corresponding to the photoinitiator; (C) "pentaerythritol tetraacrylate" and "cellosolve acetate"; and (D) a polyfunctional epoxy resin (TEPIC: from Nissan Chemical Industries LTD., a registered trademark), which is an "epoxy compound having at least two epoxy groups in one molecule".</u>
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Note that the invention described in Claim 1 of this case after the correction is called the "invention 1 of this case," the invention described in Claim 21 of this case after the correction is called the "invention 2 of this case," and both are called the "respective inventions of this case."

#### (4) Procedural History

- June 30, 2005 : the request for trial for patent invalidation by the plaintiff (Muko No. 2005-80204)
- November 29, 2005 : the first trial decision that "...the patent is invalidated."
- January 6, 2006 : the filing of the action to reverse the first trial decision by the defendant (patentee)
- March 30, 2006 : the request for the trial for corrections by defendant (the corrections of this case)
- April 26, 2006 : the decision of the reverse of the first trial decision
- July 5, 2006 : it was considered that the corrections of this case was requested (see the invention "after the corrections" above)
- November 28, 2006 : the trial decision that "The corrections are admitted. The appeal of this case does not materialize."

#### 3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>The trial decision determined that first, both of the respective inventions of this case before the corrections were made are the same as the invention described in the specification [1] below (hereinafter, "the specification of the prior application"), and then, the corrections of this case are the ones within the matters described in the specification, and also the purpose of the corrections is to restrict the scope of claims or clarify the unclear description, and thus, because the corrections do not substantially extend or change the scope of claims, the corrections were admitted, and therefore, ...the patent of this case cannot be invalidated.</p> <p>...the trial decision determined that the respective inventions of this case and the invention described in Example 2 of the specification of the prior application (...called the "cited invention") are different in technical</p>
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idea, and the corrections related to the corrected matters (1) and (2) in the corrections of this case (Hereinafter, they are called, in accordance with the numbers attached to the corrected matters, the "correction 1 of this case" and the "correction 2 of this case"; both of them together are called the "respective corrections of this case.") correspond to so-called "exclusion claims" wherein only the constitution related to the cited invention is excluded from the respective inventions of this case before the corrections were made, and it could be recognized that the corrections were made within the matters described in the specification of this case in an exceptional move, the purpose of which, therefore, was to restrict the scope of claims ....

Decision

Allegations by Plaintiff

(2) The respective corrections of this case intend to exclude the cited invention by the "exclusion claims," but the description on the "exclusion claim" in the Examination Guidelines for Patent and Utility Model (hereinafter, "Examination Guidelines") violates the regulation of the Patent Act, and therefore fundamentally, those corrections should not be admitted.

Even if these are admitted in an exceptional move, ..., it is recognized that, in accordance with the Examination Guidelines, an invention is required to be "significantly different in prior art and technical idea" and also to "have a fundamental inventive step" in order that the correction by an "exclusion claim" is admitted.

...the respective corrections of this case do not comply with the requirements for admission of an "exclusion claim" in an exceptional move, and therefore, do not correspond to an instance wherein "a correction should be made within the matters originally described in the specification, etc."

(3) Also in the description of the scope of claims after the respective corrections of this case, wherein the combination remains in which "TEPIC" is included as the component (D), the resin bearing the registered trademark "TEPIC" include more than one types, by which a single resin is not meant, and therefore, it is not possible to technically identify the

Allegations by Defendant

While, in the specification of the prior application, the composition, which happened to be identical to the composition of the invention 1 of this case, is merely disclosed in Example 2, this composition was excluded from the scope of claim of this case by the respective corrections of this case, and therefore, it should not be understood that the invention 1 of this case is disclosed in the specification of the prior application.

...while in Example 2 in the specification of the prior application, "TEPIC" is described as one component constituting the composition thereof, the respective corrections of this case appropriately exclude the composition described in Example 2 by faithfully referencing to the description in Example 2, and as a result, the trade name is described in the "exclusion claims," but ...since the use of a trade name is accepted if unavoidable, the allegation of the plaintiff is unreasonable.

<p>content of the "exclusion claims" by the description of the registered trademark "TEPIC." ...it is interpreted that the respective corrections of this case are not made "within the matters described in the specification or depicted in the drawings," and also does not aim at "restricting the scope of claims."</p>	
<p><b>Judgement by the Court</b></p> <p>...the "matter described in the specification or depicted in the drawings" means a technical matter derived through piecing together all description in the specification or depiction in the drawings by a person skilled in the art, and when the amendment does not introduce a new technical matter in relation to the technical matter derived in this manner, it can be recognized that such amendment is made "within the matters described in the specification or depicted in the drawings."</p> <p>Moreover, the similar language in Article 134(2), Proviso of the Patent Act should be interpreted in a similar manner, and when a correction does not introduce a new technical matter in relation to the technical matter derived through piecing together all description in the specification or depiction in the drawings by a person skilled in the art, it can be recognized that such correction is made "within the matters described in the specification or depicted in the drawings."</p> <p>However, matters described in the specification or depicted in the drawings, in general, relate to the technical idea disclosed by such specification or drawings, ...when a corrected matter added is explicitly described or depicted in such specification or drawings or is self-evident from the description or depiction thereof, it can be recognized that such correction, unless the circumstances dictate otherwise, does not introduce a new technical matter, and is made "within the description or depiction of the specification or drawings."</p> <p><u>...it is not recognized that the exclusion of the specific combination, which is the content in the cited invention, does not result in any change in the technical matter related to the respective inventions described in the specification of this case before the corrections were made, and therefore, it is evident that the respective corrections of this case do not add a new technical matter to the technical matter disclosed in the specification of this case, and it can be recognized that it is evident that the respective corrections of this case do not introduce a new technical matter in relation to the technical matter derived through piecing together all description in the specification or depiction in the drawings by a person skilled in the art.</u></p> <p>Therefore, it is recognized that the respective corrections of this case ...are made "within the matters described in the specification or depicted in the drawings attached to the application."</p> <p>...the corrections are for excluding the part identical to the invention of the prior application, and therefore, the "TEPIC" in the respective corrections of this case is recognized as referring to the "TEPIC" described in Example 2 in the specification of the prior application. Thus, the "TEPIC" of the respective corrections of this case can be recognized to be limited to all products specified by the registered trademark "TEPIC" as of the application of the prior patent defined by the specification thereof, and therefore, based on such limitation, it cannot be said that the thing specified by the registered trademark of "TEPIC" is not technically evident.</p>	

The content of the respective corrections of this case is specified by a ...passive form of expression (the so-called form of "exclusion claims"), and it is believed that this is the only way by which the part identical to the cited invention is appropriately excluded.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.1(4)
Classification of the Case	81-4: As to whether amendment to originate an excluding claim against claims adds a new matter or not
Keyword	

## 1. Bibliographic Items

Case	"Adsorbent for oral administration" (Trial for Invalidation) Intellectual Property High Court Decision, March 31, 2009 (2008 (Gyo KE) No. 10358)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-548107 (International Publication No. WO2004/039381)
Classification	A61K 33/44
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Hiroaki IMAI, Judge: Chieko SHIMIZU

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The purpose of the claimed invention is to find an adsorbent for oral administration, which is far superior in selective adsorbent property, that is, good at adsorbing an uremic substance,  $\beta$ -aminoisobutyric acid, but poor at adsorbing beneficial substances such as  $\alpha$  amylase, compared to the oral adsorbent comprising the conventional porous spherical carbonaceous material obtained by preparing spherical activated carbon from tars followed by oxidation-reduction.

## (2) Disclosure of Detailed Description of the Invention

"In addition, in Examples, compared to Comparative Examples using tars as a carbon source, the adsorbents using a phenol resin as a carbon source, even when not treated with oxidation-reduction (Example 1, 2), are superior in selective adsorption rate to the adsorbent in Comparative Example 1, which was treated with oxidation-reduction (the adsorbent using an ion exchange resin as a carbon source [Example 5], which, however, is not within the scope of the invention of this case after the decision to grant a patent was made, because the conditions of the pore volume do not satisfy the conditions described in Claim 1, has a higher selective adsorption rate compared to Comparative Examples 1, 2).

Thus, it is recognized that the feature of the invention of this case originally described in the specification is the use of a thermosetting resin, substantially, a phenol resin or ion exchange resin, as a carbon source for spherical activated carbon to be used for an adsorbent for oral administration, and thereby, the effect is provided that the selective adsorbent property is improved compared to the conventional spherical activated carbon using tars." (Cited from the court decision)

(3) The description of the "patent of another case," which was considered (Japanese Patent No. 3672200) (Identified by the court decision)

"...in the patent of a separate case, as for an agent for oral administration comprising spherical activated carbon, in addition to a diameter and specific surface area, by focusing attention to its porous structure, the X-ray diffraction intensity providing the best selective adsorbent property was defined in terms of a diffraction angle as an R value, and the feature lies in this R value being 1.4 or greater. The patent of the separate case relates to spherical activated carbon, and, unlike the patent of this case, does not specify a phenol resin or ion exchange resin as a starting material. Moreover, in the patent of this case, while the preparation is possible even by using tars that is recognized to belong to the prior art, the spherical activated carbon was specified in terms of this R value ...." (Cited from the court decision)

(4) The Claims (before the amendment/after the amendment) (only Claim 1 provided)

before the amendment	after the amendment (the patented invention 1 of this case)
<p>[Claim 1] An adsorbent for oral administration characterized in that the adsorbent is manufactured with a phenol resin or ion exchange resin as a carbon source and comprises spherical activated carbon having a diameter of 0.01 to 1 mm, a specific surface area of 1000 m<sup>2</sup>/g or greater calculated by Langmuir adsorption isotherm, and a volume of the pore of the spherical activated carbon having a pore diameter of 7.5 to 15000 nm is less than 0.25 mL/g.</p>	<p>[Claim 1] An adsorbent for oral administration characterized in that the adsorbent is manufactured with a phenol resin or ion exchange resin as a carbon source and comprises spherical activated carbon having a diameter of 0.01 to 1 mm, a specific surface area of 1000 m<sup>2</sup>/g or greater calculated by Langmuir adsorption isotherm, and a volume of the pore of the spherical activated carbon having a pore diameter of 7.5 to 15000 nm is less than 0.25 mL/g;  <u>provided that excluded is the spherical activated carbon having a diffraction intensity ratio (R value) of 1.4 or greater, which is calculated by Equation (1):</u>  <math display="block">R = (I_{15} - I_{35}) / (I_{24} - I_{35}) \quad (1)</math> <u>[wherein I<sub>15</sub> is the diffraction intensity at a diffraction angle (2θ) of 15° by X-ray diffraction; I<sub>35</sub> is the diffraction intensity at a diffraction angle (2θ) of 35° by X-ray diffraction; and I<sub>24</sub> is the diffraction intensity at a diffraction angle (2θ) of 24° by X-ray diffraction.]</u></p>

