

Polarizing Film Manufacturing Process Case
The requirements for support in description for parametrically limited invention
IP High Court (en banc)
Case H17(Gyo-Ke) No.10042 (November 11, 2005)

The IP High Court handed down a decision outlining how much description is necessary to meet the requirement for support in the specification (the Patent Law Art.36(6)(i)) for parametrically limited invention.

FACTS

1. The plaintiff filed a patent application entitled "Process of manufacturing a polarizing film" on Oct. 21, 1993.

Claimed invention includes a parametric limitation as follows:

$Y > -0.0667X + 6.73$ (I)

$X \geq 65$ (II)

wherein X is completely dissolution temperature in hot water, Y is equilibrium swelling factor.

The original specification includes only four tangible examples, which are shown as black/white circles in the figure attached below.

2. The JPO granted a patent on July 12, 2002.

3. The JPO published the Examination Guideline for the requirements for support in the specification for a parametrically limited invention. The Guideline newly stated that the requirements are not fulfilled when a specification cannot expand/generalize up to claimed inventions accounting a state of the art at the filing of the application.

4. An opposition for the patent was filed. During the examination for the opposition, the patentee submitted additional experimental data. The data included ten new tangible examples. They are shown as black/white rectangles in the figure attached below.

5. The JPO decided a revocation of the patent for lack of the requirements for support in the specification on Nov. 26, 2004.

6. The patentee appealed to the IP high court for cancellation of the revocation.

ISSUES

Issue 1:

How much description is need to satisfy the requirements for support in the specification for a parametrically limited invention?

Issue 2:

Are the experimental data filed after the fling of the application valid for fulfilling the requirements for support in the specification?

Issue 3:

Should the Examination Guideline be retroactively applied to applications filed before its effective date?

COURT DECISION

Issue 1:

The specification must describe a technical meaning of a relation between a parametrically defined region and a meritorious effect of the invention without tangible examples, or, disclose enough tangible examples for understanding that the subject matter defined by the region has a meritorious effect.

Therefore, in this case, the requirements for support in the specification are not

fulfilled.

Issue 2:

Experimental data submitted after the application was filed cannot be used to fulfill the requirements for support in the specification. Fulfilling the requirements for support in the specification by ex-post complement outside an initial specification does not conform to the spirit of the Patent Law, which grants a patent on the premise of full disclosure of an invention.

Issue 3:

The Examination Guideline is not a legal regulation. A legality of an application depends on law itself, not on the Examination Guideline. Therefore, the retroactive application of the Examination Guideline is irrelevant for legal judgment.

FIGURE

Equilibrium swelling factor vs. completely dissolution temperature

