★★★ ＜第19回知的財産翻訳検定試験【第9回英文和訳】＞ ★★★

≪１級課題 -知財法務実務-≫

【解答にあたっての注意】

１．問題の指示により和訳してください。

２．解答語数に特に制限はありません。適切な個所で改行してください。

３．課題文に段落番号がある場合、これを訳文に記載してください。

４．課題は２題あります。それぞれの課題の指示に従い、２題すべて解答してください。

問1. アメリカ連邦巡回控訴裁判所（CAFC）のアメリカ特許権侵害事件控訴審判決から抜粋した以下の英文を日本語に翻訳してください。

※翻訳にあたっては以下を参考にしてください※

URAA：ウルグアイ・ラウンド協定法（Uruguay Round Agreements Act）翻訳ではURAAのままで構いません。

In re Fallaux：Fallaux事件と訳出してください。

Gilead：Gilead事件と訳出してください。

While often described as a court-created doctrine, obviousness-type double patenting is grounded in the text of the Patent Act. Section 101 reads: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, ... may obtain < a > patent therefor." 35 U.S.C. § 101 (emphasis < > added). Thus, § 101 forbids an individual from obtaining more than one patent on the same invention, i.e., double patenting.

If the applicant chooses to file separate applications for overlapping subject matter and to claim different priority dates for the applications, the separate patents will have different expiration dates since the patent term is measured from the claimed priority date. When such situations arise, the doctrine of obviousness-type double patenting ensures that a particular invention (and obvious variants thereof) does not receive an undue patent term extension.

Although this court has recognized that the doctrine of obviousness-type double patenting is less significant in post-URAA patent disputes, we have also recognized its continued importance. For example, in In re Fallaux, we recognized "that the unjustified patent term extension justification for obviousness-type double patenting" may have "limited force in ... many double patenting rejections today, in no small part because of the change in the Patent Act from a patent term of seventeen years from issuance to a term of twenty years from filing."

At the same time, the continued importance of the doctrine of obviousness-type double patenting where two patents have different expiration dates was recently reaffirmed by this court in Gilead. In Gilead, we held that a later-issued, but earlier-expiring patent could qualify as a double patenting reference, and thus invalidate an earlier-issued, but later expiring patent. Because both the reference and later expiring patents in Gilead issued after the 1995 URAA amendment, Gilead implicitly assumed the continued vitality of the obviousness-type double patenting doctrine. We now make explicit what was implicit in Gilead: the doctrine of obviousness-type double patenting continues to apply where two patents that claim the same invention have different expiration dates.

問２ 下記の英文は、米国特許出願における図面の意義などについて解説するものです。
全文を日本語に翻訳してください。

According to 35 USC §113, drawings are required "where necessary for the understanding of the subject matter sought to be patented." However, even if not necessary to understand the invention, the USPTO is authorized to require drawings when the nature of the invention "admits of illustration by drawing." Certain inventions, e.g., chemical compounds and processes, do not require drawings to help in their exposition. Nevertheless, it is prudent to include one or more drawings whenever it will likely assist the reader in understanding the invention, and the examiner may require them. For example, if the invention is a process, the practitioner would be wise to consider including a drawing in the form of a block diagram illustrating the steps of the process even though it is not, or may not be, required.

If neither the drawings nor the verbal disclosure in the patent (as originally filed) discloses an important element of the invention that the patentee claims is part of the invention, then the patent claim is fatally defective under 35 USC §112, para. 1. Ordinarily, the examiner will recognize this defect and will not permit that claim to issue. If the examiner should erroneously allow it to issue, then this defect will almost assuredly be exposed as part of the infringer's defense should that claim be asserted in patent infringement litigation.

It should be borne in mind that drawings are designed to teach the novelty of the invention, i.e., the patentable advance that goes beyond the prior art. Accordingly, what is typically set forth is an arrangement highlighting the concept but with quantitative parameters excluded. The relative proportions of the parts and spatial relationships represented in the drawings need not be accurate and may be roughly approximated. In electrical circuits, for example, it is a rare patent drawing that has resistor, capacitor

or inductor values quantitatively shown.