(5) Procedural History

- June 16, 2006 : the amendment by the defendant (patentee) (see the invention "after amendment" above)
- August 4, 2006 : the registration of the establishment of the patent right
- February 29, 2008 : the trial for patent invalidation by the plaintiff (Muko No. 2008-800042)
- September 2, 2008 : the trial decision that "The appeal of this case does not materialize."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial decision	
<p>...the "description of exclusion" of the patent of this case is not recognized as changing in any way the technical matter related to the respective inventions described in the specification before the amendment was made, and therefore, it is evident that the amendment, by which the "description of exclusion" is added in the patent of this case, does not cause the addition of a new technical matter to the technical matters disclosed in the specification, etc., and thus, it is suitable to interpret that the amendment does not introduce a new technical matter in relation to the technical matters derived through piecing together all descriptions in the specification of this case by a person skilled in the art.</p>	
Decision	
<p><b>Allegations by Plaintiff</b></p> <p>A The amendment of this case is particularly an addition by means of exclusion to the scope of claims before the amendment was made, by which imposed is a limitation that "the diffraction intensity ratio (R value) is less than 1.4," which is merely expressed as "excluded is the spherical activated carbon having a diffraction intensity ratio (R value) of 1.4 or greater."</p> <p>D .... the amendment of this case resulted in the "exclusion" of all of those examples from the scope of claims, and as a result, ...no pharmacological effect provided by the invention of this case after the amendment was made (the invention having an R value of less than 1.4) has not been disclosed at all in the specification. This means that, as of the priority date of the patent of this case, the defendant had not completed the invention defined by the scope of claims with the amendment made thereto in this</p>	<p><b>Allegations by Defendant</b></p> <p>...the allegation of the plaintiff is not based on the criteria determined by the grand panel decision ..., but is based on his/her own standard, which focuses attention to the matter to be amended in this case, and thus, there is no room for the allegation to materialize.</p> <p>That is, the plaintiff presupposes his/her own standard that "when an amendment that limits the matters specifying the invention (restriction by limitation) or is provided by an addition by means of exclusion is not based on the matter that is clearly stated in the original specification or self-evident from the original specification recognized as if described therein, such amendment is against the law" and applies this standard to the amendment of this case to derive the conclusion.</p>

<p>case .... The cause of this error of not completing the invention is particularly the amendment of this case being a new technical matter. It is necessary to keep it in mind that what differs from the concern in the grand panel decision is that the invention after the exclusion was made lacks the support from the detailed explanation of the invention.</p>	
<p><b>Judgement by the Court</b></p> <p>(4) The judgement whether or not the amendment of this case is appropriate</p> <p><b>B</b> That is, the amendment of this case is ...as for spherical activated carbon, to exclude the one ..., which has a diffraction intensity ratio (R value) of 1.4 or greater.</p> <p>On the other hand, ...in the invention of this case originally described in the specification, for the spherical activated carbon to be used for an adsorbent for oral administration, ...a phenol resin or ion exchange resin is used as a carbon source, and thereby, the effect is provided that the selective adsorbent property is improved, good at adsorbing an uremic substance as well as poor at adsorbing beneficial substances, compared to the conventional spherical activated carbon using pitch.</p> <p><u>...as for spherical activated carbon, when the one using phenol resin or ion exchange resin is used as a carbon source, if it has an R value of 1.4 or greater, the invention of the patent of this case and the invention of the patent of the separate case can be considered as identical.</u> In addition, <u>while the purpose of the amendment of this case is to exclude the spherical activated carbon having this R value of 1.4 or greater from the description of the claims</u>, it is suitable to recognize that, in view of the what is originally described in the above specification of this case, the amendment of this case does not introduce a new technical matter in relation to the technical matters derived through piecing together all what is described or depicted in the specification, claims or drawings.</p> <p><b>C</b> The supplementary judgement to the allegation by the plaintiff</p> <p>...the amendment of this case to exclude the portion having a diffraction intensity ratio (R value) of 1.4 or greater excludes the portion identical to that in the patent of another case, but does not impose a limitation to the description of the claims from a technical point of view, and thus not corresponding to the addition of a new matter.</p> <p>...the invention originally described in the specification of this case uses, for spherical activated carbon to be used for an adsorbent for oral administration, a thermosetting resin, substantially, a phenol resin or ion exchange resin, as a carbon source, and thereby, the effect is provided that the selective adsorbent property is improved compared to the conventional spherical activated carbon using pitch, and, unlike the patent of another case, the invention originally described in the specification of this case does not define the spherical activated carbon in terms of the diffraction intensity ratio (R value) by X-ray diffraction.</p> <p>...according to ...the certificate of experimental results B ..., in the preparation in Reference Example using a phenol resin as a carbon source, although the R value is less than 1.4, a selective adsorption rate superior to</p>	

the conventional spherical activated carbon ...is shown, .... ...according to ...the certificate of experimental results A ..., in the preparation in Reference Example using an ion exchange resin as a carbon source, although the R value is less than 1.4, a selective adsorption rate superior to the conventional spherical activated carbon ...is shown, ....

Based on these, even when the invention of this case is examined in terms of ...the R value, the invention of this case cannot be said to be incomplete. Moreover, the preparation of spherical activated carbon, which satisfies the conditions of ...described in the scope of claims, with the use of a phenol resin or ion exchange resin as a carbon source is exactly as described in the detailed explanation of the invention in the original specification of this case, and thus, it cannot be said that there is no support from the detailed explanation of the invention.

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Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.2
Classification of the Case	82: As to whether amendment to the description and drawings adds a new matter or not
Keyword	Amendment for adding contents of the prior art

### 1. Bibliographic Items

Case	"Two-sided hybrid DVD-CD disc" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, December 19, 2005 (2005 (Gyo KE) No. 10050)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-537878 (JP 2000-509879A)
Classification	G11B 7/007
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court First Division, Presiding judge: Katsumi SHINOHARA, Judge: Mitsuru SHISHIDO, Judge: Kaoru AOYAGI

### 2. Overview of the Case

#### (1) Summary of Claimed Invention

The claimed invention relates to a two-sided hybrid DVD-CD disc (compact disc) to record data both in standard audio CD format and in a super-dense (DVD) format on a same structure. In the claimed invention, first and second half-height compact disc surfaces, the heights of which are half of a thickness of a conventional (currently typical) CD disc, having data recorded therein in first and second data formats, respectively, are held together by an adhesive layer to form a compact disc of full height, and the disc formed in this way is playable in a conventional CD player or DVD player.

#### (2) Statements in the description, etc. (Before and after the amendment)

Before the amendment	After the amendment (Underlines are added to the amended parts)
[Detailed Description of the Invention] Field of the invention of a two-sided hybrid DVD-CD disc  The present invention relates to compact discs for	[Detailed Description of the Invention] [Field of the Invention] [0001] The present invention relates to <u>hybrid discs</u>

<p>optically storing primarily digital data in a series of pits and lands on a plastic surface. In particularly, the present invention relates to data storage in both a standard audio CD format and in a super-dense (DVD) format on the same structure.</p> <p>Background of the Invention</p> <p>Compact discs are ... digital or analog information, ... In this manner, the length of the pits is detected and decoded as data.</p> <p>(Cited from National Publication of International Patent Application No. 2000-509879)</p>	<p><u>according to the preamble of Claim 1 of the claims. In such discs, digital data in the state of a series of pits and lands is primarily stored optically on a plastic surface. In particularly, the present invention relates to storing data both in a standard audio CD format and a super-dense (DVD) format on the same structure.</u></p> <p>[Conventional Art]</p> <p>[0002]</p> <p><u>The hybrid disc according to the preamble of Claim 1 of the claims is disclosed in JP H8-297659A. This document (for example, see Abstract) teaches a hybrid disc comprising two different discs 2a and 2b, which are a CD disc and a DVD disc, respectively. The thicknesses of the two discs are different from each other. The CD disc 2a, which has a thickness of 1.2 mm, includes a data storing surface 3a and a flat surface at an opposite side capable of reading the data storing surface 3a with a scanning laser. The data storing surface 3a is coated with a metallization layer. The DVD disc 2, which has a thickness of 0.6 mm, includes a data storing surface 3b and a flat surface at an opposite side capable of reading the data storing surface 3b with a scanning laser. The data storing surface 3b is coated with a metallization layer. The two discs whose data storing surfaces face each other are held together by an adhesive layer 5. The thickness (total height) of the entire hybrid disc is 1.8 mm. The ratio of the thickness of the CD disc 2a to the thickness of the DVD disc 2b is two to one.</u></p> <p>[0003]</p> <p><u>EP 0745985A ...</u></p> <p>[0004]</p> <p><u>WO 98/00842A ...</u></p> <p>[0005]</p> <p><u>Further, US Patent No. 5,509,991 ...</u></p> <p>[0006]</p> <p>Compact discs (hereinafter, referred to as "CD</p>
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	<p><u>discs" in some cases)</u> are ... digital or analog information, ... In this manner, the length of the pits is detected and decoded as data.</p> <p>(Cited from the written amendment of January 14, 2004)</p>
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(3) The Claims (Amended) (Only Claim 1 is shown)

[Claim 1] A two-sided hybrid disc including a CD disc and a DVD disc thicknesses of which are different from each other, the two-sided hybrid disc comprising: a CD disc including a data recording surface (7), a flat surface (5) at an opposite side through which a scanning laser scanning the data recording surface (7) passes and a metallization layer (9) coating the data recording surface (7); and a DVD disc including a data recording surface (27), a flat surface at an opposite side through which a scanning laser scanning the data recording surface (27) passes and a metallization layer coating the data recording surface, wherein the data recording surfaces (7) and (27) face each other, the CD disc and the DVD disc are held together by an adhesive layer, the ratio of the thickness of the CD disc to the thickness of the DVD disc is approximately 3 to 2, the CD and DVD discs held together by the adhesive layer have a thickness corresponding to a total height of a general CD disc.

(4) Procedural History

- December 16, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-24335)
- January 14, 2004 : Written amendment (see "After the amendment" recited in "the Claims" and "Statements in the description, etc." above)
- November 15, 2004 : Appeal decision: The present amendment was dismissed. "The request for appeals fails to lie."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>... "In the present amendment, ... the plaintiff ... added the names of the prior art documents in the detailed description of the invention, and further, specifically described the contents of these prior art documents. <u>This is an amendment for substantially adding information on evaluation of the invention or information on carrying out the invention, since the invention of the present application (Note: the claimed invention) is compared with the prior art.</u> Thus, this amendment was made beyond the scope of matters mentioned in the originally attached description etc." ...</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>... "... Part III Amendment of Description, Claims and Drawings, Section I New Matter, 5.</p>	<p>Allegations by Defendant</p> <p>... The amendment is not an amendment, as alleged by the plaintiff, for adding the names of the</p>

<p>Amendment of the detailed description of the invention, 5.2 Specific, (1) Addition of contents of the prior art document in Examination Guidelines" ... defines that "Pursuant to Article 36(4)(ii) of the Patent Law, the prior art document information (name of publications in which the relevant invention was stated and location of other information of the inventions disclosed in the publication) is required to be stated. Therefore, an amendment to add the prior art document information in "Background Art" of the detailed description of the invention and add contents stated in the document to "Background Art" are approved since the third party receives no unexpected disadvantages."</p> <p>The present amendment for adding the prior art documents made by the applicant <u>just adds the names of the plural prior art documents and describes the contents of these documents specifically.</u> The amendment <u>includes no comparison between the prior art and the claimed invention or no evaluation on the invention.</u> The amendment complies with the Examination Guidelines published by the Patent Office and does not add any new matters. Therefore, the amendment should be approved.</p>	<p>plural prior art documents and describing the contents of these prior art documents specifically. <u>This amendment adds information on evaluation of the claimed invention or information on carrying out the claimed invention.</u> The amendment, which fails to comply with the Examination Guidelines published by the Patent Office, is illegal.</p>
<p>Judgement by the Court</p> <p>... is considered, the amendment added, to paragraph [0002] of the amended description (Exhibit A6), the expression that "JP H8-297659A discloses the hybrid disc according to the preamble of Claim 1 ... The thickness of the entire hybrid disc (total height) is 1.8 mm. The ratio of the thickness of the CD disc 2a to that of the DVD disc 2b is 2 to 1" as the prior art.</p> <p>The above description not only adds JP H8-297659A as the prior art document, but also shows that the invention claimed in Claim 1 after the amendment assumes that "a disc formed by bonding two discs together; a CD disc and a DVD disc whose thicknesses are different from each other", and also shows that "the ratio of the thickness of the CD disc to that of the DVD disc is approximately 3 to 2", which differs from the ratio in the prior art (2 to 1). It is thus recognized that the amendment <u>corresponds to an amendment adding information on evaluation of the claimed invention or information on carrying out the claimed invention.</u></p> <p>Therefore, the appeal decision, in which the amendment of the detailed description of the invention of the present amendments was made beyond the matters mentioned in the description etc., is correct.</p>	

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Relevant portion of Examination Guidelines	Part IV, Chapter 2, 3.3.2
Classification of the Case	82: As to whether amendment to the description and drawings adds a new matter or not
Keyword	

### 1. Bibliographic Items

Case	"Non-aqueous electrolyte" (Opposition to the grant of a patent) Intellectual Property High Court Decision, June 29, 2006 (2005 (Gyo KE) No. 10607)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-230072 (JP H10-74537A)
Classification	H01M 10/40
Conclusion	Dismissal
Related Provision	Article 17bis(3)
Judges	IP High Court Third Division, Presiding judge: Hisao SATO, Judge: Ryoichi MIMURA, Judge: Yuji KOGA

### 2. Overview of the Case

#### (1) Summary of Claimed Invention

The claimed invention relates to a non-aqueous electrolytic secondary battery that has excellent characteristics of high voltage and high capacity, and excellent charging/ discharging cycle characteristics, the battery containing a non-aqueous electrolytic solution containing an anode, a cathode, and lithium salt, where a specific compound is contained in the battery.

