Kallikrein Case
(Effect of a patent right as to an invention of a process)
Supreme Court Decision
Case H10 (O) No.604 (July 16, 1999)

ISSUE

Where a patent directed to "a process invention" (not "an invention of a process for producing a product") is issued, is the patent infringed by producing and selling a product produced by the process?

FACTS

The appellee, X, owns the following patent ("the patent"):

Patent Number: 1,725,747

Title of Invention: Method of Assaying Kallikrein Formation Substances

The claims of the patent are directed to a method of assaying inhibitory action of a kallikrein formation inhibitor ("the process").

The appellant, Y, was allowed to produce medicine under the Pharmaceutical Affairs Act, and produced the medicine.

The appellee, X, demanded an injunction to stop Y from producing the medicine, to order Y to dispose of the medicine so produced, *etc.,* alleging that its patent was infringed by using the patented method to produce the medicine.

DISPOSITION IN THE LOWER COURT

The Osaka High Court held that 1) the method used by the appellant is covered by the technical scope of the patented invention but that 2) the claimed invention, although conceptually directed to "a process invention," is in substance directed to "an invention of a process for producing a product," and that therefore Y infringed the patent.

Y appealed to the Supreme Court.

HOLDING

The Supreme Court held that judgment 2) of the Osaka High Court is incorrect.

With respect to "an invention of a process," "working of an invention" is defined as "the use thereof" (Article 2(3)2 of the Patent Law). With respect to "an invention of a process for producing a product," "the use thereof" is further defined as "using, assigning, leasing, importing, or offering for an assignment or a lease the product produced by the process" (Article 2(3)3).

Thus, "an invention of a process" is clearly differentiated from "an invention of a process for producing a product" in literal terms, and the effect also is clearly different.

Accordingly, "an invention of a process" cannot be equated to "an invention of a process for producing a product," and the effect of the patent right of "an invention of a process" cannot be equated to that of the patent right of "an invention of a process for producing a product."

Further, the category of an invention should be determined by the description in the claims.

In this case, because the claims of the patent describe a method of assaying inhibitory

action of a kallikrein formation inhibitor, the invention is “an invention of a process.” Thus, even if the process of the appellee X is included in the process for producing the medicine of the appellant Y, the invention still cannot be “a process for producing a product.” Also, it is difficult to find a reason to allow the same effect for “an invention of a process” as that of “an invention of a process for producing a product.”

In view of above, even when the appellant Y uses the patented process of X and produces and sells the medicine, producing and selling the medicine do not infringe the patent right of the appellee X.