

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

7. Court precedents related to Priority

Classification	Content	No.	Date of Decision (Case No.)	Relevant Portion of Examination Guidelines
91	Whether or not the effects of priority claim under the Paris Convention are recognized	1	Intellectual Property High Court Decision, November 30, 2006 (2005, (Gyo KE) No. 10737)	Part V, Chapter 1
92	Whether or not the effects of internal priority claim are recognized	1	Intellectual Property High Court Decision, October 8, 2003 (2002, (Gyo KE) No. 539)	Part V, Chapter 2
		2	Intellectual Property High Court Decision, May 30, 2006 (2005, (Gyo KE) No. 10420)	
		3	Intellectual Property High Court Decision, September 15, 2011 (2010, (Gyo KE) No. 10265)	
		4	Intellectual Property High Court Decision, February 29, 2012 (2011, (Gyo KE) No. 10127)	

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Relevant portion of Examination Guidelines	Part V, Chapter 1
Classification of the Case	91: Whether or not the effects of priority claim under the Paris Convention are recognized
Keyword	

## 1. Bibliographic Items

Case	"Microbicide" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, November 30, 2006 (2005 (Gyo KE) No. 10737)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H4-502584 (JP H6-504538A)
Classification	C07C 251/60
Conclusion	Dismissal
Related Provision	Article 4H of the Paris Convention
Judges	IP High Court Third Division, Presiding Judge: Ryoichi MIMURA, Judge: Yuji KOSEKI, and Judge: Kazuhide SHIMASUE

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The invention as claimed in the application concerned relates to a compound having a specific formula and to a method for controlling harmful organisms such as fungi, insects, nematodes, Araneae and Acari by using o-benzyl-oxime-ether and the compound.

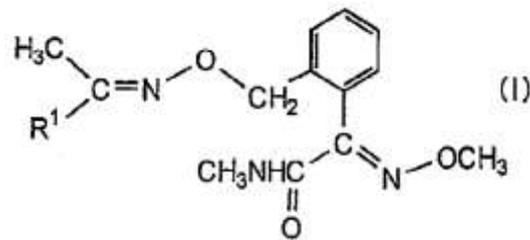
## (2) Differences in Descriptions Regarding Priority Application 1 and Priority Application 2

Priority Application 1	Priority Application 2
<p>"The specification (Exhibit A9) of Priority Application 1 describes the name and chemical structure of a compound of Priority Application 1."</p> <p>"With regard to the physical properties of the compound of Priority Application 1, the specification of Priority Application 1 has the respective sections "Oxime", "Melting Point" and "Isomer Ratio". However, the specific numbers are not described and</p>	<p>"A new matter regarding the production process was added to the specification (Exhibit A10) of Priority Application 2, the translation (Exhibit A3) of the specification of the international application, the whole specification amendment (Exhibit A7) filed on May 14, 2001." (The above is an excerpt of the Appeal Decision)</p>

<p>the corresponding portions are left blank."</p> <p>"The compound of the present application has an "oxyiminoacetamido group" at a lower portion of the benzene ring (Claim 1 of the specification of the present application). Such a compound, however, cannot be produced even if a person skilled in the art tries to produce the compound in accordance with European Patent Application Publication EP-A-0370629 (Exhibit A9-2)." (The above is an excerpt of the Appeal Decision)</p>	
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(3) The Claims (the Invention Concerned)

[Claim 1] A compound having the formula (I):



and stereoisomers thereof, wherein R<sup>1</sup> is a phenyl, a thienyl, ..., or a quinoxalinylyl group and all the groups are substituted by one or more substituents selected from halo, C<sub>1-4</sub> alkyl, C<sub>1-4</sub> alkoxy, ...; or, where appropriate, N-oxides thereof.

(4) Procedural History

- January 30, 1991 : UK Patent Application (Priority Application 1, Exhibit A9)
- August 14, 1991 : UK Patent Application (Priority Application 2, Exhibit A10)
- January 13, 1992 : International Application which claimed the benefit of priority under the Paris Convention to Priority Applications 1 and 2
- December 8, 1992 : Amendment
- July 8, 1993 : Filing of a translation of the above Amendment
- January 7, 2000 : Amendment
- January 31, 2001 : Final Rejection
- May 14, 2001 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2001-7973)  
Amendment (see the above "The Claims")
- June 1, 2005 : Appeal Decision: "The appeal of the outstanding Appeal Case is dismissed."

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

Appeal Decision (cited from the Court Decision)	
<p>The present application cannot claim the benefit of priority under the Paris Convention to Priority Application 1 and is considered to be filed on August 14, 1991, the filing date of Priority Application 2. Here, the specification of the present application is same as the original specification of Japanese Patent Application No. H3-156560 filed on June 27, 1991 (see JP H4-261147A (Exhibit A2); hereinafter, referred to as the "cited application" in the same manner as in the Appeal Decision). ... The present application cannot therefore be granted a patent under Article 29bis of the Patent Act.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>(1) Interpretation of Article 4H of the Paris Convention</p> <p>Provisions of Article 4H of the Paris Convention should be interpreted as follows: even if the claims set forth in the original application documents filed in the first country do not recite an element of the invention related to the claim of priority, the element not set forth in the claims may be specifically indicated in view of the entire original application documents filed in the first country; and in such a case, the application concerned can claim the benefit of priority. Hence, the above provisions fail to stipulate "the entire original application documents have to specifically disclose any of all the elements of the invention".</p> <p>(2) Applicability of the Benefit of Priority</p> <p>The Court Decision (Tokyo High Court 1999 (Gyo KE) No. 207; Court Decision September 5, 2000; hereinafter, referred to as "Court Decision 1") cited by the Appeal Decision recites "To be granted a patent on an invention of a chemical compound, the chemical compound has to be actually provided. It is thus insufficient to simply present its chemical structure and/or production process such that a theoretical production possibility is indicated. Hence, the chemical compound should be able to be actually produced". This Court Decision, however, refers to applicability of the benefit of internal</p>	<p>Allegations by Defendant</p> <p>(1) Interpretation of Article 4H of the Paris convention</p> <p>Provisions of Article 4H of the Paris Convention should be interpreted such that when a completed invention is found to be described in any of the entire original application documents filed in the first country, the benefit of priority can be claimed. Thus, the benefit of priority regarding the description of an incomplete, partial portion of the invention cannot be claimed. For instance, the original application may describe a partial portion and a supplemental description may be added later to complete the invention. In such a case, the date when the invention is completed should be the priority date. According to this interpretation, the benefit of the applicant is appropriately protected. In other words, if not so, the benefit of the third party will be lost.</p> <p>(2) Applicability of the Benefit of Priority</p> <p>With regard to Court Decision 1 cited by the Appeal Decision, the benefit of priority can be claimed when the invention is described in the specification of the Priority Application. In this respect, the principle of claiming the benefit of internal priority is same as that of priority under the Paris Convention. Hence, application of the judgment criteria of Court Decision 1 is quite reasonable.</p> <p>When the judgment criteria of the above court decision are applied to this case, it is determined that</p>