#### (2) Disclosure of Detailed Description of the Invention

"(1) "[Prior Art] A non-aqueous electrolyte secondary battery (lithium secondary battery) using lithium contains a non-aqueous electrolytic solution containing an anode and a cathode capable of reversibly storing and releasing lithium, and lithium salt, and a member arranged to appropriately hold and isolate the anode, the cathode, and the non-aqueous electrolytic solution. Lithium has a light and extremely low potential, so that a secondary battery containing lithium or a lithium alloy as a cathode has excellent characteristics of high voltage and high capacity while also having a defect that dendrite is likely to be precipitated to develop a short circuit. In a battery containing a carbon material as a cathode, while improvement in cycle characteristics that the reduction in capacity when charge and discharge cycles are repeated over a long period of time is low is

acknowledged, the capacity of the battery containing a carbon material is not nearly as high as the capacity of the battery containing lithium metal as a cathode. Meanwhile, in a battery containing an amorphous oxide or a chalcogen compound as a cathode material, the lithium storage amount exponentially increases, whereby an excellent secondary battery having an extremely large capacity can be obtained. However, this battery has a problem in that the reduction in capacity is observed when charge and discharge cycles are repeated over a long period of time. ..." (paragraph [0002])

(2) "[Problem to be solved by the Invention] The object of the present invention is to improve the cycle characteristics of a lithium secondary battery, and in particular to improve the cycle characteristics of a lithium secondary battery containing an amorphous oxide or a chalcogen compound as a cathode material. (paragraph [0003])..." (cited from the Court Decision)

(3) Matters in Description, etc. (Before Amendment and After Amendment)

Before Amendment	After Amendment
<p>..."The cathode material according to the present invention is mainly an amorphous chalcogen compound or oxide containing three or more types of atoms chosen from 1, 2, 13, 14, and 15 group atoms in the periodic table. ..." (paragraph [0030]) ...</p>	<p>..."It is preferable that the cathode material according to the present invention should be mainly an amorphous chalcogen compound or oxide containing three or more types of atoms chosen from 1, 2, 13, 14, and 15 group atoms in the periodic table. ..." (paragraph [0025]) ...</p>
<p>..."...Example-1 ...[Preparation of cathode mixture paste] Cathode material; 200 g of <math>\text{SnGe}_{0.1}\text{B}_{0.5}\text{P}_{0.58}\text{Mg}_{0.1}\text{K}_{0.1}\text{O}_{3.35}</math> (...no crystalline diffraction line was observed) ...was added to be further kneaded and mixed to prepare a cathode mixture paste. ...Electrolytic solutions 1 to 18 were each injected in the battery cans, ...to prepare cylindrical batteries (1 to 18)." (paragraphs [0062] to [0066])</p>	<p>..."...[Example-1] ...[Preparation of cathode mixture paste] Cathode material; 200 g of <math>\text{SnGe}_{0.1}\text{B}_{0.5}\text{P}_{0.58}\text{Mg}_{0.1}\text{K}_{0.1}\text{O}_{3.35}</math> (...no crystalline diffraction line was observed) ...was added to be further kneaded and mixed to prepare a cathode mixture paste. ...Electrolytic solutions were each injected in the battery cans, ...to prepare cylindrical batteries. ...Relative capacities of the prepared batteries (...) and cycle characteristics of the prepared batteries (...) are shown in Table 2." (paragraphs [0059] to [0064]) ...</p>
<p>"...Example-2 ...Cylindrical batteries (battery numbers 1a to 10a) were prepared in the same manner as Example 1 except that graphite powder was used as a cathode material. Charge and discharge cycles were repeated on the batteries prepared in the above-described manner under the conditions of current density of 4.8 mA/cm<sup>2</sup>, charge termination voltage of 4.1 V, and discharge termination voltage of 2.8 V, and the discharge capacity in each cycle was</p>	<p>..."[Example-2] ...Cylindrical batteries (battery numbers 1a, 7a, and 8a) were prepared in the same manner as Example 1 except that graphite powder was used as a cathode material. ... Relative capacities of the prepared batteries (capacities of the batteries in the first cycles that were normalized by the capacity of battery 1 shown in Table 2) and cycle characteristics of the prepared batteries (ratios of discharge capacities of</p>

calculated. Relative capacities of the prepared batteries (capacities of the batteries in the first cycles that were normalized by the capacity of battery 1) and cycle characteristics of the prepared batteries (ratios of discharge capacities of the batteries in the 300<sup>th</sup> cycles to the discharge capacities in the first cycles) are shown in Table 2." (paragraph [0067]) ...

..."Table 2 shows that the cycle characteristics are improved when the compounds represented by general formula (1) are added to the batteries. Among the compounds, this effect is remarkably enhanced when exemplary compounds 12, 13, 14, 15, 16, 17, 19, and 20 are added. As for the effect of the addition amounts of exemplary compounds (12), the cycle characteristics are good and preferable when the added concentration is 0.01 mass percent. In a battery containing graphite as a cathode material, the capacity is small from the beginning. In addition, even when the compound according to the present invention is added to the battery, little effect of improving the cycle characteristics is produced. Thus, the performance of the battery containing graphite powder as a cathode material is not as good as that of the battery according to the present invention with all things considered."(paragraph [0069]) ...(cited from the Court Decision)

[Table 2]

Table 2 Performance of prepared non-aqueous secondary battery

Electrolytic solution number	Additive	Added concentration (mass %)	Relative capacity	Cycle characteristics	Remarks
1	No additive	—	1	0.65	Comparative example Present invention
2	compd. (1)	1	0.99	0.74	
3	compd. (3)	1	1.01	0.78	
4	compd. (5)	1	1.00	0.73	
5	compd. (7)	1	1.00	0.73	
6	compd. (9)	1	1.01	0.75	
7	compd. (12)	1	0.99	0.85	
8	compd. (13)	1	0.99	0.84	
9	compd. (14)	1	1.00	0.80	
10	compd. (15)	1	0.99	0.81	
11	compd. (16)	1	1.02	0.81	
12	compd. (17)	1	0.99	0.83	

the batteries in the 300<sup>th</sup> cycles to the discharge capacities in the first cycles) are shown in Table 3." (paragraph [0065]) ...

..."Table 2 and Table 3 show that the cycle characteristics are improved when the compounds represented by general formula (1) are added to the batteries. As for the effect of the addition amounts of exemplary compounds (12), the cycle characteristics are good and preferable when the added concentration is 1 mass percent. In the battery containing graphite as a cathode material, the capacity is small from the beginning."(paragraph [0068]) ...(cited from the Court Decision)

Table 2 Performance of prepared non-aqueous secondary battery

Electrolytic solution number	Additive	Added concentration (mass %)	Relative capacity	Cycle characteristics
1	No additive	—	1	0.65
7	compd. (12)	1	0.99	0.85
8	compd. (13)	1	0.99	0.84
11	compd. (16)	1	1.02	0.81
12	compd. (17)	1	0.99	0.83
14	compd. (20)	1	1.00	0.85
15	compd. (12)	0.2	1.00	0.71
16	compd. (12)	0.5	0.99	0.75
17	compd. (12)	2	0.98	0.82
18	compd. (12)	5	0.97	0.80

Table 3 Performance of prepared non-aqueous secondary battery

Electrolytic solution number	Additive	Added concentration (mass %)	Relative capacity	Cycle characteristics
1a	No additive	—	0.83	0.70
7a	compd. (12)	1	0.84	0.71
8a	compd. (13)	1	0.83	0.70

(cited from Japanese Patent No. 3417228)

13	compd. (19)	1	1.01	0.74	"
14	compd. (20)	1	1.00	0.85	"
15	compd. (12)	0.2	1.00	0.71	"
16	compd. (12)	0.5	0.99	0.75	"
17	compd. (12)	2	0.98	0.82	"
18	compd. (12)	5	0.97	0.80	"
1a	No additive	—	0.83	0.70	Comparative example
2a	compd. (1)	1	0.84	0.73	"
3a	compd. (3)	1	0.82	0.70	"
4a	compd. (5)	1	0.83	0.73	"
5a	compd. (7)	1	0.83	0.72	"
6a	compd. (9)	1	0.84	0.73	"
7a	compd. (12)	1	0.84	0.71	"
8a	compd. (13)	1	0.83	0.70	"
9a	compd. (14)	1	0.83	0.71	"
10a	compd. (15)	1	0.82	0.71	"

(cited from JP H10-74537A)

## (4) Procedural History

- May 17, 2002 : Submission of written amendment (Amendment of the entire description)  
(Amendment 1)  
(See the above-described "After Amendment" of "Matters in Description, etc.")
- April 11, 2003 : Registration of establishment of the patent right
- November 21, 2003 : Opposition to the grant of a patent (Igi No. 2003-72844)
- September 28, 2004 : Notice of reasons for revocation
- December 7, 2004 : Request for correction
- June 20, 2005 : Decision "to revoke the patent"

## 3. Portions of Appeal/Trial Decisions relevant to the Holding

Decision (cited from the Court Decision)
<p>...Amendment 1 is addition of new matter. The present patent is granted to a patent application in which amendments are made which does not meet the requirements under Patent Act Article 17bis(3), and thus the patent should be revoked under the provision of Patent Act Article 113(i) in the 2003 Act 47 before the revision.</p> <p>In Amendment 1, the "Remarks" column provided in order to distinguish the "Present invention" (meaning "Example") from the "Comparative example" was removed from the descriptions of [Table 2] on Exhibit 1 while only some specific examples were chosen to be filled in [Table 2] and [Table 3]. The reason why Amendment 1 is addition of new matter made in the Decision is because "In a battery containing graphite as a cathode material" is included as Example in the invention after amendment by Amendment 1. Because the invention including "In a battery containing graphite as a cathode material" as Example is not stated in the description or drawings of the original application (hereinafter, referred to as the "originally attached description"), Amendment 1 is not made within the subject matters stated in the originally attached description....</p>
Decision

