

**Thermosetting Resin Composition Case  
Disclaimer  
IP High Court (en banc)  
Case H18 (Ne) No.10563 (May 30, 2008)**

*With respect to use of “Disclaimer” (e.g., use of proviso language to exclude a technical matter described in prior art from the claims), the IP High Court affirmed that exclusion of specific prior art combinations does not modify the technical matter of the previously claimed invention described in the specification. The IP High Court also affirmed the use of a trade name in the proviso language.*

**FACTS**

The prosecution history of the subject patent is described briefly as follows. JPO rendered a decision to revoke Patent No.2133267. Patentee appealed the decision. Patentee also filed a district court action to correct/amend the claims by “Disclaimer” (to avoid invalidity reason for novelty). IP High Court remanded the case to the JPO. JPO rendered a decision to admit the correction and affirm the validity of the patent. Demande filed a law suit against the JPO decision. The claim in question reads as follows.

*1. A photosensitive thermosetting-resin composition, comprising (A) a photosensitive prepolymer containing at least two ethylenically unsaturated bonds in the molecular unit thereof, selected from ....., (B) a photoinitiator, (C) a photopolymerizable vinyl monomer and/or an organic solvent as a diluent, and (D) a finely powdered epoxy compound containing at least two epoxy groups in the molecular unit thereof and exhibiting sparing solubility in the diluent to be used, said compound being selected from .....,  
with proviso that a photosensitive thermosetting-resin composition which comprises (A) ....., (B) ....., (C) ....., and (D) a multi-fuctional epoxy resin “containing at least two epoxy groups in the molecular unit thereof” (TEPIC: Nissan Chem., registered trademark), is excluded.*

**ISSUES**

**Issue 1:**

Whether the subject corrections/amendments (so-called “Disclaimer”) is considered to be within the matters described in the original specification or the like and is permissible under Patent law article 134-2 (reduction of scope of the claims).

**Issue 2:**

Whether the corrections/amendments to add the description of a trademark “TEPIC” is considered to reduce the scope of the claims (The product identified by the trademark may not define the technical scope definitely) and is permissible.

**COURT DECISION**

**Issue 1:**

Exclusion of specific prior art combinations does not make any modifications to the technical matter of the previously claimed invention described in the specification.

Thus, it is apparent that the correction with the exclusion does not add a new technical matter to the technical matters disclosed in the original specification, and that such a correction does not introduce a new technical matter in relation to the technical

matters to be grasped from the whole description of the specification by a skilled person in a comprehensive manner.

Accordingly, the correction is considered to have been made within the matters described in the original specification or the like.

**Issue 2:**

“TEPIC” in the correction is considered to cover all the products identified by the trademark “TEPIC” at the filing date of the earlier application. Thus, it cannot be said that products identified by “TEPIC” are indefinite.

To completely exclude the overlapping with the prior art, there is no other way. Thus, the use of the trademark “TEPIC” is permissible.