

Lipase Case
Construction of claim language
Supreme Court
Case S63 (Gyo-Tsu) No.3 (March 8, 1991)

The Supreme Court determined that only certain situations allow construction of claim language by referring to the specification of a patent application in an ex parte case.

FACTS

1. The applicant filed a patent application for an invention used to improve a method of measuring triglyceride. The method measures the glycerin obtained by an enzyme saponification of the triglyceride with the lipase (hereinafter, it is said, "Ra-lipase") from *Rhizopus arrhizus* (synonymous with *Rhizopus arrhizus*). Only the general term "lipase" is used in the claims, without any limitation, while a more specific term, "Ra-lipase", is constantly used in the specification.
2. Both the examiner and the Board of Appeal rejected the patent application.
3. The applicant appealed to the Tokyo High Court.
4. The Tokyo High Court construed the word "lipase" as "Ra-lipase" by referring to the specification in spite of no such limitation in the claim language, and denied the rejection of the application by the Board of Appeal.
5. The Japan Patent Office appealed to The Supreme Court.

ISSUE

Is construction of claim language by referring to the specification allowed or not in an *ex parte* case? If so, what is the criterion of reference?

DECISION

Comprehension of the subject matter of an invention, namely, construction of claim language, should be based on the claim language itself unless there are special circumstances such as the following:

- The technical meaning of the claim language cannot be understood unambiguously and clearly.
- A misdescription in the claim language is apparent in light of the detailed description of the invention in the specification.

In the present case, the claim language has no limitation for the term "lipase", used in enzyme saponification of the triglyceride, and no special circumstances like those stated above can be found. Thus, the lipase in the claims cannot be construed as

Ra-lipase.

In addition, that a lipase other than Ra-lipase is not likely to be used is a fact that cannot be considered to fall within the common technical knowledge of a person skilled in the field of the measuring method of this invention. Therefore, technical support in the detailed description of the invention or constant usage in the embodiments only of Ra-lipase are not sufficient to limit construction of the term "lipase" in the claims as Ra-lipase.