Allegations by Plaintiff	Allegations by Defendant
<p>The Decision should be rescinded because Amendment 1 was misjudged to be addition of new matter despite that in Amendment 1, the detailed explanation of the invention was amended in accordance with the scope of claims ...in the originally attached description, and the amendments are correction of errors or amendments corresponding to clarification of unclear descriptions....</p> <p>1 Example and Comparative example</p> <p>(1) There is a description of "Example-2" about a battery containing graphite powder in the originally attached description at the paragraph [0067].</p> <p>(2) " " " in the remarks column in [Table 2] in the originally attached description is an error.</p> <p>(3) The explanation in the originally attached description at the paragraph [0069] is merely a description emphasizing the effect of a tin compound.</p> <p>Considering the description in the scope of claims in the originally attached description, the description at the paragraph [0069] "In a battery containing graphite as a cathode material, the capacity is small from the beginning. In addition, even when the compound according to the present invention is added to the battery, little effect of improving the cycle characteristics is produced. Thus, the performance of the battery containing graphite powder as a cathode material is not as good as that of the battery according to the present invention with all things considered." is merely a description emphasizing that the addition effect ...of the additive of the present invention is remarkably produced in using a tin compound that is a preferable cathode material while effect of improving the cycle characteristics is produced in using graphite powder as a cathode material. Thus, it is obvious that the description is not intended to exclude "graphite" from</p>	<p>The judgement of the Decision is reasonable, and there is no reason to rescind the Decision.</p> <p>1 Example and Comparative example</p> <p>The plaintiff alleges that there is a description of "Example-2" about a battery containing graphite powder in the originally attached description at the paragraph [0067], and " " " in the remarks column in [Table 2] is an error.</p> <p>However, even the title "Example-2" is given, as for the batteries of electrolytic solution numbers 7a and 8a in [Table 2], described explicitly in the originally attached description (paragraph [0069]) is a negative evaluation stating "In a battery containing graphite as a cathode material, the capacity is small from the beginning. In addition, even when the compound according to the present invention is added to the battery, little effect of improving the cycle characteristics is produced. Thus, the performance of the battery containing graphite powder as a cathode material is not as good as that of the battery according to the present invention with all things considered." Therefore, there is no contradiction in understanding the batteries of electrolytic solution numbers 7a and 8a as "Comparative examples", and interpreting these negative specific examples as Examples is, on the contrary, beyond the scope of understanding of a person skilled in the art who reads the originally attached description.</p> <p>Thus, the specific examples of the electrolytic solution numbers 7a and 8a should be understood to mean "Comparative examples" according to the description in [Table 2] based on the above description in the originally attached description, and there is no reason to admit " " " in the remarks column in [Table 2] is a manifest error.</p> <p>2 Limitation of a cathode material</p>

<p>the cathode material of the secondary battery according to the present invention.</p> <p>2 Limitation of a cathode material</p> <p>The originally attached description has no description of excluding a "carbonaceous material such as graphite" from the cathode material.</p> <p>3 Disadvantage of a third party</p> <p>...The description indicated by the defendant is published including the description of the scope of claims, so that the third party understands the invention described in the originally attached description while considering the described matters in the scope of claims. Thus, it is impossible for the third party to have a misunderstanding like the allegations by the defendant. That is, considering the description in the scope of claims and the concrete data indicated in Examples and Comparative examples, it should be understood that the technical concept of using a non-aqueous electrolytic solution containing the specific compound of the original invention in a lithium secondary battery containing the cathode that is graphite is stated in the originally attached description.</p>	<p>Even if the material of the "cathode" is not limited in the description in the scope of claims, the battery containing a cathode using "graphite" is a "Comparative example" such that a person skilled in the art cannot recognize the battery to be capable of solving the expected problem described in the detailed explanation of the invention, so that the cathode using "graphite" cannot be an "Example", and cannot be understood to be included in the invention described in the scope of the claims to be supported by the contents described in the detailed explanation of the invention.</p> <p>3 Disadvantage of a third party</p> <p>In the originally attached description, the battery containing graphite as the cathode is described as a "Comparative example" of which the performance is not as good as that of the "Example" that produces the expected effect. If also this "Comparative example" is understood as the invention described in the scope of claims, it is obvious that a third party who trusts the described matters in the originally attached description will suffer an unanticipated disadvantage.</p>
<p>Judgement by the Court</p> <p>3 Example and Comparative example</p> <p>(1) ...It is recognized that the content of Amendment 1 is to the effect that the remarks column was removed from [Table 2] in the originally attached description while some specific examples including "1" and "1a" were chosen among the electrolytic solution numbers "1 to 18" and "1a to 10a" in [Table 2] to newly create [Table 2] and [Table 3], and thereby the specific examples of electrolytic solution numbers 7a and 8a in [Table 2] in the originally attached description are Examples of the present invention after amendment ....</p> <p>(2) The plaintiff alleges that there is a description of "Example-2" about a battery containing graphite powder in the originally attached description at the paragraph [0067].</p> <p>...As long as the heading of "Example" is used in the originally attached description so as to include both of "Comparative example" and the "present invention" in [Table 2], even if only "Comparative example" in [Table 2] is explained below the heading of "Example", it is never unreasonable. Thus, the allegations by plaintiff that the "batteries of electrolytic solution numbers 1a to 10a" in [Table 2] are Examples on the ground that "Example" is used for the heading cannot be adopted.</p>	

(3) The plaintiff alleges that " " in the remarks column in [Table 2] in the originally attached description is an error.

...In general, when there is a description of " " in a table, " " is interpreted to mean the same letters as the above. Thus, it is natural to interpret the "batteries of electrolytic solution numbers 1a to 10a" as "Comparative Examples" in [Table 2] in the originally attached description. As described in the above description of (2), such interpretation does not contradict the description in the originally attached description corresponding to [Table 2]. Rather, as described later, it is hard to imagine that a person skilled in the art can understand the technical matter that the plaintiff alleges when he/she reads the originally attached description from the fact that such interpretation consists with the description in the originally attached description at the paragraph [0069]. Thus, it cannot be said that the description of the "batteries of electrolytic solution numbers 2a to 10a" in the remarks column in [Table 2] in the originally attached description is an error.

(4) Further, the description in the originally attached description at the paragraph [0069] describes "In a battery containing graphite as a cathode material, the capacity is small from the beginning. In addition, even when the compound according to the present invention is added to the battery, little effect of improving the cycle characteristics is produced. Thus, the performance of the battery containing graphite powder as a cathode material is not as good as that of the battery according to the present invention with all things considered.", when the "battery containing graphite as a cathode material" that includes the batteries of electrolytic solution numbers 7a and 8a is used. This description means a negative evaluation that the performance of "the battery containing graphite powder as a cathode material" is not as good as that of the battery applying the present invention" in comparison with the original invention, which corresponds with the description in the remarks column in [Table 2] that is made "Comparative example". Taking the above descriptions concerning the cathode material and the description in [Table 2] in the originally attached description as a whole, it is natural to interpret the "battery containing graphite as a cathode material" as "Comparative example" that has a result inferior to the original invention. Interpreting these negative specific examples as Examples of the original invention is beyond the scope of interpreting of a person skilled in the art who reads the originally attached description.

(5) As described above, in view of the above description in the originally attached description, it is natural to interpret the specific examples of the "electrolytic solution numbers 7a and 8a" as "Comparative Examples" as described in [Table 2] in the originally attached description. Therefore, Amendment 1 is addition of new "Examples" of the "electrolytic solution numbers 7a and 8a", and thus the decision that this amendment is judged as addition of new matter is not in error.

#### 4 Limitation of a cathode material

...Taking the descriptions concerning the cathode material and the description in [Table 2] in the originally attached description as a whole, while it is natural to interpret the "battery containing graphite as a cathode material" as "Comparative example" that has a result inferior to the original invention, there is no ground in the originally attached description that the battery subject to the original invention can be interpreted as including the "battery containing a carbonaceous material such as graphite", and thus when the cathode material is

graphite even if the description in the scope of claims does not limit the material of the "cathode", the conclusion of the above 3 that the battery is a "Comparative example" and not an "Example" is not influenced, so that the allegations by plaintiff is misfeasance.

5 Disadvantage of a third party

...The allegations by plaintiff are based on the premise that the clerical error stated in the above 3(3) of the allegations is obvious to a person skilled in the art, and because this premise is not admitted as described above, these allegations cannot be adopted. If a specific example (Comparative example) not to belong to the original invention in the originally attached description is made to be a specific example (Example) that belongs to the original invention, it is obvious that a third party will suffer an unanticipated disadvantage.

(84)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 4
Classification of the Case	84: As to whether it is contravention of Article 17bis(5) or not
Keyword	Amendment which increases the number of claims

1. Bibliographic Items

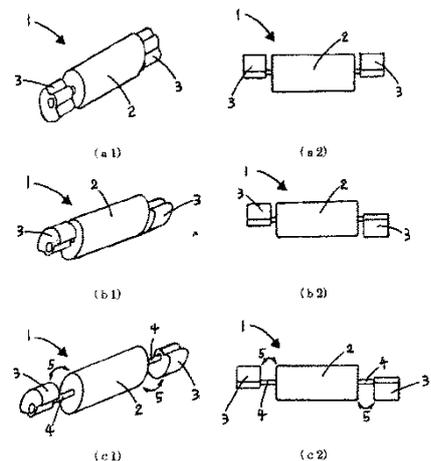
Case	"Vibration generator" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 20, 2010 (2010 (Gyo KE) No. 10051)
Source	Website of Intellectual Property High Court, Page 128 of HANREI JIHO No. 2113, Page 128, HANREI TIMES No. 1342, page 222
Application No.	Japanese Patent Application No. 2005-56554 (JP 2006-212608A)
Classification	B06B 1/16
Conclusion	Dismissal
Related Provision	(Former) any of the items set forth in Article 17bis(4)
Judges	IP High Court Fourth Division, Presiding judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Yasuto INOUE

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention provides a vibration generator for increasing a width of vibration having a structure in which shafts (4) of a small size motor for generating vibration (1) projects at both sides of a motor body (2), wherein mass eccentric weights (3) are secured at both ends of the shafts (4) and the weights 3 at both sides rotate to generate vibration, whereby a width of vibration generated is efficiently doubled.

[FIG. 1]



(2) The Claims (After Second Amendment, After Fourth Amendment)

After Second Amendment	After Fourth Amendment
[Claim 1] A vibration generator comprising a vibration motor, shafts projecting at both sides of a motor body, and mass eccentric weights provided at both ends of the vibration motor, wherein the mass	[Claim 1] A vibration generator comprising a vibration motor, shafts projecting at both sides of a motor body, and mass eccentric weights provided at both ends of the vibration motor, wherein the mass eccentric weights are

<p>eccentric weights are around the center point of the motor body, and attached approximately-symmetrically at the shafts respectively, a width of vibration is set by modifying a distance between the motor body and the mass eccentric weights to determine a magnitude of vibration and setting an attaching position for the mass eccentric weights, and the distance is a half of a width in axial direction.</p>	<p>around the center point of the motor body, and attached approximately-symmetrically at the shafts respectively, the vibration generator has the characteristic in which a magnitude of vibration generated in the vibration generator changes by modifying a distance between the motor body and the mass eccentric weights, and the distance is adjusted as to correspond to a distance by which a desired width of vibration is obtained applying the characteristic.</p> <p>[Claim 2] The vibration generator according to claim 1, the distance between the motor body and the mass eccentric weights is approximately longer than or equal to two thirds of a width in axial direction of the shaft of each of the mass eccentric weights.</p> <p>[Claim 3] The vibration generator according to claim 1 or 2, the mass eccentric weights have a semi-circular cross section shape, and corners of the both ends of the mass eccentric weights are rounded.</p>
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### (3) Procedural History

- April 11, 2007 : Notice of Reasons for Refusal
- June 25, 2007 : Filing of Amendment (Second Amendment) (see "After Second Amendment")
- August 13, 2007 : Final Notice of Reasons for Refusal (Second Amendment includes new matters (Article 17bis(3))
- October 22, 2007 : Filing of Amendment (Third Amendment)
- February 5, 2008 : Decline of Third Amendment (Violation of Requirements under Provision of Article 17bis(3)), Decision of Refusal
- March 17, 2008 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2008-6589)
- April 11, 2008 : Filing of Amendment (Fourth Amendment) (see "After Fourth Amendment")
- January 4, 2010 : Appeal Decision to Decline the fourth amendment and "Dismiss the appeal"

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p>
<p>... (1) <u>The fourth amendment was for increasing the number of claims amended from one to three in the second amendment. Thus, the fourth amendment was not for any of the purposes under the provisions of Article 17bis(4) of the Patent Act (hereinafter, referred to as "Act") prior to the revision by Act No. 55 of 2006, and</u></p>

should be declined. (2) The second amendment could not be recognized to be made within a scope of the original disclosure, to satisfy the requirements under the provisions of Article 17bis(3), and the present invention is for ... Article 49(1)(i) and (iv), thus, the present invention should be refused under the provisions of Article 49(1) ... .