<p>priority, and has nothing to do with applicability of the benefit of priority under the provisions of Article 4H of the Paris Convention.</p> <p>(3) Descriptions Regarding Production Process</p> <p>Exhibit A9 describes that the compound of Priority Application 1 (hereinafter, referred to as the "Priority Application 1 Compound") can be produced in accordance with the processes disclosed in European Patent Application Publications EP-A-0370629 (Exhibit A9-2) and EP-A-0398692 (Exhibit A9-4). In light of the known technical levels indicated by Exhibit A9 and A9-2 to A9-5, the process for producing the compound of the invention was obvious to a person skilled in the art before the date of priority of the application concerned. Accordingly, even if the specific Production Examples were not specifically disclosed in the specification of Priority Application 1, the process for producing the compound of the invention was obvious to a person skilled in the art and could have been put into practice.</p>	<p>the specification of Priority Application 1 (Exhibit A9) fails to describe that the compound of the invention can be actually produced and verified in practice.</p> <p>(3) Descriptions Regarding Production Process</p> <p>Even if the European Patent Application Publications as cited by the plaintiff were combined, the compound of the invention was unable to be produced. A new matter regarding the production process was added to the specification (Exhibit A10) of Priority Application 2, the translation (Exhibit A3) of the specification of the international application, the whole specification amendment (Exhibit A7) filed on May 14, 2001. In view of this, the specification of Priority Application 1 cannot be said to disclose the compound of the invention in such a manner that the compound was able to be actually produced.</p>
<p>Judgment by the Court</p> <p>In order to claim the benefit of priority under the Paris Convention, one completed invention has to be understood from the entire documents of the priority application filed in the first country. Meanwhile, the invention concerned relates to an invention of a chemical compound. It is reasonably understood that <u>in order to claim the benefit of priority regarding a chemical compound under the Paris Convention, it is insufficient that the application documents filed in the first country just disclose its chemical structure and production process to indicate a theoretical production possibility, but it is necessary to actually verify the real existence of the chemical compound in view of the entire application documents.</u> Perhaps, this is because it is easy to image the chemical structure and production process, however, this imagination only suggests a theoretical possibility. Unless the compound was found to be successfully produced, it is impossible to evaluate the compound as a completed invention that could be put into practice.</p> <p>In this case, the specification of Priority Application 1 (Exhibit A9) discloses the name and chemical structure of the Priority Application 1 Compound. The name and chemical structure, however, can be conceived without actually producing and verifying the compound. Also, it is found that with regard to the physical properties of the Priority Application 1 Compound, the specification of Priority Application 1 has the respective sections "Oxime", "Melting Point" and "Isomer Ratio"; but the specific numbers are not described</p>	

and the corresponding sections are left blank. Thus, the specification of Priority Application 1 cannot be said to disclose the compound of the invention in such a manner that the compound can be actually produced and verified in practice.

Thus, it cannot be recognized that the specification of Priority Application 1 describes that the compound of the invention can be actually produced and the existence was verified. Collectively, with regard to the invention concerned, the "elements of the invention" cannot be said to be specifically disclosed in the specification of Priority Application 1. The present application cannot therefore claim the benefit of priority under the Paris Convention.

Hence, the present application is considered to be filed on August 14, 1991, the filing date of Priority Application 2 (Exhibit A10).

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Relevant portion of Examination Guidelines	Part V, Chapter 2
Classification of the Case	92: Whether or not the effects of internal priority claim are recognized
Keyword	

### 1. Bibliographic Items

Case	"Artificial nipple case" (Appeals against an Examiner's Decision) Tokyo High Court Decision; October 8, 2003 (2002, (Gyo KE) No. 539)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-288535 (JP 2000-189496A)
Classification	A61J 11/00
Conclusion	Dismissal
Related Provision	Article 42(1)
Judges	Tokyo High Court Thirteenth Civil Division, Presiding Judge: Katsumi SHINOHARA, Judge: Gaku OKAMOTO, Judge: Yukio NAGASAWA

### 2. Overview of the Case

#### (1) Summary of Claimed Invention

PROBLEM TO BE SOLVED: To provide an artificial nipple more similar to mother's nipple.

SOLUTION: Provided is an artificial nipple 100 having a nipple body part 110, and a papilla part 120 formed protrusively from the nipple body part. An expanding part 122 is provided at at least a part of the papilla part and/or the nipple body part.

#### (2) Difference between Statements of the Basic Application and Statements of the Application of Claim of Priority

Basic Application (Description of Basic Application) Japanese Patent Application No. 2000-17279	Application of Claim of Priority (The Claimed Invention)
"It is found that, a papilla part and an areola part corresponding to a papilla part 12 of an artificial nipple 10 (Note: the description of "20" is considered	[Claim 1.] An artificial nipple comprising: a papilla part having a front end part that can abut on a suckling cavity of an infant; a papilla part and a nipple body

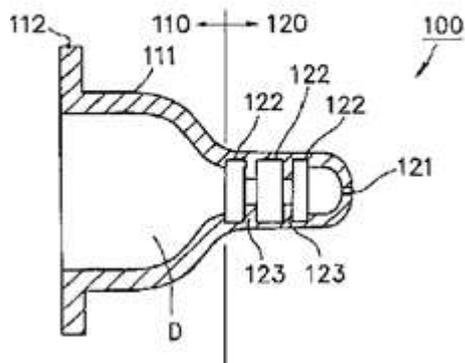
as an error), of a mother's nipple, are extended by peristaltic movement of a tongue 23 of an infant 20 ... when the infant 20 feeds milk in a nursing bottle with an artificial nipple 10 or mother's milk. There is a problem that the conventional artificial nipple 10 is not similar to the mother's nipple" (paragraph [0004]). "An object of this invention is to provide an artificial nipple more similar to the mother's nipple, in view of the above problem" (paragraph [0005]). "According to this invention, the object is achieved by an artificial nipple that comprises a nipple body part, and a papilla part formed protrusively from this nipple body part, wherein an extending part is provided at at least a part of the papilla part and/or the nipple body part" (paragraph [0006]). "According to the above configuration, because the extending part is provided at at least a part of the papilla part and/or the nipple body part, at least a part of the papilla part and/or the nipple body part extends in a mouth cavity of the infant, and a high-pressure part can be formed more effectively in this mouth cavity" (paragraph [0007]). "Further, preferably, the object is achieved by an artificial nipple provided with a rigid part provided adjacently to the extending part and having rigidity higher than that of the extending part" (paragraph [0008]). "According to the above configuration, because the rigid part provided adjacently to the extending part and having a rigidity higher than that of the extending part is provided, even when the papilla part and/or the nipple body part is extended, the rigidity of the whole of the papilla part and/or the nipple body part is not reduced" (paragraph [0009]). "Further, preferably, the object is achieved by an artificial nipple in which the extending part and the rigid part are alternately arranged" (paragraph [0010]). "According to the above configuration, because the extending part and the rigid part are alternately arranged, even when the

part having a surface that can make a tongue move so as to wave when the infant performs peristaltic movement by the tongue; and a base part for being connected with a nursing bottle, wherein an extending part thinner than a wall surface formed of silicon rubber, of the papilla part and the nipple body part is formed inside the wall surface, and wherein a rigid part thicker than the extending part is alternately formed adjacently to the extending part.

