

Utilization of a Law of Nature

IP High Court

Case H20 (Gyo-Ke) 10001, Judgment on August 26, 2008 (H20)

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FACTS

The plaintiff filed a patent application (JP No. 2003-154827, hereinafter referred to as “the present application”), claiming “a method for consulting a parallel translation dictionary in English and another language with a sound-index multi-element matrix configuration for mutually collating in a stepwise fashion”.

In response to receiving the decision of rejection from the examiner, the plaintiff filed an appeal therefrom. The appeal board at the Japan Patent Office decided that the claimed invention should be rejected.

The ground for the decision was as following. The “method” of the present invention is that for referring to a dictionary based on a rule for actions taken by men/women defined by human beings. The claim recitations specify a parallel translation dictionary which is subject to the consulting. However, these are features of the parallel translation dictionary itself. The claimed matter remains a rule for actions taken by men/women defined by human beings regardless of the features of the parallel translation dictionary.

The plaintiff appealed from the decision to the IP High Court.

ISSUE

Whether “the method for consulting a dictionary” of the present application falls under the “invention” defined in Article 2 (1) of the Patent Act.

HOLDING

Art. 2 (1) of the Patent Act provides that an invention is “a highly advanced creation of a technical idea utilizing a law of nature”. Therefore, if the creation of a technical idea to solve a problem does not include any means utilizing a law of nature, it does not fall under the “invention” under Art. 2 (1) of the Patent Act.

Because human beings are able to act freely and decide as an independent entity, generally speaking, it is impossible to predict or expect a repetitive typological universal.

Therefore, a specific mental process and so on of human beings itself cannot be directly regarded as utilization of a law of nature. On the other hand, any creation of a technical idea for solving a problem is not unrelated to a mental process and so on of human beings. Therefore, a subject matter cannot be concluded that it is not a method for solving a problem utilizing a law of nature, that is, not “an invention” under Art. 2 (1) of the Patent Act, only by including a mental process of human beings.

Accordingly, when deciding whether a claimed creation of a technical idea utilizes a law of nature, recitations of claims must be reviewed as a whole (needless to say a specification and figures may be taken into account). The decision must be made based on whether or not a utilization of a law of nature is positioned as a major means in an entire creation of a technical idea for solving a problem. It is improper to deny that the claimed subject matter is “an invention” under the provision, only because the entire configuration of the claimed creation of the technical idea includes an element of a mental process and so on of a human being, or because it is closely related to a mental process and so on of a human being.

The feature of the present invention is as following. In English, there are many patterns of pronunciation and often the spelling does not express its pronunciation. Therefore, it is difficult to infer the spelling from its pronunciation. In order to solve this problem, this invention provides a method which utilizes an ability of human beings (including non-native English speakers) to hear sounds (in particular, consonants) and identify it so as to point out an English word, thereby finding information about its spelling, a translated word and so on, to search vowel sounds from consonant sounds step by step and to reach the targeted word by referring to consonant elements which he/she caught in the sound even though he/she cannot specify the full spelling of the word.

In view of preferentially extracting consonants and listing consonant elements in alphabetical order, it is apparent that the invention is based on, and utilizes, the ability of non-native English speakers to catch consonants better than vowels. Accordingly, the present invention chose the ability of cognition for sounds, in particular, the high ability to catch consonants, from those which human beings (including subjects assumed to use a dictionary of the present invention) inherently have so as to provide a method for realizing a repetitive and continuous result in which a user finds the meaning of an English word even though he/she does not know its correct spelling. Thus, the creation of the technical idea utilizing a law of nature is positioned as a major means to resolve the problem and falls under the “invention” provided under Art. 2 (1) of the Patent Act.

Example of Dictionary concerning the Invention

Consonant elements		Word elements	Translated word
	"IPA" element		
lsh	[áilæʃ]	eyelash	睫毛(まつげ)
lshs	[láʃəs]	luscious	風味がいい
lsk	[əléskə]	Alaska	アラスカ州
lsl	[lú:slɪ]	loosely	ゆるく, ばらばらに
lsn	[lú:sn]	loosen	ゆるむ, ゆるめる
lsn	[lésn]	lessen	小さくする, 減らす
lsn	[lésn]	lesson	課, 授業, けいこ
lsn	[lísən]	listen	聞く, 聞こうとする
lsn	[lísənə]	listener	聞き手, 聴取者
lsns	[láisəns]	license	免許, 認可

Row (four elements for a word)

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Original document (Japanese):

http://www.courts.go.jp/app/files/hanrei_jp/727/036727_hanrei.pdf

English Summary:

<http://www.courts.go.jp/hanrei/pdf/20100317212150.pdf>