Decision

<p><b>Allegations by Plaintiff</b></p> <p>That is, since the notice of reasons for refusal of August 13, 2007 (Exhibit A6) stated the violation of requirements for amendment for the second amendment, the second amendment should have been declined and a subsequent amendment should not be made based on the second amendment. When the second amendment is declined, the fourth amendment should be made based on the claims amended in the first amendment prior to the second amendment. <u>The number of claims amended in the first amendment is nine, and the number of claims is decreased to include three claims in the first amendment, thus the fourth amendment should not violate the requirements under the provisions of Article 17bis(4).</u></p>	<p><b>Allegations by Defendant</b></p> <p>A When filing the appeal, if ... is not for the purpose of the restriction of the claims (Article 17bis(4)(ii)), the administrative judge should decline the amendment by decision... .</p> <p>If it could recognize that the amendment against the final notice of reasons for refusal (fourth amendment) (<i>*Note: fourth amendment seems to be rectified and read as third amendment.*</i>) violates the requirements under the provisions of Article 17bis(3) to (5) before the transmittal of a certified copy of a decision to grant a patent, the provision for declining the amendment is provided under Article 53, but, <u>no provision for declining the amendment (second amendment) for which the final notice of reasons for refusal was issued is provided under Article 53 and others.</u></p> <p>B Therefore, the fourth amendment should be determined whether or not to violate the requirements under the provisions of Article 17bis (3) to (5) based on the second amendment, not the first amendment. The claims after the second amendment and the claims after the fourth amendment should have one-to-one or equivalent correspondence relations.</p> <p>However, <u>the claims were amended to include one claim in the second amendment while the claims were amended to include three claims in the fourth amendment. Thus, it could not recognize that the claims after the second amendment and the claims after the fourth amendment have one-to-one or equivalent correspondence relations, and the determination is not erroneous in declining the fourth</u></p>
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	<u>amendment.</u>
<p>Judgement by the Court</p> <p>It should be said that since the third amendment was dismissed before filing the fourth amendment, the fourth amendment has the claims before the third amendment was made, that is, the claims of the fourth amendment are made by changing the second amended claims.</p> <p>Therefore, the fourth amendment has changed the number of claims into three from one which was made by <u>the second amendment.</u></p> <p>B Article 17bis(4) stipulates that the claim amendments to be filed in conjunction with filing the appeal against a decision of final rejection are restricted to any of the purposes under the provisions of (i) to (iv) of the same paragraph. As stated above, <u>it should be said that the amendments for increasing claims are not for any of the purposes under the provisions of (i) (cancellation of the claims), (ii) (restriction of the claims), (iii) (correction of errors), and (iv) (clarification of ambiguous description) of Article 17bis (4).</u></p> <p>... the appeal decision is not erroneous in determining that the fourth amendment does not fall under any of the purposes under the provisions of Article 17bis(4).</p> <p>... the second amendment was made against the non-final notice of reasons for refusal. <u>If ... the amendment made against the non-final notice of reasons for refusal does not satisfy the requirements under the provision of Article 17bis(3) (prohibition of addition of new matter), the application shall be refused by such reason (Article 49(i)), and the notice of reasons for refusal shall be issued (Article 50). However, the amendment shall not be dismissed by decision (Article 53(1)).</u></p> <p>Therefore, there is no reason for dismissal of the second amendment by decision.</p>	

(84-1)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 4, 3.
Classification of the Case	84-1: As to whether it falls under deletion of claims of Article 17bis(5)(i) or not
Keyword	

vnn

### 1. Bibliographic Items

Case	"Communication network configuration" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 16, 2006 (2005 (Gyo KE) No. 10266)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-234637 (JP 2000-78294A)
Classification	H04M 3/42
Conclusion	Dismissal
Related Provision	(Former) Article 17bis(3)(i)
Judges	IP High Court Third Division, Presiding judge: Ryoichi MIMURA, Judge: Kazuhide SHIMASUE, Judge: Yasuto OKINAKA

### 2. Overview of the Case

#### (1) Summary of Claimed Invention

The present invention provides a communication network configuration for allowing a user to lead the management of a network, enabling the management by a small-scale host machine, and preventing rigidification between an information provider and an information receiver. In the communication network configuration, a role for a host machine in a network is restricted to provide encounters between users, whereby after the users encounter, each user directly communicates each other without the host machine.

#### (2) The Claims (Before Amendments, After Amendments)

Before Amendment	After Amendments
[Claim 1] A communication network configuration comprising: a plurality of user stations connected between them by a bidirectional communication means; and at least one or more host stations connected to the plurality of user stations by a bidirectional communication means, wherein the host	[Claim 1] A communication network configuration comprising: a plurality of user stations connected between them by a bidirectional communication means; and at least one or more host stations connected to the plurality of user stations by a bidirectional communication means, wherein the host

<p>station includes a database in which respective user stations register consciousness information and communication connection information, the consciousness information being used as a summary of own consciousness desired by the user to be communicated to other user through the communication network, the communication connection information being required by the user station for selecting directly or indirectly other user station to communicate directly with the other user station without through the host station, the user station, upon obtaining the communication connection information for a target user to be a dialogue user, closes a communication network with the host station and communicates directly knowledge information between the user stations without through the host station.</p> <p>[Claim 2] The communication network configuration according to claim 1, wherein at least a telephone number of the communication connection information provided from the host station to the user stations is invisible to the user or encrypted, and is made meaningful or decrypted in an area where a user inside a user machine is not involved.</p> <p>[Claim 3] The communication network configuration according to claim 1 or 2, wherein the communication means is a wired communication or a wireless communication, or a combination communication of the wired communication and the wireless communication.</p> <p><i>* [Claim 4] to [Claim 8] are omitted.</i></p>	<p>station includes a database in which respective user stations register consciousness information and communication connection information, the consciousness information being used as a summary of own consciousness desired by the user to be communicated to other user through the communication network, the communication connection information being required by the user station for selecting directly or indirectly other user station to communicate directly with the other user station without through the host station, <u>at least a telephone number of the communication connection information provided from the host station to the user stations is invisible to the user or encrypted, and is made meaningful or decrypted in an area where a user inside a user machine is not involved</u>, the user station, upon obtaining the communication connection information for a target user to be a dialogue user, closes a communication network with the host station and communicates directly knowledge information between the user stations without through the host station.</p> <p>[Claim 2] The communication network configuration according to claim <u>1</u>, wherein the communication means is a wired communication or a wireless communication, or a combination communication of the wired communication and the wireless communication.</p> <p><i>* [Claim 3] to [Claim 7] are omitted.</i></p>
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Note that, in the claim 1 after amendment, the element recited in the claim 2 before amendment is incorporated in the claim 1 before amendment, the claim 2 before amendment is canceled, and the portions citing the claim 2 before amendment are deleted in the claims 3 to 8 before amendment and the claim numbers are renumbered.

### (3) Procedural History

- November 12, 2001 : Filing of Claim Amendments (see the above "Before Amendments")
- July 15, 2002 : Decision of Refusal
- September 4, 2002 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-16946),  
Filing of Written Amendment (the present amendments) (see the above "After Amendments")
- October 3, 2002 : Filing of Claim Amendments
- January 31, 2005 : Appeal Decision to Decline the amendments and "Dismiss the appeal"

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision	
<p>The present amendments for incorporating the recitation "at least a telephone number of the communication connection information provided from the host station to the user stations is invisible to the user or encrypted, and make meaningful or decrypted in an area where a user inside a user machine is not involved" is for limiting "the communication information" recited in the claims within the scope of the matters stated in the description or drawings originally attached to the application, and for the purpose of the restriction of the claims.</p>	
Decision	
<p><b>Allegations by Plaintiff</b></p> <p>Since the present amendment was for the purpose of "the cancellation" of the claim 1 of the claims, the amendment should not be subject to the requirements for independent patentability. However, the appeal decision determined erroneously that the present amendment was for the purpose of "the restriction" of the claims, ..., consequently, declined erroneously the present amendment by a reason of violating the requirements for independent patentability.</p> <p>If the claim 1 is canceled and the claim 2 is replaced as new claim 1, in the new claim 1, the recitation "the communication network configuration according to claim 1" in the claim 2 before amendment is replaced with the recitation in the claim 1 before amendment. As a result of the replacement, ... the invention recited here is identical to the invention recited in the claim 2 before</p>	<p><b>Allegations by Defendant</b></p> <p>(1) It is apparent that since in the present amendment ... in the claim 2 before amendment was incorporated in the claim 1 after amendment, the claim 1 after amendment corresponds to the restriction of the claims.</p> <p>(2) Also, it is apparent that the present amendment was for the purpose of the restriction of the claims from the amendments of October 3, 2002 (Exhibit A10) in which the reason of appeal is described, stating that the element recited in the claim 2 before amendment is incorporated in the claim 1 after amendment and the claim 2 before amendment is canceled.</p> <p>(3) The claim 8 before amendment (the claim 7 after amendment) cited the claim 1 only, and the claim 7 after amendment cited the claim 1 after amendment restricted by reciting the element of the claim 2 before amendment. Consequently, the</p>

<p>amendment.</p> <p>It should be determined objectively and substantially whether the amendment is for the purpose of "the cancellation of the claims" or "the restriction of the claim" under the provisions of Article 17bis(3)(i) and (ii), not only based on the description of the amendment, considering the contents of the amendment. It is apparent that the present amendment is for the purpose of "the cancellation" of the claim 1 before amendment by determining as above.</p>	<p>invention of the claim 8 before amendment would be restricted by incorporating the element recited in the claim 2 before amendment ...</p>
<p><b>Judgement by the Court</b></p> <p>... the plaintiff alleges that the written amendment of October 3, 2002 ... only states that, claim 1 after amendment is made by restricted claim 1 (before amendment) by incorporated the element of claim 2 (before amendment) into claim 1 (before amendment), and the explanation "that is, corresponds to the content of claim 2 before amendment" which should be described in the amendment is omitted. Thus, the present amendment is made for the purpose of "cancellation" of claim 1 before amendment considering the contents of the present amendment.</p> <p>...Since the above written amendment states expressly that the claim 2 is canceled, the allegations of the plaintiff would not accord with the description of the written amendment prepared by the plaintiff. Also the allegations of the plaintiff could not accord with ... claims 3 to 7 before amendment are moved up to claims 2 to 6 after amendment as well as the portions citing claim 1 before amendment are deleted ... .</p>	

(84-2)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 4, 2.
Classification of the Case	84-2: As to whether it falls under restriction in a limited way of claims of Article 17bis(5)(ii) or not
Keyword	

### 1. Bibliographic Items

Case	"Fireproof structure" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, April 25, 2005 (2005 (Gyo KE) No. 10192)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H9-288535 (JP H10-183816A)
Classification	E04B 1/94
Conclusion	Dismissal
Related Provision	(Former) Article 17bis(4)(ii)
Judges	IP High Court Third Division, Presiding judge: Hisao SATO, Judge: Ryuichi SHITARA, Judge: Tatsushige WAKABAYASHI

### 2. Overview of the Case

#### (1) Summary of Claimed Invention

The claimed invention provides a fireproof structure comprising a fireproof expandable sheet (b)2 having thickness of 0.5 to 40 mm on at least one surface of a board (a)1 which is made from fireproof material and has thickness of 5 to 100 mm, wherein after increasing furnace temperature to 925°C for 1 hour while the fireproof structure conforms to JIS A 1304, the relation (D'/D) of the thickness (D') after heating to the thickness (D) before heating is within the range of 2.5 to 15, and the fireproof expandable sheet (b)2 is a fireproof structure component being a resin composition comprising thermoplastic resin and/or rubber substance, a phosphorus compound, a neutralized thermally graphite and an inorganic filler, thereby construction performance and fireproof performance are excellent, and provides a method of constructing fireproof walls.

