

The Patentability of Dental Treatment
The IP High Court
Case H19 (Gyoke) No. 10369 decided June 24, 2008

Facts

The plaintiff, SHADE ANALYZING TECHNOLOGIES Inc. (US) filed a PCT Application (PCT/US99/22857) which entered into the Japanese National Phase as Application No. 2000-579144, addressing "Interactive Dental Restorative Network". The application was rejected on January 21, 2005 and the plaintiff (applicant) filed an appeal against the decision of rejection with the Board of Appeals (Appeal No. 2005-7446). In the appeal, the plaintiff tried to amend the claims on May 26, 2005, but the Board of Appeals did not accept the amendments for failing to satisfy the requirements of amendment. Thus, the rejection made final.

The plaintiff appealed the decision to the Tokyo Appellate Court (currently called "the IP High Court"). The issues in the appeal were: (1) whether the rejection of the claim amendments was appropriate; and (2) whether the claimed invention satisfies the eligibility of an invention prescribed in Art.29(1), main paragraph. As to issue (1), the IP High Court affirmed the rejection of the claim amendments. However, as to issue (2), the Court negated the Board Decision on the ground that the claimed invention satisfies the statutory eligibility of an invention.

Board Decision

The Board of Appeals states as follows:

(1) The claim amendment is disapproved because it fails to satisfy any of the statutory requirements which provide that a substantive amendment shall be limited to (1) cancellation of claim(s), (2) restriction of claim(s), (3) correction of error(s) and (4) clarification of descriptive ambiguity; and

(2) The claimed invention is not eligible for a patent, because it does not meet the statutory definition of an invention under Art.2(1) of the Patent Law.

IP High Court Decision

(1) The Court held that the Board of Appeals had wrongly underestimated the meanings of "a means for identifying ..." and "a means for designing ...". The present invention is to provide a technical means for a dentist to rely on when he or she identifies and design a dental restoration need and a treatment plan therefore.

(2) It is understood that the invention provides a method and system for assisting a dentist and a dental technician to make preliminary and final treatment plans to meet the identified dental restoration need not by a mental act but by aid of a computer which comprises a network server having a database; a communications network; one or more computers located at a dental office; and a device capable of image display and processing..

In conclusion, the claimed invention can be recognized to be eligible for a patent. Thus, the Court dismiss the Board Decision.