"Fig. 11 shows an outline sectional view of an artificial nipple 500 according to the fourth embodiment of this invention (Note: the claimed invention 1). Since the configuration of the artificial nipple 500 according to this embodiment is similar to that of the artificial nipple 100 according to the above-mentioned first embodiment, it will be explained hereinafter with attaching importance to differences, and explanation for the similar configuration is omitted by attaching reference numerals etc. In Fig. 11, the artificial nipple 500 has the nipple body part 110, the papilla part 120, and the flange part 112, similar to the above-mentioned first embodiment. However, this embodiment is different from the first embodiment in such a point that a thin part 522 that is the extending part is formed in a spiral shape over the papilla part 120 and the nipple body part 110 of the artificial nipple 500, as shown in Fig. 11. In this way, by forming the thin part 522 in a spiral shape, the artificial nipple 500 becomes more stretchy at sucking movement of the infant 200. Further, at this sucking movement, even when a pressure is added in a lengthwise direction of Fig. 11, a thick part 523 that is the rigid part is always arranged at a position corresponding to the thin part 522 in a lengthwise direction of the artificial nipple 500. Therefore, the artificial nipple 500 is prevented from

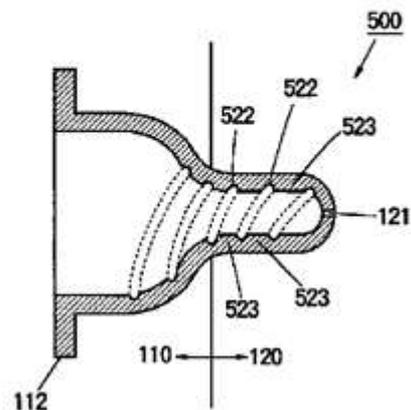
papilla part and/or the nipple body part is extended, the rigidity of the whole of the papilla part and/or the nipple body part can be further prevented from being reduced" (paragraph [0011]). "Preferably, the object is achieved by an artificial nipple formed of silicon rubber, a thickness of this silicon rubber being relatively thin at the extending part and relatively thick at the rigid part" (paragraph [0012]). "According to the above configuration, because the extending part with the relatively thin silicon rubber extends, and the rigidity is enhanced at the rigid part with the relatively thick silicon rubber, the whole of the papilla part and/or the nipple body part is extended without reducing the rigidity" (paragraph [0013]) (Extracted from the court decision).

[Fig. 1]



being flattened, and the sucking movement of the infant 200 is not made difficult. In addition, in this embodiment, because the thin part 522 is formed in a spiral shape as shown in Fig. 11, the artificial nipple 500 formed of silicon rubber is easily removed from a mold at the manufacture, and the manufacture is facilitated" (paragraph [0042]).

[Fig. 11]



(3) Technical common knowledge and the like in consideration

(4) Procedural History

- October 20, 1998 : Application for Patent (Japanese Patent Application No. H10-316899) (Basic Application)
- October 8, 1999 : Application for Patent that Claims Internal Priority Based on the Basic Application (Japanese Patent Application No. H11-288535: This Case Application)
- September 18, 2001 : Examiner's Decision of Refusal (This Case Application)
- November 8, 2001 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2001-20120)
- September 12, 2002 : Appeal Decision of "The Request for Appeals for this case is not established."

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

<p>Appeal Decision (cited from the Court Decision)</p> <p>.... Originally, in the description of the claims, the invention for which a patent is sought must be suited to that described in the detailed description of the invention (Patent Act Article 36(6)). Therefore, in the earlier application, the descriptions of "a rigid part provided adjacently to the extending part and having a rigidity higher than that of the extending part", "the extending part and the rigid part are alternately arranged", and "an artificial nipple formed of silicon rubber, a thickness of this silicon rubber being relatively thin at the extending part and relatively thick at the rigid part" should be interpreted while limiting to a range disclosed from the first in the earlier application. It cannot be possibly said "the extending part" includes that in a spiral shape, in an invention described in the description or drawings firstly attached to a request of the earlier application.</p> <p>Accordingly, the working example related to Fig 11 is included in the claimed invention but is not described in the description or drawings firstly attached to a request of the earlier application, and should be recognized as that firstly described in the description or drawings attached to a request of the subsequently filed application.</p>	
<p>Decision</p>	
<p>Allegations by Plaintiff</p> <p>With respect to applications which add a new working example in the internal priority system, in a case where an invention related to claims of the earlier application is sufficiently verified by the working example of the earlier application, even when a working example substantially the same invention is added in the subsequently filed application, the invention related to claims of the earlier application is not affected by this added working example. When an invention related to claims of the subsequently filed application is within an overlapped range of the earlier application and the subsequently filed application, the effects of Claim of Priority are confirmed.</p> <p>...</p>	<p>Allegations by Defendant</p> <p>Since an invention limited to the working example of Fig. 11 is an invention not described at all in the originally attached description etc. of the earlier application, it is obvious that an amendment for submitting it as an amendment for the claims of the earlier application is not approved. Since the claimed invention 1 that is the subsequently filed application includes an invention limited to the working example of Fig. 11, it is a matter of course that the amendment is not approved if submitted as an amendment for claims of the earlier application. In addition, because an invention included in the claimed invention 1 and supported by the working example added in the subsequently filed application is not sufficiently clarified by the originally attached description etc. of the earlier application, it is not considered that the invention is sufficiently verified only by matters described in the originally attached description etc. of the earlier application.</p>
<p>Judgment by the Court</p> <p>(1)... Since whether or not the invention related to the subsequently filed application is within a range of a</p>	

matter described in the originally attached description etc. of the earlier application should be decided not by simply comparing words of the claims of the subsequently filed application with words described in the originally attached description etc. of the earlier application but by comparing a technical matter that is a gist of the invention described in the claims of the subsequently filed application with a technical matter described in the originally attached description etc. of the earlier application. Therefore, even in a case where the words in the claims of the subsequently filed application are described in the originally attached description etc. of the earlier application, if a technical matter that is a gist of the invention described in the claims of the subsequently filed application is beyond a range of the technical matter described in the originally attached description etc. of the earlier application by stating a technical matter not described in the originally attached description etc. of the earlier application in the detailed description of the invention of the description of the subsequently filed application, it should be considered that the effects of claim of priority with respect to the part that is beyond the range is not recognized.

(2)...The artificial nipple described in the originally attached description etc. of the subsequently filed application as a working example for the claimed invention 1 and related to the working example of Fig. 11 where the thin part that is an extending part is formed in a spiral shape, is not clearly described in the originally attached description etc. of the earlier application, and also takes an effect peculiar to the spiral shape, different from an effect of the artificial nipple related to the working example of [Fig. 1] that is actually described in the originally attached description etc. of the earlier application and in which a thin part that is an extending part is formed in an annular shape. Accordingly, it is obvious that the technical matter that is a gist of the invention described in the claims of the subsequently filed application becomes beyond the range of the technical matter described in the originally attached description etc. of the earlier application by adding the working example of the artificial nipple in which the thin part that is the extending part is formed in a spiral shape (the working example of Fig. 11) to the description of the subsequently filed application, and therefore, it should be considered that the effects of claim of priority is not approved with respect to the part that is beyond the range.

