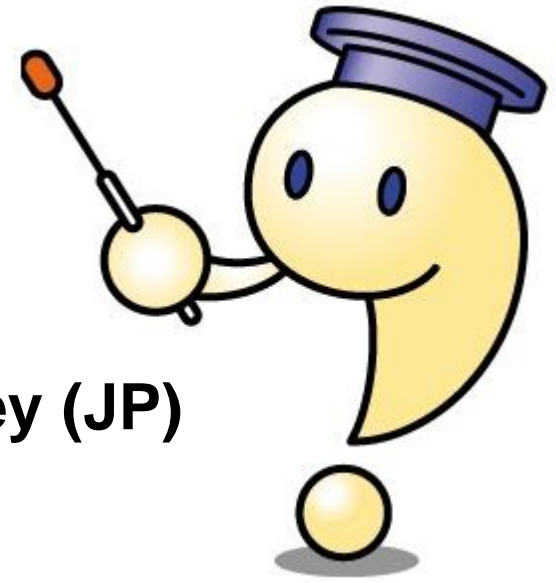




IP High Court Rules on Disclaimer Claims in Favor of Patentee

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Summary of the Case

- The Chemours Company (the “Plaintiff”) is the holder of a patent for a composition that can be used as a refrigerant (the “Patent”). AGC Inc., filed an invalidation action of the Patent with the JPO. After the trial, the JPO issued a preliminary notice of decision to invalidate the Patent citing a prior art that denies inventive step.
- The Plaintiff filed a request for claim amendment to overcome the lack of inventive step, requesting that the claims of the Patent be amended by “disclaimer” (as shown below). However, the JPO decided that such amendment could not be granted and issued a decision invalidating the patent.

Summary of the Case

- The Plaintiff then filed a lawsuit to overturn the JPO's decision.
- The IP High Court found no problem with such claim amendment and reversed the decision of the JPO. (IP High Court Decision dated October 5, 2023 [Case Reiwa4 (gyo-ke) 10125])

Parties

- The Chemours Company is the owner of the Patent for the invention entitled "Compositions comprising 2,3-dichloro-1,1,1-trifluoropropane, 2-chloro-1,1,1-trifluoropropene, 2-chloro-1,1,1,2-tetrafluoropropane, or 2,3,3,3-tetrafluoropropene" (Patent No. 6585232), the respondent of the invalidation action before the JPO, and the Plaintiff before the IP High Court.
- AGC Inc., is the claimant of the invalidation action before the JPO and is the defendant before the IP High Court.

Claims

- **Invention (Before claim amendment)**

Claim 1

A composition comprising HFO-1234yf, HFC-254eb and HFC-245cb.

Claims 2 to 7: omitted.

- **Invention (After the claim amendment)**

Claim 1

A composition comprising HFO-1234yf, HFC-254eb and HFC-245cb (except a composition comprising 1% by weight or more of HCFC-225cb).

Claims 2 to 7: omitted.

“Disclaimer Claims”

- Note: As described above, the patentee has requested an amendment to exclude underlined portions from the original claims. Such an amendment is called a "disclaimer" in Japan.

Decision of the JPO

- The JPO, in general, ruled that in order for the amendment of the disclaimer with a numerical limitation not to add any new matter, it is required that such "excluded" area/matter be disclosed in the Specification.
- Then, the JPO found the claim amendment to be a new matter, saying that the amendment provided a new technical matter of “a composition containing HCFC-225cb at less than 1% by weight”, but the specification did not disclose anything about HCFC-225cb.
- Namely, the JPO took issue with the fact that the "excluded" area/matter was not written in the Specification.

Decision of the IP High Court

- The IP High Court held that the claim amendment must be made “within the scope of the matters disclosed in the description, claims, or drawings attached to the patent application,” and that “matters disclosed in the description, claims, or drawings attached to the patent application” shall mean technical matters that can be inferred by a person ordinarily skilled in the art after considering the entire disclosure of the description, claims, or drawings as a whole.

Decision of the IP High Court

- The Court then held that, with respect to claim 1 before the amendment, the language of that claim should have allowed the inclusion of any other substance as long as it contained HFO-1234yf, HFC-254eb, and HFC-245cb, and the amendment only provided for the exclusion of “composition containing more than 1% by weight of HCFC-225cb” from that scope.

Decision of the IP High Court

- The Court further held that the disclaimer claims must not materially enlarge or modify the scope of the claims, but "there is no further requirement that they exclude only those parts that are identical to the prior invention or that they exclude only those parts that are identical to the prior art known prior to the filing of the patent application in question."
- Thus, the IP High Court accepted the requested claim amendment because such amendment did not add any new technical matter to the technical matter disclosed in the Specification and reversed the decision of the JPO.

Comments

- Currently, courts in Japan allow disclaimer claims quite freely.
- In this regard, it is very noteworthy that this decision states that the disclaimer claims must not substantially enlarge or modify the scope of the claims, but “beyond that, there is no requirement to exclude only those parts that are identical to the prior invention or to exclude only those parts that are identical to the prior art known prior to the filing of the patent application in question.”

Comments

- On the other hand, with respect to “disclaimer” claims, some Japanese practitioners have expressed concern that the current standard where a “disclaimer” can be made without any particular limitation is problematic. Such people suggest that limitations be placed on making “disclaimer” claims. One possible interpretation is to require some basis for excluding part of the claim, for example, limiting it to the case of securing novelty against “the incidental prior art.”
- However, given the recent pro-patent trend of the courts, it is unlikely that the courts will adopt such a limitation.

Comments

- Not only this decision, but also a number of recent court decisions allowing disclaimer claims will contribute to the protection of patent rights in Japan.



Thank you!



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