[FIG. 1]



#### (2) The Claims (Before and After Amendment)

Before Amendment	After Amendment
[Claim 1] A fireproof structure comprising a fireproof expandable sheet (b) having thickness of 0.5 to 40	[Claim 1] # (Claim 1+Claim 2+Claim 3 before amendment)

<p>mm on at least one surface of a board (a) which is made from fireproof material and has thickness of 5 to 100 mm, wherein after increasing furnace temperature to 925°C for 1 hour while the fireproof structure conforms to JIS A 1304, the relation (D'/D) of the thickness (D') after heating to the thickness (D) before heating is within the range of 2.5 to 15.</p> <p>[Claim 2] The fireproof structure according to claim 1, wherein the fireproof expandable sheet (b) comprises thermoplastic resin and/or rubber substance, a phosphorus compound, a neutralized thermally graphite and an inorganic filler.</p> <p>[Claim 3] The fireproof structure according to claim 2, wherein an amount of blending of the phosphorus compound and the neutralized thermally graphite is 20 to 200 pts.wt. in the total amount with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, an amount of blending of the inorganic filler is 50 to 500 pts.wt. with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, a weight ratio ((the neutralized thermally graphite)/(the phosphorus compound)) of the neutralized thermally graphite to the phosphorus compound is in the range of 0.01 to 9, and a weight ratio ((the inorganic filler)/(the phosphorus compound)) of the inorganic filler to the phosphorus compound is in the range of 0.6 to 1.5.</p> <p># [Claim 4] to [Claim 10] are omitted.</p>	<p>[Claim 2] # (Claim 1 before amendment)+the fireproof expandable sheet (b) limited as follows</p> <p>A fireproof structure, in which the fireproof expandable sheet (b) is a resin composition comprising thermoplastic resin and/or rubber substance, a phosphorus compound, and carbonate of alkali metal, alkaline-earth metal and metal of IIb group in the periodic table, the total amount of the phosphorus compound and metal carbonate is 50 to 900 pts.wt with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, and a weight ratio ((the metal carbonate)/(the phosphorous compound)) of the metal carbonate to the phosphorous compound is 0.6 to 1.5.</p> <p>[Claim 3] # (Claim 1 before amendment)+the fireproof expandable sheet (b) limited as follows</p> <p>A fireproof structure, in which the fireproof expandable sheet (b) is a resin composition comprising thermoplastic resin and/or rubber substance, a phosphorus compound, carbonate of alkali metal, alkaline-earth metal and metal of IIb group in the periodic table, and hydrated inorganic substance and/or calcium, the total amount of the phosphorus compound, metal carbonate, and hydrated inorganic substance and/or calcium is 50 to 900 pts.wt with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, a weight ratio ((the total amount of the metal carbonate and hydrated inorganic substance and/or calcium)/(the phosphorous compound)) of the total amount of the metal carbonate and hydrated inorganic substance and/or calcium to the phosphorous compound is 0.6 to 1.5, and the total amount of the hydrated inorganic substance and/or calcium is 1 to 70 pts.wt. with respect to 100 pts.wt. of the metal carbonate.</p> <p>[Claim 4] # (Claim 1 before amendment)+the fireproof expandable sheet (b) limited as follows</p> <p>A fireproof structure, in which the fireproof</p>
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expandable sheet (b) is a resin composition comprising thermoplastic resin and/or rubber substance, a phosphorus compound, polyalcohol, and carbonate of alkali metal, alkaline-earth metal and metal of IIb group in the periodic table, the total amount of the phosphorus compound, polyalcohol and metal carbonate is 50 to 900 pts.wt with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, a weight ratio ((the polyalcohol)/(the phosphorus compound)) of the polyalcohol to the phosphorus compound is 0.05 to 20, and a weight ratio ((the metal carbonate)/(the phosphorus compound)) of the metal carbonate to the phosphorus compound is 0.01 to 50.

[Claim 5] # (Claim 1 before amendment)+the fireproof expandable sheet (b) limited as follows)

A fireproof structure, in which the fireproof expandable sheet (b) is a resin composition comprising thermoplastic resin and/or rubber substance, a phosphorus compound, neutralized thermally expandable graphite, polyalcohol, and carbonate of alkali metal, alkaline-earth metal and metal of IIb group in the periodic table, the total amount of the phosphorus compound, neutralized thermally expandable graphite, polyalcohol and metal carbonate is 50 to 900 pts.wt with respect to 100 pts.wt. of the thermoplastic resin and/or rubber substance, a weight ratio ((the polyalcohol)/(the phosphorus compound)) of the polyalcohol to the phosphorus compound is 0.05 to 20, a weight ratio ((the neutralized thermally expandable graphite)/(the phosphorus compound)) of the neutralized thermally expandable graphite to the phosphorus compound is 0.01 to 9, and a weight ratio ((the metal carbonate)/(the phosphorus compound)) of the metal carbonate to the phosphorus compound is 0.01 to 50.

# [Claim 6] to [Claim 12] are omitted.

## (3) Procedural History

December 2, 2002	: Amendment (see the invention "before amendment")
June 26, 2003	: Decision of refusal
July 30, 2003	: Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-14682)
August 29, 2003	: Amendment (present amendment) (see the invention "after amendment")
March 3, 2004	: Dismissal of the present amendment and appeal decision that "the request for appeal against examiner's decision of refusal is not established"

## 3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>... In the present amendment, matters specifying the invention of Claims 2 and 3 before the amendment are incorporated in Claim 1 before the amendment, two claims are reduced by substantially cancelling the Claims 2 and 3, <u>"a fireproof expandable sheet (b)", being a matter specifying the invention stated in Claim 1 before the amendment develops to new four claims from Claim 2 to Claim 5 after the amendment, and the new four claims are substantially added and stated.</u> As a result, <u>two claims are increased</u> by the amendment.</p> <p>Since the number of claims stated in the scope of claims after the amendment is substantially increased, the claimed invention stated in the scope of claims after the amendment is enlarged in comparison with that before the amendment, and it is evident that the amendment corresponds to enlargement of the scope of claims.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>... Legislators only have indicated, as an example of "restriction of the scope of claims", "the invention stated in the claim as generic concept is stated as that as more specific concept", and they have not indicated that increasing the number of claims corresponds to restriction of the scope of claims.</p> <p>(2) In Patent Act Article 17bis(4), "deletion of the claim(s)" (Article 17bis(4)(i)), "restriction of the scope of claims" (Article 17bis(4)(ii)), ... are each prescribed as distinct purposes of amendment. Thus, it is should be understood that each requirement is to be independently determined.</p> <p>... The number of claims being a formal matter is exclusively treated in Article 17bis(4)(i), and it should be understood that <u>Article 17bis(4)(ii) to (iv)</u></p>	<p>Allegations by Defendant</p> <p>1 According to the parenthesis of Patent Act Article 17bis(4)(ii), it is prescribed that "restriction of the scope of claims is limited to the cases where the restriction aims to restrict matters required to specify the invention stated in the claim(s) under Article 36(5), and the field of industrial application of the invention stated in the claim(s) before the amendment and the problem to be solved by the invention are identical with those after the amendment".</p> <p>In the prescription of the parenthesis, according to "the invention stated in the claim(s)" before amendment and "the invention stated in the claim(s)" after amendment, in the correspondence relation of the claims before and after amendment, <u>amendment related to restriction in a limited way of claim(s) is required so that the one claim before amendment is</u></p>

<p><u>other than Article 17bis(4)(i) do not take the number of claims being a formal matter into account.</u></p> <p>Accordingly, in "restriction of the scope of claims" (Article 17bis(4)(ii)), it cannot be understood that the amendment of increasing the number of claims cannot be permitted.</p>	<p><u>restricted in a limited way so as to become the one claim after amendment as it is.</u></p> <p>Accordingly, it is evident in the law that amendment related to "restriction of the scope of claims" (Article 17bis(4)(ii)) <u>naturally requires the one-to-one correspondence relation of the claims before and after amendment</u> with the prescription of the parenthesis.</p>
<p><b>Judgement by the Court</b></p> <p>... <u>It is reasonable that Article 17bis(4)(ii) prescribes that an amendment is made by limitation of matters specifying the invention of the claim(s) by restriction, and the claim(s) can be maintained as the claim(s) after the amendment as it is. The provision should not be supposed about an amendment that one of the claims is deleted and a new claim is added instead, or an amendment that the invention claimed in one claim is divided into plural claims to add new claims.</u></p> <p>... Since the invention(s) is specified to each claim and each claim is subject to examination, the subject to examination is different if claims are different, and if a new claim(s) is added, a new examination related to a new claim(s) is needed as a general rule. <u>Permitting the amendment in which one claim is divided into plural claims causes a subject to examination to be added, causes a case where new examination is needed, or a case where the determination whether the amendment corresponds to restriction in a limited way of the claimed invention before the amendment is complicated and difficult.</u> If it is permitted, it does not comply with the purpose of the system in which an amendment is permitted to the extent that the examined result is effectively exploited so as to realize prompt and accurate examination, and the examination of the amended invention can be performed.</p> <p>Consequently, <u>even if the amendment in which the invention stated in one claim is divided into plural claims and new claim(s) is added has a purpose to limit matters specifying the invention stated in the one claim as a whole, the amendment does not correspond to "restriction of the claims" prescribed by Article 17(4)(ii).</u> It is understood that "restriction of the scope of claims" prescribed by Article 17(4)(ii) requires the one-to-one correspondence relationship of the claims before and after amendment.</p> <p>In addition, the following amendments in which the claim before the amendment substantially includes plural claims are expected: an amendment in which one claim stated in a multiple dependent form <u>becomes claims stated in an independent form by decreasing dependent claim(s); and an amendment in which one claim stated as constituent features are alternative forms become plural claims to limit each of the constituent features.</u> <u>Even if the number of claims is increased by amending the one claim to plural claims in an independent form, such amendments are not denied since new claim(s) is not substantially added and the amendments have the one-to-one correspondence relationship of the claims before and after amendment.</u></p>	

(84-2)-2

Relevant portion of Examination Guidelines	Part IV, Chapter 4, 2.
Classification of the Case	84-2: As to whether it falls under restriction in a limited way of claims of Article 17bis(5)(ii) or not
Keyword	

## 1. Bibliographic Items

Case	"Mobile phone terminal" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 17, 2012 (2011 (Gyo KE) No. 10133)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-182514 (JP 2004-7746A)
Classification	H04M 1/00
Conclusion	Dismissal
Related Provision	(Former) Article 17bis(4)(ii)
Judges	IP High Court First Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Tamotsu SYOUJI, Judge: Toshiya YAGUCHI

## 2. Overview of the Case

## (1) Summary of Claimed Invention

In a conventional mobile phone terminal, it is necessary to power off all functions on a mobile phone terminal at hospitals or aircrafts, etc. prohibited mobile phone communication, and is inconvenient that phonebook function independent of communication function cannot be used. In the claimed invention, inputting specific instructions, when the power source is turned on, stops communication function on a mobile phone by cease of supplying power, but makes it possible to use phonebook function, etc. by continuing supply of power to them. Therefore, at the area such as hospitals, etc. prohibited wireless communication, it can improve convenience to make it possible to continue to use phonebook function, etc., by means of stopping only communication function.