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Relevant portion of Examination Guidelines	Part V, Chapter 2
Classification of the Case	92: Whether or not the effects of internal priority claim are recognized
Keyword	

## 1. Bibliographic Items

Case	"Information supply system using communication lines" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 30, 2006 (2005 (Gyo KE) No. 10420)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-208464 (JP 2004-147293A)
Classification	H04M 11/00
Conclusion	Dismissal
Related Provision	Article 42(1)
Judges	IP High Court First Division, Presiding Judge: Katsumi SHINOHARA , Judge: Ataru SHISIDO, Judge: Yoshiaki SHIBATA

## 2. Overview of the Case

## (1) Summary of Claimed Invention

The claimed invention is an information supply system that supplies information acquired by a monitoring terminal disposed in a monitoring-target area, like a house, by way of a communication line network made up of the Internet and a telephone network. In the invention, a user ID and a telephone number of a monitoring terminal corresponding to the user ID or address data are registered in a database of a management computer that is on a relay side. When a match exists between authentication data and registered information, the management computer works on and causes the control section to supply information to the monitoring terminal by way of the communication line. When a connection with the monitoring terminal is disabled or when information is not transmitted from the monitoring terminal, an anomaly notice is transmitted to the user.

## (2) Difference between Statements of the Basic Application and Statements of the Application of Claim of Priority

Basic Application (Description of the Basic Application) Japanese Patent Application No. 2000-17279	Application of Claim of Priority
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<p>A "[Technical Field of the Invention] The present invention relates to ... a specific area monitoring system using a telephone line system." (paragraph [0001])</p> <p>B "[Problem to be Solved by the Invention] Accordingly, the present invention aims at providing <u>an information supply system using a telephone line</u> for enabling monitoring ...by providing a specific area monitoring system using a telephone line system which enables monitoring an internal condition of a specific area; for instance, a house ... utilizing a <u>telephone line (including a wired line and a wireless line).</u>" (paragraph [0005])</p> <p>C "<u>the information supply system using a telephone line</u> of the present invention can acquire information from only the relay side ..., and hence confidentiality of information is enhanced." (paragraph [0007])</p> <p>D "the telephone 8 is disposed as an example of a communication terminal in the room 100 of the house, and the control terminal 5 serving as a control section is in communication with the telephone 8. The control terminal 5 is provided with an antenna 6 and arranged so as to be able to transmit a predetermined control signal to the controller 4." (paragraph [0014])</p> <p>E "moreover, the public line 9 is naturally connected with the communication terminal, such as the telephone 8, ... may also be embodied as a system structure in which the line is connected from the public line 9 directly to the control terminal 5 or the controller 4 without passing through the telephone 8 and in which information of the monitoring means is taken outside." (paragraph [0016])</p> <p>F "reference symbol 9 designates a public line network that is in communication with the base station 10 that is a communication interruption</p>	<p>[Claim 1] An information supply system using a communication line in an management computer disposed <u>in a communication network made up of the Internet and a telephone network</u> in which the management computer on a relay side has a user database that includes, in a registered manner, a user ID and a phone number or address data imparted to a monitoring terminal disposed at a location desired to be monitored by the user registered in correspondence with the user ID, the system comprising:</p> <p>means for acquiring at least one piece of specific information, such as a phone number, an ID number, address data, and a password, in authentication data about a user who makes an access <u>by utilization of the communication line network made up of the Internet and the phone network</u>;</p> <p>means for searching whether or not the acquired specific information matches with registration information previously registered in the user database;</p> <p>means by way of which, when the specific information matches with the registration information, the management computer works on the monitoring terminal <u>by utilization of the communication line network made up of the Internet and a phone network</u> and by use of a phone number or address data registered in correspondence with the user ID with which the user who made the access previously contracted and;</p> <p>means for obtaining information, which will be transmitted as data captured by the monitoring means, from the monitoring terminal that includes registered authentication data enabling authentication of the relay-side management computer and that certifies the management computer by the authentication data;</p> <p>means by way of which the management computer supplies information obtained from the monitoring terminal to the</p>
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<p>section (note: admitted to be a clerical error of the "communication relay") with respect to various public phones 13, a common telephone unit, the personal computer 14, and also the portable phone 11 serving as a mobile terminal and the mobile computer 15." (paragraph [0018])</p> <p>G "the relay 17 is interposed in the public line network 9, and the relay 17 is a system configured by an intermediate computer, or the like, that provides a service by processing data." (paragraph [0019]) (Cited from the Court Decision)</p>	<p>previously-contracted-and-registered user who made the access, by use of <u>the communication line network made up of the Internet and the phone network</u>; and</p> <p>means for transmitting a predetermined anomaly notice to the user who made the access when the management computer ascertains a state in which the management computer is incapable of connection with a communication terminal of the monitoring terminal or a state in which information is not transmitted from the monitoring means to the management computer.</p>
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(3) Common General Knowledge etc. taken into consideration

(i) Document Exhibit A6: "Information Communication Dictionary" issued on Jun 1, 2000, Industrial Research Center of Japan, Inc. Dictionary Publication Center

"...in a narrowest sense, the Internet is "aggregates of networks interconnected at all times by means of a TCP/IP protocol." The TCP/IP is also called an Internet protocol suite and inseparably bound up with the Internet. ... the Internet in a broader sense is one including temporary network connections established by dial-up connections etc., PC communication service, and connections established by protocols other than a TCP/IP such as a UUCP.... The internets with these two definitions are expressed as a proper noun like the Internet in English. In a broadest sense, the Internet simply means interconnection between networks and is denoted as "internet" in English." (Cited from the Court Decision)

(4) Procedural History

- January 26, 2000 : Patent Application (Japanese Patent Application No. 2000-17279) (Basic Application)
- May 31, 2000 : Patent Application claiming Internal Priority on the basis of the Basic Application (Japanese Patent Application No. 2001-542109)
- August 22, 2003 : Patent Application into which a part of Patent Application Claiming Internal Priority is Divided (Patent Application Concerned)
- May 28, 2004 : Decision of Refusal (Patent Application Concerned)
- July 5, 2004 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2004-13939)
- December 24, 2004 : Amendment (see Invention stated in "Application of Claim of Priority")
- March 1, 2005 : The appeal decision stating that the request for trial and appeal shall not arise.

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

Appeal Decision (cited from the Court Decision)	
<p>(1) The appeal decision mentions that ...the claimed invention is not disclosed in the description or drawings (...referred to as "Basic Filed Description") originally attached to the request for ..."basic application" ...serving as a basis of a claim of internal priority. On ground of this, stating that the claimed invention cannot receive a benefit of a claim of priority, the appeal decision rules that the claimed invention is unpatentable under the provision of Article 29bis ....</p> <p>(1) The appeal decision states that "the invention claimed in claim 1 (...referred to as "claimed invention") takes as a constituent matter of the invention, a matter such as "<u>Internet</u>", .... not disclosed in ...the description of the basic application...serving as a basis of internal priority...and cannot be admitted as an invention stated in the description or drawings attached to the request for the patent application serving as a basis of internal priority." On ground of this, the appeal decision interprets that the claimed invention cannot receive at least a benefit of internal priority....</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>...the description of the basic application does not use a term "Internet" but discloses a system in which two different networks; or a first network made up of a user and an intermediate computer and a second network made up of the control terminal 5 and the intermediate computer, enable communication by way of the intermediate computer. Therefore, the description of the basic application states "a connection between different networks"; that is, "an internet in a slight broader sense."</p> <p>(a) According to ... the description of the basic application ..., image information is exchanged between the control terminal 5 and the intermediate computer (the relay 17). Meanwhile, image data as well as characters can be handled. For this reason, an explosive increase has occurred in Internet population. At the time of ... basic application, the majority of connections between computers and personal computers was established by the Internet connection service.</p> <p>...the public line 9, which is a communication channel between the portable phone 11 etc. on the</p>	<p>Allegations by Defendant</p> <p>The description of the basic application is admitted that it discloses the public line 9 in FIG. 1 or FIG. 4. The public line 9 enables people to perform a phone conversation by a phone number without passing through the Internet. Therefore, the public line 9 is obviously not "the Internet." Moreover, <u>the description does not include any statements</u> of: establishing a connection with the Internet of the above meaning and intra-office LANs by way of the public line 9; <u>establishing a connection with the Internet</u> by making a dial-up connection with a business entity called an Internet provider and further <u>establishing a connection with the Internet by use of a dedicated line possessed by the provider; and "TCP/IP" etc. that is a technical feature characterizing the Internet....</u> The "information supply system using a phone line" disclosed in the description of the basic application connects the portable phone 11 etc. on the calling side with the phone 8 etc. on the specific phone side by way of the public line 9 and the relay 17. Since the connection can be sufficiently realized by communication means other than the Internet, there is</p>

