Appendix 4

Case No. 2004 (Gyo-Ke) 290 (excerption)

Legal judgment revocation appeal case No. 2004 Gyo-Ke 290

Oral argument terminated on March 14, 2005

Chapter 5. Official judgment pronounced by the Tokyo High Court

Regarding the Plaintiff's claim maintaining that the Japan Patent Office erred on the judgment laid down as the violation against the provision set forth in the former Article 36(5)(ii) of the Patent Act of Japan

(1) In summary, the reasons for the official judgment pronounced by the appeal against the Plaintiff comprise the essential factors as explicated hereinafter. With regard to the inert particles available for carrying out the invention in subject, any of the representative diameter, the average particle diameter, and the distribution of the particle diameter has not definitely been determined, and further, the definition and the meaning of the average particle diameter have not definitely determined as well. Due to these reasons, it is officially concluded that the invention in the present case is not specified.

(2) With regard to the method of determining the average particle diameter of the above inert particles, there are many kinds of methods including the number average particle diameter, the length average particle diameter, and the volume average particle diameter and formulas for calculating these factors differ from each other.

The Evidence submitted by the Defendant cites the following configurations in FIG. 5.2 on page 30.

(A) With regard to the group of particles consisting of a sum of 16 cubic substances including 4 cubes 7μm on a side, 3 cubes each whose length are 6μm and 8μm on a side, 2 cubes each whose length are 5μm and 9μm on a side, and one cube each whose length are 4μm and 10μm on a side, it is shown in FIG. 5.2 that the average particle diameter based on the length average particle diameter, the planar dimension average particle diameter, and the volume (weight) average particle diameter, are respectively identified as 7.0μm, 7.17μm, and 7.34μm. It is also shown in FIG. 5.2 that the average particle diameter based on the length average particle diameter and the planar dimension average particle diameter, and the surface area average particle diameter, are respectively identified as 7.4μm and 7.7μm.

(B) The above Evidence further cites on page 30 "5.1.2 particle diameter measurement method: Based on the classification of the commercially available methods currently applied to the measurement of particles, the measurement range, the meaning of the measured particle diameter, etc. are summarized in Table 5.2" Table 5.2 designates the following definitions. In the case of applying an optical microscope and an electronic microscope, the measurable particle diameter is related with the particle length and planar dimension. Number distribution is adopted as

distribution reference. In the case of applying the Coulter counter method, the measurable particle diameter corresponds to the diameter of the equivalent spherical diameter. Weight distribution is adopted as distribution reference. In the case of applying the laser forward scattering method and the light scattering method, the measurable particle diameter corresponds to the diameter of the equivalent spherical diameter. Volume distribution is adopted as distribution reference. As shown above, applicable methods are different from each other.

According to the above descriptions, when measuring the average particle diameter related to a simplified distribution model shown in FIG. 5.2, depending on any of the applied basis including the length, planar dimension, and the volume, it is understood that there is a substantial difference among the individual method by a maximum of approximately 10%. It should be noted that FIG. 5.2 illustrates cubic configuration of particles. However, even if the illustrated object consists of spherical configuration, it is a matter of course that the ratio remains invariable. Further, since FIG. 5.2 merely illustrates a simplified model, depending on the distribution rate, it is expected that the above difference will become more conspicuous. Based on the above case, there may be a case in which the length average particle diameter of the certain particles becomes 2.9μm, which is shorter than the numerical range cited in the invention in subject, on the other hand, in the case of the volume average particle diameter and the planar dimension average particle diameter, the average particle diameter of the same particles above becomes approximately 3.2μm, which is within the numerical range cited in the invention.

Hence, unless specifying the definition and the meaning of the average particle diameter concretely, it is recognized that the meaning of the average particle diameter is not definitely clear.

The experimental result certificates have respectively disclosed the measurement results showing different results generated by the different methods in measuring the diameter of same spherical particle. Thus the above result corroborates that there are many kinds of methods for measuring the average particle diameter including the laser forward scattered method, the Coulter counter method, and the gravity sedimentation, etc., and the numerical range of the average particle diameter having an identical definition could differ from each other depending on the methods for measuring the average particle diameter. Hence, it is not recognizable that substantial difference could not be generated due to the difference in the method for measuring the average particle diameter as maintained by the Plaintiff.

(3) The above-cited amended Specification merely describes on the average particle diameter of inert particles as follows:

(A) “Paragraph [0010]:

If the average particle diameter was less than 3μm, the sliding characteristics and anti-blocking characteristics would respectively be degraded, which is not desirable. Conversely, if the average particle diameter exceeds 15μm, the external appearance of the inventive composite film will be

degraded, which is also undesirable. Available inert particles may be of one kind or plural kinds having different average particle diameter in combination with each other. Practically, it is a preferred embodiment of the present invention to combine more than two kinds of inert particles having different average particle diameter. Further, available inert particles may be of an organic substance or an inorganic substance or a composite substance of these. Insofar as inorganic inert particles are insoluble and inert to linear low-density polyethylene, there is no further restriction to them. Concretely, applicable inorganic inert particles may comprise those metallic oxides including silica, alumina, zirconia, or the like, for example. These inorganic inert particles may be of natural product or synthesized product. There is no restriction on the form of particles."

(B) "Paragraph [0011]:

To compose the cross-linked high-polymer particles, any of the following materials may be applied, which, for example, include copolymer comprising acrylic monomers such as acrylic acid, methacrylic acid, styrene monomer such as styrene, acrylic substitutive styrene, and any of those cross-linked monomers. Although the practical form of the above-cited inert particles is not specifically restricted, it is desired that a substantially spherical form or an ellipsoidal form be used."