## (2) The Claims (before and after amendment)

Before amendment(after the amendment of Exhibit A6)	After amendment (after the amendment)
[Claim 1] A mobile phone equipped with communication function and multiple functions other	[Claim 1] A mobile phone equipped with communication function and multiple functions other

<p>than communication function including those of clock, phonebook, converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio, and one set of display means for displaying items concerning communication function and multiple functions other than communication function, and input means having power keys and number keys, etc. featuring:</p> <p>Pushing the power key on the input means leading to supply of power with each of constituent parts including the display means, and start of operation of the mobile phone terminal, and then allowing communication on the mobile phone by means of communication of communication contact information with the communication function, and also allowing use of multiple functions other than the communication function including those of clock, phonebook, converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio in a communicable state. An input of instructions for stopping communication function by pushing any key other than the power key on the input means, preventing a mobile phone from communicating communication connect information by stopping such communication function, and making it possible to operate and <u>select</u>, with a stop of the communication function, multiple functions other than the communication function including those of clock, phonebook, <u>converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio.</u></p>	<p>than communication function including those of clock, phonebook, converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio, and one set of display means for displaying items concerning communication function and multiple functions other than communication function, and input means having power keys and number keys, etc. featuring:</p> <p>Pushing the power key on the input means leading to supply of power with each of constituent parts including the display means, and start of operation of the mobile phone terminal, and then allowing communication on the mobile phone by means of communication of communication contact information with the communication function, and also allowing use of multiple functions other than the communication function including those of clock, phonebook, converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio in a communicable state, and pushing any key other than the power key on the input means, preventing a mobile phone from communicating communication connect information by stopping such communication function, and making it possible to operate, with a stop of the communication function, multiple functions other than communication function including those of clock, phonebook, converting voice with a microphone to electrical signals, converting electrical signals with a speaker to audio, and also making it possible to select <u>the clock function and the phonebook function.</u></p>
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(3) Procedural History

- May 25, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2007-18278)
- October 22, 2010 : Written Amendment (amendment of Exhibit A6) (See above invention "before amendment")

January 27, 2011 : Written Amendment (the amendment) (See above invention "after amendment")  
 March 7, 2011 : The JPO decision of rejection of the amendment, "Dismiss a request for appeal."

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>...(1) <u>the amendment deletes the item of "' possible to select' 'converting voice with a microphone to electrical signals' and 'converting electrical signals with a speaker to audio' "</u> described in Claim 1 relating to <u>...the amendment of Exhibit A6 before amendment</u>, and then is not intended to restrict the scope of claims in a limited way, and also does not fall under the amendment for the purpose of the correction of errors in the description and for the purpose of clarification of an ambiguous description, ...</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>...the amendment replaces the expression of making it possible to select "the clock function and the phonebook function" which are narrower range of selectable functions, with that of "making it possible to select ... multiple functions other than the communication function including that of clock, phonebook, converting voice with a microphone to electrical signals, converting audio with a speaker to electrical signals" constituting a part of matters identifying the invention described in the scope of claims before the amendment. Accordingly, the inventions before and after the amendment are identical, concerning industrially applicable fields and the problems to be solved.</p> <p>Since restricting "selectable" range as above means that, after amendment, the function is restricted on technology, it should be said that such restriction falls under the restriction of the scope of claims as long as that does not change the problems to be solved or industrially applicable fields before and after the amendment.</p> <p>If the JPO decision ...were correct, in Markush claim referring to "one or more compounds selected from a group consisting of A, B and C", the amendment restricting selection range of substance is</p>	<p>Allegations by Defendant</p> <p>...the statement of Claim 1 relating to the amendment of Exhibit A6 before the amendment expresses that "a mobile phone terminal" comprises at least "communication function", "clock function", "phonebook function", "converting voice with a microphone to electrical signals" and "converting electrical signals with a speaker to audio," and also "display means" and "input means", that is, necessarily comprises all of the functions, but does not express that "a mobile phone terminal" comprises any one of the each functions. Accordingly, it should not be interpreted that each of the functions is an option for the matters specifying the invention such as Markush claim.</p> <p>In addition, <u>the amendment deletes the items of "making it possible to select" "converting voice with a microphone to electrical signals" and "converting electrical signals with a speaker to audio."</u> <u>Accordingly, it is clarified that such amendment comes to include the invention, that is, expands the invention of a mobile phone, for example, which maintains a state which makes it possible to always use "microphone" and "speaker" in case of supplying power with main body (control body 10), and then make it impossible to select the function of</u></p>

<p>unreasonable because such amendment would not fall under the restriction of the scope of claims, for example.</p>	<p><u>"converting voice with a microphone to electrical signals" or "converting electrical signals with a speaker to audio."</u> Therefore, it is clear that the amendment is not intended to restrict the scope of claims.</p>
<p><b>Judgement by the Court</b></p> <p>...in the amendment of Exhibit A6 ..., it is interpreted that the matters specifying the invention are to make it possible to operate and select, with a stop of communication function, each of multiple functions including those of "clock", "phonebook", "converting voice with a microphone to electrical signals", and "converting electrical signals with a speaker to audio."</p> <p>Otherwise, in the invention relating to Claim 1 after amendment (the claimed amended invention), it is interpreted that the matters specifying the invention are to make it possible to operate, with a stop of communication function, each of multiple functions including those of "clock", "phonebook", "converting voice with a microphone to electrical signals", and "converting electrical signals with a speaker to audio," and to make it possible to select functions of "clock" and "phonebook" among the "multiple functions."</p> <p>Then, when comparing the amended invention of Exhibit A6 with the claimed amended invention, the amended invention of Exhibit A6 makes it possible to select, with a stop of communication function, each of multiple functions including those of "clock", "phonebook", "converting voice with a microphone to electrical signals", and "converting electrical signals with a speaker to audio," while <u>the claimed amended invention makes it possible to select, with a stop of communication function, each of only functions of "clock" and "phonebook" among the "multiple functions."</u> Thus, it is recognized that the amendment deletes, with a stop of communication function, a part of selectable functions. As a result of above, in the claimed amended invention, <u>the amendment makes it an optional matter to select any function, with a stop of communication function, among functions other than those of "clock" and "phonebook."</u> <u>obviously deletes a part of the matters specifying the invention in series, and expands the statement of Claim 1 in the claims, then it cannot be said that the amendment restricts the claims, and it is not recognized that the amendment falls under the amendment for the purpose of "restriction of the claims in a limited way."</u></p> <p>Consequently, since amendment of Claim 1 by the amendment deletes a part of the matters specifying the invention in series, and does not delete the element of selectable description, none of the allegations by the plaintiff can be adopted.</p>	

(84-3)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 4, 4.
Classification of the Case	54-3: As to whether it falls under correction of error of Article 17bis(5)(iii) or not
Keyword	

## 1. Bibliographic Items

Case	"Fiber optic cable" (Trial for Invalidation) Intellectual Property High Court Decision, October 18, 2006 (2006 (Gyo KE) No. 10204)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H3-353715 (JP H5-40208A)
Classification	G02B 6/255
Conclusion	Dismissal
Related Provision	(Former) Article 134(2), proviso (ii)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Yoshiyuki MORI, Judge: Kouichi TANAKA

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention is intended to provide a fiber optic cable that has no fear to generate large connection loss due to a curve of itself. A fiber optic cable comprises a multiple of fiber optic cable arranged in parallel, gathering in a shape of tape, and the edge of a fiber optic cable being spliced by batch fusion, and also the curvature radius of curving in the vicinity of the spliced edge being at least larger than  $\frac{\lambda}{1.41}$  in a fiber optic wavelength ( $\lambda$ ).

## (2) Disclosure of Detailed Description of the Invention

"[0022]accordingly, from such circumstances, even if each of fiber optic cable to be spliced is curved to other fiber optic cable in the opposite direction, in order to satisfy the requirement for above connection loss, that is, in order to set maximum allowable connection loss not more than 0.5 dB, a curving state is required to be curvature of 0.92 or less at the point X for 1.55  $\mu$  m band based on FIG. 5, ...(C) in addition, such curving state is required to be curvature of 1.1 or less at the point Y for 1.3  $\mu$  m band based on FIG. 4, ...(D)above condition turned out to be required, in other word, for 1.55 $\mu$  m band and 1.33 $\mu$  m band, a curvature radius is required to be 0.92 m and 1.1 m, respectively, and against the fiber optic wavelength ( $\lambda$ ) [ $\mu$ m], relationship of

each

[0023]

[Numbers 3]

1.3 / 0.92 ≈ 1.41

1.55 / 1.1 ≈ 1.41

[0024] exists. Namely, it turned out that, if a curvature radius is not less than  $\lambda / 1.41$ , maximum allowable loss value is satisfied." (Cited from the judgement)

(3) Common Technical Knowledge, etc. Taken into Account

"curvature and a curvature radius are not the same thing ..." (Cited from the judgement)

(4) The Claims (before and after correction (claim 1 is only specified))

Before correction	After correction
[Claim 1] A fiber optic cable, comprising a multiple of fiber optic cable (1) arranged in parallel, gathering in a shape of tape and its edge being spliced by batch fusion, and featuring a curvature radius (R) of curving in the vicinity of the spliced edge of fiber optic cable being at least larger than $\lambda / 1.41$ in a fiber optic wavelength ( $\lambda$ ).	[Claim 1] A fiber optic cable, comprising a multiple of fiber optic cable (1) arranged in parallel, gathering in a shape of tape and its edge being spliced by batch fusion, and featuring a curvature radius (R) of curving in the vicinity of the spliced edge of fiber optic cable being at least larger than $\lambda / 1.4$ in a fiber optic wavelength ( $\lambda$ ).