<p>user side and the intermediate computer (the relay 17), is a physical line network capable of being utilized as both a phone line and the Internet. In light of this, it is natural that the public line 9, which is a communication channel between the control terminal 5 and the intermediate computer (the relay 17), is also interpreted as a physical line network capable of being utilized also as both the phone line and the Internet.</p>	<p>no necessity to make an additional connection with the Internet and the LANs by way of the public line 9.</p> <p>C (a) The description of the basic application states use of the personal computer 14 and the mobile computer 15. However, even if the intermediate computer of the relay 17 is connected between these computers and the control terminal 5, the public line network of the phone will not be separated into a different network. There is no inevitability of a TCP/IP protocol necessary for a connection between different networks. Consequently, the personal computer etc. is connected solely with the public line 9 of the phone and does not need to be connected with the Internet.</p>
<p><b>Judgment by the Court</b></p> <p>...the "Internet" stipulating the gist of the claimed invention is a technique selectively utilized, as a communication channel, between the management computer and the monitoring terminal and between the management computer and the user, along with the communication line network made up of the telephone network. Therefore, it is obvious that the "internet in a broader sense" having a simple meaning of an interconnection between networks obtained by abstracting such technique does not correspond to the Internet. It is reasonable to interpret that the Internet herein means the "Internet in a narrower sense" which is aggregates of networks normally connected by the TCP/IP protocols or the "Internet in a slightly broader sense" including connections, like a PC communication service and UUCP-based connections.</p> <p>...information transmission between the relay and the control terminal (a telephone when passing through the phone [a communication terminal] placed in a room) is performed over the public line in the invention stated in the description of the basic application. In addition, information transmission between the relay and a registered party on the calling side is also recognized that it is performed over the public line. It is obvious that a "phone line (including a wired line and a wireless line)" is presumed as the "public line" used herein. On the other hand, <u>the description of the basic application does not include an explicit statement of using the "Internet" of the claimed invention as a communication channel, and use of the Internet can not be recognized to be technically indispensable in order to realize the technical matter of the description of the basic application.</u></p> <p>...even if the state of the art at the time of filing of the basic application is as alleged by Plaintiff, the technique will not be allowed to be taken in, so long as the description of the basic application does not include the technique. As a matter of course, the description does not need to include it explicitly without fail. However, <u>the purport of the priority system lies in that a matter disclosed in a description of a basic application can receive a benefit of a filing date of an earlier application. Hence, a matter nearly stated and a matter which can be easily ascertained from statements should be differentiated from each other. Even if the Internet</u></p>	

is widely known and if a person skilled in the art encountered the description of the basic application ascertains that the Internet can also be used to implement the invention of the basic application, it will be still insufficient to evaluate that the use of the Internet is nearly stated. It is obvious that a matter nearly stated must be obvious to such an extent that a person skilled in the art can naturally ascertain a statement of the matter in the description and that the description of the basic application should be written as such.

(92)-3

Relevant portion of Examination Guidelines	Part V, Chapter 2
Classification of the Case	92: Whether or not the effects of internal priority claim are recognized
Keyword	

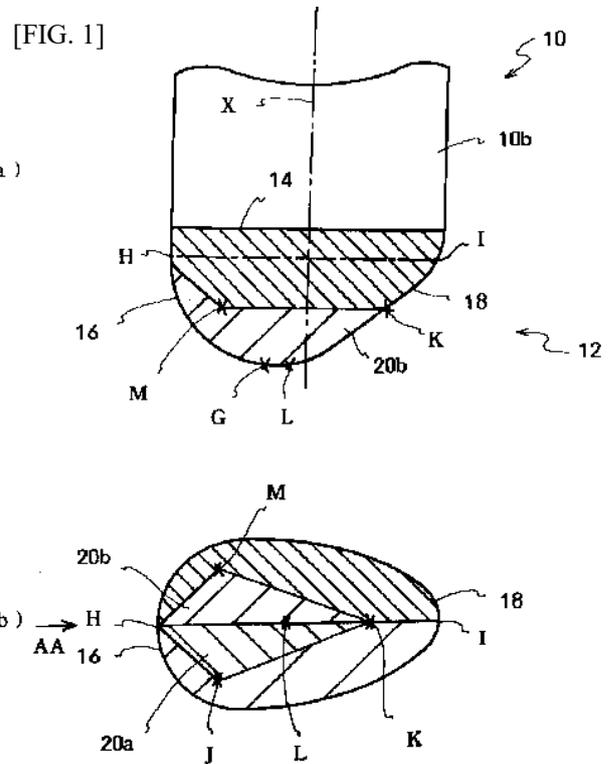
1. Bibliographic Items

Case	"Socks"(Trial for Invalidation) Intellectual Property High Court Decision, September 15, 2011 (2010 (Gyo KE) No. 10265)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-320874 (JP 1998-217703A)
Classification	A41B 11/00
Conclusion	Dismissal
Related Provision	Article 41(2)
Judges	IP High Court Fourth Division, Presiding Judge: Takaomi TAKIZAWA, Judge: Makiko TAKANOBE, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

A claimed invention relates to asymmetric socks, wherein a front-end position G in a tiptoe 12 of a sock is slightly closer toward the thumb 16. The shape of the tiptoe 12 of the sock is analogous to a shape of a human's foot in which the thumb is larger than the other fingers. Increased-thickness knitted portions 20a and 20b for increasing the thickness of the thumb 16 than the fifth finger 18 of the tiptoe 12 are knitted into the front end of the tiptoe 12 so as to become closer toward the thumb 16. Further, in order to increase the area of the thumb 16 of the increased-thickness knitted portions 20a and 20b, edges HJ and HM of the increased-thickness knitted portions 20a and 20b are formed so as to assume a V



shape when the front end G of the tiptoe 12 faces upward and the increased-thickness knitted portions 20a and 20b are viewed from a side surface of the thumb 16 of the tiptoe 12. Thus, the thumb etc., of the sock can be imitated as closely as possible from the shape of the thumb of the human's foot etc. As a result, when the socks are put on the feet, the feeling of the thumbs etc. being pressed by the socks can be lessened.