(C) "Paragraph [0016]:

In the present invention, it is essential that layer B shall contain 0.3wt% up to 1.5wt% of inert particles having 2μm ~ 7μm of average particle diameter. If the average particle diameter is less than 2μm, the sliding characteristics and anti-blocking characteristics would respectively be lowered, which is not desirable. Conversely, if the average particle diameter exceeds 7μm, it will degrade the film appearance, which is also undesirable. It is preferable that the average particle diameter shall be in a range from 3μm up to 6μm."

It is obvious from the above descriptions that the definition, the meaning, and the method of measuring the average particle diameter have not been specified, and yet, the product names of the corresponding spherical inert particles have not been specified concretely. Further, there is no description that helps grasping the above detailed information at all in the above amended Specification. Therefore, it is impossible for a person skilled in the art to comprehend the numerical range of the average particle diameter of the above spherical inert particles from the amended Specification.

Nevertheless, if a person skilled in the art commonly understands the adoptable measuring method without referring to the concrete description thereof, it is arguable that the average particle diameter can be specified. However, even in the related patent practice, the various average particle diameter and measurement methods cited above have actually been practiced by way of explicating the meaning and the measurement methods in the corresponding specifications as cited in the Evidences submitted by the Defendant. Based on this reason, it is not recognizable that a person skilled in the art can commonly understand the above matter. In the previous procedure, the

Plaintiff claims that the average particle diameter in the invention in subject is based on the number average particle diameter of the applied inert particles, whereas the Plaintiff claims that the average particle diameter thereof is based on the volume average particle diameter in the present lawsuit. Hence, the Plaintiff's claim is inconsistent.

(4) As fully described above, the numerical range of the above average particle diameter are significantly variable depending on the definitions and meanings of the average particle diameter, and also depending on the method of measuring the average particle diameter. Any of the above definitions, the meanings, and the measurement methods have actually been used. In addition, since it is not recognizable that a person skilled in the art can commonly and normally conceive adoptable the definition, the meaning, and the measurement method of the average particle diameter of available inert particles (if not being described in Specification), it is quite necessary for the Plaintiff to properly define the above requirements in the amended Specification.

Nevertheless, as described above, the amended Specification is totally devoid of descriptions that specify the above requirements nor any description to provide a clue thereof. Even though it is assumed that, by specifying the inert particles consisting of certain spherical material, it is possible to comprehend the applied material and the meaning of a representative diameter (spherical diameter), it is obvious that the above inert particles are still not be able to specify them.

(5) The Plaintiff maintains that, inasmuch as the average particle diameter does not constitute the essential part of the invention in subject, it is not necessary to strictly specify the average particle diameter of the applicable inert particles.

However, as cited in the "Technical Problem" described in the amended Specification, "the object of the present invention is to fully solve the problems by providing a novel composite film comprising linear low-density polyethylene incorporating excellent adhesion under low temperature, with satisfactory anti-blocking characteristics, and stable rigidity". Hence, as cited in the foregoing section (3), since the Plaintiff claims that an arrangement for securing the average particle diameter within a predetermined extent is necessary so as to at least secure the blocking-proof property, it is apparent that the arrangement for securing the average particle diameter constitutes the essential part of the invention.

Now that the average particle diameter has duly been identified as the essential part of the invention in subject, it is a matter of course that the average particle diameter must not be of the numerical range that makes it impossible to have the invention achieve the above object, and thus, it is hardly recognizable that it is not necessary that the definite range of the average particle diameter is strictly defined in the amended Specification.

As fully explicated in the above descriptions, there are no mistakes in the appeal decision on the provision set forth in the former Article 36(5)(ii) of the Patent Act of Japan.

Appendix 4

3. Regarding the alleged err in the judgment related with the alleged violation against the provision set forth in Article 36(4) of the Patent Act of Japan

(1) As described in the foregoing section 2, insofar as the invention in subject fails to specify the definition of the average particle diameter, the names of the manufacturers and the product names of the applicable inert particles, this in turn causes a person skilled in the art to be uncertain of the appropriate spherical inert particles each having a definite average particle diameter. Due to this reason, it is quite apparent that the invention in subject cannot practically be carried out by a person skilled in the art.

(2) The Plaintiff maintains that, inasmuch as any of the spherical particles of silica, zeolite (silicon dioxide), and cross-linked polymethyl methacrylate is readily procurable from the commercial market, it is possible to carry out the invention in subject by applying them.

However, the amended Specification is devoid of any description to explain that if only the nominal range of spherical inert particles announced by the corresponding manufacturers correctly meet the numerical range of the average particle diameter described in Claims, any of such inert particles can be used as the particles described in Claims. Actually, there is no evidence enough to believe that nominal range of the above spherical inert particles announced by corresponding manufacturers correctly meet the numerical range of the average particle diameter described in the Claims. As described in the foregoing section 2, it is quite evident that there are a variety of the definitions and the methods for measuring the average particle diameter, and many kinds of the measurement methods have actually been applied, and yet, the resultant numerical range is significantly variable. Hence, it is not found that a person skilled in the art believes that the numerical range of the inert particles used for carrying out the invention is coincident with the nominal range announced by corresponding manufacturers. Due to the above reasons, the claim maintained by the Plaintiff has no grounds.