(5) Procedural History

- August 30, 2004 : A request for trial for patent invalidation by the defendant (Muko No. 2004-80133)
- March 28, 2005 : First decision of "Invalid the patent."
- July 8, 2005 : A request for trial for correction by the plaintiff (the patentee's side)
- August 1, 2005 : Decision to rescind above trial decision under Article 181(2) (re-opening of trial examination)
- September 5, 2005 : Considered to be requested a correction which is the same as a request for a trial for correction (the present amendment) (See above invention "before amendment" and above invention "after amendment")
- March 29, 2006 : Trial decision of rescission of the amendment, "Invalid the patent."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)
<p>A    Correcitons (a)</p> <p>Amend "<math>\lambda/1.41</math>" to "<math>\lambda/1.4</math>" in "Claim 1" of "scope of claims" for the purpose of the correction of errors in the description .</p>

<p>A Since the amendment matters from item (a) through (e) cannot be said to be the correction of errors in the description or the clarification of an ambiguous description, such amendment does not fall under the proviso of Article 134(2) of the Patent Act prior to the revision of Act No. 116, 1994 (hereinafter referred to as "former Patent Act")</p> <p>...concerning FIG. 5, "accordingly, since a curve A' is originally the approximate curve, and also the curvature value is necessarily approximate value, which can be read by giving a perpendicular line to the X axis from intersection between the approximate curve and connection loss value, it should be said that such curvature is desirable to be read according to the scale of the axis X (it is clear that the scale is calibrated in hundredth place, if not, the calculated value of triple-digit significant figures cannot be plotted exactly), and the operation to daringly round significant figures to tenth place does not fall under the correction of errors in the description , even in view of measurement errors." ...</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>...measurement value of "curvature" has large variations such as 1.51+0.08, -0.10 (test certificate A. Exhibit A12). Above fact indicates that <u>there is no technical meaning in the hundredth digit.</u></p> <p><u>...since curvature at the point X can be read only "0.9" in FIG. 5, it is objectively clear that "curvature of 0.92" in paragraph [0022] of "detailed explanation of the invention" indicates same meaning with "curvature of 0.9," and it entirely does not fall under novel operation to amend "curvature of 0.92" to "curvature of 0.9".</u></p> <p>Accordingly, in paragraph [0022] of "detailed explanation of the invention" ...</p> <p>...it should be accepted to amend "curvature of 0.92" to "curvature of 0.9" and then, in paragraph [0023] of "detailed explanation of the invention," ...</p> <p>...it falls under the correction of errors in the description to amend "1.41" to "1.4" ...amendment matters (a) which amend "<math>\lambda/1.41</math>" to "<math>\lambda/1.4</math>" in Claim 1 fall under the correction of errors in the description.</p>	<p>Allegations by Defendant</p> <p>In case that measurement value of "curvature" has large variation such as 1.51+0.08, -0.10 (test certificate A. Exhibit A12), <u>it is considered that tenth digit would have variation, and thus, it has no technical meaning to amend "curvature of 0.92" to "curvature of 0.9."</u></p> <p>However, <u>it is not necessary to round out the hundredth digit in which the plaintiff asserts that there is no technical meaning,</u> because there are methods of round-up and round-down.</p> <p><u>...insofar as to determine tenth digit, there is obviously technical meaning for hundredth digit, and it cannot be said that it has no meaning to read 0.92 for the curvature at the point X.</u></p> <p>...it is objectively not recognized that, "curvature of 0.92" is wrong and "curvature of 0.9" is correct, and "curvature of 0.92" and "curvature of 0.9" indicate the same meaning ...</p> <p>...it cannot be also said that amendment matters (a), based on above fact, are the correction of errors in the description.</p>
Judgement by the Court	
<p>...it is understood that, for saying "clerical errors", it should be clear, by the statements of description and drawings, or common general knowledge of ...a person skilled in the art, that the statements before correction are wrong and the statements after correction are correct, and should be natural that a person skilled in the art</p>	

finds such errors and understand that the content after correction.

...the statements of "the detailed description of the invention" before correction ... (a) despite the fact that curvature and a curvature radius are not the same thing since curvature is a curvature radius divided by 1, ...the curvature calculated based on FIG. 4 and FIG. 5 is used ...directly as a curvature radius. (b) ...are not understandable in view of each of the above points ...

When understanding above statements as reasonably as possible, ..."a curvature radius" is error of "curvature." accordingly, a curvature radius is  $1/0.92 \approx 1.087$  for  $1.55 \mu\text{m}$  band and  $1/1.1 \approx 0.909$  for  $1.3 \mu\text{m}$  band, and when those are divided by each wavelength ( $\lambda$ ) [ $\mu\text{m}$ ], the results are  $1.55/1.087 \approx 1.426 \approx 1.43$ ,  $1.3/0.909 \approx 1.430 \approx 1.43$ . In addition, it should be said that "greater than  $\lambda/1.41$ " in "Claim 1" of "the claims" is unclear in terms of the technical meaning, because value of " $\lambda /1.43$ " can be only obtained, even when understanding as above.

...since, in the description of the patent of this case before correction, from the fact that numerical values sought by [Expression 3] are displayed approximately to second decimals, it is reasonable to calculate after removing third decimals as above and to display the final results approximately to second decimals.

Accordingly, by the statements of the description and drawings of the patent of this case before correction, a measurement value of "curvature" has no technical meaning for hundredth digit and it cannot be admitted that "curvature of 0.92" is wrong and "curvature of 0.9" is correct in paragraph [0022] of "the detailed description of the invention."

...it cannot be admitted that the description of "curvature of 0.92" in paragraph [0022] of "the detailed description of the invention" is clerical error of "curvature of 0.9."

...accordingly, in paragraph [0023] of "the detailed description of the invention" ...

...it is not accepted to amend "1.41" to "1.4," because such amendment does not falls under the correction of clerical errors in the description. Therefore, in "Claim 1" of "the claims," the correction matter (a) which corrects " $\lambda/1.41$ " to " $\lambda/1.4$ " cannot be admitted, because it does not fall under the correction of errors in the description.

(84-4)-1

Relevant portion of Examination Guidelines	Part IV, Chapter 4, 5.
Classification of the Case	84-4: As to whether it falls under clarification of ambiguous statements of Article 17bis(5)(iv) or not
Keyword	Amendment made for the matters stated in the reasons for refusal

## 1. Bibliographic Items

Case	"Quake damping device" (Appeal against Examiner's Decision) Intellectual Property High Court Decision, October 11, 2005 (H17 (Gyo KE) 10156)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-100678 (JP 2000-291730A)
Classification	F16F 15/04
Conclusion	Dismissal
Related Provision	Article 17bis(5)(iv)
Judges	IP High Court Second Division, Presiding Judge: Gaku OKAMOTO, Judge: Takuya UEDA, and Judge: Koji HASEGAWA

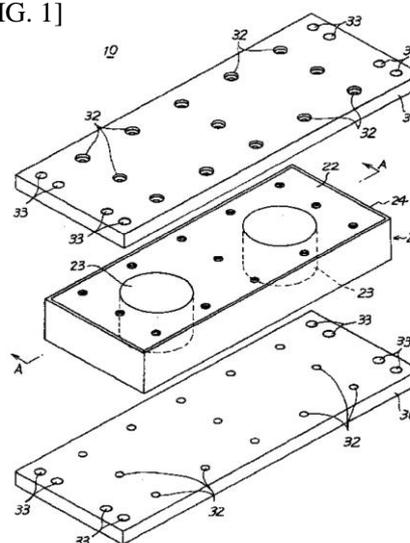
## 2. Overview of the Case

## (1) Summary of Claimed Invention

In the claimed invention, an external steel plate 22 is coupled to upper and lower surfaces of a single layer rubber unit or a layered rubber unit (hereinafter, referred to as "a layered rubber unit and the like"), and a lead plug 23 is buried while penetrating through the layered rubber unit and the like and the external steel plate 22 to configure a damper 20. By setting a cross sectional area of the lead plug 23 to that of the damper 20 in a horizontal direction to 15 to 35% that is larger than an ordinary case, an end part of the lead plug 23 is less likely to be deformed in the external steel plate 22, and a large attenuation capability can be obtained.

Thereby, a quake damping device with a high quake damping function is achieved.

[FIG. 1]



## (2) The Claims (Before Amendment and After Amendment) (Only Claim 1 is described.)

Before Amendment	After Amendment
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<p>[Claim 1] A quake damping device, wherein an external steel plate is coupled to upper and lower surfaces of a single layer rubber unit or a layered rubber unit obtained by laminating a steel plate and a rubber layer, wherein a single or a plurality of lead plugs penetrating through the single layer rubber unit or the layered rubber unit and the external steel plate are buried to configure a damper, and wherein a cross sectional area in a horizontal direction of the lead plug to a cross sectional area in a horizontal direction of the damper is set to 15 to 35% <u>so that a diameter is gradually reduced from one end toward the other end.</u></p>	<p>[Claim 1] A quake damping device wherein an external steel plate is coupled to upper and lower surfaces of a single layer rubber unit or a layered rubber unit obtained by laminating a steel plate and a rubber layer, wherein a single or a plurality of lead plugs penetrating through the single layer rubber unit or the layered rubber unit and the external steel plate are buried to configure a damper, the lead plug continuously applying a pressure in a lateral direction to the single layer rubber unit or the layered rubber unit by being applied with a predetermined surface pressure from upper and lower parts when buried in the damper, a horizontal dimension of the lead plug to a vertical dimension of 1 being set to 1.5 to 3, and wherein a cross sectional area in a horizontal direction of the lead plug to a cross sectional area in a horizontal direction of the damper is set to <u>15</u> to 35%.</p>
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(3) Procedural History

- June 4, 2001 : Procedure Amendment for Adding Words of "so that a diameter is gradually reduced from one end toward the other end" to Claim 1 (Refer to the above invention "Before Amendment")
- May 7, 2002 : Decision of Refusal
- June 12, 2002 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-10552)
- July 12, 2002 : Procedure Amendment for Removing Words of "so that a diameter is gradually reduced from one end toward the other end" from Claim 1 (This Case Procedure Amendment) (Refer to the above invention "After Amendment")
- January 25, 2005 : Dismissal of This Case Procedure Amendment, and Appeal/Trial Decision of "The request for this case trial and appeal is not established."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>A constituent feature of "so that a diameter is gradually reduced from one end toward the other end", which is a constituent feature of the lead plug, is removed from the description of Claim 1 before amendment, and with respect to the lead plug, a constituent feature of "the lead plug continuously applying a pressure in a lateral direction to the single layer rubber unit or the layered rubber unit by being applied with a predetermined</p>
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<p>surface pressure from upper and lower parts when buried in the damper, a horizontal dimension of the lead plug to a vertical dimension of 1 being set to 1.5 to 3," is newly added. It is obvious that the scope of claims is extended or changed.</p>	
<p>Decision</p>	
<p>Allegations by Plaintiff</p> <p>Removing the words of "so that a diameter is gradually reduced from one end toward the other end" from the description of Claim 1 before amendment by this case procedure amendment, is owing to that, as a result of amendment by the procedure amendment on June 4, 2001 for adding an expression of "a diameter is gradually reduced from one end toward the other end" to the description of Claim 1, Examiner <u>pointed out</u> in the decision of refusal <u>that</u>, with respect to the expression of "a cross sectional area in a horizontal direction of the lead plug is set to 15 to 35% so that a diameter is gradually reduced from one end toward the other end", <u>amendment grounds</u> about whether or not the cross sectional area in the horizontal direction is set within a range of 15 to 35% in the whole of the lead plug whose diameter is gradually reduced from one end toward the other end, <u>are ambiguous</u>. <u>Thus, clarification of the description is intended by removing this expression</u>. That is so-called "clarification of an ambiguous statement".</p>	<p>Allegations by Defendant</p> <p>If the constituent feature of "so that a diameter is gradually reduced from one end toward the other end" of Claim 1 before this case procedure amendment is removed, a shape of the lead plug can include a cylindrical shape without taper as shown in FIG. 1 of the original descriptions, a prismatic shape whose cross sectional shape in the horizontal direction is triangle, quadrilateral, or polygon, and a columnar body with various cross sectional shapes in the horizontal direction. Thus, it is obvious that the amendment is not applicable to "the clarification of an ambiguous statement" alleged by the plaintiff.</p>
<p>Judgement by the Court</p> <p>The plaintiff removed the words of "so that a diameter is gradually reduced from one end toward the other end" from the description of Claim 1 before filing the written amendment of this case. In the decision of refusal (Exhibit A4), Examiner's point related to the words is as follows ..."with respect to the expression of "a cross sectional area in a horizontal direction of the lead plug is set to 15 to 35% so that a diameter is gradually reduced from one end toward the other end.", the ground of this amendment about whether or not the cross sectional area in the horizontal direction is set within a range of 15 to 35% in the whole of the lead plug whose diameter is gradually reduced from one end toward the other end, is ambiguous".</p> <p>According to the above description, <u>because the gist of the Examiner's point indicates that the ground of the amendment is indefinite, but does not indicate that contents of the description of Claim 1 is ambiguous, it cannot be the grounds that the removal of the expression of "so that a diameter is gradually reduced from one end toward the other end" is applicable to the clarification of an ambiguous statement.</u></p>	