(2) Difference between Statements of Basic Application and Statements of Application of Claim of Priority

Basic Application (Application on which Priority bases)	(Corrected) Application of Claim of Priority
<p>[0011] Next, when the needle hook rotates toward the position H, .... Thus, .... In this case, an increase in number of stitches achieved when the needle hook rotates in a forward direction and an increase in number of stitches achieved when the needle hook rotates backward direction <u>are the same</u> (hereinafter referred to as "the same increase in number of stitches in both forward and backward directions").</p> <p>Further, knitted from ...as a sewed portion 14. Here, the tiptoe 12 ... an end of rotation. Such a connecting line ... a V shape.</p>	<p>[0014] .... In this case, a decrease in number of stitches achieved when the needle hook rotates in a forward direction and a decrease in number of stitches achieved when the needle hook rotates in a backward direction are <u>substantially the same</u>.</p> <p>[0015] Next, when the needle hook rotates toward the position H, .... Thus, .... In this case, an increase in number of stitches achieved when the needle hook rotates in the forward direction and an increase in number of stitches achieved when the needle hook rotates in the backward direction <u>are substantially the same</u>.</p> <p>[0016] Further, .... Here, .... The connecting line .... Meanwhile, the "<u>substantially the same number</u>" that has been referred to heretofore in the explanation about FIG. 1 <u>means that an about 10% difference of the number of stitches contributing to knitting can exist</u> between a decrease or increase in number of stitches achieved when the needle hook rotates in the forward direction and a decrease and increase in number of stitches achieved when the needle hook rotates in the backward direction.</p>

(3) Procedural History

- May 6, 1997 : Patent Application by Defendant (Patentee) (Japanese Patent Application No. H9-115607) (Basic Application for Priority)
- April 30, 1998 : Patent Application by Defendant based on Basic Application for Priority (Japanese Patent Application No. H10-120756) (Original Application Concerned)
- November 11, 1998 : Divisional Application by Defendant (Application Concerned)

- June 7, 2002 : Registration of establishment of a Patent Right
- November 14, 2008 : Request of Trial for Patent Invalidation by Defendant (Muko No. 2008-800254)
- January 30, 2009 : Request of Correction by Defendant
- September 28, 2009 : Correction Approved, Trial Decision stating "...patent shall be invalidated"
- : Suit of Reverse of Trial Decision Filed by Defendant (2009 (Gyo KE) No. 10356)
- January 29, 2010 : Decision to revoke the Trial Decision
- February 22, 2010 : Request of Correction (Correction concerned) by Defendant in Request of Trial for Patent Invalidation after the Rescission Decision Settlement (Muko No. 2008-800254)
- July 7, 2010 : Correction Concerned Approved, Appeal Decision stating that "the request of trial and appeal concerned shall not arise."

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

Appeal Decision (cited from the Court Decision)	
<p>Plaintiff provides, <u>as preliminary ground for invalidation</u> of the corrected invention concerned, the followings in the written refutation (3) dated April 2, 2010 submitted in the trial and appeal concerned proceedings. <u>Paragraphs [0014] to [0016] of the corrected description concerned include the statement about "substantially the same" that is not included in the original description for priority. The statement is in excess of the scope of the invention stated in the original description for priority, and hence a retroactive effect in respect of a filing date is not admitted.</u> Therefore, a person skilled in the art could easily conceive the corrected invention concerned from the invention of Exhibit A1. On the contrary, the appeal decision holds that the allegation by Plaintiff is not provided before submission of the request pertinent to the correction concerned and corresponds substantially to an amendment for changing the gist of the appeal, hence, the allegation violates Article 131bis(1) and cannot be adopted.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>...the corrected description concerned includes a <u>plurality of statements "substantial" which are not found in the original description for priority</u>; for instance, "a decrease in number of stitches achieved when the needle hook rotates in the forward direction and a decrease in number of stitches achieved when the needle hook rotates in the backward direction <u>are substantially the same</u>" ([0014]), and <u>"substantially the same" means that an about 10% difference of the number of stitches contributing to knitting can exist</u></p>	<p>Allegations by Defendant</p> <p>(1) Allegations by Plaintiff are as follows. The statements "substantially the same" in the corrected description concerned are not found in the original description for priority. Hence, a retroactive effect in respect of the application concerned is not admitted. On this ground, the trial decision interpreting the novelty and the inventive step of the corrected invention concerned on the basis of the erroneous filing date shall be revoked.</p> <p>However, the allegations by Plaintiff are the</p>

<p>between a decrease or increase in number of stitches achieved when the needle hook rotates in the forward direction and a decrease and increase in number of stitches achieved when the needle hook rotates in the backward direction" ([0016]). In view of the above statements of the corrected description concerned, for instance, <u>the shape of the edge of the increased-thickness knitted portion 16, which is created according to the knitting way stated in the corrected description concerned while the number of stitches is arbitrarily changed within a range of about 10%, falls within the corrected invention concerned even when the shape is not a V shape in a strict sense.</u> Obviously, <u>this is a matter not stated in the original description for priority.</u></p> <p><u>Even when the description about the scope of claims does not include any modifications, a retroactive effect in respect of a filing date under Article 41(2) of the Patent Act shall not be admitted in the invention (the invention claimed in the later application) outside the scope of claims if the invention goes beyond the scope of claims stated in the description of the patent application of claim of priority as a result of addition of an embodiment etc.</u></p> <p>In this case, when compared with the inventions stated in the original description for priority, the scope of right of claims 1 and 3 of the corrected inventions concerned have obviously become broader. Hence, a retroactive effect in respect of a filing date is not admitted.</p>	<p>same as the interpretation made in the trial decision; namely, the allegations "corresponding to a change to the gist of the request of appeal, violating Article 131bis(1) of the Patent Act, and being unable to be adopted." Thus, the allegations cannot be grounds for revoking the trial decision.</p> <p>(2) The statements of the corrected description concerned, which are the allegations by Plaintiff, are only "<u>substantially the same number (of stitches).</u>" This is a <u>concept or definition differing from "substantially a V shape."</u> The definition stated in the corrected description concerned is one meaning "substantially the same number" as can be seen from the phrase of "substantially the same number" and <u>not defining the word "substantial" itself.</u></p> <p>(3) Therefore, <u>the statement "substantially the same number" in the corrected description concerned is totally irrelevant to the "V shape."</u> Such a statement included in the corrected description concerned does not exert any influence on the technical range of the invention determined by a rectification from "<u>substantially V shape" to "V shape."</u></p>
<p>Judgment by the Court</p> <p>(1) About Justice of the Trial Decision</p> <p>...Allegations by Plaintiff in the request of appeal concerned (Exhibit A33) are as follows. The statement "substantially the same number" not stated in the original description for priority is included in the description of the application from the beginning. Hence, the invention concerned is beyond the scope of the invention stated in the original description for priority and cannot be subjected to application of Article 41(2) of the Patent Act. Therefore, the allegations of the written refutation (3) cannot be said to be an amendment</p>	

for changing the gist of the request of appeal.

Therefore, the trial decision must be said to include erroneous interpretations. Namely, Article 131bis(1) of the Patent Act was erroneously interpreted and, as a consequence, the allegations by Plaintiff were excluded without examination.

(2) About Justice of Allegations by Plaintiff

However, the following statements are not found in the original description for priority; for example, "in the meantime, the "substantially the same number" referred to heretofore in the explanation of FIG. 1 means that an about 10% difference of the number of stitches contributing to knitting can exist between decrease or increase in the number of stitches achieved when the needle when the needle hook rotates in a forward direction and decrease or increase in the number of stitches achieved when the needle hook rotates in a backward direction" ([0016] of the corrected description concerned) and "the decrease in the number of stitches in the forward and backward directions is substantially the same" (paragraph [0018] of the corrected description concerned). All the words "substantially" used herein do not relate to the V shape but to a difference between the decrease or increase in the number of stitches achieved when the needle hook rotates in the forward direction and decrease or increase in the number of stitches achieved when the needle hook rotates in the backward direction. The V shape is defined by the connecting line HJ and the connecting line HM or the connecting line NT and the connecting line VN that are the ends of rotation when the needle hook rotates in the forward direction. Hence, a difference between the increase or decrease in the number of stitches between the forward direction and the backward direction does not affect the V shape or the structure.

In that case, when compared with the inventions stated in the original description for priority, the scope of right of the claims 1 and 3 of the corrected invention concerned cannot be said to become broader.

(92)-4

Relevant portion of Examination Guidelines	Part V, Chapter 2
Classification of the Case	92: Whether or not the effects of internal priority claim are recognized
Keyword	

1. Bibliographic Items

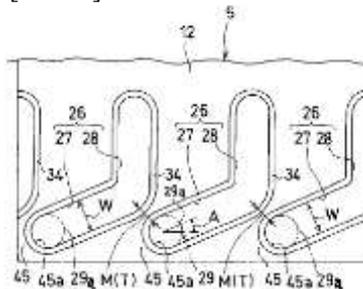
Case	"Rotary clamp case" (Trial for Invalidation) Intellectual Property High Court Decision, February 29, 2012 (2011, (Gyo KE) No. 10127)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2002-296828 (JP 2004-1163A)
Conclusion	Dismissal
Related Provision	(Former) Article 41(2)
Judges	IP High Court Second Division, Presiding Judge: Hidehira SHIOTSUKI, Judge: Kenjiro KOTANI, Judge: Minoru TANABE

## 2. Overview of the Case

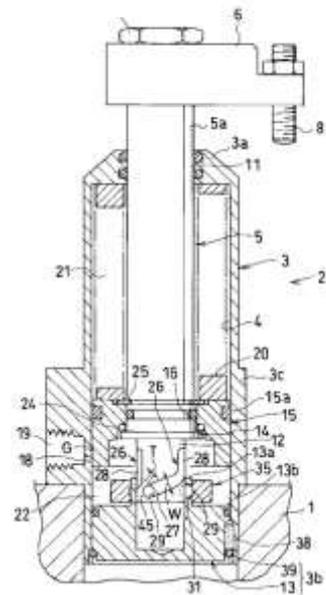
### (1) Summary of Claimed Invention

The claimed invention is to provide a rotary clamp for guiding a clamp rod with high accuracy, the clamp of which rotates the clamp rod. An upper slide portion 11 of the clamp rod 5 is vertically movably supported by an upper end wall 3a of a housing 3. A lower slide portion 12 of the clamp rod 5 is vertically movably supported by a support cylinder 13 of a lower end wall 3b of the housing 3. The rod 5 is provided with an input portion 14 between the upper slide portion 11 and the lower slide portion 12. The clamp rod 5 is driven downwards for clamping by a clamp spring 20 connected to the input portion 14. A helical rotary groove 27 and a straight groove 28 which is in upward continuity with the rotary groove 27 is provided to an outer periphery of the lower slide portion 12. A ball 29 engaging with the rotary groove 27 and the straight groove 28 is supported by an inner wall 13a of the support cylinder 13.

[FIG. 4]



[FIG. 1]



### (2) Description in the basic application (Finding of the Decision)

"It is disclosed in the specification (including figures. Priority 1, Exhibit A16) of the patent application (first basic application) filed on November 13, 2001, the specification (including figures. Priority 2, Exhibit A17) of the patent application (second basic application) filed on December 18, 2001 and the specification 3 (including figures. Priority 3, Exhibit A18) of the patent application (third basic application) filed on April 3, 2002 that, with four guide grooves which are assumed to be arranged to the lower slide portion 12 of the clamp rod 5, the helical rotary groove 27 has an inclined angle as the outer periphery of the lower slide portion 12 is in the state of being developed (for example, paragraph [0016] of Exhibit A16 and FIG. 2). However, there is no description or suggestion with regard to a specific range of the inclination angle." (Cited from the Court Decision)

### (3) The Claims (Claim 1 and Claim 3 only) ("the present invention 1" and "the present invention 3", in this order)

[Claim 1] A rotary clamp comprising: a housing (3) having a first end and a second end in a direction of an axis; a clamp rod (5) being inserted into the housing (3) rotatably around the axis and being moved for clamping in a direction from the first end to the second end, the clamp rod (5) has, a portion that fixes an arm (6), an upper slide portion (11) ..., an input portion (14) ..., and a lower slide portion (12) having a plurality of guide grooves (26) formed in the outer peripheral portion at almost equal distances, arranged in this order in the direction of an axis, and a plurality of balls (29) supported by the housing (3) so as to be fitted into each of the guide grooves

(26) ..., wherein ... each of the plurality of guide grooves (26) comprising a helical rotary groove (27) and a straight groove (28) which are provided in continuity with each other in a direction from the second end to the first end.

[Claim 3] The rotary clamp as set forth in claim 1 or claim 2, wherein the helical rotary groove (27) is formed in spiral and the inclination angle (A) of the helical rotary groove (27) is set in a range of 10 to 30 degrees.

(To note, claim 2 is recited in the form of dependent claim citing claim 1, and claim 4 is recited in the form of dependent claim alternatively citing claims 1 to 3.)

#### (4) Procedural History

- October 10, 2002 : Patent Application by Plaintiff (Patentee)  
(Priority date: November 13, 2001 (Japanese Patent Application No. 2001-346977, First basic application, Japan))  
(Priority date: December 18, 2001 (Japanese Patent Application No. 2001-383987, Second basic application, Japan))  
(Priority date: April 3, 2002 (Japanese Patent Application No. 2002-100851, Third basic application, Japan))
- November 9, 2007 : Registration of establishment of the patent right
- August 20, 2010 : Request for Trial for Patent Invalidation by Plaintiff (Muko No. 2010-800145)
- March 24, 2011 : Appeal Decision stating that "The patent regarding the inventions according to claims 1 to 3 was invalidated. ...the request for the Present Trial regarding the invention according to claim 4 is dismissed."

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

#### Appeal Decision (cited from the Court Decision)

It is described in the specifications of Priority 1, Priority 2, and Priority 3 that the helical rotary groove (27) has an inclination but a specific inclination angle value is not described. Moreover, there is no other description on the inclination of the helical rotary groove. Therefore, the inclination angle of the helical rotary groove of the present invention 3, which is a limited matter, is not a technical matter led from the description of the specification and the like of the basic applications as summed up. Rather, as a description in paragraph [0020] of the specification of the present patent states "the helical rotary groove 27 has an inclination angle A set to a small value within a range of about 11 degrees to about 25 degrees. ...As such the inclination angle A of the helical rotary groove 27 has been made small to result in largely shortening a lead of the rotary groove 27. This decreases the stroke for rotating the clamp rod 5," a new effect of the present invention 3 is generated and the present invention 3 would have the filing date which is the actual filing date of October 10, 2002. Individual claim has the effect of priority claim, however, ... the technical matter to be the gist of the invention recited in claim 3 of the present patent is beyond the scope of the technical matter described in the original specification and figures of the basic application for the priority claim, in which case the matter beyond the

scope is not recognized the effect of priority claim. ... the reference date of applying the provision of Article 29 is the actual filing date of October 10, 2002.

For the present invention 4 that cites the present invention 3, the reference date of applying the provision of Article 29 is also the actual filing date of October 10, 2002.

It is clear that the technical matter (in this case, the technical matter stated in the present invention 3...) being the gist of the invention described in Claims of the later application (in this case, the present inventions 1 to 4) goes beyond the scope of the technical matter described in the original specification and figures of the earlier application (in this case, Priorities 1 to 3), so that the technical matter beyond the scope of the present inventions 1 and 2 is not recognized as the effect of priority claim. In other words, the present inventions 1 and 2 including a configuration of the helical rotary groove has specified the angle thereof in the specification attached to the application document submitted on October 10, 2002, the actual filing date of the present patent, meaning that these inventions have incorporated a new matter as mentioned above. It is clear that the technical matter being the gist of the invention described in Claims 1 and 2 goes beyond the scope of the technical matter described in the original specification and figures of the earlier application. Thus, in the present patent, the effect of priority claim of the present invention 1 is not recognized. The effect of priority claim of the present invention 2 is not recognized on the same ground.

Decision	
<p>Allegations by Plaintiff</p> <p>Japanese Patent Application No. 2001-346977A (Exhibit A16), one of the grounds of the priority claim of each of the present inventions, has a description in paragraph [0005] that "when making the clamp rod more smoothly rotate, a rotary mechanism such as helical rotary groove is not necessarily made to have greater inclination. This decreases the rotation stroke of the clamp rod." Also, in FIG. 2 of the same publication, the helical rotary groove having the inclination angle of about 20 degrees is disclosed as a specific inclination value for the rotary mechanism. <u>By summing up what are described in the specification and figures, it can be said that the technical matter of "making the inclination angle of the helical rotary groove be smaller than the angle in general results in a clamp with the rotation stroke of a clamp rod decreased" is disclosed.</u></p> <p>... the limitation of "the inclination angle set in a</p>	<p>Allegations by Defendant</p> <p>FIG. 2 of Exhibit A16 is merely a schematic diagram from which a specific inclination angle cannot be read, and ... it is not clear from the figure what the inclination angle is for the helical rotary groove being disposed in the number of two, three or five.</p> <p>Moreover, the description in the paragraph ... of Exhibit A16 does not account for a specific numerical range of 10 to 30 degrees. <u>According to the allegation of the plaintiff, the range of the inclination angle concerned is innovative as well as exponential compared to the conventionally known range, so that it is not the common general knowledge among a skilled person in the art, which the skilled person in the art cannot be easily conceived from the description in specification and figure.</u></p> <p>... the limitation of numerical range for the inclination angle in the present invention 3 introduces a new technical matter and the appeal decision mentioning so is considered valid.</p>

<p><u>range between 10 to 30 degrees" makes the technical matter of "smaller than the angle in general" be definite. Thus, the limitation in the present invention 3 is considered as merely a matter achieved within a range of the technical matter led from the above-mentioned specification and figures, which does not introduce a new technical matter.</u></p> <p><u>Since there is no limited matter with regard to the inclination angle of the helical rotary groove in the recitation of Claims of the present inventions 1 and 2, it is not recognized as the addition of new matter to the present inventions 1 and 2.</u></p>	<p>The present inventions 1 and 2 serve as generic claim for the present invention 3 and <u>it should be said that "helical rotary groove" in Claims inherently has a limited matter with respect to "inclination angle."</u> In this regard, the present invention 3 <u>added a new technical matter that is not included in the basic application, the present inventions 1 and 2 are also deemed to have a new technical matter added.</u> Therefore, the present inventions 1 and 2 should also be considered as not enjoying the effect of priority claim.</p>
<p>Judgment by the Court</p> <p>"It is disclosed in the specification (including figures. Priority 1, Exhibit A16) of the patent application (first basic application) filed on November 13, 2001, the specification (including figures. Priority 2, Exhibit A17) of the patent application (second basic application) filed on December 18, 2001 and the specification 3 (including figures. Priority 3, Exhibit A18) of the patent application (third basic application) filed on April 3, 2002 that the helical rotary groove 27 has an inclination angle. However, <u>there is no description or suggestion with regard to a specific range of the inclination angle.</u>" <u>A configuration of the present invention 3 which reads "the inclination angle (A) of the helical rotary groove (27) is set in a range of 10 to 30 degrees" (a matter specifying the invention) is not a matter in the patent application that is filed "based on the invention described in the specification or figures attached to the originally filed document" of the earlier application, so-called according to Article 41(1) before revision of the Patent Act (hereafter "former Patent Act"). Thus, when the present invention 3 is determined for its applicability to the provision of Article 29 of the Patent Act, the effect of priority claim cannot be enjoyed and the novelty of the invention should be determined on the basis of the actual filing date of October 10, 2002.</u></p> <p>... although the limitation (a matter specifying the invention) of the present invention 3 "the inclination angle is set in a range of 10 to 30 degrees" defines a specific numerical range, <u>FIG. 2 attached to each of the specifications for the basic applications altogether fails to describe a numerical value for size and angle and the like. Besides, what is depicted in FIG. 2 does not make up a complete cylinder when making each end of the left and right sides meet. It is clear from these points that FIG. 2 is a schematic view that serves to show a structure of the guide groove, not allowing one to interpret it as a specific numerical range of the inclination angle. Furthermore, in the clamp device as disclosed in the present invention 3, there is not enough evidence to recognize a common technical knowledge of a person skilled in the art that "the inclination angle of the guide groove which guides the rotational movement of the clamp rod would be "in a range of 10 to 30 degrees" when it is made smaller than that of the conventional clamp device. ...</u></p> <p>The present invention 4 cites any one of the present inventions 1 to 3 and additionally limits as "it is</p>	

characterized by ..... wherein ... the plurality of balls (29) ... ," and similar to the present invention 3, the present invention 4 cannot enjoy the effect of priority claim and thus, the novelty of the invention should be determined on the basis of the actual filing date of October 10, 2002.

In this case, the present inventions 1 and 2 fail to specify the inclination angle for the guide groove but the present invention 3 has a matter specifying the invention with regard to the inclination angle, "the inclination angle is set in a range of 10 to 30 degrees," not disclosed in the specifications (including figures) of the first to third basic applications. Regardless of this circumstance, the present inventions 1 and 2 are not deemed to be filed as specifying the above matter by encompassing it as the matter specifying the invention and then to be registered accordingly. The rationale here would be further clear if a case is assumed where, for example, claim 3 (the present invention 3) is cancelled from the recitation in Claims. Therefore, in view of the recitation in Claims of the present inventions 1 and 2 (Claims 1 and 2), there is no way of denying the patent application is filed "based on these inventions described in the specification or figures attached to the original application of" the earlier application as set forth in Article 41(1) of the former Patent Act and accordingly the plaintiff can enjoy the effect of the priority claim. Also, in applying the provision of Article 29 of the Patent Act, the earliest priority date (November 13, 2001, the filing date of the first basic application) may be allowable to be the reference date.